LETTERS PATENT FOR INVENTIONS.

THE

LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

WITH

EXAMPLES OF SPECIFICATIONS

AND A FEW PRECEDENTS

FOR THE TRANSFER OF INTERESTS IN LETTERS PATENT.

BY

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BARRISTER-AT-LAW.

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PREFACE.

In this edition I have cut out a great deal of matter which was strictly speaking irrelevant to the subject of Patent Law, and I have brought the subject up to date by including recent decisions, and the Acts of 1885, 1886, and 1888. I have also added a few examples of specifications which have successfully passed the ordeal of litigation, and which may be useful in considering the cases in which they were contested, and in drafting. The Precedents for the Transfer of interests in letters patent are limited to the most elementary instances—the valuable work of Mr. Morris on Patent Conveyancing making it unnecessary to treat the subject at greater length.

The great increase in commercial importance which was given to Patents by the Act of 1883, has opened the eyes of the legislature to the magnitude of the interests which are entrusted to the profession of Patent Agents, and to the imperative necessity in the interests of the public of ensuring competence and integrity in that profession. It is difficult to conceive any human pursuit which requires greater qualifications than that of

a Patent Agent—his legal acquirements must be considerable, he must be an expert in mechanics, chemistry, and the whole range of applied science, and he must be capable of applying this varied knowledge to the preparation of clear and precise specifications. One day he is engaged on the details of a locomotive, the next on a complex chemical process, and the third on a specification for electrical transformers. It is not too much to say that the legislature has not stepped in one day too soon in requiring that the profession of a Patent Agent should be placed on a par with the other learned professions, and that the public should be to some extent assured of reasonable competence in the men that they employ. In future Patent Agents will be registered or enrolled much in the same way that Barristers or Solicitors are, and thus not only will an opportunity be given to the governing body of testing the knowledge of the members which they admit, but a control will be exercised so as to ensure the high tone which should prevail in the profession.

Since the issue of the first edition of this work, although some changes have been introduced in the Practice, but little alteration has been made in the law of Letters Patent. *Siddell* v. *Vickers* may be pointed to as one of the most important cases, weakening as it does greatly the importance which has always been attached to *conformity* between the provisional and complete specifications, and further, limiting the effect of

section 5 of the Act of 1883, requiring a claim to the complete specification.

The personnel of Patent lawyers has been somewhat changed, though fortunately no very familiar faces have been removed by death.

As Attorney-General, Sir Richard Webster has been in a position to use his great experience in Patent Law in settling upon a safe and reasonable basis the law and practice before the comptroller and the law officers. Mr. Fletcher Moulton has taken his place as a leader in that branch of law where the attainments of a senior wrangler are of pre-eminent value. Sir Frederick Bramwell, now raised to the dignity of a baronet, Mr. Imray and Dr. Hopkinson still delight us with the ingenious theories by which they show with perfect impartiality that either or both sides in a patent action may be absolutely right. The great Author of "The Correlation of Forces" has retired from the bench, regretted greatly by his compeers, and by those members of the junior bar who had the honour to appear before him, and who will long remember the kindly consideration which they always received at his hands.

THOMAS TERRELL.

NEW COURT, TEMPLE.
8th January, 1889.

CONTENTS.

PAGE.

PREFACE v

TABLE OF CASES xv

THE LAW OF PATENTS.

INTRODUCTION 1

CHAPTER I.

THE PATENTEE 5
(First Inventor; First Importer.)

CHAPTER II.

THE CONSIDERATION 10
(The Actual Inventor; the First Introducer.)

CHAPTER III.

THE CONSIDERATION (*continued*) 22
(A New and Useful Invention.)

CHAPTER IV.

THE CONSIDERATION (*continued*) 56
(The Specification; the Title; the Provisional Specifications; the Complete Specification; the Claims.)

CHAPTER V.

PAGE
AMENDMENT OF SPECIFICATIONS 102
(Memorandum of Alteration; Disclaimer.)

CHAPTER VI.

OPPOSITION TO THE GRANT 116

CHAPTER VII.

THE GRANT 123
(The Address; the Recitals; the Grant; the Prohibition; the Conditions; the Construction of the Grant.)

CHAPTER VIII.

THE DEVOLUTION OF A PATENT 134
(By Operation of Law; by Assignments; by the Grant of Licences.)

CHAPTER IX.

EXTENSION OF TERM OF PATENT 145
(Jurisdiction of the Privy Council.)

CHAPTER X.

CONFIRMATION 162

CHAPTER XI.

REMEDIES OF THE PATENTEE AND OF THE PUBLIC..... 163
(Action for Infringement; Parties.)

CHAPTER XII.

PAGE
THE CAUSE OF ACTION 167
(Infringement; by Making; by Using; by Selling.)

CHAPTER XIII.

THE REMEDY 193
(Injunction; Damages; Account of Sales and Profits.)

CHAPTER XIV.

REVOCATION 208

CHAPTER XV.

INTERNATIONAL AND COLONIAL ARRANGEMENTS 213

PRACTICE.

CHAPTER I.

ACTION FOR INFRINGEMENT 215

CHAPTER II.

PARTIES 216

CHAPTER III.

INTERLOCUTORY INJUNCTION 218

CHAPTER IV.

STATEMENT OF CLAIM 221

CHAPTER V.

PAGE
PARTICULARS OF BREACHES 222

CHAPTER VI.

STATEMENT OF DEFENCE 227

CHAPTER VII.

PARTICULARS OF OBJECTIONS 229

CHAPTER VIII.

INTERROGATORIES 239

CHAPTER IX.

INSPECTION 246

CHAPTER X.

THE TRIAL 251

CHAPTER XI.

QUESTIONS FOR COURT AND JURY 264

CHAPTER XII.

CERTIFICATES 269

CHAPTER XIII.

PRACTICE ON PETITION FOR REVOCATION 277

CHAPTER XIV.

PRACTICE ON APPEAL 280

CHAPTER XV.

ACTION FOR INJUNCTION TO RESTRAIN THREATS 282

PAGE

FORMS OF PRACTICAL PROCEDURE..... 287

EXAMPLES OF SPECIFICATIONS AND CLAIMS 307

PROVISIONAL AND COMPLETE SPECIFICATION TO A PATENT FOR A NEW MECHANICAL APPLIANCE AND MODE OF OPERATING.—A very general Claim. 1885. No. 6205 307

COMPLETE SPECIFICATION.—Application of an Old Article in a New Manner. 1876. No. 4216 311

COMPLETE SPECIFICATION FOR A CHEMICAL INVENTION.—Four Processes.—Two Claims. 1878. No. 786..... 313

COMPLETE SPECIFICATION.—A new Principle, coupled with the method of carrying the Principle into effect—Supported by a Combination Claim. 1882. No. 3660 319

PRECEDENTS FOR THE TRANSFER OF INTERESTS IN LETTERS PATENT 322

SALE OF PATENT RIGHTS TO A PROPOSED COMPANY 322
1. Preliminary Agreement with Promoter 322
2. Agreement to Assign to the Company 323

AGREEMENT TO OBTAIN AND ASSIGN LETTERS PATENT FOR AN INVENTION IN CONSIDERATION OF A SUM OF MONEY AND DELIVERY OF CERTAIN NUMBER OF THE PATENT ARTICLES... 324

AGREEMENT BETWEEN JOINT OWNERS OF A PATENT FOR PARTITION 327

AGREEMENT FOR WORKING AND SELLING AN INVENTION, IN RESPECT OF WHICH AN APPLICATION FOR A PATENT HAS BEEN MADE, FOR THE JOINT BENEFIT OF THE INVENTOR AND ANOTHER PERSON 329

ASSIGNMENT OF A PATENT 334

NON-EXCLUSIVE LICENCE TO USE PATENTED INVENTION IN CONSIDERATION OF AN ANNUAL PAYMENT AND THE PURCHASE OF THE PATENTED ARTICLES FROM THE INVENTOR 344

EXCLUSIVE LICENCE FOR A DISTRICT 347

MORTGAGE OF A PATENT 349

APPENDIX.

PAGE

PATENTS, DESIGNS AND TRADE MARKS ACT, 1883 353

PATENTS, &c., ACT, 1885 378

PATENTS, &c., ACT, 1886 379

PATENTS, &c., ACT, 1888 380

PATENTS RULES, 1883 383

Rules Regulating Appeals to the Law Officers 394

First Schedule, List of Fees, &c. 396

Second Schedule, Forms, &c. 398

PATENT RULES, 1885 407

First Schedule, Fees, &c. 408

Second Schedule, Forms, &c. 409

PATENT RULES, 1886 413

RULES OF THE PRIVY COUNCIL 415

INDEX 417

TABLE OF CASES.

A.

PAGE

ADAIR'S Patent, *In re* (1881), L. R. 6 App. Cas. 176 .....151, 155
Adair *v.* Young (1879), L. R. 12 Ch. D. 13 .....188, 200
Adams *v.* North British Rail. Co. (1873), 29 L. T. R. N. S. 367 217
Adamson's Patent, *In re* (1856), 6 De G. M. & G. 420 ; 25 L. J. Ch. 456 ; 4 W. R. 473 117
Alcock *v.* Cook (1829), 5 Bing. 340 126
Allan's Patent, *In re* (1867), L. R. 1 P. C. 507 ; 4 Moo. P. C. C. N. S. 443 150
Allen's Patent, 2 Griffin P. C. 3 107
Allen *v.* Rawson (1845), 1 C. B. 551 (at p. 574) 14, 33
Ames *v.* Kelsey, 22 L. J. Q. B. 84 293
Anderton's Patent, 2 Griffin P. C. 25 395
Anglo-American Brush Light Co. *v.* Crompton, 34 Ch. D. 152 ; 56 L. J. Ch. 167 238
Arkwright *v.* Nightingale (1785), 1 Web. P. C. 60 (at p. 61) ; Dav. P. C. 37 81
Arnold's Patent, 2 Griffin P. C. 5 106
Aube's Patent, *In re* (1854), 9 Moo. P. C. C. 43 158
Aveling *v.* Maclaren (1881), L. R. 17 Ch. D. 139, n. 234
Avery's Patent, *In re*, 36 Ch. D. 307 .....8, 211
Axmann *v.* Lund (1874), 22 W. R. 789 ; L. R. 18 Eq. 330 ; 43 L. J. Ch. 655 ; 3 L. T. Rep. N. S. 119 140

B.

BACON *v.* Jones (1839), 4 My. & Cr. 433 201
—— *v.* Spottiswood (1839), 1 Beav. 382 207
Badische Aniline Co. *v.* Levenstein, L. R. 24 Ch. D. 156 .....81, 82
—— L. R. 29 Ch. D. 366 .....83, 272
—— L. R. 12 App. Cas. 723..... 84
Bailey's Patent, Griffin P. C. 254, 269, 270.....118, 150, 395
Bailey *v.* Roberton (1878), L. R. 3 App. Cas. 1055 ; 38 L. T. Rep. N. S. 854 ; 27 W. R. 477 .....68, 179
Bainbridge *v.* Wigley (1810), Higgins' Digest, 155 ; Par. Rep. Pat. 1829, p. 197 ; 18 Rep. Arts. 127 ; 1 Carp. P. C. 270 ; Higgins' Digest, 340.....63, 127

PAGE

Baird *v.* Moule's Patent Earth Closet Co. (1881), L. R. 17 Ch. D. 139, n. 234, 299
Bamlett *v.* Pickaloy, Griffin P. C. 42 31
Bancroft *v.* Wardon (1873), Romilly's Notes to Cases, 103 170
Barber *v.* Waldnok (1823), 1 Carp. P. C. 438; 1 C. & P. 567, reported under name of Barber *v.* Shaw; Holroyd Pat. 60; 1 Web. P. C. 126 11
Barker *v.* Grace (1847), 1 Ex. 339; 17 L. J. Ex. 122 79
Barlow *v.* Baylis, Griffin P. C. 44 ..... 43, 171
Barrett *v.* Barrett Screw Stopper Co., Limited, 1 P. O. R. 9..... 284
——— *v.* Vernon (1876), 45 L. T. Rep. N. S. 755; 25 W. R. 343 179
Bateman *v.* Gray (1853), Mac. P. C. 93 181
Bate's Patent, *In re* (1836), 1 Web. P. C. 739, n. 153
Bates & Redgate, *Ex parte* (1869), L. R. 4 Ch. 577; 38 L. J. Ch. 501; 17 W. R. 900; 21 L. T. Rep. N. S. 410 ..... 16, 17
Batley *v.* Kynock (1874), L. R. 19 Eq. 91 (at p. 231)...222, 248, 293
Beard *v.* Egerton (1846), 3 C. B. 97; 10 Jur. 643; 15 L. J. C. P. 270 20
——— (1849), 19 L. J. C. P. 36 (at p. 38); M. Dig. 75; 8 C. B. 165; 13 Jur. 1004 ..... 74, 267
Bock *v.* Justice, 2 Griffin P. C. 10 106
Bentley *v.* Keighley (1844), 7 M. & G. 652; 1 D. & L. 944; 8 Scott, N. R. 372; 13 L. J. C. P. 167 ..... 230, 232
Bossoman *v.* Wright (1858), 6 W. R. 719 138
Betts' Patents, *In re* (1862), 1 Moo. P. C. C. N. S. 49; 9 Jur. N. S.; 137; 11 W. R. 221; 7 L. T. Rep. N. S. 577; 1 N. R. 137..... 150, 152, 155, 158
Betts *v.* De Vitre (1864), 11 L. T. Rep. N. S. 533; 11 Jur. N. S. 9; 5 N. R. 165; 34 L. J. Ch. 289..... 204, 215, 276
——— V.-C. W. (1865), A. 119 202
——— (1865), 12 L. T. Rep. N. S. 51; 34 L. J. Ch. 291 202
——— (1868), L. R. 3 Ch. 429; 37 L. J. Ch. 325; 18 L. T. Rep. N. S. 165; 16 W. R. 529 ... 43, 166, 217
——— (1873), L. R. 6 H. L. 319 (at p. 321); 21 W. R. 705 ..... 203, 215
——— *v.* Gallais (1870), L. R. 10 Eq. 392; 18 W. R. 945; 22 L. T. R. N. S. 841 206
——— *v.* Menzies (1857), 3 Jur. N. S. 357 ..... 42, 195
——— (1859), 1 Ell. & Ell. 990; 28 L. J. Q. B. 361; 5 Jur. N. S. 1164 37
——— (1862), 10 H. L. Cas. 117; 31 L. J. Q. B. 233; 9 Jur. N. S. 29; 11 W. R. 1; 7 L. T. Rep. N. S. 110 ..... 42, 43, 77, 80
——— *v.* Neilson (1868), L. R. 3 Ch. 429; 37 L. J. Ch. 321; 18 L. T. Rep. N. S. 159; 16 W. R. 524 ... 40, 43, 88
——— (1865), 6 N. R. 221; 12 L. T. Rep. N. S. 489; 13 W. R. 804 ..... 183, 217

PAGE
Botts *v.* Neilson (1871), L. R. 5 H. L. 1 ; 40 L. J. Ch. 317 ; 19 W. R. 1121 256
——— *v.* Wilmott (1871), L. R. 6 Ch. 239 ; 19 W. R. 369 ; 25 L. T. Rep. N. S. 188 ..... 142, 170, 191, 192, 200, 220, 258
Bowley *v.* Hancock (1856), 6 De G. M. & G. 391 (at p. 402) ; 2 Jur. N. S. 239 ; 4 W. R. 334 26
Bickford *v.* Skewes (1837), 1 Web. P. C. 211 196
——————— (1841), 1 Q. B. 938 ; 1 G. & D. 736 ; 6 Jur. 167 ; 10 L. J. Q. B. 302 ; 1 Web. P. C. 214 (at p. 218) 74, 94, 267
Binney *v.* Feldtman, Griffin P. C. 50 75
Birch *v.* Mather, 22 Ch. App. 629 299
Bircot's case (15 Eliz.), 3 Inst. 184 ; 1 Web. P. C. 31, n. 27
Blake's Patent, *In re* (1873), L. R. 4 P. C. 535 ; 9 Moo. P. C. C. N. S. 373 158
Bloxham *v.* Elsee (1825), 1 C. & P. 558 ; Ry. & Moo. 187 ; 1 Carp. P. C. 434 .....55, 267
——————— (1827), 1 Web. P. C. 132, n. ; 6 B. & C. 169 ; 9 Dow. & Ry. 215 ; 1 Carp. P. C. 440.....11, 60, 135, 165, 216
Bodmer's Patent, *In re* (1853), 1 Moo. P. C. C. 469 ; 8 Moo. P. C. C. 282 ; 6 M. D. 114 158
Booth *v.* Kennard (1856), 1 Hurl. & Norm. 527 ; 26 L. J. Ex. 23 ; 3 Jur. N. S. 21 ; 28 L. T. Rep. 160 ; 5 W. R. 85..... 25
——————— (1857), 2 Hurl. & Norm. 84 ; 26 L. J. Ex. 305 ; 5 W. R. 607 ; 29 L. T. Rep. 163 80
Boulton *v.* Bull (1795), 2 H. Blac. 463 (at p. 491) ; Dav. P. C. 162 ; 1 Carp. P. C. 117..... 19, 23, 40, 53, 87
——— *v.* Watt (1795), 2 H. Bl. 468 26
——— *v.* Keyworth (1857), 7 Ell & Bl. 725 ; 3 Jur. N. S. 817 ; 5 W. R. 686 ; 29 L. T. Rep. 194 33
Bovill *v.* Crate (1865), L. R. 1 Eq. 388 202
—— *v.* Smith (1866), L. R. 2 Eq. 459 242
—— *v.* Goodier (1866), L. R. 2 Eq. 195 ; 35 Beav. 427 ; 35 L. J. Ch. 432 263
—— *v.* Hadley (1864), 17 C. B. N. S. 435 ; 10 L. T. Rep. N. S. 650 ; 4 N. R. 464 270
—— *v.* Moore (1816), Dav. P. C. 361, 400 ; 2 Coop. C. P. 56, n. 92, 95, 179. 246
—— *v.* Pimm (1856), 11 Ex. 740 ..... 27, 264
Bower *v.* Hodges (1853), 22 L. J. C. P. 194 (at p. 198) ; 13 C. B. 765 ; 17 Jur. 1057 ; 1 Ch. R. 807 142
Bowman *v.* Taylor (1834), 2 A. & E. 278 ; 4 N. & M. 264 137
Bramah *v.* Hardcastle (1789), Holroyd, 81 ; 1 Carp. P. C. 168 ; 1 Web. P. C. 44, n. 51
Branden's Patent, L. R. 9 App. Cas. 589 ; 53 L. J. P. C. 84..... 145
Bray *v.* Gardner, 34 Ch. D. 668 111
Brereton *v.* Richardson, 1 P. O. R. 166 171
Bridson's Patent, *In re* (1852), 7 Moo. P. C. C. 499 161
——— *v.* Benecke, 12 Beav. 1 ; 34 Lond. Jour. 295 ..... 201, 219
——— *v.* M'Alpine (1845), 8 Beav. 229 ; L. R. 4 Ch. 289...196, 219

PAGE

Brook *v.* Aston (1857), 8 El. & Bl. 178 (at p. 485); 4 Jur. N. S. 279; 27 L. J. Q. B. 145; 6 W. R. 42 ..... 30, 31
Brooks *v.* Ripley (1831), 2 Lond. Jour. C. S. 35; Web. P. C. 102 258
Brown's Patent, 2 Griffin P. C. 1 104
Brunton *v.* Hawkes (1821), 4 B. & Ald. 541 (at p. 550); 1 Carp. P. C. 405 ..... 33, 51, 61, 62, 126
Bulnois *v.* Mackenzie (1837), 4 Bing. N. C. 132 231
Burney *v.* United Telephone Co., L. R. 28 Ch. D. 394 285
Bush *v.* Fox (1852), Macrory's P. C. 152 (at p. 164); 23 L. J. Ex. 257 30
—— —— (1856), 5 H. L. Cas. 707; 2 Jur. N. S. 1029; 25 L. J. Ex. 251; Macrory's P. C. 178 ..... 30, 80
Butler's case (about 1680), Vent. 344 210

C.

Caldwell *v.* Vanvlissingen (1851), 9 Ha. 415; 16 Jur. 115; 21 L. J. Ch. 97 ..... 166, 171, 187, 192
Campion *v.* Benyon (1821), 6 B. Mo. 71; 3 B. & B. 5 60
Canham *v.* Jones (1813), 2 Ves. & B. 218 129
Cannington *v.* Nuttall (1871), L. R. 5 H. L. 205; 40 L. J. Ch. 739 ..... 34, 177
Cardwell's Patent, *In re* (1856), 10 Moo. P. C. C. 488 (at p. 490) 149
Carpenter *v.* Smith (1841), 1 Web. P. C. 530 (at p. 538)...33, 37, 50
—— —— *v.* Walker (1842), 1 Web. P. C. 268, n. 233
Carr's Patent, *In re* (1873), L. R. 4 P. C. 539 153
Challender *v.* Royle, 36 Ch. D. 425 ..... 282, 283, 284, 285
Chambers *v.* Crichley (1864), 33 Beav. 374 140
Chandler's Patent, Griffin P. C. 270, 271 ..... 388, 394, 395
Chanter *v.* Dewhurst (1844), 12 M. & W. 823; 13 L. J. Ex. 198 135, 142
—— *v.* Johnson (1845), 14 M. & W. 408 (at p. 411); 14 L. J. Ex. 289 136
—— *v.* Leese (1838), 1 Web. 295; 4 M. & W. 295; 1 H. & H. 224 ..... 138, 142
Cheeseborough's Patent, Griffin P. C. 303 108
Chollett *v.* Hoffman (1857), 7 Ell. & B. 686; 26 L. J. Q. B. 249; 3 Jur. N. S. 935; 5 W. R. 573; 29 L. T. Rep. 158 144
Church's Patent, Griffin P. C. 256 145
Clarke's Patent, *In re* (1870), 7 Moo. P. C. C. N. S. 255; L. R. 3 P. C. 421 155
Clarke *v.* Adie (1875), L. R. 10 Ch. App. Cas. 667; 45 L. J. Ch. 228 173
—— —— (first appeal), 33 L. T. Rep. N. S. 295 173
—— —— —— (1877), L. R. 2 App. Cas. 315; 46 L. J. Ch. 585; 36 L. T. Rep. N. S. 923; 26 W. R. 45 ... 80, 101, 176, 257
—— —— —— (second appeal) (1876), L. R. 3 Ch. D. 134 (at p. 144); 24 W. R. 1007 138
—— —— —— —— (1877), L. R. 2 App. Cas. 423; 46 L. J. Ch. 598; 37 L. T. Rep. N. S. 1; 46 W. R. 47 ..... 76, 138

PAGE
Clarke *v.* Ferguson (1859), 1 Giff. 184 219
Clothworkers of Ipswich case (1615), Godbolt R. 252 (at p. 253); 1 Roll. R. 4; 1 Web. P. C. 6 ..... 6, 13
Cochrane's Patent, Griffin P. C. 304 395
Cochrane *v.* Smethurst (1816), Davy's P. C. 354; 1 Stark. 205 . 60
Cooking's Patent, 2 P. O. R. 151 145
Codd's Patent, Griffin P. C. 307 ..... 107—110, 390
Codd *v.* Brutby, Griffin P. C. 56 110
Coles *v.* Bayliss, 3 P. O. R. 178 71
Collard *v.* Allison (1839), 4 My. & Cr. 433 219
Cook *v.* Pearce (1844), 8 Q. B. 1054; 8 Jur. 499; 13 L. J. Q. B. 189 61
Cooper and Ford's Patent, Griffin P. C. 275, 276 .....388, 394
Cornish *v.* Keene (1835), 1 Web. P. C. 501 (at p. 507); 2 Carp. P. C. 314 .....12, 13, 38, 51, 55, 267
——— (1837), 2 Bing. N. C. 570; 4 Scott, 337; 2 Hodges, 281; 6 L. J. C. P. 225; 1 Web. P. C. 513; 2 Carp. P. C. 371; 6 Rep. Arts. 4th Series, 102 ..... 37, 267
Crane *v.* Price (1842), 1 Web. P. C. 393; 4 Y. & G. 580; 5 Scott, N. R. 336; 12 L. J. C. P. 81; 2 Carp. P. C. 669; 18 Rep. Arts. 4th Series, 102 ..... 33, 54
Croll *v.* Edge (1850), 9 C. B. 479; 14 Jur. 553; 19 L. J. C. P. 261; M. Dig. 194 ..... 63, 170
Crompton *v.* Anglo-American Brush Light Co., 35 Ch. D. 283; 56 L. J. Ch. 802 238
——— *v.* Ibbertson (1828), 1 Web. P. C. 85; Dan. & Lloyd, 33; 1 Carp. P. C. 460 94
Cropper *v.* Smith, Griffin P. C. (at p. 62) 75
——— L. R. 28 Ch. D. 148 109
——— L. R. 26 Ch. D. 700 ..... 136, 280
——— L. R. 10 App. Cas. 249 ..... 137, n.
Crosskill *v.* Evory (1848), 10 L. T. R. 459 195
Crossly *v.* Beverley (1829), 9 B. & C. 62; 1 Web. P. C. 106, 112, 119; 3 C. & P. 513; Mo. & Mal. 283; 1 Russ. & My. 166 ..... 72, 84, 92
——— *v.* Derby Gas Co. (1834), 4 L. J. Ch. 25; 1 Web. P. C. 119 ..... 202, 206
——— *v.* Dixon (1863), 10 H. L. Cas. 293; 9 Jur. N. S. 607; 11 W. R. 716; 8 L. T. Rep. N. S. 260; 1 N. R. 540; 32 L. J. Ch. 617 ..... 139, 142
——— *v.* Potter (1853), Macrory, P. C. 240 ..... 63, 88
——— *v.* Stewart (1863), 1 N. R. 426 239
——— *v.* Tomey (1876), L. R. 2 Ch. D. 533; 34 L. T. R. N. S. 476 240
Croysdale *v.* Fisher, 1 P. O. R. 17 ..... 31, 37
Cummings' Patent, Griffin P. C. 277 ..... 118, 395
Curtis *v.* Platt (1863), 3 Ch. D. 135, n.; 19 Newt. Lond. Jour. N. S. 44; 8 L. T. Rep. N. S. 657 ..... 32, 181
——— (1864), 11 L. T. Rep. N. S. 245 169
——— (1866), 35 L. J. Ch. 852; L. R. 1 H. L. 337 ... 168, 177, 179, 268
Cutler *v.* Bower (1848), 11 Q. B. 973; 12 Jur. 721; 17 L. J. Q. B. 217 139

D.

PAGE

Dangerfield *v.* Jones (1865), 13 L. T. Rep. N. S. 142 33
Darcy *v.* Allin (1602), 1 Web. P. C. (at p. 6); Noy R. 173 (at p. 182) 6, 18, 36, 52
Dart's Patents, Griffin P. C. 307 106
Davenport *v.* Goldberg (1865), 2 Hem. & M. 282; 5 N. R. 584 195
——— *v.* Jepson (1862), 1 N. R. 173, 307 ..... 195, 249
——— *v.* Richards (1860), 3 L. T. Rep. N. S. 503 ..... 216, 256
David & Wodley's Patent, 2 Griffin P. C. 26 118
Daw *v.* Eley (1865), 2 H. & M. 725 ..... 242, 244
——— (1865), L. R. 1 Eq. 38; 13 L. T. R. N. S. 399; 14 W. R. 48 235
——— L. R. 1 Eq. 38 235
——— 2 H. & M. 725 ..... 242, 244
——— (1867), L. R. 3 Eq. 496; 36 L. J. Ch. 482; 15 L. T. Rep. N. S. 559 202
De la Rue *v.* Dickenson (1857), 7 E. & B. 738; 3 Jur. N. S. 841; 5 W. R. 704; 29 L. T. R. 194 ..... 167, 267
Denley *v.* Blore (1851), 38 Lond. Jour. 224 ..... 165, 166, 217, 276
Dent *v.* Turpin (1861), 2 J. & H. 139 164
Dering's Patent, *In re* (1880), 13 Ch. D. 393 17
Derosne's Patent, *In re* (1844), 2 Web. P. C. 1; 4 Moo. P. C. C. 416 ..... 148, 151
Derosne *v.* Fairie (1835), 1 Web. P. C. 154; 1 Mo. & Rob. 457... 165
De Vitre *v.* Betts (1873), L. R. 6 H. L. 319; 21 W. R. 705...203, 215
Dircks *v.* Mellor (1845), 26 Lond. Jour. 268 219
Dixon *v.* London Small Arms Co. (1875), L. R. 10 Q. B. 130; L. R. 1 App. Cas. 632; 31 L. T. Rep. N. S. 830; L. R. 1 Q. B. D. 384 ..... 132, 133, 185
——— (1876), L. R. 1 App. Cas. 632; 46 L. J. Q. B. 617; 35 L. T. R. N. S. 559; 25 W. R. 142 185
Dollond's Patent (1758), 1 Web. P. C. 43; 2 H. Bl. 469, 470, 487; Dav. P. C. 170, 171, 172, 199; 1 Carp. P. C. 28..... 11, 40
Downton's Patent, *In re* (1839), 1 Web. P. C. 565 161
Drake *v.* Muntz Metal Co., 3 P. O. R. 43 249
Driffield, &c., Pure Linseed Cake Co. *v.* Waterloo Mills, &c., Co., 31 Ch. D. 638 283
Dudgeon *v.* Thompson (1874), L. R. 3 App. Cas. 34; 22 W. R. 464; 30 L. T. Rep. N. S. 244 ..... 76, 114, 178, 219, 291
Duncan & Wilson's Patent, 1 P. O. R. 257..... 152
Dundon's Patent, Griffin P. C. 278 118
Dunnicliff *v.* Mallett (1859), 7 C. B. N. S. 209; 1 L. T. Rep. N. S. 514; 6 Jur. N. S. 252; 29 L. J. C. P. 70; 8 W. R. 260...163, 216

E.

Eadie's Patent, Griffin P. C. 274 388
East India Co. *v.* Kynaston (1820), 3 Bl. App. Cas. 153 247
——— *v* Sandys (1728), Skin. 225..... 123

PAGE
Edgeberry *v.* Stevens (1691), 1 Web. P. C. 35; 2 Salk. 447; Comb. 84; Dav. P. C. 36; 1 Carp. P. C. 35 ..... 7, 19, 52
Edison & Swan Electric Light Co. *v.* Woodhouse, 32 Ch. D. 520 70
——— ——— ——— Griffin P. C. 90, 95...51, 72
Edison & Swan United Electric Light Co. *v.* Holland, L. R. 33 Ch. D. 497 227
Edison Telephone Co. *v.* India Rubber Co. (1881), L. R. 17 Ch. D. 137 234
Edmund's Patent, Griffin P. C. at p. 283 117
Ehrlich *v.* Ihlee, 56 L. T. N. S. 819 234
——— W. N. 3 March, 1888 55
Electric Telegraph Co. *v.* Nott (1847), 4 C. B. 462; 11 Jur. 590; 16 L. J. C. P. 174; 2 Coop. 41...200, 224
——— *v.* Brett (1851), 10 C. B. 838; 20 L. J. C. P. 123; 15 Jur. 579..... 163, 181, 216
Elliott *v.* Aston (1840), 1 Web. P. C. 222 267
Ellwood *v.* Christy (1864), 10 Jur. N. S. 1079; 17 C. B. N. S. 754; 34 L. J. C. P. 130; 13 W. R. 54; 11 L. T. Rep. N. S. 342; 5 N. R. 12 140
Elmslie *v.* Boursier (1869), L. R. 9 Eq. 217; 39 L. J. Ch. 328; 18 W. R. 665..... 190
Elsey *v.* Butler, Griffin P. C. 96 225
Erard's Patent, *In re* (1835), 1 Web. P. C. 557 (at p. 559); 5 Rep. Arts. N. S. 58..... 148
Evans & Otway's Patent, Griffin P. C. 279 ..... 118, 388
——— *v.* Rees (1842), 2 Q. B. 334 165
Everitt's opposition to L'Oiseau's Patent, 2 Griffin P. C. 28 120
——— Patent, 2 Griffin P. C. 36 120

F.

Feather *v.* R. (1865), 6 B. & S. 257; 35 L. J. Q. B. 200; 12 L. T. N. S. 114..... 132, 185
Felton *v.* Greaves (1829), 3 C. & P. 611..... 56, 61, 127
Fiechter's Patent, Griffin P. C. 284 117
Finnigan *v.* James (1875), L. R. 19 Eq. 72..... 241
Fisher *v.* Dewick (1838), 1 Web. P. C. 267; 1 Web. P. C. 551, n. 230, 231, 232, 233
Flower *v.* Lloyd (1876), W. N. 1876, 169, 230; 20 Sol. Journ. 1876, 860 ..... 224, 236, 247
——— (1877), W. N. 1877, 132; Johnson's P. M. 245 ..... 179, 294, 298
Forsyth *v.* Riviere (1819), 1 Web. P. C. 97; Chit. Prerog. Ca. 182; 1 Carp. P. C. 401..... 179
Fowler *v.* Gaul, Griffin P. C. 99 235
Fox *v.* Dellestable (1866), 15 W. R. 194..... 28
Foxwell *v.* Bostock (1864), 12 W. R. 723; 10 L. T. R. N. S. 144; 4 De G. J. & S. 298...33, 66, 99, 113, 173, 176, 301
——— *v.* Webster (1863), 3 N. R. 103; 4 De G. J. & S. 77; 9 L. T. N. S. 528; 12 W. R. 186; 10 Jur. N. S. 137 201

PAGE

Fromson *v.* Loo (1878), L. R. 9 Ch. D. 48 ; 27 W. R. 183 .. 51, 54, 184, 198, 202

Fuzoo Vesta Co. *v.* Bryant & May, 34 Ch D. 458 111

G.

Galloway *v.* Blondon (1839), 1 Web. P. C. 268, n. ; 1 Web. P. C. 521 ..... 51, 231, 232

Galloway's Patent, *In re* (1843), 1 Web. P. C. 724 ; 7 Jur. 453..... 153, 156

Gamble *v.* Kurtz (1846), 3 C. B. 425 179

Gandy *v.* Reddaway, 2 P. O. R. 49 97

Gardner *v.* Broadbent (1856), 2 Jur. N. S. 1041 ; 4 W. R. 767... 194, 195, 218, 220

Gare's Patent (*In re*), 26 Ch. D. 105..... 104, 115

Garthwaite's Patent, Griffin P. C. 284 ..... 118, 388

Gaulard *v.* Lindsey, W. N. Feb. 4th, 1888 ..... 111, 283

Germ Milling Co. *v.* Robinson, 55 L. J. Ch. 287 ; Griffin P. C. 103..... 247, 249, 292

Gibson *v.* Brand (1841), 1 Web. P. C. 627 50

——————— (1842), 4 M. & G. 179 ; 4 Scott, N. R. 844 ; 1 Web. P. C. 631 ; 11 L. J. C. P. 177 ..... 26, 95, 166

Gillett *v.* Green (1841), 7 M. & W. 347 ; 9 Dowl. 219 : 1 Web. P. C. 271 ; 10 L. J. Ex. 124 270

——— *v.* Wilby (1839), 9 C. & P. 334 ; 1 Web. P. C. 270 172

Glossop's Patent, Griffin P. C. 286 121

Goucher's Patent, *In re* (1865), 2 Moo. P. C. C. N. S. 532 161

Goucher *v.* Clayton, 34 L. J. Ch. 239 ; 11 Jur. N. S. 107 and 462..... 139

Goulard & Gibbs' Patent, 34 Ch. D. 396 ; 56 L. J. Ch. 606 278

Graham *v.* Campbell (1878), L. R. 7 Ch. D. 490 218

Granger, *Ex parte* (1812), Godson on Patents, 2nd ed. p. 225 ... 135

Greaves *v.* Eastern Counties Rail. Co. (1859), 1 E. & E. 961 ; 28 L. J. Q. B. 290 ; 5 Jur. N. S. 733 273

Green's Patent, Griffin P. C. 286 119

Grover and Baker Sewing Machine Co. *v.* Millard (1862), 8 Jur. N. S. 713 (at p. 714)..... 139

H.

Haddan's Patent, 54 L. J. Ch. 126 ; 2 Griffin P. C. 12 ... 108, 215, 240, 277

Hall *v.* Jarvis (1822), 1 Web. P. C. 100 25

Hallett *v.* Hague (1831), 2 B. & Ad. 370 (at p. 377)..... 74

Halsey *v.* Brotherhood, 15 Ch. D. 514..... 283, 285

——————— 19 Ch. D. 386..... 285

PAGE
Hancock *v.* Moulton (1852), Johnson's Patentees' Manual, 3rd ed. p. 208; M. Dig. 506 ..... 181, 200 202
——— *v.* Somervoll (1851), 39 Newton's Lond. Jour. 158..... 33
Hardy's Patent, *In re* (1849), 6 Moo. P. C. C. 441; 13 Jur. 177. 153
Harmar *v.* Playne (1809), Dav. P. C. 311 (at p. 316); 11 East, 101..... 71, 81, 87
Harris *v.* Rothwell, Griffin P. C. 109 235
——— ——— 35 Ch. D. 416; 56 L. J. Ch. 459 47
Harrison *v.* The Anderston Foundry Co. (1876), L. R. 1 App. Ca. 574 (at p. 581); 2 S. C. L. R. 4th series, 857 33, 76—98, 173
Harwood *v.* Great Northern Rail. Co. (1860), 29 L. J. Q. B. 193; 6 Jur. N. S. 993 ..... 32, 37
——— ——— (1865), 11 H. L. Cas. 654; 35 L. J. Q. B. 27; 12 L. T. Rep. N. S. 771; 14 W. R. 1 32
Haslam Foundry Co. *v.* Goodfellow, 37 Ch. D. 121..... 111
——— ——— *v.* Hall, 20 Q. B. D. 491 271
——— *v.* Hall, 5 P. O. R. 144 273
Hassall *v.* Wright (1870), 40 L. J. Ch. 145; L. R. 10 Eq. 509; 18 W. R. 821 ..... 144, 216
Hasting's Patent (1567), 1 Web. P. C. 6; Noy, R. 182 ..... 18, 36
Haworth *v.* Hardcastle (1834), 1 Web. P. C. 480 (at p. 483); 4 M. & Sc. 720; 1 Bing. N. C. 182; 3 L. J. C. P. 311...54,74,127
Hayne *v.* Maltby (1789), 3 T. R. 438; Dav. P. C. 156...137, 138, 139
Hayward *v.* Hamilton, Griffin P. C. 115 33
———*v.* Pavement Light Co., Griffin P. C. 124..... 219
Hearson's Patent, Griffin P. C. 309 107
——— ——— 266..... 124
Heath's Patent, *In re* (1853), 8 Moo. P. C. C. 217; 2 Web. P. C. 247; M. Dig. 114..... 154, 158
Heath and Frost's Patent, Griffin P. C. 311 ..... 109—121
——— *v.* Smith (1854), 2 Ell. & Bl. 256; 2 C. L. R. 1584; 18 Jur. 601; 23 L. J. Q. B. 166; 2 Web. P. C. 268... 40, 50
——— *v.* Unwin (1842), 15 Sim. 553; 10 M. & W. 684 168, 232, 237
——— ——— (1845), 14 L. J. Ex. 153; 2 Web. P. C. 221; 13 M. & W. 583 168
——— ——— (1852), 22 L. J. C. P. 7; 2 Web. P. C. 236; 12 C. B. 522; 25 L. J. C. P. 19 ..... 80, 84, 93, 169
Henderson *v.* Mostyn Copper Co., L. R. 3 C. P. 202 143
Herbert's Patent, *In re*, L. R. 1 P. C. 399; 4 Moo. P. C. C. N. S. 300 150
Hesse *v.* Stevenson (1803), 3 B. & P. 565 135
Heugh *v.* Chamberlain (1877), 25 W. R. 742..... 140
Higgs *v.* Godwin (1858), 27 L. J. Q. B. 421; 5 Jur. N. S. 97; Ell. Bl. & Ell. 529.....25, 183
Hill's Patent, *In re* (1863), 1 Moo. P. C. C. N. S. 258; 9 Jur. N. S. 1209; 12 W. R. 25; 9 L. T. Rep. N. S. 101 ..... 151, 152, 153, 156, 161
Hill *v.* Thompson (1817), 1 Web. P. C. 235; 3 Mer. 622, 626 ... 33, 55, 63, 74, 220, 267
——— ——— (1818), 2 B. Moo. 424; 8 Taunt. 375; 1 Web. P. C. 239.....40, 51, 126, 127, 178

PAGE

Hills *v.* Evans (1862), 31 L. J. Ch. 457; 8 Jur. N. S. 525; 6 L. T. Rep. N. S. 90; 4 De G. F. & J. 288 ... 45, 80, 105, 215, 264
—— *v.* London Gaslight Co. (1857), 27 L. J. Ex. 60 79
—— —— (1860), 29 L. J. Ex. 409; 5 H. & N. 312 (at p. 336) 25, 41, 45, 51
Hindo *v.* Osborne, Griffin P. C. 127 280
Hinks *v.* Safety Lighting Co. (1876), L. R. 4 Ch. D. 607 (at p. 612); 46 L. J. Ch. 185; 36 L. T. Rep. N. S. 391 ..... 75, 80
Hocking *v.* Hocking, Griffin P. C. 129 227
—— *v.* Frazer, Griffin P. C. 129 281
Hoffman *v.* Posthill (1869), L. R. 4 Ch. App. Cas. 673; 17 W. R. 901; 20 L. T. Rep. N. S. 893 ..... 243, 244
Holland *v.* Fox (1853), 1 C. L. R. 440; 1 W. R. 448...230, 232, 233
Holmes *v.* London and North Western Rail. Co. (1852), 22 L. J. C. P. 57; Macrory's P. C. 13; 12 C. B. 831 ..... 79, 183
Honiball *v.* Bloomer (1854), 2 Web. P. C. 199; 10 Ex. 538; 1 Jur. N. S. 188; 24 L. J. Ex. 11; 3 W. R. 71; 3 C. L. R. 167; M. Dig. 46 ..... 50, 273
Hornblower *v.* Boulton (1799), 8 T. R. 95; Dav. P. C. 221; 1 Carp. P. C. 156 ..... 23, 27, 72, 81
Horton *v.* Mabon, 12 C. B. N. S. 437 321
Hoskin's Patent, Griffin P. C. 291 388
Houghton's Patent, *In re* (1871), 7 Moo. P. C. C. N. S. 309; L. R. 3 P. C. 461 155
Household Iron Co. *v.* Neilson (1842), 1 Web. P. C. 673, 676, 718, n.; 9 C. & F. 788 ..... 23, 42, 51, 60, 84
Household *v.* Fairburn, Griffin P. C. 131 284
How *v.* McKernan (1862), 30 Beav. 546 239
Huddart *v.* Grimshaw (1803), Dav. P. C. 265; 1 Web. P. C. 85; Carp. P. C. 200 ..... 33, 256
Hughes' Patent, *In re* (1879), L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; 27 W. R. 493 150
Hull *v.* Bolland (1856), 25 L. J. Ex. 304; 1 H. & N. 134...223, 233, 234, 261
—— *v.* Jarvis, 1 Web. P. C. 100 25
Hutchinson's Patent, *In re* (1861), 14 Moo P. C. C. 364 155

J.

Jackson *v.* Duke of Newcastle (1864), 33 L. J. Ch. 698 250
—— —— *v.* Needle, Griffin P. C. 133 219
—— —— *v.* Wolstenhulmes, Griffin P. C. 134 175
Jessop's case (before 1795), Cit. 2 H. Bl. 490; Dav. P. C. 182, 203; 1 Web. P. C. 42, n. 127
Johnson's Patent, *In re* (1871), 8 Moo. P. C. C. N. S. 282; L. R. 4 P. C. 75 ..... 152, 158
—— —— —— (1877), 8 Moo. P. C. C. N. S. 291; L. R. 5 Ch. D. 503; 46 L. J. Ch. 555 152
—— —— —— *In re*, 5 Ch. D. 503 ..... 104, 115

PAGE
Johnson and Atkinson's Patent, *In re* (1873), L. R. 5 P. C. 87 ...154
Jones's Patent, *In re* (1854), 9 Moo. P. C. C. 41 161
——————— Griffin P. C. 313 106
——————— 2 Griffin P. C. 33..... 118
——————— Griffin P. C. 265 124
Jones *v.* Borgor (1843), 1 Web. P. C. 504; 5 M. & G. 208; 6 Scott, N. R. 208; 7 Jur. 883; 12 L. J. C. P. 179 ... 230, 232, 235, 237
——— *v.* Loes (1856), 1 H. & N. 189; 2 Jur. N. S. 645; 26 L. J. Ex. 9 142
——— *v.* Pearce (1831), 2 Coop. 58 220
——————— (1832), 1 Web. P. C. 122; 1 Carp. P. C. 524; 1 Lon. Jour. C. S. 215..... 25, 51, 183
Jordan *v.* Moore (1866), L. R. 1 C. P. 624; 12 Jur. N. S. 766; 35 L. J. C. P. 268; 14 W. R. 769 32
Jupe *v.* Pratt (1837), 1 Web. P. C. 145 ..... 22, 181

K.

Kay's Patent, *In re* (1839), 1 Web. P. C. 568; 3 Moo. P. C. C. 24 153
Keynaston *v.* East India Co. (1819), 3 Swan. 248 247
Knowles *v.* Bovill (1870), 22 L. T. Rep. N. S. 70 142
Kurtz *v.* Spence, 33 Ch. D. 579 283
——————— 36 Ch. D. 770 .....283, 284
Kynock *v.* National Arms Co., Limited (1877), 37 L. J. Rep. N. S. 31; 26 W. R. 22 115

L.

Lake's Patent, 2 Griffin P. C. 16 395
——————— 2 Griffin P. C. 35 121
Lamb *v.* Nottingham Manufactures Co., Limited, M. R. 14th March, 1874, B. 776 296
Lancaster's Patent, Griffin P. C. 293 119
Lang *v.* Gisborne (1862), 31 Beav. 133; 8 Jur. N. S. 736; 31 L. J. Ch. 769; 10 W. R. 638; 6 L. T. Rep. N. S. 771 46
Lawrence *v.* Perry, Griffin P. C. 143, 148 .....45, 111
Lea *v.* Saxby (1875), 32 L. T. R. N. S. 731 240
Ledgard *v.* Bull, 11 App. Cas. 648 230
Lewin *v.* Brown (1860), 14 W. R. 640 140
Lewis *v.* Davis (1829), 1 Web. P. C. 488; 3 C. & P. 502; 1 Carp. P. C. 471 33
——— *v.* Marling (1829), 10 B. & C. 22; 4 C. & P. 56; 5 M. & R. 66; 1 Web. P. C. 493; 1 Carp. P. C. 478 ...12, 37, 54, 88, 94, 126, 127
Liardet *v.* Johnson (1778), 1 Web. P. C. 52; Bull. N. P. 78; 1 Carp. P. C. 35..... 36, 93

PAGE
Lister *v.* Eastwood (1864), 9 L. T. R. N. S. 766 177
—— *v.* Lonther (1857). 8 E. & B. 1004 (at p. 1017); 3 Jur. N. S. 433, 811; 5 W. R. 603: 29 L. T. Rep. 142.....28, 96, 174, 175, 176
—— (1858), 27 L. J. Q. B. 295; 4 Jur. N. S. 947; 4 K. & J. 425; 8 E. & B. 1031 33
—— *v.* Norton, Griffin P. C. 148 .....48, 219, 239
L'Oiseau & Pierrard's Patent, 2 Griffin P. C. 36 118
London & Leicester Hosiery Co. *v.* Griswold, Griffin P. C. 154 ... 137
Losh *v.* Hague (1837), 1 Web. P. C. 200.....50, 55, 199, 201
—— (1839), 7 D. P. C. 495; 5 M. & W. 387; 3 Jur. 409; 8 L. J. Ex. 251; 7 Dowl. 495 273
Lovell *v.* Hicks (1836), 2 Y. & C. 46; 5 L. J. Ex. 101 140
Lowe's Patent, *In re* (1846), 10 Jur. 363 154
Lucas *v.* Miller, Griffin P. C. 156 68
Luke's Patent, Griffin P. C. 294 118

M.

M'Alpine *v.* Mangnall (1846), 15 L. J. C. P. 298; 3 C. B. 496... 135
M'Cormick *v.* Gray (1861), 7 H. & N. 25; 31 L. J. Ex. 42; 9 W. R. 809; 4 L. T. Rep. N. S. 832 .....52, 169
M'Dougal's Patent, *In re* (1867), L. R. 2 P. C. 1; 37 L. J. P. C. 17; 5 Moo. P. C. C. N. S. 1 150
M'Innes' Patent, *In re* (1868), 5 Moo. P. C. C. N. S. 72; L. R. 2 P C. 54; 37 L. J. P. C. 23 157
Macfarlane *v.* Price (1816), 1 Web. P. C. 74; 1 Stark. 199 87
Macnamara *v.* Hulse (1842), C. & M. 471; 2 Web. P. C. 128, n. 267—268
Manceaux's Patent, *In re* (1870), L. R. 6 Ch. 272..... 118
Manton *v.* Manton (1815), Dav. P. C. 333 (at p. 350); 1 Carp. P. C. 278 259
Marsden *v.* Saville Street Foundry and Engineering Co. Limited (1878), L. R. 3 Ex. D. 203; 39 L. T. Rep. N. S. 97, 100; 26 W. R. 784..... 19, 20, 131
Mathers *v.* Green, L. R. 1 Ch. 29 9
Meadows *v.* Kirkmann, 27 L. J. Ex. 205 293
Medlock's Patent, *In re* (1865), 22 Newt. Lond. Jour. N. S. 69 114, 122
Mercier *v.* Cotton (1876), L. R. 1 Q. B. D. 442 239
Milligan *v.* Marsh (1856), 2 Jur. N. S. 1083 ..... 7, 21
Milner's Patent, *In re* (1854), 9 Moo. P. C. C. 39 161
Minter *v.* Mower (1835), 1 Web. P. C. 138..... 37
—— *v.* Wells (1834), 1 Web. P. C. 127; 1 Carp. P. C. 622, 639; 1 C. M. & R. 505; 5 Tyr. 163; 4 L. J. Ex. 2...12, 179
—— *v.* Williams (1835), 1 Web. P. C. 135; 4 A. & E. 251; 5 N. & M. 657; 1 H. & N. 585; 5 L. J. K. B. 60 189
Mitchell *v.* Barker (1851), 39 Lond. Jour. 531 220
—— *v.* Reynolds (1713), 19 Mod. R. 130; 1 P. Wms. 181... 36

PAGE
Moore *v.* Bennett, Griffin P. C. 158 .....33, 100, 281, 200
Morewood *v.* Tupper (1855), 3 C. L. Rep. 718 175
Morgan's Patent, *In re* (1843), 24 W. R. 245; 1 Web. P. C. 737 .....144, 147, 159
Morgan *v.* Fuller (1860), L. R. 2 Eq. 296 230
——— *v.* Seaward (1837), 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 Web. P. C. 167, 170, 187, 196; 1 Carp. P. C. 37, 96; 6 L. J. Ex. 153...37, 50, 63, 71, 88, 93, 125, 179, 247, 267
Mosey's Patent, *In re* (1858), 25 Beav. 581; Higgins' Dig. 339; 6 W. R. 612 144
Moss *v.* Malings, 33 Ch. D. 603 234
Mozeley *v.* The Victoria Rubber Co., 57 L. T. 142 .....64, 70
——— Griffin P. C. 163 241
Mullins *v.* Hart (1852), 5 Car. & K. 297 50
Muntz' Patent, *In re* (1846), 2 Web. P. C. 113 .....149, 152
——— *v.* Foster (1843—4), 2 Web. P. C. 93; 1 Dowl. & Low, 942 .....28, 42, 52, 80, 166, 179, 183, 189, 195, 253, 267
——— *v.* Gronfell (1842), 2 Coop. 61, n.; 7 Jur. 121 220
Murray *v.* Clayton (1872), L. R. 7 Ch. 570; 20 W. R. 649; 27 L. T. Rep. N. S. 100; 21 W. R. 118; 42 L. J. Ch. 191; L. R. 15 Eq. 115; 27 L. T. Rep. N. S. 644; 21 W. R. 498... 34, 179, 205, 243

N.

Napier's Patent, *In re* (1861), 13 Moo. P. C. C. 543; 9 W. R. 390..... 149
Needham *v.* Johnson 1 P. O. R. (at p. 58) 76
——— *v.* Oxley (1863), 11 W. R. 852; 8 L. T. Rep. N. S. 604; 2 N. R. 388 .....203, 215, 305
——— (1863), 1 H. & M. 248 222
Neilson *v.* Betts (1871), L. R. 3 Ch. 429; L. R. 5 H. L. 1; 40 L. J. Ch. 317; 19 W. R. 1121..... 43, 185, 203, 215
——— *v.* Forman (1841), 2 Coop. 61, n. 196
——— *v.* Fothergill (1841), 1 Web. P. C. 287 138
——— *v.* Harford (1841), 1 Web. P. C. 295 ...74, 81, 179, 266, 267
——— (1841), 1 Web. P. C. 331; 8 M. & W. 806; 11 L. J. Ex. 20; 10 L. J. Ex. 493; 2 Coop. C. C. 61, n. 22, 63, 94, 234, 261, 265
——— *v.* Thompson (1841), 1 Web. P. C. 278; 2 Coop. 61, n. 71, 196
Newall *v.* Elliott (1858), 4 C. B. N. S. 269; 4 Jur. N. S. 562; 27 L. J. C. P. 537 .....51, 66
——— (1864), 13 W. R. 11; 10 Jur. N. S. 954; 10 L. T. Rep. N. S. 792; 4 N. R. 429.....25, 65, 169, 188
——— *v.* Wilkins (1851), 17 L. T. Rep. 20 270
——— *v.* Wilson (1852), 2 De G. M. & G. 282; 19 L. T. Rep. 161 220
Newbery *v.* James (1817), 2 Mer. 446 (at p. 451); 1 Carp. P. C. 367 .....72, 129

PAGE

Nowton's Patent, *In re* (1861), 14 Moo. P. C. C. 156; 15 Moo. P. C. C. 176 .....151, 158
9 App Cas. 592.....155, 161
Nowton v. Grand Junction Rail. Co. (1846), 5 Ex. 331; 20 L. J. Ex. 427 n.; M. Dig. 75 .....171, 172, 268
—— —— v. Vauchor (1851), 21 L. J. Ex. 305; 6 Ex. 859...60, 77, 175
Nickols' Patent, *In re*, 1 Web. P. C. 649 104
——— v. Haslam (1844), 13 L. J. C. P. 146; 8 Scott, N. R. 97; 7 M. & G. 378; 8 Jur. 474 63
——— v. Ross (1849), 8 C. B. 679 (at p. 710) 20
Nobel's Explosives Co. v. Jones, Scott & Co. (1878), 17 Ch. D. 721.....186—188
——— 8 App. Cas. 10 ... 183
Nordenfelt v. Gardner, 1 P. O. R. 65 174
Normand's Patent, *In re* (1870), 6 Moo. P. C. C. N. S. 477 158
Norton's Patent, *In re* (1863), 1 Moo. P. C. C. N. S. 339; 9 Jur. N. S. 419; 11 W. R. 720; 1 N. R. 557 .....156, 158
Norton v. Brooks (1861), 7 H. & N. 499; 8 Jur. N. S. 155; 10 W. R. 111..... 139
Numm v. D'Albuquerque (1865), 34 Beav. 595 207

O.

Oldham v. Langmead (before 1789), Cit. 3 T. R. 439, 441 136
Ormson v. Clarke, 14 C. B. N. S. 475 32
Otto v. Steele, Griffin P. C. 182 269
——— 31 Ch. D. 241 46
Oxford and Cambridge Universities v. Richardson (1802), 6 Ves. 689 .....186, 194
Oxley v. Holden (1860), 30 L. J. C. P. 68; 8 C. B. N. S. 666; 8 W. R. 626; 2 L. T. Rep. N. S. 464 .....48, 50, 189

P.

Palmer v. Cooper (1853), 9 Ex. 231; L. R. 23 Ex. 82; 2 C. L. R. 430 .....230, 231, 235
——— v. Wagstaff (1853), 8 Ex. 840; 17 Jur. 781; 22 L. J. Ex. 295; 1 W. R. 438; 1 C. L. R. 448 ... 230
——— (1854), 9 Ex. 494; 23 L. J. Ex. 217..... 256
Parkes v. Stevens (1869), L. R. 8 Eq. 358; 38 L. J. Ch. 627; 17 W. R. 846; L. R. 3 Ch. 36 .....32, 74, 97, 176, 267
Parnell's Patent, *In re*, 5 P. O. R. 126 144
Parnell v. Mort Leddell & Co., 29 Ch. D. 325..... 273
Patent Bottle Envelope Co. v. Seymer (1858), 5 C. B. N. S. 164; 5 Jur. N. S. 174; 28 L. J. C. P. 22.....32, 173

PAGE
Patent Typo Founding Co. *v.* Richards (1859), 2 L. T. R. N. S. 359 223
——————————— *v.* Walter (1860), 8 W. R. 353; Johns. 727 .....249, 293
Patterson's Patent, *In re* (1849), 6 Moo. P. C. C. 469; 13 Jur. 593 156
Patterson *v.* Gas Light & Coke Co. (1876), L. R. 2 Ch. D. 827 (at p. 832); 46 L. J. Ch. 843; 35 L. T. Rep. N. S. 11 15
——————— (1877), L. R. 3 App. Ca. 239 (at p. 243); 47 L. J. Ch. 402; 38 L. T. Rep. N. S. 303; 26 W. R. 482 ..... 23, 44
——— *v.* Holland (1845), Hindmarch, 293 254
Penn *v.* Bibby (1866), L. R. 1 Eq. 538 (at p. 548) 234
——————— L. R. 3 Eq. 308 .....205, 270
—— *v.* Jack (1866), L. R. 2 Ch. App. Ca. 127; 36 L. J. Ch. 455; 15 W. R. 208; 15 L. T. Rep. N. S. 399... 31, 67, 68
——————— (1866), 3 L. R. Eq. 308 195
——————— (1866), L. R. 2 Eq. 314 (at p. 317); 14 L. T. R. N. S. 495; 14 W. R. 760.....260, 261
——————— (1867), L. R. 5 Eq. 81 .....203, 205
—— *v.* Fernie (1866), L. R. 3 Eq. 308 270
Perkins's Patent, *In re* (1845), 2 Web. P. C. 6 (at p. 18) 149
Peroni *v.* Hudson, Griffin P. C. 183 274
Perry *v.* Mitchell (1840), 1 Web. P. C. 269 225
—— *v.* Skinner (1837), Hindmarch, Patents, p. 207; 2 M. & W. 471; M. & H. 122; 1 Jur. 433; 1 Web. P. C. 250; 6 L. J. Ex. 124.....114, 115
Philpott *v.* Hanbury, 2 P. O. R. 43..... 45
Pietschmann's Patent, Griffin P. C. 314 107
Piggott *v.* Anglo-American Telegraph Co. (1868), 19 L. T. R. N. S. 46 247
Pinkus' Patent, *In re* (1847), 12 Jur. 233 .....156, 157
Pitman's Patent, *In re* (1871), 8 Moo. P. C. C. N. S. 293; L. R. 4 P. C. 84 159
Plimpton *v.* Malcomson (1876), L. R. 3 Ch. D. 531; 45 L. J. Ch. 505; 34 L. T. Rep. N. S. 340; L. R. 20 Eq. 37 .....55, 85, 91, 103, 219, 258, 304
——————— *v.* Spiller (1876), 20 Sols. Jour. 1876, p. 860 236
——————— (1877), L. R. 6 Ch. D. 412 .....44, 51, 75, 196
Poole's Patent, *In re* (1867), 4 Moo. P. C. C. N. S. 452; L. R. 1 C. P. 514; 36 L. J. P. C. 76 .....153, 158
Pooley *v.* Pointon, Griffin P. C. 200 272
Pow *v.* Taunton (1845), 9 Jur. 1056 28
Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co. (1858), 4 K. & J. 727 .....202, 206
Printing and Numerical Registering Co. *v.* Sampson (1875), 44 L. J. Ch. 705; L. R. 19 Eq. 462; 32 L. T. Rep. N. S. 354... 140
Proctor *v.* Bennis, 36 Ch. D. 740.....97, 167
——— *v.* Sutton Lodge Chemical Co., 5 P. O. R. 184 273

R.

PAGE

R. *v.* Arkwright (1785), 1 Web. P. C. 64; Dav. P. C. 61; Printed Cases, fol. Lon. 1785; 1 Carp. P. C. 53 .....36, 52, 53, 72, 80
R. *v.* Cutler (1847), 3 C. & K. 215; Macrory, 124; 14 Q. B. 372, n. 28
R. *v.* Else (1785), 1 Web. P. C. 76; Bull. N. P. 76; Dav. P. C. 144 60
R. *v.* Lister (1826), Web. P. L. 80 179
R. *v.* Mill (1850), 20 L. J. C. P. 16 (at p. 24); 10 C. B. 379; 15 Jur. 59; 1 L. M. & P. 695; 14 Beav. 315 112
R. *v.* Wheeler (1819), 2 B. & Ald. 345; 1 Carp. P. C. 394...11, 26, 127
Ralston *v.* Smith (1865), 11 H. L. C. 223; 20 C. B. N. S. 28; 13 L. T. Rep. N. S. 1; 35 L. J. C. P. 49 .....32, 113
Renard *v.* Lewinstein (1864), 3 W. R. 665; 10 L. T. Rep. N. S. 94. 240
——— (1864), 10 L. T. N. S. 177 .....8, 195
——— (1865), 2 Hem. & M. 628; 5 N. R. 301; 11 L. T. Rep. N. S. 766; 13 W. R. 382 165, 216, 234
Roberts' Patent, *In re* (1839), 1 Web. P. C. 573 153
Robinson's Patent, Griffin P. C. 267 124
Roden *v.* London Small Arms Co. (1876), 46 L. J. Q. B. 213 ... 142
Rolls *v.* Isaacs (1878), L. R. 19 Ch. D. 268; W. N. 1878 (p. 37) 131
Rushton *v.* Crawley (1870), L. R. 10 Eq. 522 .....32, 95
Russell's Patent, Goodeve P. C. 589 118
Russell *v.* Cowley (1834), 1 Web. P. C. 459; 2 Coop. C. C. 59 25, 181, 195, 247
——— *v.* Crichton (1837), 15 Dec. of Ct. of Sess. 1270; 1 Web. P. C. 667, n. 247
——— *v.* Hatfield, Griffin P. C. 204 225
——— *v.* Ledsam (1843), 11 M. & W. 647 .....232, 237
——— (1845), 14 M. & W. 574; 14 L. J. Ex. 353... 179

S.

Samuda's Patent, *In re* (1846), Cit. Hind. on Pat. 534 116
Saxby's Patent, *In re* (1870), L. R. 3 P. C. 292; 7 Moo. P. C. C. N. S. 82; 19 W. R. 513 150
Saxby *v.* Gloucester Waggon Co. (1880), L. R. 7 Q. B. D. 305; W. N. 1880 (at p. 28) 34, 252
Scott and Young, *Ex parte* (1871), L. R. 6 Ch. App. 274; 19 W. R. 425 16
Seed *v.* Higgins (1860), 8 H. L. C. 550; 30 L. J. Q. B. 314; 6 Jur. N. S. 1264; 3 L. T. Rep. N. S. 101 .....96, 257, 264, 268
Sellers *v.* Dickenson (1850), 5 Ex. 312; 20 L. J. Ex. 417 ...172, 268
Sharp's Patent, *In re* (1840), 1 Web. P. C. 641 (at p. 645); 10 L. J. Ch. 86; 3 Beav. 245 104
Sharp *v.* Braner, Griffin P. C. 205 284
Shaw *v.* Beck (1853), 8 Ex. 392 260

PAGE
Shaw *v.* Bank of England, 22 L. J. Ex. 26 293
Sheehan *v.* Great Eastern Rail. Co. (1880), L. R. 16 Ch. D. 59 164, 217
Siddell *v.* Vickers, 39 L. R. Ch. D. 92 .....69—96
Simister's Patent, *In re* (1842), 1 Web. P. C. 721; 4 Moo. P. C. C. 164 156
Simpson *v.* Holliday (1866), L. R. 1 H. L. 315; 35 L. J. Ch. 811 27
——— (1864), 20 Newton's Lond. Jour. N. S. 105 (at p. 108) 94, 181, 264
——— (1865), 13 W. R. 577; 12 L. T. Rep. N. S. 99; 21 Newton, Lond. Jour. N. S. 111; 5 N. R. 340 ...78, 85, 95
Singer Sewing Machine Co. *v.* Wilson (1865), 5 N. R. 505; 12 L. T. Rep. N. S. 140; 13 W. R. 560 .....240, 293
——— *v.* Stasson, 50 L. T. 326 111
Smith's Patent, *In re* (1855), Macr. P. C. 232 .....114, 122
——— Griffin P. C. 263 146
Smith *v.* Buckingham (1870), 18 W. R. 314; 21 L. T. R. N. S. 819 140
——— *v.* Cropper, 10 App. Cas. 249; reversing 26 Ch. D. 700... 229
——— *v.* Davidson (1857), 19 C. S. 691 41
——— *v.* Dickenson (1804), 3 B. & P. 630 129
——— *v.* London & North Western Rail. Co. (1853), 2 E. & B. 69; 17 Jur. 1071 173
——— *v.* London & South Western Rail. Co. (1854), Kay, 408; 23 L. J. Ch. 562; 23 L. T. R. 10; 2 Eq. Rep. 428; 2 W. R. 310; 23 L. T. R. 10 202
——— *v.* Scott (1859), 6 C. B. N. S. 771; 28 L. J. C. P. 325; 5 Jur. N. S. 1356 139
——— *v.* Upton (1843), 6 M. & G. 257 254
Soame's Patent, *In re* (1843), 1 Web. P. C. 560, 729 (at p. 733) 21, 147, 148, 149
Société Anonyme des Manufactures de Glaces *v.* Tielghman's, &c., Co., 25 Ch. D. 1 ..... 191, 283
Speckhart *v.* Campbell & Co., Solicitors' Journal, Feb. 2, 1884... 215
Spencer *v.* Jack (1864), 11 L. T. R. N. S. 242 267
Spicer *v.* Todd (1839), 1 D. P. R. 306..... 165
Spilsbury *v.* Clough (1842), 2 Q. B. 466; 2 G. & D. 17; 6 Jur. 579; 1 Web. P. C. 255; 11 L. J. Q. B. 109 105
Stead *v.* Anderson (1846), 2 Web. P. C. 147 39
——— (1847), 4 C. B. 806; 2 Web. P. C. 151; 16 L. J. C. P. 250 ..... 169, 170, 179, 256
—— *v.* Williams (1843), 2 Web. P. C. 126 ..... 39, 51
——— (1844), 2 Web. P. C. 137; 7 M. & G. 318; 8 Scott, N. R. 449; 8 Jur. 930; 13 L. J. C. P. 218..... 42, 63
Steiner *v.* Heald (1851), 20 L. J. Ex. 410; 6 Ex. 607; 17 Jur. 875 29
Stevens *v.* Keating (1847), 2 Web. P. C. 176; 2 Phill. 333 ... 180, 219, 268
——— (1850), 1 Mac. & G. 659 168
Stewart's Patent, 3 P. O. R. 7 150

PAGE

Stocker *v.* Rodgers (1843), 1 Car. & Kir. 99 271
Stocking *v.* Llewellyn (1842), 3 L. T. R. 33 220
Stoner *v.* Todd (1876), L. R. 4 Ch. D. 58; 46 L. J. Ch. 32; 35 L. T. Rep. N. S. 661; 25 W. R. 138 ..... 43, 68
Stubbs' Patent, Griffin P. C. 298..... 120, 395
Sturtz *v.* De la Rue (1828), 5 Russ. 322; 1 Web. P. C. 83 ... 63, 81, 220
Sugg *v.* Bray, Griffin P. C. 210 285
—— *v.* Silber (1876), L. R. 1 Q. B. D. 362 251
—————— (1877), L. R. 2 Q. B. D. 495 233
Swinborne *v.* Nelson (1853), 16 Beav. 416; 22 L. J. Ch. 331 ... 242
Sykes *v.* Howarth (1879), L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; 41 L. T. R. N. S. 79; 28 W. R. 215 ..... 182, 183, 189, 191, 224, 233, 262

T.

Talbot *v.* La Roche (1854), 15 C. B. 310; 2 C. L. Rep. 836; M. Dig. 210 224
Taugye *v.* Stott (1865), 14 W. R. 386 ..... 215, 304
Taylor *v.* Hare (1805), 1 Web. P. C. 292, 293; 1 B. & P. N. R. 260..... 137, 141
Templeton *v.* Macfarlane (1848), 1 H. L. C. 595 52
Tennant's case (1802), 1 Web. P. C. 125; Dav. P. C. 429; 1 Carp. P. C. 177..... 10, 41
Terrell, *In re* (1883), L. R. 22 Ch. D. 473 276
Tetley *v.* Easton (1852), Mac. P. C. 48, 76 ..... 80, 93
—————— (1857), 2 C. B. N. S. 706; 26 L. J. C. P. 269. 96
Thomas *v.* Foxwell (1858), 5 Jur. N. S. 37 176
—— *v.* Hunt (1864), 17 C. B. N. S. 183 142
—— *v.* Welch (1866), L. R. 1 C. P. 182 (at p. 192); 12 Jur. N. S. 316; 35 L. J. C. P. 200..... 68
Thorn *v.* Worthing Skating Rink Company (1876), L. R. 6 Ch. D. 415 179
Tielens *v.* Hooper (1850), 5 Ex. 830 143
Tilghman's Sand Blast Company *v.* Wright, Griffin P. C. 216 ... 224
Tolhausen's Patent, *In re* (1866), 14 W. R. 551 117
Townsend *v.* Haworth (1875), L. R. 12 Ch. D. 831, n.; Higgins' Dig. Pt. II. p. 60 (not fully reported anywhere) 183, 189, 191
Travell *v.* Carteret (35 Car. 2), 3 Lov. 135..... 126
Trotman's Patent, *In re* (1866), L. R. 1 P. C. 118; 3 Moo. P. C. C. N. S. 488 .....154, 155
Trotman *v.* Wood (1864), 16 C. B. N. S. 479 140
Turner *v.* Hancock (1881), 20 Ch. D. 303 275
—— *v.* Winter (1787), 1 Web. P. C. 77; 1 T. R. 602; Dart, P. C. 145.....52, 72, 259

U.

PAGE
United Horse Nail Co. *v.* Stewart, Griffin P. C. 217 205
United Telephone Co., &c. *v.* Harrison, Cox, Walker & Co. (1882), L. R. 21 Ch. D. 720 .....44, 46, 181
——— *v.* Dale, 25 Ch. D. 778 203
——— *v.* Donohoe, 31 Ch. D. 399 227
——— *v.* Henry, Griffin P. C. 228 189
——— *v.* London Globe Telephone Co., 26 Ch. D. 766 .....187, 202
——— *v.* Sharples, 29 Ch. D. 164 184
——— *v.* Walker, 56 L. T. 508 205
Unwin *v.* Heath (1855), 25 L. J. C. P. 8 .....77, 179
——— 2 Web. P. C. C. 314 181
Useful Patents Co. *v.* Rylands, Griffin P. C. 234 51

V.

Vavasseur *v.* Krupp (1878), L. R. 9 Ch. D. 351; 39 L. T. R. N. S. 437 203
Vidi *v.* Smith, 3 E. & B. 969 294
Vincent's Patent, *In re* (1867), L. R. 2 Ch. 341; 15 W. R. 524 117
Vow Buch's Application, 2 Griffin P. C. 40 119
Vow Heyden *v.* Newstadt, 14 Ch. D. 230 183

W.

Walker *v.* Clarke, 56 L. J. Ch. 239 283
Wallington *v.* Dale (1852), 7 Ex. 888; 23 L. J. Ex. 49 .....74, 267
Walton *v.* Bateman (1842), 1 Web. P. C. 613 .....37, 167, 179, 267
——— *v.* Lavater (1860), 3 L. T. Rep. N. S. 272; 8 C. B. N. S. 162; 29 L. J. C. P. 275; 6 Jur. N. S. 1251 .....139, 163, 169, 190, 216
——— *v.* Potter (1841), 1 Web. P. C. 585 .....25, 167, 179, 268
Warwick *v.* Hooper (1850), 3 M. & G. 60 143
Wegmann *v.* Corcoran (1879), L. R. 13 Ch. D. 65 (at p. 77); 39 L. T. Rep. N. S. 563; 27 W. R. 357 .....76, 90, 272
Westinghouse's Patent, Griffin P. C. 315 108
Westrupp & Gibbons' Patent, *In re*, *Ex parte* Wells (1836), 1 Web. P. C. 554 161
White *v.* Fenn (1867), 15 W. R. 348; 15 L. T. Rep. N. S. 505; L. R. 5 Ch. App. Cas. 36 177
Whitton *v.* Jennings (1860), 1 D. R. & S. 110 220
Wield's Patent, *In re* (1871), L. R. 4 P. C. 89; 8 Moo. P. C. C. N. S. 300.....155, 161
Williams *v.* Williams (1819), 3 Mer. 157 129
Winan's Patent, *In re* (1872), 8 Moo. P. C. C. N. S. 306; L. R. 4 P. C. 93 158

PAGE

Wirth's Patent, *In re* (1879), L. R. 12 Ch. D. 303; 28 W. R. 329..... 6
Wood *v.* Zimmer (1815), 1 Web. P. C. 44, 82; Holt, N. P. 58; Kay, P. C. 200 .....50, 91
Woodcroft's Patent, *In re* (1841), 1 Web. P. C. 740; 3 Moo. P. C. C. 171 156
Woodward *v.* Sansum, 56 L. T. 347 64
Wren *v.* Weild (1868), L. R. 4 Q. B. 213, 730.....225, 284
Wright *v.* Hitchcock (1870), L. R. 5 Ex. 37; 39 L. J. Ex. 97... 63, 177, 183, 190, 256

Y.

Yates' & Kolett's Patent, *In re*, L. R. 12 App. Cas. 147 154
Young *v.* Fernie (1864), 12 W. R. 901 (at p. 903); 4 Giff. 577; 10 Jur. N. S. 926; 10 L. T. Rep. N. S. 861; 9 Prac. Mech. Jour. 2nd Series, 102; 4 N. R. 318 .....25, 44, 259
——— *v.* Rosenthal, 2 P. O. R. 41 272

THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

INTRODUCTION.

LETTERS patent for inventions are granted by the crown by virtue of its common law prerogative. By the creation of monopolies to first and true inventors in the right of using their inventions, a species of property is created in favour of inventors, as a reward for the benefits which they have conferred on humanity, by the exercise of their thought, knowledge and industry. It is to the interests of the community that persons should be induced to devote their time, energies and resources in furtherance of the development of arts and manufactures, and this was recognized in England from the earliest periods which can pretend to be described as civilized.

It was to the advantage of the whole community that inventors should be rewarded, and no measure of reward can be conceived more just or equitable, and bearing a closer relation to the benefit conferred by the particular inventor than to grant him the sole right of making, using and vending his invention for a limited period of time. In the corrupt ages of the Stuarts, it is not to be wondered at, that the prerogative of the crown to grant monopoly rights to first and true inventors, should have been made a

lever for assuming a prerogative to grant monopoly rights in trade generally.

In the reign of James the First, to such an extent had this abuse been carried, that it was deemed advisable by the legislature that the rights of the crown in respect of letters patent should be declared by legislative enactment — this was the origin of the Statute of Monopolies.

It has been supposed that the prerogative of the crown to grant letters patent for inventions was created by this statute, but the most cursory perusal of its enactments and of the authorities which preceded it, shows clearly that, so far from the statute giving to the crown any right which it did not possess before it was passed, it has as its intention the limiting the right of the crown, and the declaring that, which had always been the common law upon the subject. In the first section of this Act, for instance, we find it recited "that all grants of monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm. . . . That all monopolies, and all commissions, grants, licenses, charters and letters patent heretofore made or granted or hereafter to be made or granted . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no-wise to be put in use or execution."

Section 6 saved the granting of letters patent to inventors in the following words:—

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

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

It will thus be seen that the Statute of Monopolies creates no statutory right, but merely saves the common law rights of the crown; and by sect. 116 of the Patents Designs and Trade Marks Act, 1883, it is enacted, "*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 the grant thereof.*" By sect. 46 of the same Act the word "*invention*" is defined as meaning "*any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies . . . . and includes an alleged invention.*"

So it is that in the present day, notwithstanding the various statutes which have been passed in relation to letters patent for inventions, these monopolies are still granted upon the mere motion of the sovereign, in the exercise of her royal prerogative, and that all that has been done, has been declaratory of the limits within which that prerogative should be exercised, and of the method of procedure to be adopted in obtaining letters patent for inventions.

For the purpose of supporting the validity of the letters patent it is necessary that the patentee should conform to certain requisites, and these requisites are indicated in the 6th section of the Statute of Monopolies. In the first place, he must be the true and first inventor of a new manufacture; the new manufacture must not be contrary

to law, nor must it be mischievous to the State, by raising the prices of commodities at home; it must not be hurtful to trade, nor generally inconvenient. The Act of 1883 has adopted this definition of an invention, and anything that does not conform with all these requisites is not entitled to be called an invention. The host of important decided cases as to the construction of the 6th section of the Statute of Monopolies, and the enormous expense, and labour and learning, which have been devoted to obtaining these decisions, no doubt induced the legislature to adopt a definition which had in some respects obtained a correct judicial meaning; but it is doubtful whether it was wise to re-enact it in a form which had, we may say, centuries ago, already become to some extent obsolete.

The protection of trade by means of Guilds, and of all those various protective schemes which were elaborated in the middle ages, have been found to be fallacious. Industries in this country are no longer protected by the artificial process of law, and therefore it is difficult to understand the correct meaning which would be given to the words in the 6th section of the Statute of Monopolies, which refer to an invention having a tendency to **raising the prices of commodities at home**, or to **hamper trade**, or to be **generally inconvenient**, terms exceedingly vague in themselves, and which the Courts have not had occasion to consider for a very great number of years.

These matters, and the construction which is to be placed upon the word "*invention*," will have to be dealt with hereafter, when we consider the cases which have been decided upon the matter.

CHAPTER I.

THE PATENTEE.

By sect. 46 of the Act of 1883, the word **patentee** is construed as meaning "*the person for the time being entitled to the benefit of the patent*;" consequently it may mean the original grantee, his executors and administrators, or the assignee of the original grantee. By sect. 4 of the same Act it is enacted;—

(1) "*Any person, whether a British subject or not, may make an application for a patent.*"

It will be observed, that there is no limitation whatever preventing a person under incapacity, either by reason of infancy or otherwise, from obtaining a patent.

(2) "*Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.*"

By sect. 5, (1) "*An application for a patent must be made in the form set forth in the Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office, in the prescribed manner.*"

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

Before this Act it was competent for an **alien** to obtain a patent; Lord Cairns, in the matter of *Wirth's Patent* (*a*), went even further than this: "I am quite clear that letters patent may be granted to a foreigner who is resident abroad for an invention communicated to him by another resident also abroad."

There does not appear to have ever been a question as to whether an **infant** or a **married woman** might, under the old law, have become a grantee of letters patent. The new law, however, is perfectly clear, and sweeps away any doubt that might have been entertained on the subject.

By sect. 99 of the Patent Act of 1883, it is found that due provision is made for enabling infants and persons under incapacity to take the requisite steps for obtaining letters patent. It will be observed that sect. 6 of the Statute of Monopolies deals with new manufactures *within this realm*, and the construction which has been placed upon that statute has been, that the consideration for the grant of the patent could be equally supported by the process of inventing a new manufacture, as by the process of **importing from abroad a manufacture** which up to the time of such importation had been unknown within this realm.

In the case of *Darcy* v. *Allin* (*b*), it was held, "Where any man by his own charge and industry, or by his own wit and invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm, that in such cases the king may grant to him a monopoly patent for some reasonable time until the subjects may learn the same in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not." So in *The Clothworkers of Ipswich case* (*c*), it was laid

(*a*) L. R., 12 Ch. D. 303. (*b*) 1 Web. P. C. 6.
(*c*) Godbolt's R. 253.

down that "the bringing of a new invention into the kingdom equally with the discovery of anything was sufficient to support the king's grant." It is true that these cases were prior to the Statute of Monopolies, but the Statute of Monopolies merely affirmed the common law, hence these cases are applicable. *Edgebury* v. *Stephens* (*d*) was decided after the statute; there it was held that "a grant of a monopoly may be to the first inventor, and if the invention be new in England, a patent may be granted though the thing was practised beyond the sea before; for the statute speaks of a new manufacture *within this realm*, so that if it be new here it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing" (*d*).

The practice of granting letters patent to the **first importers** of manufactures new within this realm, has been uniformly sustained by our Courts of Law.

We have seen that the word "invention" is construed by the language of the 6th section of the Statute of Monopolies, that language has been held in *Edgebury* v. *Stephens* (*d*) and the succeeding authorities, to include an importer of an invention.

In *Milligan* v. *Marsh*, (*e*) it was held by Vice-Chancellor Page-Wood that a person taking out a patent and making a declaration that he is a first inventor when in truth he is only an importer of a communicated invention, makes a false suggestion and the patent is void.

When the Act of 1883 was passed, doubts were expressed as to whether the effect of sect. 5, sub-sect. 2, was not to do away with the granting of patents for what is known as communications from abroad, these doubts were shared by the author particularly with reference to the case of *Milligan* v. *Marsh* (*supra*). The question has since been in a

(*d*) 1 Web. P. C. 35.

(*e*) 2 Jur., N. S. 1083.

manner touched upon in the case of *In re Avery's* patent (*f*), where although in no way deciding the point it appears to have been considered that such a patent might be granted. Stirling, J. (subsequently affirmed by the Court of Appeal) in giving judgment said, "The rules which have been framed by the Board of Trade under the power conferred upon them by sect. 101 of the statute contain provisions which the statute itself does not contain, in reference to an application for a grant for an invention which has been communicated from abroad. Rule 27 provides that the application for such a grant shall be in the form 'A' in the 2nd schedule, and that form is different from that which is prescribed by the statute and from the terms in which Lindsay made the application" (his Lordship read the form and continued) "that form has been framed so as to fit in with sect. 5, sub-sect. 2, of the statute which enacts that an application must contain a declaration . . . that the applicant is in possession of an invention, whereof, he . . . claims to be the true and first inventor. That form has not been followed in this case. There is no decision that a patent taken out as for an original invention, when in fact the invention patented was communicated from abroad, is void, though there is in the case of *Milligan* v. *Marsh* (*supra*) what appears to be a dictum of Vice-Chancellor Sir W. Page-Wood, to that effect, nor is there any decision that where an invention is partly original and partly communicated from abroad, the part communicated from abroad ought to be distinguished in the specification; but in the case of *Renard* v. *Levenstein* (*g*), the Lord Justice Knight Bruce expressed great doubt upon the point." . . . . And at p. 318: "That being so notwithstanding that the invention was founded on a communication received from abroad it appears to me that it well might be held that the statutory declaration made by the applicant was true in point of law."

(*f*) 36 Ch. D. 307.

(*g*) 10 L. T., N. S. 177.

Only one of the applicants need make the declaration, a capitalist or other person or persons may join an inventor and obtain a valid joint patent (*h*).

Where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without the consent of the others (*i*).

As to the rights of such joint grantees to the profits made by granting licenses, *quaere* (*ib*).

Sect. 34 of the Act of 1883 makes provision for the granting of letters patent to the legal representative of a deceased inventor, provided application be made within six months from the decease of the inventor, the application must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

We have now to deal with the construction of the words "first and true inventor."

The reason that the common law has created a prerogative of the crown to grant letters patent to first and true inventors, is that the public benefit by the consideration which the inventor gives in return for the monopoly privilege which is granted to him. That consideration may be divided into three parts.

In the first place, the patentee must be the actual inventor, that is, the consideration must move from him.

Secondly. He must have invented a new and useful invention.

Thirdly. He must publish his invention.

(*h*) See express enactment, sect. 5 of Patents, &c., Act, 1885.

(*i*) *Mathers* v. *Green*, L. R., 1 Ch. 29.

CHAPTER II.

THE CONSIDERATION—BEING THE ACTUAL INVENTOR.

An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The process of invention may be divided into two parts. The operation of the mind, and the carrying out of the results of that operation by the hands. It is true that when an invention is the result of pure accident, the physical production may precede the operation of the mind in perceiving its applicability, still, as a general rule, it will be observed that the operation of the mind must precede the physical production. The operation of the mind must in all cases be that of the mind of the inventor. The carrying out of the results of the operation of the mind may be done by the hands of the inventor, or by those of anyone else whom he may employ for that purpose.

In *Tennant's case* (*a*), a material portion of the invention claimed was found to have been suggested by a chemist at Glasgow. Lord Ellenborough held, that the patent was bad because the plaintiff was not the inventor. It will be observed in this case, that although it is possible that the plaintiff was the first person to use the particular method for making a bleaching liquor, still, inasmuch as that method of producing this bleaching liquor was thought out by some one else and communicated to the plaintiff, he was

(*a*) 1 Web. P. C. 125.

held not to be an inventor. In considering this question we must not confuse the idea of **first manufacturer** with that of first inventor.

"A." may have invented something, it may have pleased him to try a few experiments with his invention, and then to abandon it without publication. "B." may subsequently have invented the same thing altogether independently of "A." If "B." applies for letters patent he is at law the first inventor; but should it be shown that the process of invention was not carried on in "B.'s" mind at all, but that "A." communicated his ideas to "B.," although with the full intention of abandoning them, "B." will not be the first inventor. Take, for instance, the case of *Dollond's Patent* (*b*), this was an improvement in the manufacture of object glasses for telescopes. Dr. H. had made and used identically similar object glasses for his own purposes, but he had in no way published his invention. Dollond, without any communication from Dr. H., had re-invented these object glasses; held that Dollond's patent was good.

In *R.* v. *Wheeler* (*c*), Abbott, C. J., delivering the judgment of the court, said: "If the patentee has not invented the matter or thing of which he represents himself to be inventor, the consideration of the royal grant fails." In *Barber* v. *Walduck* (*d*), it was proved that the **invention** was made by a **workman** in the workshop of the patentee, that he communicated it to his master: the patent was opposed on the ground that the patentee was not the inventor.

In *Bloxham* v. *Elsee* (*e*), the patentee had worked out the principle of his invention in his own mind, but he intrusted the mechanical details to Mr. D., an engineer. Mr. D. had suggested several parts of the machine to the patentee. An objection was taken that

(*b*) 1 Web. P. C. 43.
(*c*) 2 B. & Ald. 345.
(*d*) 1 Carp. P. C. 438.
(*e*) 1 Web. P. C. 132, n.

the patentee was not the inventor: the objection was overruled. It will be seen in this case, that the patentee's mind conceived the invention, and that Mr. D. was only, so to speak, the **intellectual hands** employed by the patentee to carry out that which he had previously conceived in his mind. The summing up of Mr. Baron Alderson, in the case of *Minter* v. *Wells* (*f*), is instructive upon this point:—"The patentee," said the learned judge, "claims under the patent, stating it in his petition to the crown, that he is the true inventor of the machine in question, and if it could be shown that he was not the true inventor, but that some one else had invented it, the crown is deceived in that suggestion, which was the foundation on which it granted the patent, and then the law is, that the patent obtained under such circumstances would be void, and no action could be maintained against the party for the infringement of the patent. . . . . If Sutton suggested the principle to Minter, then he, Sutton, would be the inventor; if, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter uses for the purpose of enabling him to carry his original conception into effect."

In *Lewis* v. *Marling* (*g*), Mr. Justice Bailey said: "If I discover a certain thing for myself, it is no objection to my claim to a patent that another also has made the discovery, provided I first introduce it into public use." The suggestion in that case having been that the patentee had acquired his invention by seeing a model of a similar machine which had been brought from America; it was disproved that he had seen the model, and consequently he was held to be the first and true inventor.

In *Cornish* v. *Keene* (*h*) Chief Justice Tindal said:

(*f*) 1 Web. P. C. 127. (*g*) 10 B. & C. 22.
(*h*) 1 Web. P. C. 507.

"Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not, because these patents are granted as a reward, not only for the benefit that is conferred upon the public by the discovery, but also the *ingenuity of the first inventor*; and although it is proved that it is a new discovery so far as the world is concerned, yet if anybody is able to show that although that was now with the party who got the patent, he was not the man whose ingenuity first discovered it, that he borrowed it from A. or B., or had taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, it would be an important question whether he was the first and original inventor of it." There is no doubt that under the circumstances stated by the Chief Justice, the patentee would not be the original inventor.

We do not propose to deal at length with the cases that succeed *Cornish* v. *Keene*. The principle laid down in cases we have cited has been invariably followed. In *Gibson* v. *Brand* (*i*), Chief Justice Tindal said: "A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor, he may have borrowed it from some other person, or book. The legislature never intended that a person, who had taken his knowledge from the art of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill." The same judge, in *Walton* v. *Potter* (*k*), said: "If the subject-matter of the patent has been published in a dictionary, for example, and, if a man merely adopts it, the merit is so small that his patent for it would be worth nothing."

(*i*) 1 Web. P. C. 628.

(*k*) 1 Web. P. C. 592.

It is evident that cases may arise where the operation of one man's mind may have assisted the operation of another's mind. In this case it will be a question for the jury which was, so to speak, the dominant mind and which the servient mind, the dominant mind will be entitled to the patent. In *Allen* v. *Rawson* (*l*), Chief Justice Tindal said: "I think it is too much that a suggestion of a workman employed in the course of experiments of something calculated more easily to carry into effect the conceptions of the inventor should render the whole patent void."

In dealing with this branch of the subject, and showing that one of the essential portions of the consideration for the grant of letters patent is the **labour of the mind** of the inventor, we may cite the case of *Patterson* v. *Gas Light and Coke Company* (*m*). In that case certain referees had been appointed under the City of London Gas Act to inquire into the subject of the purification of gas. The plaintiff was one of those referees. The referees drew up a report on the 31st January, 1372. The report contained a description of the subject-matter of the plaintiff's patent. Subsequently to the making of the report, but before its delivery to the Board of Trade, the plaintiff, who had really discovered the invention, obtained provisional protection. The action was brought against the Gas Light and Coke Company for infringing his patent. The company alleged that the invention was not new, and also denied the title of the plaintiff to take out a patent in respect of it, on the ground presumably, that he had no consideration to offer to the public in return for the grant of letters patent, he having already disposed to the public of his knowledge upon the subject for other considerations. In the judgment of the House of Lords, Lord Blackburn said; "It seems to me clear that the duty of the referees under the Act was

(*l*) 1 C. B. 574. (*m*) L. R., 3 App. C. at p. 243.

to ascertain how far the gas could be practically purified by each company. If they found that gas containing not more than a certain limited amount of impurity could be practically produced by any means, they were to prescribe the maximum amount accordingly, and they were by obvious implication, though it is not expressly enacted, to make public how this degree of purity could practically be obtained. It was not material to them to inquire whether these were means previously known, which the companies had failed to make use of from parsimony, negligence or ignorance, or whether there was some new idea which had been developed during the course of their inquiries, which made these old means practicably valuable when before they were not. They were not at all required to distinguish new from old. In all these respects the report was quite different from a specification. But, as soon as they became aware that the gas could be practicably brought to this degree of purity, their duty was to fix the maximum accordingly, and to make known to the public the means by which this could practicably be done. The report of the 31st January, 1872, is drawn up as it ought to have been. It shows that, by some means there explained, purity to a great extent could practicably be obtained, it makes no attempt to show how much of this was previously known though neglected, and it nowhere states that any part of what was now disclosed was invented by one of their own body." In the Court of Appeal Lord Justice James had said (*n*): "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the very least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation, . . . It is to be borne in mind

(*n*) L. R., 2 Ch. D. at p. 832.

that the report then made belonged absolutely to the State. Every fact and figure in it had been ascertained and obtained at the public expense, every hour of every referee and of the secretary employed in the production of it was public time . . . the consideration for every patent is the communication of useful information to the public. What consideration is there when the information was already the property of the State."

These judgments, although going to a point which was not absolutely necessary for the decision of the case (for the case was decided upon the ground of want of novelty in the invention), tend to show that it was in the minds of the judges that the mental labour of making the discovery being an essential element for the consideration of the grant, if that mental labour had already been paid for by the State, it failed as a consideration to support the patent.

By sect. 35 of the Act of 1883, "*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.*" This clause is only a re-enactment of that which had been decided to be the law previous to the Act. In *Ex parte Scott and Young* (*o*), the servant had filed a provisional specification of an invention, after which the master filed a specification for a similar invention, and subsequently filed a complete specification, and obtained letters patent. It was held that, under the circumstances, the Great Seal might be affixed to the letters patent of the servant's invention, and that the patent might bear the date of his provisional specification.

In the case of *Ex parte Bates and Redgate* (*p*), it was held, that leaving a provisional specification, and obtaining a provisional protection, does not prevent a second applicant

(*o*) L. R., 6 Ch. App. 274.

(*p*) L. R., 4 Ch. App. 577.

from leaving a specification of a similar invention, and obtaining valid letters patent for the invention before six months have elapsed from the time when the first provisional specification was left, and in such a case letters patent will not be granted to the first applicant for any part of his invention, which is covered by the letters patent already obtained by the second applicant, but in this case there was no suggestion of fraud on the part of the second applicant. This decision has, however, been doubted in *Re Dering's Patent* (*q*), by Lord Cairns, who said: "I may, however, state my objections to that decision" (*Bates and Redgate*), "which I never could thoroughly understand; it has always seemed to me that if Parliament held out to inventors the advantage they could get from provisional protection, the inventor should have the enjoyment of that advantage for the six months granted to him. Parliament intended the six months to be for the completion of the invention, and for perfecting the specification, and never said that the applicant should be deprived of or lose that privilege for want of any due diligence on his part."

The difficult questions, however, which arise in these cases, seem to be set at rest by the 14th section of the Act of 1883: "*Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same. And such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

The general question of concurrent applicants, where there is no fraud, that is, where each applicant is in a position to offer the consideration of mental labour, will be considered in the next Chapter. It is only material

(*q*) L. R., 13 Ch. D. 393.

here so far as concurrent application is brought about by reason of one man fraudulently appropriating the invention of another.

The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. We find that so far back as 1567 a patent had been granted to one Hastings (*r*) for the making of frisadoes in consideration of his having *imported the skill of manufacturing them from abroad.* So in Mathey's case, "It was granted unto him the sole making of knives with bone hafts and plates of lattice, because, as the patent suggested, he brought the first use thereof from beyond the seas." This was in the reign of Elizabeth. In the clothworkers of Ipswich case we have this (*s*) said, "The king granted unto B. that none besides himself should make ordnances for battery in the time of war: such grant was adjudged void. But if a man hath brought in a new invention and a new trade in the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything, in such cases the king, of his grace and favour in recompense of his costs and travail, may grant by charter unto him that he only shall use such a trade or trafique for a certain time; because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the king cannot make a new grant thereof." This was in 1615.

Then came the Statute of Monopolies, and we have seen that the 6th section of that Act carefully excepted "the sole working or making of any manner of new manufactures **within this realm,** to the true and first inventor or inventors of such manufactures, which others at the time of making such letters patents and grants shall not use."

Afterwards came the decisions of *Darcy* v. *Allin* (*t*), and

(*r*) 1 Web. P. C. 6.

(*s*) 1 Web. P. C. 6; 1 Godb. 252, 254.

(*t*) 1 Web. P. C. 6.

Edgebury v. *Stevens* (*u*), where it is said, "for the statute speaks of new manufactures **within this realm,** so that if it be new here it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing." See the remarks of Eyre, C. J., in *Boulton* v. *Bull* (*x*).

In the early days of manufacturing enterprise, when true inventors were so exceedingly rare as scarcely ever to be heard of, the word inventor had not acquired the meaning which it has at present, and seems to have been used to designate a **first introducer** rather than a first inventor. In the early reports shortly succeeding the Statute of Monopolies we do not find the judges in any difficulty in dealing with the words "true and first inventor," showing that the word **inventor** had not the precise meaning which it has since acquired.

In *Marsden* v. *Saville Street Co.* (*y*) in the Court of Appeal, Jessel, M. R., said, speaking of imported inventions, "It has been argued that before the Statute of James such patents were valid and were allowed by the judges, and that the statute merely restricts the duration of the patent and does not destroy the right as it previously existed. Even supposing that were so, the statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been followed ever since. It is difficult to say *à priori* on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor. I have never been able to discover the principle; and although I have often made enquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend

(*u*) 1 Web. P. C. 35. (*x*) 2 H. Bl. 491.
(*y*) L. R., 3 Ex. D. 203.

not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, 'It has been so decided and you are bound by the decisions.' But it is an anomaly as far as I know, not depending on any principle whatever. It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is that I must look on it as a sort of anomalous decision which has acquired by time and recognition the force of law."

A patent granted to a British subject, in his own name, for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent be in truth taken out and held by the grantee in trust for such foreigner (*z*).

Sect. 23 of the Act of 1883, provides for the registration of owners of patents. Sect. 85 prohibits the registration of any trust. This does not abolish trusts, but merely prohibits the registration of trusts.

The importer of an invention need not be a meritorious importer, but may only be a mere agent, *Beard* v. *Egerton* (*a*).

The importer need not have acquired the information from a foreigner abroad, but may have done so from a British subject abroad (*b*).

But a communication made **in England** by one British subject to another, of an invention, does not make the person, to whom the communication is made, the first and true inventor within the meaning of the statute 21 Jac. 1, c. 3, so as to enable him to take out letters patent for the invention (*c*).

When a patent is taken out as for an original invention

(*z*) *Beard* v. *Egerton*, 3 C. B. 97.

(*a*) *Supra*, at p. 129.

(*b*) *Nickels* v. *Ross*, 8 C. B. at p. 710, per Earl, C. J.

(*c*) *Marsden* v. *Saville Street Co.*, C. A.; L. R., 3 Ex. D. 203.

the subject of the patent being, in fact, a communication from abroad, the patent is void. *Milligan* v. *Marsh* (*d*).

"The merit of an importer is less than of an inventor. . . . . and it is an argument against the patent, that it was imported and not invented. I do not say it takes away the merit, but it makes it much smaller." Per Lord Brougham in *re Soame's Patent* (e).

We have now shown what is meant when it is said that the consideration for a patent must move from the patentee personally.

(*d*) 2 Jur. N. S. 1083; but see remarks of Sterling, J., upon this case, *In re Avery's patent*, 36 Ch. D. at p. 316. See, also, *Renard* v. *Levinstein*, 10 L. T. N. S. 177.

(*e*) 1 Web. P. C. 733.

CHAPTER III.

THE CONSIDERATION (*continued*)—A NEW AND USEFUL INVENTION.

THE second branch of the consideration is that the inventor must have invented **a new and useful invention.** It is evident that a person may have invented a manufacture which, although new to him, may not be new so far as the world is concerned. He may have had all the work and labour of discovering for himself a process which, although not generally known, yet the previous knowledge of which may amount to prior user. In such a case, inasmuch as the public are considered at law to be in full possession of the invention, it is evident that the applicant for letters patent has no consideration to offer in return for the grant. The 6th section of the Statute of Monopolies defines a new invention as "any manner of new manufacture which others at the time of making such letters patent shall not use."

We have seen that the Act of 1883 has adopted this definition of an invention. We have now to consider the legal meaning which has been placed upon the words "New Manufactures."

A new manufacture does not mean, as it is erroneously sometimes supposed, only **a new article** of manufacture, but it also means **a new process** or method of manufacturing something new or old; it does not mean a new principle of manufacturing, but it means a new application of principles. No man can claim an

invention in **a principle** (*a*), for that would be to invent the laws of nature, which have always existed. Man merely discovers the principle, and if, when he discovers a principle he can discover a method of utilizing the principle so as to make it applicable to the production of a new manufacture, he can obtain a patent for the method. In *Hornblower* v. *Boulton*(*b*), decided in 1799, the patent was granted for a method for lessening the consumption of steam and fuel in fire engines, by applying certain principles of combustion. It was held that the invention could be made the subject of a patent. The language of the learned judges does not seem very clearly to expound the doctrine upon which that judgment was based; but Mr. Justice Grose said, "I am inclined to think that the patent cannot be granted for the mere principle; but I think that, although in words the privilege granted is to exercise the method of making or doing anything, yet if that thing to be made or done be a manufacture, and the mode of making that manufacture is described, it thus becomes in effect (by whatever name it may be called) not a patent for the mere principle, but for the manufacture of the thing so made, and not merely for the principle upon which it is made." In *Boulton* v. *Bull* (*c*) the Lord Chief Justice Eyre said: "When the effect produced is some new substance or composition of things, it should seem that the privilege of sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no substance or composition of things, the

(*a*) *Boulton* v. *Bull*, 2 H. Bl. 479; *Hornblower* v. *Boulton*, 8 T. R. 101; *Jupe* v. *Pratt*, 1 Web. P. C. 146; *Neilson* v. *Harford*, 1 Web. P. C. 342; *The Househill Co.* v. *Neilson*, 1 Web. P. C. 673; *Cross-ley* v. *Potter*, Mac. P. C. 240; *Patterson* v. *The Gas Light Co.*, L. R., 3 App. Cas. 246.

(*b*) 8 T. Rep. 95.

(*c*) 2 H. Bl. 463.

patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating with or without old mechanism, by which the effect is produced." Mr. Justice Heath said, "What then falls within the scope of the proviso? such manufactures as are reducible to two classes: the first class includes machinery, the second, substances, such as medicines formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form; in the first class the machine, and in the second the substance produced, is the subject for the patent. I approve of the term 'manufacture' in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso—that it was introduced for the benefit of trade." With reference to this judgment, we may point out that a new chemical substance is not a new manufacture, as the words "new manufacture" are understood in modern times, but that in the case of manufacturing a new chemical substance, the process of making that substance is the subject of the patent, and not the substance when made.

Upon perusing the cases which we propose to quote, it will be seen that the more modern view of the construction of the words "new manufacture" has been the result of a great deal of development. At first the judges seemed to be inclined to limit the **subject-matter** of letters patent to new articles produced; but as the arts and manufactures of the country progressed and increased, it was seen that by far the most important inventions were inventions in the **process** of making old and well-known articles of commerce, and so it became evident that should the construction of the words "new manufactures" be entirely limited to the production of new articles, to the exclusion of the process of manufacturing old articles by cheaper, better and more improved methods, the inducement which the common law

intended to give to inventors would be curtailed to the narrowest possible limits.

Hull v. *Jarvis* (*d*) was an action for the infringement of a patent for the improvement of the manufacture of lace by the use of the flame of gas for the purpose of singeing the fluffy ends of the surface of lace manufactured from cotton. For the defendants it was contended that the process was not new. Fire and flame had been applied for similar purposes before the plaintiff's invention. The mere doing that with the flame of gas could not be the subject-matter of a patent. The patent, which was clearly only for a process, was supported. In *Jones* v. *Pearce* (*e*) the patentee had used the principle of suspension to the manufacture of wheels; the patent was supported because, although the principle could not be patented, the method of applying that principle to the manufacture of wheels was properly the subject of a patent. In *Russell* v. *Cowley* (*f*) the patent, which was for an improved process of manufacturing iron tubes, was supported. Lord Lyndhurst, in giving judgment, said: "It is an invention to manufacture tubes for gas and other purposes by welding them without the use of any mandril or internal support, by which certain advantages are produced."

In *Walton* v. *Potter* (*g*), Chief Justice Tindal said: "Now there can be no doubt whatever, that although one man has obtained a patent for a given object, there are many modes open for a man of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery after a patent has been obtained been able to give to the public without reference to the former

(*d*) 1 Web. P. C. 100. See also *Booth* v. *Kennard*, 1 Hurl. & N. 527; *Higgs* v. *Godwin*, 27 L. J., Q. B. 421; *Hills* v. *London Gas Light Co.*, 29 L. J., Ex. 409; *Young* v. *Fernie*, 12 W. R. 903; *Newall* v. *Elliott*, 13 W. R. 11.

(*e*) 1 Web. P. C. 122.

(*f*) 1 Web. P. C. 459.

(*g*) 1 Web. P. C. at p. 590.

one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose." In this case, the learned judge by the word "object" must have meant the method of producing an article.

The same judge, in *Gibson* v. *Brand* (*h*), said: "The patent is taken out 'for a new or improved process for the manufacture of silk, and silk in combination with certain other fibrous substances,' taken out therefore strictly for a process . . . . . undoubtedly there is a very strong reason to suppose if the specification is carefully and properly prepared, so as to point out with great distinctness and minuteness what the process is, that such a patent may be good in law. Such certainly was the opinion of Chief Justice Eyre, in *Boulton* v. *Watt* (*i*), and such also appears to have been the opinion (carefully guarding against any abuse of that doctrine) of Lord Tenterden in the case of *The King* v. *Wheeler* (*k*), who says that, 'the subject-matter of letters patent, *i. e.* the word "manufacture," as used in the Statute of James, is generally understood to denote either a thing made, which is useful for its own sake, and vendible, or to mean an engine or instrument, or some part of an engine or instrument to be employed either in the making of some previously-known article, or in some other useful purpose . . . . . or it may perhaps extend also to a new process to be carried out by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner or to a better or more useful account.'"

Since the date of these earlier decisions the law seems to have been considered as settled upon the subject. In *Bewley* v. *Hancock* (*l*), Lord Cranworth said: "A discovery

(*h*) 1 Web. P. C. 633.
(*i*) 2 H. Bl. 468.
(*k*) 2 B. & A. 350.
(*l*) 6 De G., M. & G. 402.

that the mixture of two or more simple substances in certain definite proportions will form a compound substance valuable for medical or other qualities, would afford a good ground for a patent. A discovery of some machinery, whereby such a mixture might be more quickly and effectually accomplished, might be the foundation of another patent." In *Simpson* v. *Holiday* (*m*), the specification said, "I mix aniline with dry arsenic acid and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or nearly to, its boiling point until it assumes a rich purple colour." The patentee claimed "the manufacture or preparation of red or purple dyes by heating aniline dyes with arsenic acid as hereinbefore described." Lord Chelmsford, in giving judgment, said: "There is nothing on the face of the specification to show that the invention described is not, in every part of it, the subject of a patent." It is obvious that there may be many different processes of accomplishing the same object; if some of the processes are old, and that which is claimed is merely a new method, the subject of the invention will be confined to that method (*n*).

Hereafter, in considering the specification, we shall have to discuss the limitations within which the patent for a new process will be held valid, and the cases which have been decided upon the point.

Any **addition to or subtraction from any known machine** or process causing the old machine or process to accomplish an object in a more speedy, perfect or economical manner, is evidently the subject of a patent. In *Hornblower* v. *Boulton* (*o*) Mr. Justice Grose said: "A doubt is entertained whether there can be a patent for the addition of an old manufacture, this doubt rests altogether upon *Bircot's case* (*p*), if that were to be considered as law

(*m*) L. R., 1 H. L. 315.
(*n*) *Bovill* v. *Pimm*, 11 Exch. 739.
(*o*) 8 T. Rep. 104.
(*p*) 3 Inst. 184.

at this date (1799) it would set aside many patents for many ingenious inventions . . . . . if indeed a patent could not be granted for the addition it would be depriving the public of one of the best benefits of the statute of James." In *Lister* v. *Leather* (*q*), Lord Campbell said: "The assertion that all patents for improvements of existing patents must be void, is obviously untenable." In *Fox* v. *Dellestable* (*r*), V.-C. Malins said: "No doubt a man may make an **invention** which is partly covered by an **existing patent,** but he cannot use it without the licence of the patentee. He may wait for the expiration of the patent and take out one himself. If his invention be novel, that patent will be valid."

An application of an old machine or an **old material for a new purpose,** may be the subject of a patent; for instance, *Muntz* v. *Foster* (*s*) was an action for an infringement of a patent for the manufacture of metal plates to be used for sheathing the bottoms of ships. The improvement consisted of using an alloy of zinc and copper in certain proportions for the manufacture of the plates, and for this purpose copper alone had hitherto been used. The alloy of zinc and copper was to produce an old and well-known material, still the application of that old material to sheathing of ships had not before been discovered, and upon its being shown that such an application was a great improvement on the old method of sheathing with copper, it was held that the patent could be sustained.

The mere application of a **known instrument or machine to a new purpose** will not support a patent unless the means or method of the application is also new (*t*).

In *Reg.* v. *Cutler* (*u*) Lord Denman said: "With regard

(*q*) 8 E. & B. at p. 1017.
(*r*) 15 W. R. at p. 195.
(*s*) 2 Web. P. C. 103; see also *Hayward* v. *Hamilton*, Griffin, P. C. 115.
(*t*) *Pow* v. *Taunton*, 9 Jur. 1056.
(*u*) 3 C. & K. 215.

to the third and fourth claims, in which the defendant claims the application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that would have been a new discovery, and a proper subject for a patent . . . I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article, or to the mode of applying it for attaining that result, forms no ground for a patent." Lord Denman's distinction between the mere application of an old instrument to a new purpose and a new combination, appears to have been followed, and to be a correct exposition of the law.

In *Jackson* v. *Needle* (*x*) North, J., said: "The plaintiff's first witness seemed to have an idea that because the parcels post was new, therefore a thing to be sent through the parcels post was new: there is no foundation for that."

In the case of *Steiner* v. *Heald* (*y*), in the Exchequer Chamber, the head-note is inexplicable and erroneous. If the case itself is read, it will be found to be in accordance with the other decided cases on this subject: In the ordinary process of dyeing, by means of madder, the colouring matter was obtained from fresh madder by the application of hot-water; the refuse, after boiling, was called spent madder. It had long been known to dyers, that a portion of the colouring remained in the spent madder, but it was not known how to extract it, as it remained in combination with the plant; recently it was discovered that by means of acid and hot-water the pure colouring matter of madder, called garancine, could be obtained from fresh madder, and that this process extracted the colouring matter of the plant. The plaintiff obtained a patent for the new manufacture of garancine, by applying

(*x*) Griffin, P. C., at p. 134.

(*y*) 20 L. J. Exch. 410.

the same process of acid and hot-water to the spent madder; since his invention the spent madder, which was previously worthless, became valuable.

At the trial Chief Baron Pollock directed the jury to find a verdict for the defendant, upon the ground apparently that there was no subject for a patent; in reversing this decision Mr. Justice Pearson said: "Now spent madder might be a very different thing from fresh madder in its properties, or it might be in effect the same thing as fresh madder in its properties, chemical and otherwise, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical and otherwise, might or might not have been known to chemists and other scientific persons, so that they could find out whether fresh madder and spent madder were different or substantially the same things. The points appear to us to be questions of fact, and materially to affect the validity or invalidity of a patent." It will appear, therefore, that the Court were of opinion that it was a question of fact whether spent madder and fresh madder were the same thing in their chemical properties; if they were, no patent; if they were not, the validity of the patent would be sustained, but the fact must be decided by the jury.

In *Bush* v. *Fox* (*z*) Chief Baron Pollock graphically illustrated the point we are now discussing. He said: "I think if one man invents a new mode of looking at the moon, somebody else cannot take out a new patent for looking at the sun. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think anyone could say, 'I will take out another patent for another telescope to be used for taking observations on the sea.'" That case was ultimately confirmed in the House of Lords (*a*). In *Brook* v. *Aston*, Baron Martin said (*b*): "The application of a well-known tool

(*z*) Macrory's P. C. 164.

(*a*) 5 H. L. C. 707.

(*b*) 8 E. & B. 485.

to work previously untried materials, or to produce new forms, is not a subject of a patent."

In *Bamlett* v. *Picksley* (*c*), Blackburn, J., said: "There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Take this example. It was discovered that by taking flour and making it into tough dough by means of machinery you could spin it into a pipe known as macaroni pipe. An ingenious man knowing how to spin flour into a pipe, it occurred to him to take red-hot iron, and spin that into pipes by machinery in the same way as flour was spun into a pipe for macaroni. That was not an invention as it turned out, but had that been so, and had he been able to spin the iron in the same way as flour was spun into pipes for macaroni, few men I think would deny that there was an invention there, it being a product so completely new, and that it would be an invention for making a new manufacture which others did not make, because the result was so totally different, even although in fact the machinery which was used for the purpose, except that it was made stronger, would be indentically the same as the machinery originally used for the purpose of making the macaroni."

It is evident to anyone considering these cases, that the border line is exceedingly fine. In *Penn* v. *Bibby* (*d*), Lord Chelmsford, L. C., recognized the difficulty of stating any definition which should be applicable to every case. He said: "It is very difficult to extract any principle from the various decisions on this subject which can be applied with certainty to every case, nor indeed is it easy to reconcile them to each other." He then proceeds to dissent from the definition given by Lord Campbell in *Brook* v. *Aston*, doubting the accuracy of the report, and proceeds to say:

(*c*) Griffin, P. C., at p. 42. See also *Croysdale* v. *Fisher*, 1 Patent Office Reports, 17.

(*d*) L. R. 2 Ch. App. 127.

"Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or at least of a rule for judging in these cases, in *Harwood* v. *G. N. R.* (*e*), where he says, 'although authorities established the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purpose, or to purposes so nearly cognate and similar as that the application of it in one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, whether the amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is so sufficiently meritorious as to be deserving of a patent.'" The case of *Harwood* v. *G. N. R.*, quoted above by the Lord Chancellor, was carried to the House of Lords, where Lord Chelmsford, then Lord Chancellor, said: "The question is, whether there can be any invention of the plaintiff in having taken that thing, which was a fish for the bridge, and having applied it as a fish for the railway, upon that I think the law is well and rightly settled . . . . . viz., that you cannot have a patent for a well-known mechanical appliance, merely because it is applied in a manner or to a purpose which is analogous to the manner or purpose in or by which it has hitherto been notoriously used (*f*)." It may be noticed that where the **object** of a patent is **old**, and the **means** to effect it only are **new**, the Court construes the invention strictly, as it looks jealously at the claims of inventors seeking to limit the right of the public to a well-known object (*g*).

(*e*) 29 L. J., Q. B. 193; also *Ralston* v. *Smith*, 11 H. L. Cas. 223; *Jordan* v. *Moore*, L. R., 1 C. P. 624; *Parkes* v. *Stevens*, L. R., 8 Eq. 367; L. R., 5 Ch. 36.

(*f*) 11 H. L. Cas. 654.

(*g*) *Curtis* v. *Platt*, 3 Ch. D. 135, n.; *Rushton* v. *Crawley*, L. R., 10 Eq. 522; *The Patent Bottle Envelope Co.* v. *Seymer*, 5 C. B., N. S. 164; *Horton* v. *Mabon*, 12 C. B. N. S. 437; *Ormson* v. *Clarke*, 14 C. B., N. S. 475.

A new combination is an invention consisting of the discovery that two or more known processes, materials, or implements when used together will become applicable to a new purpose, or will effect an old purpose in a better, cheaper or more expeditious manner than it had before been done.

In *Huddart* v. *Grimshaw* (*h*), Lord Ellenborough said: "I suppose it will not now be disputed that a new combination of old materials, so as to produce a new effect, may be the subject of a patent." There may be a valid patent for a new combination of materials previously in use for the same purpose (*i*).

In *Foxwell* v. *Bostock* (*k*), Lord Westbury said: "If a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented."

Bovill's patent consisted of a combination of a blast, with an exhaust of air to millstones, for the purpose of preventing the heat generated in grinding corn and saving the dust generated. It was proved that a blast and an exhaust had been used separately. But that the **combination was a substantial improvement**. The patent was held good (*l*).

In *Crane* v. *Price* (*m*), the patentee, in his specification, after specifically disclaiming the use of the hot blast or the

(*h*) Dav. P. C. 267.

(*i*) Per Lord Eldon, *Hill* v. *Thompson*, 1 Web. P. C. 237.

(*k*) 12 W. R. 725. See also *Harrison* v. *The Anderston Foundry Co.*, *infra*, p. 98; *Hayward* v. *Hamilton*, Griffin, P. C. 115; and *Moore* v. *Barrett*, Griffin, P. C. 158.

(*l*) *Bovill* v. *Keyworth*, 7 E. & B. 725; *Brunton* v. *Hawkes*, 4 B. & Ald. 550; *Lewis* v. *Davis*, 1 Web. P. C. 488; *Carpenter* v. *Smith*, 1 Web. P. C. 538; *Allen* v. *Rawson*, 1 C. B. 551; *Lister* v. *Leather*, 27 L. J. Q. B. 295; *Dangerfield* v. *Jones*, 13 L. T. R., N. S. 142.

(*m*) 1 Web. P. C. 393.

use of anthracite coal, proceeded: "What I do claim as my invention is, the application of anthracite or stone coal or culm *combined* with the using of hot air blast in the smelting and manufacture of iron from ironstone, mine or ore as above described." The patent was held valid for the combination. This decision was afterwards questioned by Lord Justice James in *Murray* v. *Clayton* (*n*), but not on the ground that a combination could not form the subject of a patent. In *Murray* v. *Clayton* the decision was followed, and a patent of this description was upheld.

A patent was granted in 1870 for railway signalling apparatus; in 1871 another patent was granted for other improvements in railway signalling apparatus; in 1874 the plaintiffs obtained a patent for a combination which, in effect, was constituted of the improvements in the 1870 and 1871 patents; any person of ordinary knowledge of the subject would, by placing the two inventions of 1870 and 1871 side by side, be able to effect the desired combination without making any further experiment or gaining any further information. Field, J., held the 1874 patent void (*o*).

In *Cannington* v. *Nuttall* (*p*), it was held that the patent could be sustained, although **each principle or process in it was previously well known**, provided that the mode of combining these processes was new and produced a beneficial result, and provided also that the specification claimed not the old processes or any other, but only the new combination. This case is very instructive, as clearly demonstrating what is meant by a "new combination."

Having now considered the interpretation which has been placed by the Courts upon the word "manufacture," we next examine what has been held to be a "**new manufacture,**" that is to say, to what extent prior user is an

(*n*) L. R., 7 Ch. 584.
(*o*) *Saxby* v. *Gloucester Wagon Co.*, L. R., 7 Q. B. D. 305.
(*p*) L. R., 5 H. L. 205.

answer to an action for the infringement of a patent. It is evident, that, if the alleged new manufacture can be shown to have been in the possession of the public before the application for the grant of letters patent, that there is no consideration for the grant. The patentee offers to the public, in return for the monopoly privilege, his information and knowledge respecting a new manufacture; if the public is already possessed of the information or knowledge the supposed inventor has nothing to give. We shall see hereafter, when we discuss the practice of the Courts in actions for the infringement of patents, that the **burden of proof** lies on the alleged infringer when he sets up a defence of **prior user,** *i.e.*, of want of novelty in the alleged manufacture at the date of the patent; and it is as well to keep this in mind in reading the cases which have been decided as to what amounts to prior user.

We have seen that the Statute of Monopolies is a mere declaration of that which was the law before it was passed; it was always held by the Courts that the principle of a patent grant was not an arbitrary advantage granted by the Crown to one subject in detriment to the rest, but that it was an advantage granted by the Crown to persons who introduced a new manufacture, and that it was granted upon principle, not for the benefit of the patentee but for the benefit of the public: it being considered to the benefit of the public that reasonable encouragement should be given to inventors to induce them to devote their time, energies and resources to the improvement of the arts and manufactures of the realm.

In the case of *Hasting's Patent* (*q*), decided in 1567, the patent was in consideration of the patentee having brought into the country the making of frisadoes as they were made in Haarlem, in Amsterdam, being not used in England. The infringers defended the patentees' bill in the Exchequer

(*q*) 1 Web. P. C. 6.

Chamber, on the ground that they had made baies very like to Mr. Hasting's frisadoes, prior to the date of Mr. Hasting's patent; they were therefore not restrained from making baies like his frisadoes. A patent was granted to "one Humphrey, of the Tower, 'for the sole and only use of a sieve or instrument for melting of lead, supposing it was his own invention, and therefore prohibited all others to use the same for a time;' and because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber by English bill, in which Court the question was whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendip, in West country, which if it were there before used then the Court were of opinion that he should not have the sole use thereof (*r*)."

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex* v. *Arkwright* (*s*), decided in 1785, Mr. Justice Buller gave a definition of "*novelty*" which now would be considered too wide. "Thus the case stands as to the several component parts of this machine, and if upon them you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant, upon either of these points the prosecutor is entitled to your verdict."

When we speak of an invention being new, we mean that it must be new so far as the public are concerned, that is, so far as the means of information of the public goes. If a man had invented a machine and made it and used it **secretly**, so that no one but himself had access to it, and the general public had no means of information upon it,

(*r*) 1 Web. P. C. 7; *Darcy* v. *Allin*, 1 Web. P. C. 6; *Mitchell* v. *Reynolds*, 19 Mod. R. 130; *Liardet* v. *Johnson*, 1 Web. P. C. 52 and 53.

(*s*) 1 Web. P. C. 64.

there is no doubt that a subsequent inventor, re-inventing, so to speak, the same machine, and disclosing his knowledge to the public in his specification, would be entitled to a valid patent. A machine made by the person who kept it secret would not amount to such a public knowledge as would anticipate the invention of the patentee, but if the first-made machine had been used in such a manner that other persons had been enabled to acquire the knowledge of its use and application, there would be a prior user to void the subsequent patent. Lord Chief Justice Tindal said, in *Cornish* v. *Keene* (*t*): "If it was known at all to the world publicly, or practised openly so that any other person might have the means of acquiring a knowledge of it as well as the inventor, then the patent would be void." In *Carpenter* v. *Smith* (*u*), Lord Abinger, C. B., analyzed the meaning of the words "**public use.**" "Public use does not mean a use or exercise by the public, but a use or exercise in a public manner." Taking that as a definition of the meaning of the words "public use," it will be apparent that the question of prior user is one of fact, and one which will have to be considered by a **jury** or a judge sitting as a jury upon the facts of each particular case.

The decided cases only offer illustrations of that which has been held to be public use or prior user in the different cases which have come before the Courts. In *Walton* v. *Bateman* (*x*), Cresswell, J., said, referring to the words in the statute, "which others at the time of making such letters patent and grants did not use," said: "Now that has been held to mean a user, not by way of experiment, but a public user, in distinguishing which the knowledge of the parties as to the article in use will be material for your

(*t*) 1 Web. P. C. 508.

(*u*) 1 Web. P. C. 534. See also *Croysdale* v. *Fisher*, 1 Patent Office Reports, 17; *Lewis* v. *Marling*, 10 B. & C. 26; *Minter* v. *Mower*, 1 Web. P. C. 139; *Morgan* v. *Seaward*, 2 M. & W. 544; *Betts* v. *Menzies*, 1 E. & E. 1008; *Harwood* v. *G. N. R.*, 29 L. J., Q. B. 193.

(*x*) 1 Web. P. C. 615 to 619.

consideration. . . . . Whether it is a *manufacture* within the meaning of this Act I apprehend to be a question of law." The learned judge then proceeds to sum up to the jury upon the question of fact as to prior user. "First, was any article made before, answering the purposes or having the properties of that which the plaintiff has made and claimed as in the patent . . . . . then even supposing that article did embody the principles of the plaintiff's, so as to present to persons using it the properties, qualities and advantages in principle of that article which the plaintiff makes, the question for you will be whether that user is not to be considered rather in the nature of an **experiment** than of any public use of the article, so as to deprive the plaintiff of the fruit of his discovery in respect of this manufacture." The learned judge then proceeds to quote the words of Tindal, C. J., in *Cornish* v. *Keene* (*y*): "'The question raised for the jury was this, whether various instances brought forward by the defendants amounted to proof, that before or at the time of taking out the patent the manufacture was in public use in England, or whether it fell short of that point and proved only that experiments had been made in various quarters and had been afterwards abandoned.'" It is very difficult to reconcile the meaning of Mr. Justice Cresswell when he says, that "the question of prior user is one for the jury," with his remarks in the latter part of the judgment. "The third issue is much wider. The defendants say that the alleged invention was not, nor is, a new manufacture within the meaning of the statute concerning monopolies. Now that is put to him as a question of law . . . and I am confirmed now, on further consideration, in the opinion I previously expressed, that there is sufficient of a new manufacture in this case to justify and maintain the patent that has been granted. I think that there is a new principle

(*y*) 1 Web. P. C. 519.

developed, carried out and embodied in the mode of using that principle." The learned judge must have had present in his mind that the point of law was as to whether the manufacture was a manufacture in the meaning of the statute or not, for the **novelty** of the manufacture is certainly **a question of fact.**

As further illustrating the distinction between "public use" and "secret use" we may quote the words of Mr. Justice Williams in *Hancock* v. *Somervell*, which is quoted in "Newton's London Journal," Vol. XXXIX. p. 158. "The defendants say that the invention had been substantially published and was in use, not in secret use, but in public use in England before the date of the patent, and if that is so, it would entitle the defendants no doubt to a verdict upon this novelty issue. Upon that part of the case the view that it seems to me ought to be taken by you is this, you will first consider whether the material was before the public; it is not necessary that it should be used by the public if it is in public use, not in secret use. . . . I should here say that I do not think it necessary the use should be actually for sale; if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handed about the country for the purpose of attracting customers. If you should think that the material being so in use, it was so palpable that you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it, that would be a public use."

In *Stead* v. *Anderson* (*z*), Baron Parke placed some considerable limitation of the meaning of the words "public use" in saying, "if the mode of forming and laying blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been sufficient user to destroy

(*z*) 2 Web. P. C. 149. See also *Stead* v. *Williams*, 2 Web. P. C. 136.

the plaintiff's patent, though put in practice in a spot to which the public had not free access."

It is difficult to draw the line precisely between public and secret use: we do not suppose that for the purpose of shewing that some use was secret use, it would be necessary to shew an intention of secrecy, but in all cases it will be a matter of fact whether the use was so private and so secret as to make it practically impossible that the public should become acquainted with the manufacture.

Mr. Justice Erle, in *Heath* v. *Smith* (*a*), cast a doubt even upon whether **secret use** would not amount to anticipation. He said, "If one party only had used the process and had brought out the article for profit and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." But this seems to be in direct contradiction to the decision in *Dollond's Case* (*b*). In that case the objection to Dollond's Patent was, that he was not the inventor of the method of making new object-glasses, but that Dr. Hall had made the same discovery before him; but it was held, that inasmuch as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the inventor (*c*).

In *Betts* v. *Neilson* (*d*) it is said, "There may be public use of a patented article, **without** actual **sale** of the goods manufactured."

There are some conflicting cases on the subject of **secret use.** It does not appear to be open to much doubt that purely secret use, without publication, even if accompanied with the sale of the article manufactured, provided the article itself, by its appearance or other qualities, does not disclose the invention, ought not to invalidate the

(*a*) 3 E. & B. 256.

(*b*) 1 Web. P. C. 43.

(*c*) See also the remarks of Buller, J., in *Boulton* v. *Bull*, 3 H. Bl. 463 to 470; and Mr. Justice Dallas in *Hill* v. *Thompson*, 1 Web. P. C. 244.

(*d*) L. R., 3 Ch. 429.

letters patent granted to a subsequent inventor, since he is in the position to, and does give to the public the full consideration required by the Statute of Monopolies and the common law, for the patent grant which he applies for. On the other hand, if the secret use has been by himself, and he only applies for letters patent when he has any fear of his invention being discovered, then, probably, the previous secret use of the inventor would be held to invalidate his patent; but that must be on the ground of want of *bona fides* on the part of the inventor, and not on the ground of prior user, and want of *bona fides* has always been held to invalidate letters patent (*e*). This question is discussed hereafter (p. 50).

In *Smith* v. *Davidson*, a Scotch case (*f*), the Lord President said, "In order to invalidate letters patent on the ground of previous use it is necessary not only that the use shall have been prior to the date of letters patent, but that it should be a public and not a secret use." The remarks of Lord Bramwell, in *Hills* v. *London Gaslight Co.* (*g*), on this subject were as follows: "If a person has invented anything which is the subject of a patent, and has kept it to himself or communicated it privately to one or two, in fact has not made it public knowledge, if anyone else discovers that invention it is new, that is to say, new in the sense that the first invention has not been published."

There is another description of anticipation which is capable of invalidating a patent besides that of public use, and that is **prior publication.** Prior publication means the printing, writing, or publishing of some document to which the public have access, containing such a description of the invention as will enable a practical man to carry it out from the description given. Vague hints

(*e*) See *Tennant's case*, 1 Web. P. C. 125.

(*f*) 19 C. S. 691.

(*g*) 5 H. & N. 336.

or descriptions of experiments, incomplete, or imperfect, are not sufficient to invalidate a subsequent patent. It is not necessary that that which is described in the book or publication should have been carried out in practice, it equally anticipates the patent (*h*). The question will always be one of fact, depending on the circumstances of each particular case, and the point which should be left to the consideration of the jury is, whether upon the whole evidence there has been such a publication as to make the description part of the public stock of information (*i*).

It is necessary that the description in the publication which is relied upon as evidence of prior publication, should be such as will when carried out produce the patented article; otherwise, however similar the description may be, if it will not produce the alleged invention it will not amount to anticipation (*j*).

Vice-Chancellor Wood, in *Betts* v. *Menzies* (*k*), said, "I think that if a man sits down and takes out a patent from his own conjectures without ever having tried the experiments set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless." This remark of the learned Vice-Chancellor indicates how difficult a thing it is to lay down a general rule which shall bind every case; indeed no such general rule has ever been framed. It is evident that if a man were to describe an invention in a book or in a specification, and describe it so minutely and accurately that any practical person could from the description produce the invented matter, it would be immaterial whether the writer had tried

(*h*) See *The Household Company* v. *Neilson* in the House of Lords, 1 Web. P. C. 718, n.

(*i*) *Stead* v. *Williams*, 2 Web. P. C. 142.

(*j*) *Muntz* v. *Foster*, 2 Web. P. C. 94.

(*k*) 3 Jur. N. S. 358.

experiments or had ascertained whether his invention would work in practice or not. If it should afterwards turn out to work in practice, and work as described, without any further inventive power and without any further invention being necessary, the description in the book or specification would be sufficient to invalidate any subsequent patent for the same invention.

In *Betts* v. *Menzies* (*ante*) the Vice-Chancellor had before him a case where the method described in the earlier publication was practically useless. In that event there is no doubt that the description would not invalidate a subsequent patent, because further invention would be necessary to bring the matter to a successful issue.

When *Betts* v. *Menzies* (*l*) came before the House of Lords, Lord Westbury said: "To defeat a new patent, it must be clear that the antecedent specification disclosed a practical mode of producing the result which was the object and effect of the subsequent discovery; a barren general description therefore, though containing some **suggestive information** or involving some **speculative theory,** could not be treated as avoiding for want of novelty a subsequent specification or invention, unless it was ascertained that the antecedent publication involved the same amount of **useful information.**" In the same case the opinion of the judges having been taken by the House of Lords as to whether the Court could pronounce Betts' patent to be void simply on the comparison of two specifications without evidence to prove identity of invention, and also without evidence that Dobbs' specification disclosed a practical mode of producing the result, or some part of the result described in Betts' patent; Mr. Justice Blackburn, subsequently Lord Blackburn, gave it as his opinion, "that **to avoid a patent on the**

(*l*) 10 H. L. C. 117. See also and *Barlow* v. *Baylis*, Griffin, *Stoner* v. *Todd*, L. R., 4 Ch. D. 58, P. C. 44.

ground of want of novelty, it is necessary to show that part of what the patentee claimed as a new invention was at the date of the patent already a publicly-known invention; this may be shown by proving that the invention was already disclosed in a publication accessible to the public . . . . . it is not necessary to show that the invention thus made publicly known had already been put in actual use . . . . . as soon as it has been ascertained that the description in the book makes known an invention, that is to say, that it adds to the public stock of knowledge what would without any further discovery enable a person to produce a result in the nature of a new manufacture . . . . . If Dobbs had made it part of the public knowledge how to produce a new material as a practical result, and Betts had afterwards claimed to have a patent for, amongst other things, producing that result, he would have claimed that which was not new, and if Dobbs had not made it part of the public knowledge how to produce the result, then Betts would not have claimed anything already known. The Court cannot tell without evidence whether what Dobbs disclosed would produce a result, and, therefore, as it seems to me, cannot pronounce the first patent void without evidence. I therefore answer your lordships' question in the negative" (*m*).

The cases which have been decided have generally been upon the subject of antecedent publication by means of a **specification,** but it is evident that the publication of **a book** or **newspaper,** or in any other form which gives the public a means of information, is equally potent as an anticipation of a subsequent patent (*n*). *Hills* v. *London*

(*m*) See also *Betts* v. *Neilson* and *Betts* v. *de Vitre*, L. R., 3 Ch. 429; *Neilson* v. *Betts*, L. R., 5 H. L. 1.

(*n*) *Young* v. *Fernie*, 12 W. R. 901; *Plimpton* v. *Spiller*, L. R., 6 Ch. D. 412; also *Patterson* v. *Gas Light and Coke Co.*, L. R., 3 App. Cas. 239; *United Telephone Co.* v. *Harrison, Cox, Walker & Co.*, L. R., 21 Ch. D. 720.

Gas Light Company (*o*) illustrates very clearly the principle laid down by Lord Westbury in *Betts* v. *Menzies*. The plaintiff obtained a patent for the employment of hydrated oxide of iron in purifying coal gas. A specification was put in evidence as published some ten years prior to the plaintiff's patent by one Croll, in which he said that coal gas could be purified by using the oxide of manganese, the oxide of zinc, or the oxide of iron. Now there are two descriptions of oxide of iron, hydrated and anhydrous. Anhydrous oxides of iron will not purify coal gas. It was held, therefore, that inasmuch as further experiments were required to discover that the action of hydrated oxide of iron was different from that of anhydrous oxide of iron in the purification of coal gas, that the antecedent specification did not anticipate the plaintiff's specification.

In *Hills* v. *Evans* (*p*) Lord Westbury said: "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments."

In *Philpott* v. *Hanbury* (*q*), however, Grove, J., said: "What I am going to say now is an expression of opinion that is rather obiter. . . . . As a matter of fact my opinion is . . . . . that there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there

(*o*) 29 L. J. Ch. 409.

(*p*) 31 L. J. Ch. 463. See also *Lawrence* v. *Perry*, Griffin, P. C. 143.

(*q*) 2 P. O. R. 43.

is a distinction; but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled—the higher class of skilled workmen), would enable them to understand it. If it be such it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent."

It is not necessary that the book containing the description of the invention should be sold so as to constitute an anticipation. Mere **exhibition** in a bookseller's window **for sale** is sufficient publication, or sending it to a bookseller's in this country to be published. "There is no difference between a foreign inventor and an English one if, when the inventor is a foreigner, he publishes the book in a foreign language and sends it over to the booksellers in this country for the purpose of being sold" (*r*). Prior publication in a foreign journal and in a foreign language will invalidate an English patent if it can be shown that a single copy was deposited in England in a public place, and was open to public inspection (*s*).

In *Otto* v. *Steel* (*t*), where a French treatise was placed in the British Museum Library in 1863, it was held by Pearson, J., that having regard to the arrangements of the library there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876. The library arrangements were as follows: There was no access to the public to any part of the library of the British Museum beyond the reading room. The public had

(*r*) Per M. R. in *Lang* v. *Gisborne*, 31 Bevan, 135.

(*s*) *United Telephone Co.* v. *Harrison, Cox, Walker & Co.*, L. R., 21 Ch. D. 720.

(*t*) 31 Ch. D. 241.

access to the general catalogue and to books of reference kept in the reading room. In the general catalogue of the British Museum the printed books were referred to under the names of their authors. The treatise in question was entered in the catalogue under the name of Beau de Rochas, and in no other place. It was itself kept in an inner room, and it could only be obtained by one of two means, either by some person knowing of the book and writing the name of the book on a piece of paper and requesting that the book might be furnished to him; or if a reader wanted to find something on a particular subject, and went to the superintendent and asked what books there were that he had better read. The superintendent, if not able to give the information, would direct one of the assistants to take him to that section of the library where such books were likely to be found, and would desire him to let the reader look over the titles of those books, and select what book he pleased out of that section of the library.

But in *Harris* v. *Rothwell* (*u*) it was held by the Court of Appeal that, *primâ facie*, a patentee is not the first inventor if before the date of his patent an intelligible description of his invention either in English or in any other language commonly known in this country, was known to exist in this country either in the patent office or in any other public library to which persons in search of information on the subject would naturally go for information. But if it be proved that the foreign publication, although in a public library, was not in fact known to be there, the existence of the publication in this country is not fatal to the patent. *Otto* v. *Steel* (*supra*) was distinguished on the ground that there the anticipating publication was proved not to be known to be in the public library.

An inventor may invalidate his own invention by previous

(*u*) 35 Ch. D. 416; 56 L. J. Ch. 459; 56 L. T. 552.

publication in a specification. For instance, if an inventor applies for letters patent and files a complete specification, and after the publication of the specification abandons it and begins again applying for letters patent for the same invention, the previous publication of the specification will invalidate a subsequent patent.

Under the Act of 1883 it is clear that if he only filed a provisional specification there would be no publication, since provisional specifications which are subsequently abandoned, are not published. In *Oxley* v. *Holden* (*x*) it appeared that on the 17th March, 1858, the plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages. On the 10th April, 1858, he obtained a second provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The first application was abandoned, and the second carried to completion—*there was no evidence that between the date of the first application and the second the invention had in any way been put in practice or published:* held, that the first application did not invalidate the patent. In *Lister* v. *Norton* (*y*) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J., held that the reasoning of *Oxley* v. *Holden* applied to this case, and said, "But reverting to the point of law, I think that this user in public is covered by the grounds on which the Court of Common Pleas decided *Oxley* v. *Holden*. The Court held that the protection of the first provisional specification extended down to the grant of the patent, and made this one of the grounds of their decision. A provisional specification was the creature of the Act of 1852. That Act, after providing for the filing of such a specification which is to describe the nature of the invention, and

(*x*) 8 C. B. N. S. 666.

(*y*) Griffin, P. C., at p. 151—154.

for the grant of the certificate, proceeds in the 8th sect. to enact that 'Thereupon the invention therein referred to may during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same.' The phrase 'to be granted for the same' obviously means in this section, and in the 9th section (which relates to the filing of a complete specification in the first instance) for the same invention, and cannot be construed as referring to the application or petition." So far as the author can ascertain this judgment was not appealed from, nor does it appear to have been discussed in any subsequent cases. Should the decision be upheld the results will be curious.

The secret manufacture and sale by the inventor himself of a subsequently-patented article prior to the date of the patent, would of itself constitute an anticipation of the invention. This branch of the subject is surrounded with considerable difficulty, for bearing in mind that the consideration which the inventor gives for the patent is the information which he is in a position to give to the world, it is difficult to understand upon what principle, if he keeps that information to himself and manufactures an article which of itself does not disclose his invention, he should not have a patent; since he is always in a position to give the information to the public, and to give a valid consideration for the grant. Unless indeed we regard the grant of letters patent, as not only the result of a contract between two parties, the state and the inventor, but also as somewhat after the nature of a reward for invention, which is only given for merit. There is, as we have pointed out before, no merit in publishing an invention which you find it difficult to keep any longer secret. Of course it would be otherwise where the article itself, by its appearance or by its properties, discloses the invention; the Courts, in their decisions, seem to have recognized the difficulty of

this question. Baron Parke, in *Morgan* v. *Seaward* (*x*), said: "For if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a very much longer period than fourteen years." It does not seem to have been expressly decided that if an article sold did not disclose the invention, the use of the invention, if kept secret, would invalidate a subsequent patent by the inventor. Baron Parke seems to have thought that it would; on the other hand, if the original inventor manufactured articles, but kept the invention secret so that no one else could practise it, and someone else were to re-invent the same matter subsequently, can it be said that the secret use of the invention by the first inventor would invalidate the patent of the second inventor? and if not the patent of the second inventor, why, upon principle, should one person from whom the consideration would move personally be in a worse position than another? It may be said, perhaps, that the common law contemplated *bona fides* on the part of the inventor, and a *bonâ fide* discovery of the invention to the public within a reasonable time, and that the working of the invention in secret and subsequent application for the patent was strong evidence of *mala fides*, and consequently would avoid the patent on the ground of a constructive fraud upon the public (*a*).

Mere **experiments** with a view to discovery have been frequently held not to invalidate a subsequent patent; few inventions could be made without trial, and there are some things of such magnitude that the trials cannot practically

(*x*) 2 M. & W. 544.

(*a*) As to publication by sale, see *Wood* v. *Zimmer*, 1 Web. P. C. 44; *Losh* v. *Hague*, 1 Web. P. C. 205; *Gibson* v. *Brand*, 1 Web. P. C. 328; *Carpenter* v. *Smith*, 1 Web. P. C. 536; *Mullins* v. *Hart*, 5 Car. & K. 297; *Heath* v. *Smith*, 2 Web. P. C. 268; *Honiball* v. *Bloomer*, 2 Web. P. C. 200; *Oxley* v. *Holden*, 8 C. B. N. S. 666.

be conducted in private: hence it has been held that the mere making of experiments, with a view to invention, does not invalidate a patent (*b*).

Neither does the manufacture and sending out of samples for the purpose of experimenting as to the satisfactory character of the invention (*c*).

Not only must the invention be new, but **the whole** of the **invention** which is claimed in the specification **must be now** (*d*); and if *any material part of it can be shown to* have been anticipated, there would be a valid objection to the patent, and an action for infringement, even of the parts that are new, would not be maintainable.

We shall show hereafter that the claiming of too much in a specification, that is to say, the claiming of things which are not new, is not incurable, but that it operates in such a way as to prevent the inventor from successfully maintaining an action against an infringer until he has taken the proper steps to obtain a disclaimer of the tainted portion, so to speak, of his specification. In *Bramah* v. *Hardcastle* (*e*) Kenyon, J., said: "Unlearned men look at the specification, and suppose everything new that is there; if the whole be not new, it is hanging terrors over them." In *Hill* v. *Thompson* (*f*), per Dallas, J., "If any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." In *Brunton* v. *Hawkes* (*g*)

(*b*) *Newall* v. *Elliott*, 4 C. B., N. S. 269; *Hills* v. *London Gas Light Company*, 29 L. J. Ex. 409. See also *Jones* v. *Pearce*, 1 Web. P. C. 122; *Bramah* v. *Hardcastle*, Holroyd, 81; *Cornish* v. *Keene*, 1 Web. P. C. 508; *Galloway* v. *Bleaden*, 1 Web. P. C. 525; *Stead* v. *Williams*, 2 Web. P. C. 135; *Household Company* v. *Neilson*, 1 Web. P. C. 673. *Edison and Swan Electric Light Co.* v. *Woodhouse*, Griffin, P. C. 90.

(*c*) *The Useful Patents Co.* v. *Rylands*, Griffin, P. C. 234.

(*d*) *Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412, and per Jessel, M. R., in *Frearson* v. *Loe*, L. R. 9 Ch. D. 58.

(*e*) 1 Carp. P. C. 168.

(*f*) 1 Web. P. C. 249.

(*g*) 4 B. & Ald. 541.

Abbott, C.J., said: "I feel myself compelled to say that I think so much of the plaintiff's invention, as respects the anchor, is not new, and that the whole patent is therefore void." A process incidental to the manufacture, which is not one of the substantial elements of the claim, will not invalidate a patent (*h*).

A description of two processes, one of which is old, and the other new, a claim of the combination of the two would be valid for the combination; but if the claim is not for the combination, but for the two processes, then the patent is void (*i*).

When a part of a described invention is old, the question will always arise as to whether the claim is for the several parts as described, or for the combination. We shall treat of this subject at length when we deal with the specification.

We now come to the consideration of the question of **utility**, for not only must the invention be new, but it must be new and useful. The 6th section of the Statute of Monopolies does not refer to the necessity of utility in the invention, but saving, as it does, the common law prerogative of the Crown in respect of inventions, it refers us back to what had previously been held to be the necessary elements of an invention. In *Darcy* v. *Allin* (*k*), decided in 1602, it was held, the invention must tend to the furtherance of trade, and be for the good of the realm, and that the monopoly was granted in consideration of the good that the inventor doth bring by his invention to the commonwealth, otherwise not. Consequently an essential element of a valid grant is, that it should be for something which is for the good of the realm; that is, it must be useful (*l*).

(*h*) *Muntz* v. *Foster*, 2 Web. P. C. 112.

(*i*) *Templeton* v. *Macfarlane*, 1 H. L. C. 595; see also *McCormick* v. *Gray*, 7 H. & N. 25.

(*k*) Noy, R. 182.

(*l*) *Edgebury* v. *Stephens*, 1 Web. P. C. 35; *R.* v. *Arkwright*, 1

In *Boulton* v. *Bull* (*m*), Rooke, J., said: "The public have a right to receive a meritorious consideration in return for the protection granted." In the same case, Buller, J., said: "The invention professes to lessen the consumption of steam, and to make the patent good the method must be capable of lessening the consumption to such an extent as to make the invention useful." And in the case of *The King* v. *Arkwright* (*n*), the same judge, in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for if it appears, as some of the witnesses say, to do as well without the stripes, and to answer the same purpose if you suppose the stripes never to have been used before, that is not such an invention as will support the patent."

It will always be a question for the consideration of the **jury**, whether the invention is useful; that is, whether that which is new is a sufficient advance or improvement upon what was already known by the public as to add to a material extent to the public stock of knowledge. It does not mean that there must necessarily be a great deal of invention, or an extensive operation, to support the patent, but that the invention when carried out in some way materially improves the process or manufacture, either by cheapening the article produced, or by improving its quality, or by improving the method of producing, or the uses to which it can be put.

Each of the cases which have been decided upon the question of utility deal, and necessarily must deal, with an independent state of facts, and consequently, no case can be said to be an authority for another case; but they go to show the general principle that "utility" means a **substantial improvement**, and **not** necessarily **an extensive improvement**; for instance, a man might invent a large and

Web. P. C. 72; *Turner* v. *Winter*, 1 Web. P. C. 80.

(*m*) 2 H. Bl. 478.
(*n*) 1 Web. P. C. 72.

complicated machine for the manufacture of boots, which, when completed, would do nothing which was not done before, and would not make them any quicker or any cheaper than they were made before. Such a machine would not form the subject of a patent. On the other hand, a man might discover a new needle for stitching boots, which would economise half-an-hour in the manufacture of each boot; such a needle would be the subject of a patent, although the whole improvement might consist of a bend.

In *Crane* v. *Price*, Tindal, C. J., said: "If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden or lucky thought, or mere accident of discovery" (*o*).

We have seen that the invention must be *new* in every part. It is not, however, necessary that it should be *useful* in every part. Provided always, that useless parts have not been added to the specification for the purpose of deception, or of misleading the public as to what the real nature of the invention is, and how it is to be performed (*p*). The invention further need not be useful for every purpose to which it can be applied, provided it be useful for some purpose to which it can be applied (*q*).

In *Pearson* v. *Loe* (*r*), Sir George Jessel said: "It is not because a patentee has attempted to claim as an advantage something else to which he is not entitled that the improvement he has made is to be held not worthy of a patent. I am not to say that because even half the advantages said to arise from his invention may not be new he is not to be protected in respect of the other half." It will be observed that in this case the Master of the Rolls does not refer to the novelty of the invention claimed, but to the novelty of

(*o*) *Crane* v. *Price*, 1 Web. P. C. at p. 411.

(*p*) *Lewis* v. *Marling*, 1 Web. P. C. 496.

(*q*) *Haworth* v. *Hardcastle*, 1 Web. P. C. 483.

(*r*) L. R., 9 Ch. D. 64.

the advantages. A large number of patents which are applied for are intituled "improvements in the manufacture of ————," and sometimes it has been considered that when that which is claimed is really no substantial improvement at all, the patent is bad for a false suggestion (*s*).

In the case of a patent for a combination it appeared that in putting the invention into practice the inventor did not use everything described in the specification; it was objected that the specification was bad on this account. The objection was overruled (*t*).

It is always a question for the jury whether the invention be useful or not (*u*).

In *Plimpton* v. *Malcolmson* (*x*), Sir George Jessel said: "The cases cited may be rather used as illustrations of what will amount to sufficient evidence than as deciding anything in principle beyond this, that it must be sufficiently known." This would apply to the utility issue as well as that of novelty. In such matters cases merely offer illustrations, and cannot be said to lay down any rigid principles of law.

(*s*) *Losh* v. *Hague*, 1 Web. P. C. 202.

(*t*) *Ehrlich* v. *Ihlee*, W. N. 3rd March, 1888.

(*u*) *Hill* v. *Thompson*, 1 Web. P. C. 237; *Bloxham* v. *Elsee*, 1 C. & P. 565; *Cornish* v. *Keene*, 1 Web. P. C. 506.

(*x*) L. R., 3 Ch. D. 557.

CHAPTER IV.

THE CONSIDERATION (*continued*)—THE SPECIFICATION.

THE third condition which supports the consideration for a valid patent, is **that the patentee must publish his invention,** that is to say, that in the specification which he files, and which forms the basis of the description of the subject-matter of his patent, he must give such an account of his invention, of the way of working it, and of what he particularly claims, as to enable an ordinary skilled person to carry out the invention without further assistance or discovery. By the 5th section of the Act of 1883, it is provided :—

"(1) *The application for a patent must be made in the form set forth in the first schedule of this Act, or in such other form as may be from time to time prescribed, and must be left at or sent by post to the Patent Office in the prescribed manner.*

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

(a) "Whereas sub-sect. 2 of s. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-sect. mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts; Be it there-

"(3) *A provisional specification must describe the nature of the invention, and be accompanied by drawings if required.*

"(4) *A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings if required* (*b*).

"(5) *A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.*"

Sect. 6 of the same Act vests in an examiner the duty of reporting to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

Sect. 7 provides for the report of the examiner, and for an appeal from the decision of the comptroller should he refuse the application, to the law officer, who may affirm, reverse or vary the decision of the comptroller. By sect. 8 (1), "*If the applicant does not leave a complete specification with his application, he may leave it at any*

fore enacted that: The declaration mentioned in sub-sect. 2 of s. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act or not, as may be from time to time prescribed." Patents, &c., Act, 1885, s. 2.

(*b*) By the Patents, &c., Act, 1886, s. 2, it is provided: "The requirement of sub-sect. 4 of s. 5 of the Patents, &c., Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the Complete Specification refers to the drawings which accompanied the provisional specification, and no patent heretofore sealed shall be invalid by reason only that the Complete Specification was not accompanied by drawings, but referred to those which accompanied the provisional specification."

subsequent time within nine months from the date of application" (c). (2) "*Unless the complete specification is left within that time, the application shall be deemed to be abandoned.*" By sect. 9, "*Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner, for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.*" Sub-sect. 2 provides for the refusal of the complete specification by the comptroller upon an adverse report of the examiner; and sub-sect. 3 gives the machinery for appealing to the law officer; by sect. 10, "*On the acceptance of the complete specification, the comptroller shall advertise the acceptance, and the application and specification or specifications with the drawings (if any), shall be open to public inspection.*" By sect. 18, sub-sect. 1, "*An applicant or patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of*

(c) This has been varied by the Patents, &c., Act, 1885, by sect. 3 of which it is enacted: "Whereas under the principal Act, a complete specification is required (by s. 8) to be left within nine months and (by s. 9) to be accepted within twelve months, and a patent is required (by s. 12) to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times; Be it therefore enacted as follows: A complete specification may be left and accepted within such extended times not exceeding one month and three months respectively after the said nine and twelve months respectively, as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act."

disclaimer, correction or explanation, stating the nature of such amendment, and his reasons for the same." Subsects. 2, 3, 4, 5, 6, 7, 8 and 9, deal with the practice to be observed upon amendment, to which we shall refer hereafter; and sub-sect. 10 enacts that "*the foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*"

Such are the provisions of the new Act in respect of the requirements of the specification. It leaves the law respecting the necessary disclosures to be made in the specification very much as it was before; and the changes which are made are more changes of practice than anything else.

The specification is the means which is provided by the state, whereby a patentee publishes his invention, that is, dedicates it to the public. We have observed that two descriptions of specifications are provided for, one called "provisional," and the other "complete;" the applicant for letters patent may, if he so pleases, in the first instance, file a complete specification, or he may file a specification which, for want of a better word, has been described as provisional; subsequently, and within the prescribed time, filing a complete specification, which particularly describes and ascertains his invention. It is only necessary, however, that the provisional specification should describe the nature of the invention; and although it is not absolutely necessary that full details should be given as to the method of working the invention, care should be taken to ascertain to what extent and in what direction the invention goes.

There are three things, in the specification, which must agree with each other—the title, the provisional specification, and the complete specification.

The Title.

The title of the specification must disclose the object of the invention (*d*).

The title is a part of the specification, and should be read into it so that it may limit the patentee's claim, which otherwise would be too large (*e*).

In the case of *Rex* v. *Else* (*f*), the title of the patent was held to contain the claim, there being no other claim.

It has frequently been held that the **title must not go too far;** for instance, a man who had invented a new street lamp, and described his invention in the title as being "a method or methods of more completely lighting cities, towns and villages," was held to have vitiated his patent by going too far in his title. His claim should have been for a new or improved street lamp (*g*). So care must be taken that an improvement in buttons, for instance, is not described as an improvement in the manufacture of buttons; if the improvement is in the article, it must be so stated, and if in the process, likewise. In *Campion* v. *Benyon* (*h*), the title was a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, without any starch whatever; the title, therefore, described an invention, the novelty and utility of which was to omit the use of starch, but upon reading the specification we find that the real invention was an improved mode of twisting the threads to be applied to the making of unstarched cloth, the patent was held bad. In the case of *Bloxam* v. *Elsee* (*i*), the title for the invention was for a machine

(*d*) *Household Co.* v. *Neilson*, 1 Web. P. C. 678.

(*e*) *Newton* v. *Vaucher*, 21 L. J., Ex. 308.

(*f*) 1 Web. P. C. 76.

(*g*) *Cochrane* v. *Smethurst*, Davy's P. C. 354.

(*h*) 6 B. Mo. 71.

(*i*) 6 B. & C. 169.

for making paper in single sheets without seam or joining from 1 to 12 feet and upwards wide, and from 1 to 45 feet and upwards in length. It was found that to vary the width of the paper it was necessary to have a different machine, and that consequently the title did not **correspond with the invention,** and the title was held bad. In *Felton* v. *Greaves* (*k*), the title was "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments." The machine would not sharpen scissors:—Held bad. These cases seem to have been decided upon the ground that an incorrect or too extensive title is evidence of fraud upon the Crown. For instance, in *Brunton* v. *Hawkes* (*l*), Best, J., said, "that the patent was taken out for more than the patentee was entitled to, that, in my opinion, avoids the patent *in toto*, for the king is deceived." In *Cook* v. *Pearce* (*m*), however, Tindal, C. J., in the Exchequer Chamber, said: "This was an action on the case against the defendant for the infringement of a patent taken out by the plaintiff for improvements in carriages. The 6th plea, after setting out the specification, averred that 'although the said alleged invention in the declaration of letters patent respectively mentioned is therein styled and described as improvements in carriages, yet the said invention in truth, and in fact, is not an invention of improvements of carriages generally, but certain alleged improvements in the fixing and adapting of German shutters in those carriages only in which German shutters are used, and that German shutters cannot be used in divers and very many carriages to wit, coaches, &c.,' and so the defendants say that the title of the said invention is too large and general, and by reason thereof the said letters patent are void and of no force. . . . . It

(*k*) 3 C. & P. 611. (*l*) 4 B. & Ald. 552.
(*m*) 8 Q. B. 1054.

has been observed that the decision (in the Court below) does not proceed upon the ground that the title of this patent must be held of necessity to claim more than the invention as explained by the specification, as if the title had been 'an invention and improvement of *all* carriages,' and the specification had limited the invention to the improvement of one or more species of carriages only, or if the title had been for the invention of two things, and the specification had shown it to be an invention of one only out of the two; in such cases it may be readily admitted that the patent would be void, in the first, because there was no specification enrolled agreeing with the title, and in the second, upon the principle laid down by Mr. Justice Bayley, in his judgment in *Brunton* v. *Hawkes*: 'that the entire discovery of all the things for which the patent was taken out may be held to be the consideration upon the patent which was granted by the Crown;' but such an objection would not apply to the case now before us, for the words 'improvements in carriages' do not necessarily imply in all carriages, but in their ordinary use may well be held to be satisfied by an invention for improvements in some carriages only, but the ground of the decision is as before stated confined to the vagueness and generality of the title, and to that only. Now the mere vagueness of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground to avoid the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void. . . . . We think it would be unsafe to lay down the rule in terms so large as it appears to have been adopted by the Court below, for that it would endanger the validity of very many patents which had hitherto been free from exception, if

every patent must be held to be void simply on the ground that its title was conceived in such terms as to be capable of comprising some other invention besides that contained in the specification in the absence at the same time of any proof of an intention to commit any fraud upon the Crown, or of deceiving or misleading the public" (*n*). It will be seen, therefore, that although **variance** between the title and the specification is held to vitiate the patent as in *Felton* v. *Greaves*, that mere excess and generality in the title will not vitiate the patent in the absence of any evidence of fraud upon the Crown (*o*).

In *Neilson* v. *Harford* (*p*), Abinger, C. B., said, "If the specification is **consistent** with the title, that would be sufficient;" and Baron Parke said, "The title of the patent is for the improved application of air, though that is ambiguous. It is sufficiently explained by the specification, and is not at variance with it."

The question of **variance** between the title and the specification is one upon which the decided cases can have but little bearing. All that can be gleaned from previous decisions of the Courts is that variance is a fatal blemish; but in the immense variety of inventions it is evident that the same variance will never occur in any two cases, and it will be a question for the Court in each individual case that comes before it to decide whether, in that case, the specification and the title vary or differ from each other; and although the decided authorities will be of assistance to the Court in showing to what extent variance has been held in prior cases to vitiate the patent, no prior decision will be absolutely binding (*q*).

(*n*) This decision was followed in *Crossley* v. *Potter* by Pollock, C. B. See Macr. P. C. 242.

(*o*) *Sturtz* v. *De la Rue*, 5 Russ. 322; *Morgan* v. *Seaward*, 1 Web. P. C. 196; *Stead* v. *Williams*, 2 Web. P. C. 137.

(*p*) 1 Web. P. C. 331.

(*q*) *Bainbridge* v. *Wigley*, Higgins' Digest, 155; *Hill* v. *Thomp-*

THE PROVISIONAL SPECIFICATION.

It was found that application for letters patent, being made merely upon the title of an invention, caused a great deal of inconvenience and uncertainty, therefore by the Patent Law Amendment Act, 1852, the provisional specification was created. Prior to the passing of that Act applicants for letters patent, when they made their application, merely deposited the title of their invention. By sect. 6 of that Act a provisional specification was required, which should give some more definite information as to the nature of the invention for which protection was sought than could be possibly given in a mere title.

It is very difficult to clearly define the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification. In *Woodward* v. *Sansum* (*r*) the Court of Appeal held that all a patentee need do in his provisional specification is to describe his invention. He need not go on therein to describe any method of carrying out the invention, but, whether he do so or not, if a different or further mode of carrying out the invention is described in his complete specification that will not invalidate the patent so long as such new method of carrying out is fairly within the invention as described in the provisional specification. In *Moseley* v. *Victoria Rubber Co.* (*s*) Chitty, J., laid it down that the object of a provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details of the complete specification.

Sect. 8 of the Act of 1852, to which we have referred, says that "the law officer must be satisfied that the provisional specification describes the nature of the in-

son, 1 Web. P. C. 239; *Nickels* v. *Haslam*, 13 L. J., C. P. 146; *Croll* v. *Edge*, 9 C. B. 479; *Wright* v. *Hitchcock*, L. R. 5 Ex. 37.

(*r*) 56 L. T. 347.

(*s*) 57 L. T. 142.

vention," and we have seen that the exact words of that section are retained in sub-sect. 3 of sect. 5 of the Act of 1883; and probably the legislature had in view the desirability of retaining the effect of the numerous valuable decisions of the Courts of law upon the construction which should be placed upon what is a sufficient description of the nature of the invention. It will be observed that the complete specification to which we shall refer at greater length hereafter must not only describe the nature of the invention, but must also *ascertain* the nature of the invention and in what manner it is to be performed; but both a provisional specification and a complete specification must commence with a title, and the complete specification must conclude with a distinct statement of the invention claimed.

The cases which we have quoted, and which were decided prior to the year 1852, as to the fatal nature of a variation between the title and the specification, will apply equally to the consideration of a variance between a provisional and a complete specification. It is evident, however, that the object of the legislature in creating a provisional specification, and founding upon it a period of provisional protection, was to enable the inventor in that interval to improve and perfect his invention, and to clearly ascertain what was new, and what was old, in that which he proposed to patent. That being so, it is obvious that it could not have been the intention of the legislature that, when framing a complete specification the inventor should be bound to follow implicitly every detail which he had given in his provisional specification, or that he should be prevented from adding to or subtracting from his invention: for, in that case, the object of the legislature would be defeated.

In *Newall* v. *Elliott* (*t*), Pollock, C. B., said: "The

(*t*) 10 Jur., N. S. 955.

object of the statute which requires a provisional specification is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for a patent, to give some notion of what his invention is; that has been followed by Act of Parliament, requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance . . . . I have no doubt that the object of the Act of Parliament was not to ascertain the **entirety** of the invention, but the **identity** of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." Baron Channell in the same case, at p. 960, describes a provisional specification as a "short note or minute of that which was ultimately disclosed in the full specification." It will be observed that in the cases to which we drew attention upon the subject of variance between title and specification, the point always was as to whether the title and the specification varied in the description of the **nature** of the invention; and the same principle holds good when considering the variation between the provisional and complete specification, the question always is, Do they differ in their description of the nature of the invention? In *Newall* v. *Elliott* (*u*) Mr. Justice Byles said: "The office of the provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out" (*x*).

(*u*) 4 C. B., N. S. 269.

(*x*) *Foxwell* v. *Bostock*, 12 W. R. 723.

Lord Chelmsford, in *Penn* v. *Bibby* (*y*), said: "The relation which the provisional specification bears to the complete specification is much the same as that which before the Patent Law Amendment Act a title bore to the specification . . . . . the only objection then which is open upon the complete specification, is whether it is sufficient in itself, and whether it agrees with the provisional specification. Now, by 'agreement' is not meant a perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional." The learned Lord Chancellor then proceeds to quote *Newall's case*, to which we have referred, and proceeds: "Nor is it at all necessary that the specification should extend to everything comprehended in the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now if he would be allowed to disclaim in such a case, which is a matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand. It is clear, therefore, that unless a complete specification in this case claims something *different* from the provisional specification, the objection to the patent under consideration cannot prevail."

In the absence of fraud, any part, whether in the description or the claim of the provisional specification, may be omitted in the complete specification without the

(*y*) L. R., 2 Ch. App. 127.

necessity of any disclaimer (*z*). In *Stoner* v. *Todd* (*a*), Jessel, M. R., said: "I must consider first the nature of a provisional specification, and the effect of a provisional specification on a final specification of the same invention. A provisional specification was never intended to be more than a mode of protecting an inventor, until the time of filing a final specification; it was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly no doubt, but in its rough state, until the inventor could perfect its details, the provisional specification as such is not and cannot be known to the public. It is never published unless with the final specification, when they become parts of the same document."

In the case of *Bailey* v. *Roberton* (*b*), decided in the House of Lords, the provisional specification stated the object of the invention to be the preserving of animal substances in the fresh state, and the patentees claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphite of lime, but in the complete specification they claimed as solution No. 1 a solution composed of bisulphite of lime alone, and gave no direction how this solution was to be used. Bisulphite of lime had been used by a prior patentee. In the action for infringement against the defendants who had used bisulphite of lime pure and simple, it was held that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than and different from that disclosed in the provisional specification. It will be observed that in this case the invention, which was described in the provisional specification, was the coat-

(*z*) *Thomas* v. *Welch*, L. R., 1 C. P. 192. See also the remarks of Lord Chelmsford in *Penn* v. *Bibby*, quoted above.

(*a*) L. R., 4 Ch. D. 58.

(*b*) L. R., 3 App. C. 1055. See also *Lucas* v. *Miller*, Griffin P. C. 156.

ing of animal substances with a film of a mixture of gelatine and bisulphite of lime; the complete specification claimed the dipping of the animal substance into a solution of bisulphite of lime in water; it is apparent, therefore, to anyone acquainted with the action of antiseptic substances upon animal decomposition, that the operation of a film of gelatine with bisulphite of lime is entirely different from the operation of a solution of bisulphite of lime; it is a totally different idea, and therefore a different invention; the complete specification, therefore, was not an extension, curtailment or modification of the provisional specification, but was a description of a totally different invention, and so it was held bad for variance.

Thus we see that the provisional specification is a mere extension of the title; but since variance between the title and the specification vitiated the patent before the inauguration of the provisional specification, variance between the provisional and complete specification also vitiates a patent; but it is quite open to a patentee to extend, improve or curtail the claim which he has made in his provisional specification when he comes to file his complete specification. A patent is not renderd invalid by the fact that the complete specification describes something different from anything specifically referred to in the provisional specification, provided that what is so described comes within the nature of the invention described in general terms in the provisional specification (*c*).

THE COMPLETE SPECIFICATION.

We now come to the more important subject of the requirements of a complete specification. The complete specification is, as we have seen, one of the essential considerations which the patentee gives for the grant which is

(*c*) *Siddell* v. *Vickers*, 39 L. R., Ch. D. 92.

made to him. **It is the disclosure of his invention,** and of the mode of performing it. It contains the information which he is bound to give to the public. That information must be *bonâ fide*, full, complete, and unambiguous; it must disclose the invention, the nature of it, the intention of it, the way of performing it, and an exact statement of what is claimed by the patentee (*bb*).

These conditions are imposed by the common law; they were maintained intact by the Statute of Monopolies, by the Patent Law Amendment Act, 1852, and are now specifically re-enacted in the Act of 1883.

The specification must be **sufficient**—that is, it must give a sufficient description of the invention to enable a person skilled in the art to which it refers to perform the invention from the description which it gives. It must be *bonâ fide*—there must be no reserve on the part of the inventor. He must disclose what he knows; he must conceal nothing, and thus he must give to the public the full benefit of his invention. In *Edison and Swan Electric Light Co.* v. *Woodhouse* (*c*), a patent dated as to its provisional specification, November, 1879, and as to its final specification, 10th May, 1880, claimed an electric lamp with a carbon filament for its illuminating conductor. The patentee took out a subsequent patent, dated as to its provisional specification, December, 1879, for a method of making carbon filaments for electric lamps. Objection was taken that inasmuch as at the time of filing the complete specification of the first patent the patentee knew the subject-matter of the second, he should have included it in the first, and that therefore the first patent was bad by reason of concealment. This objection was overruled. In *Mozeley* v. *The Victoria Rubber Co.* (*d*), Chitty, J., held, that if the patentee, between the time of filing the provisional and the

(*bb*) As to required conformity between provisional and complete specification, see "The Provisional Specification," *supra*.

(*c*) 32 Ch. D. 520.

(*d*) 57 L. T. 142.

complete specification, discovers any improvement in the manner in which the invention is to be performed, he is not merely at liberty, **but is bound**, to give the public the benefit of his discovery. In *Harmar* v. *Playne* (*e*), Lord Ellenborough said :—"The object of requiring the specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell from an inspection of the specification itself what the invention was for which the patent was granted, and how it was to be executed." In *Morgan* v. *Seaward* (*f*), Baron Alderson said :—"The patentee ought to state in his specification the precise way of doing it (referring to the invention) ; if it cannot completely be done by following the specification, then a person will not infringe the patent by doing it. If this were an infringement, it would be an infringement to do that perfectly, which, according to the specification, requires something else to be done to make it perfect. If that be correct, you would prevent a man from having a perfect engine. He says, practically speaking, the difference in the length of the rods would not be very material, the difference being small. But the whole question is small, therefore it ought to have been specified, and if it could not be ascertained fully it should have been so stated." We quote this decision at length, because the exposition of the law which it contains is still absolutely correct. The subsequent cases have implicitly followed the judgment of Baron Alderson (*g*).

In *Coles* v. *Baylis* (*h*), the invention was for "Improvements relating to the preparation of lithographic printing surfaces." It was alleged by the defendant that the plaintiff was acquainted with an improved method of using the lithographic printing surfaces after they had been prepared by the patented process, but that he had

(*e*) Dav. P. C. 316.
(*f*) 1 Web. P. C. at p. 182.
(*g*) See *Neilson* v. *Thompson*, 1 Web. R. 278.
(*h*) 3 Patent Office R. 178, Griffin P. C. 57.

not disclosed the same in his specification, and that therefore the patent was bad. Bacon, V.-C., overruled the objection, and said :—"It is to be said that the specification . . . . is bad because he knew a mode by which a stone prepared according to the specification may be more conveniently or more usefully worked than anybody but himself knew, that he was bound to put that into the specification. I know no authority for saying that."

The specification is a portion of the patent (*i*).

In the case of *The King* v. *Arkwright* (*k*), Mr. Justice Buller said, "The public have a right to a fair, full, and true description of the invention in the specification."

It is incumbent on a patentee to give a specification of his invention in the fairest and most unequivocal terms of which the subject is capable (*l*). In the same case, Mr. Justice Buller said :—"Many cases upon patents have arisen within our memory, most of which have been decided against the patentees upon the ground of their not having made a full and fair discovery of their inventions. Whenever it appears that the patentee has made a fair disclosure I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him." In *Newbery* v. *James* (*m*), Lord Eldon said :—"In order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it was granted was at an end."

In *Edison and Swan Electric Light Co.* v. *Woodhouse* (*n*), Lindley, L.J., said :—"The next objection that requires notice is, that it is contended that the evidence shows that it is essential to success to increase the temperature gradually, and that the specification is **insufficient** because it does not point this out. Now the evidence certainly shows that

(*i*) *Hornblower* v. *Boulton*, 8 T. R. 95 ; *Crossley* v. *Beverley*, 9 B. & C. 63.

(*k*) 1 Web. P.C. 72 ; Dav. P.C. 61.

(*l*) Per Mr. Justice Ashurst, in *Turner* v. *Winter*, Dav. P. C. 151.

(*m*) 2 Mer. 451.

(*n*) Griffin, P. C. at p. 95.

the maintenance of a high temperature is that which distinguishes Cheesebrough's process from Despretz's experiment, and although Professor Dewar points out the importance of a gradually increasing current, neither he nor any other witness says that the temperature ought to be low to begin with, and be gradually raised. Their evidence only comes to this—that the temperature must be kept up and the electric current must be increased, or the temperature will fall. But the patentee himself tells you this. He says that the temperature must be as high as 7,000° F., and the sentence in the specification, 'as the carbon increases in size more current is required to maintain the temperature,' is shown by the evidence to be useless, and an obvious truism to those who understand the subject, unless the sentence is understood to be a direction to keep up the temperature; and when we find that in fact no difficulty is experienced by reason of defective instructions on this point, the Court cannot hold as a matter of law that the specification is not sufficiently explicit. If the defendants had shown that the directions as to temperature were not practically sufficient to enable a competent person to make the patented articles, the case would be very different; but they have not attempted to do this; they rely on the words used, and on the evidence as to temperature already alluded to. This, in our opinion, is not sufficient for our purpose. If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court and not for a workman to construe the specification; but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that as regards clearness of description the specification is in point of law sufficient."

We have next to consider the bearing of the different decisions upon the question of **what amounts to sufficiency** in a specification. It is always a question of fact whether

the specification is sufficient or not, taking care to distinguish between sufficiency of description and an attempt to cover too much—it is for the jury to say whether from the description given the invention could be carried out. It is for the Court to determine whether the inventor has claimed that which is not new among that which is new (*o*). The question of the sufficiency of the specification is a question for the jury (*p*).

The **intelligibility** of the specification is a question for the jury (*q*). The **construction** of the specification is in the same manner as the construction of all documents—a question of law. The duty of the judge at Nisi Prius is to **tell the jury** the specification says so-and-so, placing a meaning upon the different words used and the different sentences used in the specification. It is then for the jury to say it is intelligible or it is not, it is sufficient or it is not sufficient, but the Court will determine in all cases whether or not the patent is defective by reason of the patentee having endeavoured to describe or to claim too much (*r*).

We will deal with these different heads in their natural order, first, as to **construction**, next as to intelligibility, and then as to sufficiency. The object of the Courts is not to defeat patents. In *Hallett* v. *Hague* (*s*), Lord Tenterden said:—"I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat, and not to sustain, them." The patentee is to be presumed not to claim things which he must have known to be in use (*t*).

(*o*) *Hill* v. *Thompson*, 3 Mer. 626.

(*p*) *Bickford* v. *Skewes*, 1 Q. B. 938; *Wallington* v. *Dale*, 7 Exch. 888; *Parkes* v. *Stephens*, L. R., 8 Eq. 358.

(*q*) *Neilson* v. *Harford*, 1 Web. P. C. 295.

(*r*) *Hill* v. *Thompson*, 3 Mer. 626; *Beard* v. *Egerton*, 19 L. J., C. P. 38.

(*s*) 2 B. & Ad. 377.

(*t*) *Haworth* v. *Hardcastle*, 1 Web. P. C. 484.

The leaning of the Courts is invariably in favour of the patentee, and specifications will **not** be **construed astutely** so as to overthrow a patent. Sir George Jessel, in the case of *Hinks* v. *The Safety Lighting Co.* (*u*), said "I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on mere cavillings with the language of their specifications, so as to deprive the inventor of the benefit of his invention; that is sometimes called a benevolent mode of construction, perhaps that is not the best term to use, but it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." And the same judge, in *Plimpton* v. *Spiller* (*x*), adopted the remark that "the judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it."

Per James, L.J., in *Binney* v. *Feldtman* (*y*), "giving that benignant interpretation which every instrument is entitled to have."

Per Cotton, L.J., in *Cropper* v. *Smith* (*z*), "It was said that one ought to interpret in favour of a good inventor, benignantly the construction of his specification. Now I am not satisfied to what cases that is to be applied. If it is to be applied to cases where the objection is that the specification is of such a character that it does not describe sufficiently the nature of the invention, that language may bear perhaps the not unreasonable interpretation, that you are to get all the knowledge you can with reference to the subject matter of the patent, and then you must in an intelligent frame of mind, and not in a frame of mind which shuts its

(*u*) L. R. 4 Ch. D. 612.
(*x*) L. R., 6 Ch. D. 422.
(*y*) Griffin, P. C. at p. 50.
(*z*) Griffin, P. C. at p. 62.

eyes to what is possibly not stated as clearly as it might be, consider what is the real meaning of the specification, not only of itself, but having regard to the knowledge existing at the time, and which would exist in the minds of those to whom the specification was addressed. Of course the judicial mind does not know, without evidence, all the facts which persons engaged in the trade would know, and it is merely saying, 'Now try and put yourself in the same position as regards knowledge as those to whom the specification was addressed, and then reasonably and intelligently construe it.'" See also the remarks of Bowen, L.J., which follow at p. 64.

In *Needham* v. *Johnson* (*a*), Lindley, L.J., said, "I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but of course if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid."

Lord Chelmsford, in *Harrison* v. *Anderston Foundry Co.* (*b*), said, "the language should be construed according to its ordinary meaning, the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention, and if the specification is thus sufficiently intelligible it performs all that is required of it." In *Clark* v. *Adie* (*c*) it was held that the words used in the specification must be construed like the words in any other instrument, in their natural sense, according to the general purpose of the instrument in which they are found.

The title of a specification and the specification itself are one document, and an ambiguity in the specification must

(*a*) 1 P. O. R. at p. 58.
(*b*) L. R., 1 Ap. C. 581.
(*c*) L. R., 2 Ap. C. 423; *Dudgeon* v. *Thompson*, L. R., 3 App. Cas. 53; *Wegmann* v. *Corcoran*, L. R., 13 Ch. D. 77.

be construed by the light which is thrown upon it by the title (*d*). In the case of *Unwin* v. *Heath* (*e*), in the course of an opinion given by the judges to the House of Lords, Mr. Justice Crompton said, "I think it will be a narrow and a dangerous construction to limit the invention claimed in express words by the mode and process of working which the plaintiff sets forth as a means of carrying his invention into effect."

The claims in specifications frequently claim the invention in a general manner with the words added "as herein described." It has been held that the meaning of the words "as herein described" is not limited where the invention is for a mode of construction or manufacture, and not for a particular method of carrying out the principle which is described in the specification. In *Betts* v. *Menzies* (*f*) Mr. Justice Blackburn, giving his opinion to the House of Lords, said, "I agree with what was said by Mr. Justice Crompton in the Court below that, if a general claim for the use of an invention were cut down and limited to the use of the invention in the particular way pointed out by reason of the words 'as herein described,' it will be a narrow rule of construction, generally working to the detriment of patentees, and, what weighs more with me, generally giving an effect to specifications different from what the persons drawing them intended or those reading them understand."

In the case of *Unwin* v. *Heath* (*supra*), Mr. Justice Williams said, "But if the invention described and claimed by the patentee in this case is not the particular process specified, but the employment of carburet of manganese in the process of the conversion of iron into steel, and if the description of the process in the specification, instead of being a description of the invention, is only one mode of

(*d*) *Newton* v. *Vaucher*, 6 Exch. 864.

(*e*) 25 L. J., C. P. 8.

(*f*) 10 H. L. C. 140.

carrying the invention into effect, an entirely different doctrine becomes applicable to the question, viz., that *if the patent is taken out for the application of a principle coupled with the mode of carrying the principle into effect, the patentee is entitled to protection from all other modes of doing so, whether known or not known at the time of the specification.*"

There are numerous authorities which bear out the general rule of construction which has been laid down, viz., that a specification of an invention must be construed by the same rules and upon the same principles that are applied to other written documents, and if, on the one hand, minute cavilling at the words of a specification is not to be allowed as against a patentee, so, on the other hand, the interpretation must not be strained in favour of a patentee. Lord Westbury, in *Simpson* v. *Holliday* (*g*), said—"It was contended before me, and the Vice-Chancellor is reported to have said, that it has been settled by authority that the most liberal construction is to be given to the patent that will sustain it. . . . . I am not aware of any such authority."

A patent may be, as we have seen, for the application of a newly-discovered principle of manufacture or, for that of an old principle to a new object or, for a new method of carrying out an old principle applied to an old object. It frequently becomes a matter of construction upon the specification as to which of these branches of invention the specification is intended to apply, and there have been several cases upon the subject. It is evident that inasmuch as the patent will be valid provided a fair description of a new invention in either branch is given, that, in construing the specification of a patent a decided case upon some other specification will be of very little value. We do not propose, therefore, to discuss at length the constructions which

(*g*) 13 W. R. 578.

have been placed upon specifications in particular cases. The words "improvements . . . . in the manner hereinafter mentioned," followed by a claim concluding with the words, "as above described," have been held to limit the claim to the particular machine described in the specification or to the particular method of carrying out the process and not to include the principle of the process or any other method than that described of carrying it out (*h*).

We have seen, and we shall see more fully at length hereafter, that it is incumbent on a patentee in drawing the specification to distinguish that which is new in his invention from that which is old. In the case of *Holmes* v. *London and North Western Railway* (*i*), A. obtained a patent for an improved turning-table for railway purposes, and in his specification gave a description of the machinery, of which no part was new except certain suspending rods; the combination, however, was both new and useful. In the specification the patentee claimed as his invention "An improved turning-table hereinbefore described, such my invention being, to the best of my knowledge and belief, entirely new." It was held, that no construction of the claim could be put upon it as including a combination of the various parts which were old, but that it must be construed as meaning that the patentee claimed the several parts of the invention as being new, and the combination being the only part which was new, the patent was held void. In the case of *Hills* v. *London Gaslight Company* (*k*), it was held, that where the meaning of a document depends upon its terms and not on matters of fact, dehors the document, the question will be for the judge, even although the terms are technical or scientific; and where an ambiguity is raised by evidence, dehors the document, which is plain

(*h*) *Barber* v. *Grace*, 1 Ex. 339. (*i*) 22 L. J., C. P. 57.
(*k*) 27 L. J., Exch. 60.

upon the face of it, the ambiguity being as to a term which imports one thing in a scientific sense, and another in a commercial sense—Query, whether it is for the judge or the jury. We should venture to say, that it would undoubtedly be for the jury. The question not being one at all as to the construction of the document, but being as a matter of fact, did the writer of the specification use the scientific term or the commercial term? A specification is to be construed with reference to the state of knowledge at the time it is published (*l*).

When drawings are attached to a specification, although the drawings may be used in construing the specification as explanatory of the text, they will not be allowed to be used in limiting the claim in a manner not provided for by the specification (*m*).

When two documents such as specifications are before the Court for comparison, the Court must interpret the meaning of the words, but the jury must say if they are identical (*n*). It is evident that, inasmuch as technical expressions are used in different trades and businesses, and that it is impossible for one person to be acquainted with every trade and every business, and every technical expression used in such trade and business, it is not necessary that the specification should be **intelligible** to any one, it is sufficient that it should be intelligible to a person reasonably skilled in the trade to which it particularly refers, and it must be intelligible to them without the necessity of their making new inventions of their own or additions to the specification or experiments (*o*).

(*l*) *Heath* v. *Unwin*, 22 L. J., P. C. 105; *Tetley* v. *Easton*, Mac. C. P. 7.

(*m*) *Hinks* v. *Safety Lighting Co.*, L. R., 4 Ch. D. 607. See also *Clark* v. *Adie*, L. R., 2 Ap. Cas. 315.

(*n*) *Betts* v. *Menzies*, 10 H. L. C. 117; *Muntz* v. *Foster*, 2 Web. P. C. 68. But see *Bush* v. *Fox*, 5 H. L. C. 707; *Booth* v. *Kennard*, 2 H. & N. 84. Also *Hills* v. *Evans*, 31 L. J., Ch. 457.

(*o*) *Reg.* v. *Arkwright*, 1 Web. P. C. 66.

In *Arkwright* v. *Nightingale* (*p*), Lord Loughborough, in charging the jury, said: "The clearness of the specification must be according to the subject-matter of it; it is addressed to the persons in the profession having skill in the subject, not to men of ignorance, and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible." And in *Hornblower* v. *Boulton* (*q*), to which we have previously referred, Mr. Justice Grose said: "If the specification be such as to enable artists to adopt the invention and to make the manufacture, it is sufficient."

In *Harmar* v. *Playne* (*r*), Lord Ellenborough graphically puts it: "No sort of specification would probably enable a ploughman utterly ignorant of the art to make a watch." But it is necessary that the specification should be in such terms as to enable persons of ordinary ability to understand it, and it will not be sufficient to show that one individual of extraordinary ability or of very exceptional technical knowledge is enabled to understand the specification (*s*). In *Neilson* v. *Harford* (*t*), Baron Parke puts it to the jury: "You are not to ask yourselves the question whether persons of great skill, a first-rate engineer, or a second-class engineer, as described by Mr. Farey, whether they would do it, because generally these persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification is supposed to be addressed: it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary capacity, to the subject."

In the case of the *Badische Anilin Fabrick* v. *Levenstein* (*tt*), the patentee claimed, "First, the production of red

(*p*) 1 Web. P. C. 61.
(*q*) 8 T. Rep. 104.
(*r*) Dav. P. C. 318.
(*s*) *Sturtz* v. *De la Rue*, 5 Russ. 327
(*t*) 1 Web. P. C. 314.
(*tt*) L. R. 24 Ch. D. 156.

and brown colouring matters, which in chemical language may be termed the sulpho acids of oxyazo-naphthaline by the action of the diazo compounds, which may be prepared from naphthylamin or from the sulpho acids of naphthylamine upon any of the isomeric naphthols, or of mixtures of the same, or upon any of the sulpho acids which may be prepared from either alpha naphthol or from beta naphthol, or from mixtures of the same substantially by the process above described." It appeared that the patent was dated 1878; that there were two descriptions of naphthylamine, one called alpha naphthylamine and the other beta naphthylamine; that the substance alpha naphthylamine had been known for a considerable period of time, but that beta naphthylamine had only been discovered in 1876; that at the date of the patent beta naphthylamine was very little known and very rare; that up to the year 1880 it was only used in laboratory experiments and that it was very costly; and that until beta naphthylamine was known, the alpha compound only was known and was called naphthylamine. Objection, that it was not stated what naphthylamine it was intended to be used. Pearson, J., said: (*u*) "I come to the conclusion that the word 'naphthylamine' in the patent means that which was generally known in the year 1878 as naphthylamine, namely, what is now described as alpha naphthylamine . . . . . although beta naphthylamine was invented in 1876 and would at once be called beta naphthylamine to distinguish it from the naphthylamine which had been known for at least 15 years before, it does not follow that that naphthylamine would all of a sudden acquire the name of alpha naphthylamine; it would remain in all the books printed up to that time as naphthylamine only, and I am satisfied that at the date of the patent and subsequently to the date of the patent any person ordering naphthylamine simply, would have been supplied with the old naphthy-

(*u*) At p. 161.

lamine, and nobody would have thought of asking him whether he wanted 'beta naphthylamine.' Under these circumstances I think it would be improper to come to the conclusion that any naphthylamine was meant in this patent except that which was known simply as 'naphthylamine,' that is, that which is now properly described as 'alpha naphthylamine.'"

In the Court of Appeal (*v*), Baggalay, L.J., differing from Fry and Bowen, L.JJ., said: "If the language of the specification can be fairly construed, so as in the one case put, to support the validity of the patent, if challenged on the ground that the use of beta naphthylamine would lead to failure and in the other to protect the patentee against an infringement by the use of that substance, it would be fatal to the plaintiff's case in the present action whether the language had been adopted *per incuriam* or of set design. Though the term 'the literature' has been conveniently applied to the documentary evidence admitted in the present case, it is clear that publications of this nature must be regarded as of two classes—those addressed to the scientific world, and those addressed to working or practical men, a distinction which cannot, in my opinion, be more simply and clearly illustrated than it was by Dr. Odling, who being asked by Pearson, J., when the body, as alpha naphthylamine, but formerly known as naphthylamine without any prefix, first acquired its present name, replied as follows: 'My Lord, there are two distinct forms of literature upon the subject. There is the systematic scientific literature, and there is the technical literature, and in the technical literature it is called naphthylamine up to the present day, but in the more scientific literature you may find the distinction although it is very rare.' The distinction between the information given by scientific literature and that given by technical literature is one very im-

(*v*) L. R. 29 Ch. D. 366.

portant to be borne in mind when we are dealing with questions such as that now under consideration. Publications having reference to chemical science and intelligibly expressed will always be enquired after and studied in their laboratories by scientific chemists, ever on the alert to make themselves acquainted with the newest compounds with a view of putting them to some useful purpose ; but, speaking generally, it is not the fact that such publications are sought after and studied by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained."

In the House of Lords, Lord Herschell, upon the same point, said : (*x*) " I am satisfied that after 1875 and down to the time of the patent, alpha naphthylamine was still sometimes spoken of as 'naphthylamine,' and that if anyone had ordered 'naphthylamine' of a manufacturer he would without hesitation have supplied alpha naphthylamine. Under these circumstances I entertain no doubt that any reader of the specification would understand by the word 'naphthylamine' occurring in it, the known commercial article, which, until recently at all events, had always borne that name, and not beta naphthylamine, to which the term 'naphthylamine' alone had never been applied. I am therefore of opinion that the specification is not in this respect open to the charge of ambiguity."

In the process of the invention it is necessary to use some old or well-known apparatus ; it is not necessary in the specification to describe the apparatus, save in such terms as it is generally known by, in the particular business to which it belongs (*y*).

In *Heath* v. *Unwin* (*z*), Mr. Baron Alderson said : "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or

(*x*) L. R. 12 App. Ca. at p. 723.
(*y*) *Crossley* v. *Beverley*, 3 C. & P. 513 ; *Household Co.* v. *Neilson*, 1 Web. P. C. 676.
(*z*) 2 Web. P. C. 245.

chemical sciences involved in such invention; thus, if a particular mechanical process is specified, and there are for some parts of it, as specified, other well-known **mechanical equivalents**, the specification in those parts is in truth the specification of the well-known equivalent also, to those to whose general knowledge we refer: viz., mechanics and readers of specifications; and so it is with chemical equivalents also, in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and chemists. These are not included in the specification but must be expressly stated there."

An error in a specification which may be said, in a sense, to be a technical error, will not vitiate a specification, although it be an error in description, provided it be such an error that an ordinary skilled workman would at once observe and be in a position to correct; provided it is not such an error as would require experiments to show that it was an error (*a*).

In *Plimpton* v. *Malcolmson* (*b*), Sir George Jessel said: "It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it; but there are various kinds of people who know something about it, if it is a mechanical invention, as this is; you have, first of all, scientific mechanicians of the first class, eminent engineers; then you have scientific mechanicians of the second class, managers of great manufactures, great employers of labour, persons who have studied mechanics, but not to the extent of the first class, and scientific engineers, but still to a great extent for the purpose of conducting the manufacture of complicated and

(*a*) Per Lord Westbury, *Simpson* v. *Holliday*, 13 W. R. 578.
(*b*) L. R. 3 Ch. D. 568.

unusual machines, and who therefore must have made the subject a matter of considerable study ; and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even with slight hints and still more from imperfect description, and would be able to supplement so as to succeed even from a defective description, and, even more than that, would be able to correct an erroneous description—that is what I would say to be the two first classes, which I would call the scientific classes ; the other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him, not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description. Now, as I understand it, to be a good specification it must be **intelligible to the third class** I have mentioned, and that is the result of the law." This judgment very precisely lays down the law upon the subject of intelligibility generally.

The next question, as to what is a **sufficient** specification, is by far the most important branch of the subject.

We have seen that the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed ; consequently for a specification to be sufficient it must particularly ascertain —(1) What the invention itself is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he has invented, and if in the course of the description of his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, "This is old and I do not

claim it as a part of my invention." There are two reasons why the inventor should be called upon to particularly state what he has invented; one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In *Macfarlane* v. *Price* (*c*), Lord Ellenborough said: "The patentee in his specification ought to inform the person who consults it what is new and what is old; he should say, 'my improvement consists in this . . . .' A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this." And the same judge, in *Harmar* v. *Playne* (*d*), maintained the same opinion.

The **degree of sufficiency** which is required by the law is very aptly and accurately put by Eyre, C.J., in *Boulton* v. *Bull* (*e*): "Suppose a newly-invented chemical process and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary that, in order to carry out this operation, the gold should be put in a crucible, and should be melted in that crucible, but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold in a state of fusion was to be performed. These are mere incidents, with which every man acquainted with the subject is familiar." In taking this distinction as a guide, however, we must be careful to remember that could it be shown that the chemical process would only be successful when the gold was melted in a particular kind of crucible, or at a particular temperature, that then, unless the description

(*c*) 1 Web. P. C. 74. (*d*) Dav. P. C. 311.
(*e*) 2 H. Bl. 498.

was given of the temperature and of the crucible, the specification would be insufficient.

It will be evident that, in any action for infringement, the statement of claim must relate to an infringement of something which is described and claimed in the specification, and consequently the invention, which must be proved, must be one of something which is found described in the specification. If that which is alleged to be an infringement is not described in the specification, then there can be no infringement of the patent. If anything cannot be completely done by following the specification then a person will not infringe the patent by doing it (*f*). The disclosure in the specification of the nature of the invention must be *bonâ fide*, but it need not go farther than the knowledge of the inventor at the time extends (*g*). If a patentee **suppresses** anything, or if he **misleads,** or if he does **not communicate** all he knows, his specification is bad. So if he says that there are many modes of doing a thing, when, in fact, only one will do, this will also avoid the patent (*h*). The object of the patent is to benefit the world, and not to obstruct a subsequent invention ; consequently, if the specification is worded in such a manner as to grasp at more than the patentee has actually invented, and to endeavour to cover, so to speak, wholesale problematic inventions, the patent will be void (*i*).

There is a head-note to the case of *Betts* v. *Neilson* (*k*) which is apt to mislead. The head-note is this : "Whether a specification contains a sufficient description can only be ascertained by experiments, and in making an experiment knowledge and means may be employed which have been acquired since the date of the patent." It is evident that

(*f*) *Morgan* v. *Seaward*, 1 Web. P. C. 182.

(*g*) *Lewis* v. *Marling*, 1 Web. P. C. 496.

(*h*) Per Mr. Justice Bailey, in *Lewis* v. *Marling*, 1 Web. P. C. 496.

(*i*) *Crossley* v. *Potter*, Mac. P. C 245.

(*k*) L. R., 3 Ch. Ap. 429.

this head-note is incorrect, and if the case be read it will be found that the judgment of Lord Chelmsford was, not that the specification of the plaintiff could be held sufficient or insufficient upon experiments tried on the specification itself, with the assistance of subsequently-acquired knowledge, but that the specification, which was alleged to anticipate the plaintiff's patent, might be read for the purpose of determining whether there was anticipation or not, or whether there had been prior publication or not in the light of knowledge acquired by the general public since the date of the specification. This would be undoubtedly correct, because the question always is, in dealing with matters of prior publication, Was the supposed invention of the plaintiff's, at the time when he obtained his patent, already part of the public stock of knowledge or not? The public stock of knowledge consisted of the specification, which is put forth as anticipating the patent, together with all knowledge on the subject which can be proved to have been published or used prior to the date of the plaintiff's patent, and so in reading a specification with a view to ascertaining whether it anticipates a subsequent patent you must read into that specification all subsequently-acquired knowledge of the subject prior to the date of the patent; but in discussing the sufficiency of the specification which is actually in dispute, you cannot make use of information which has been acquired since the publication, for otherwise it would be held that the patent, which was void at first for insufficiency of specification, might become valid at some subsequent date by further discovery, which is obviously absurd.

The question of the sufficiency of a specification is one which must be dealt with on each particular case as it arises; a single word added to a specification may make that which was insufficient sufficient, and that which would be a sufficient description of one invention would be found to be an insufficient description of another, consequently

there can be no absolutely fixed rules of construction in dealing with specifications.

In *Wegmann* v. *Corcoran* (*l*) it was held that the specification of a patent was bad if one of the materials to be used was described by a generic comprising a variety of species, the majority of which would be unsuitable. The specification of a patent is bad if a skilled mechanic would not, without performing a series of experiments, be able to construct the machine from the description.

The specification (*m*) of a machine for crushing meal, described the rollers as "to have a surface consisting of material containing so much silica as not to colour the meal or flour. I prefer to make them of iron, coated with china, and finally turned with diamond tools;" and the claim was, *inter alia*, for the use of material "of the hardness required." It appeared that the rollers must be made of very hard china, such as had scarcely been made in Europe during this century, and specially tough, and must be fixed in a peculiar manner to an iron core or spindle, which carried them; and, according to the evidence, a miller or a skilled mechanic would not, without making a series of experiments, discover of what china the rollers must be made, or how they must be fixed to the spindle. Held by the Court of Appeal, confirming the judgment of Mr. Justice Fry, that the specification was insufficient and the patent invalid. Mr. Justice Fry had said: "Though the grantee of a patent for an invention communicated to him by a foreign resident abroad is only bound to tell the public what he himself knows, yet if the original inventor has not told him enough to enable him so to describe the invention as that it could be constructed by the aid only of the specification, the patent will be invalid. As we have seen, it is doubtful whether this does not only affect those patents which were obtained before the Act of 1883, known as "communications from abroad."

(*l*) L. R., 13 Ch. D. 65. (*m*) *Wegmann* v. *Corcoran*, supra.

It will be seen that the last-mentioned case is distinguishable from the case of *Plimpton* v. *Malcolmson* (*n*). There the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, which he himself did not know, but which was within the knowledge of the person communicating from abroad; in that case it was properly held that he was not so bound, but it is obvious that he was bound to describe an invention in his specification which of itself was useful, and that he was bound to tell all that he himself knew, and to give a sufficient description to work the invention.

We have seen that *bona fides* in the description of the invention is one of the essential elements of the consideration for the grant. The patentee must say not only that which is sufficient to carry out the invention, but he must say all he knows, and he must give every improvement which is within his knowledge at the time and which assists the process or manufacture. *Wood* v. *Zimmer* (*o*), decided so far back as 1815, gives a very clear idea of the law upon this branch of the subject. In this action to try the validity of Zinck's patent "for a method of making verdigris," it appeared that the method described in the specification was sufficient to make verdigris, but that Zinck had been accustomed, clandestinely, to put aquafortis into the boiler, whereby the metallic copper was dissolved more rapidly, but the verdigris produced was neither better nor cheaper than that made according to the specification. Gibbs, C. J., said: "It is said that the method described makes verdigris, and that the specification is therefore sufficient—the law is not so. A man who applies for a patent, and possesses a mode of carrying out that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The

(*n*) L. R., 3 Ch. D. 531. Judgment of Jessel, M.R., at p. 582.
(*o*) 1 Web. P. C. 82.

price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without the aquafortis as with it, still, inasmuch as it would be made with more labour by the omission of aquafortis, it is **prejudicial concealment** and a breach of the terms which the patentee makes with the public."

In this case it must have been proved that the patentee, at the time when he obtained his letters patent and filed his specification, knew of the benefit to be derived by the use of aquafortis. It is evident that if he did not know it at the time, but **discovered** it **subsequently** during the currency of the patent, that then it would form an improvement upon his invention, and not one which he could possibly have disclosed at the time he filed his specification, and therefore there would be no *mala fides* on his part in not describing it.

The remarks of Gibbs, C. J., in *Bovill* v. *Moore* (*p*) go to the same extent; and in *Crossley* v. *Beverley* (*q*), Bailey, J., said: "It is the duty of the inventor if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable him better to effect the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he had obtained before the specifica-

(*p*) Dav. P. C. 400.

(*q*) 1 Web. P. C. 117.

tion." In *Morgan* v. *Seaward* (*r*), Alderson, B., said: "If the patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect he ought to state it in his specification: that was laid down in a case before Lord Mansfield; there the question arose on a patent for steel trusses. It appeared that the patentee in some parts of his process used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of tallow. The Court held the specification to be bad, because they said: 'You ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so if that is the best mode of doing it, for you are bound to make a *bona fides* full, and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet* v. *Johnson* (*s*).

In *Tetley* v. *Easton* (*t*), Pollock, C. B., said: "A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it;" and in *Heath* v. *Unwin* (*u*), Coleridge, C. J., said: "If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple and cheap one, it would be directly contrary to the good faith required from a patentee in his communication to the public."

Upon the same ground of *mala fides* it has been held, in a large number of cases, that if the patentee in his

(*r*) 1 Web. P. C. 174.
(*s*) 1 Web. P. C. 53; and Bull N. P. 78.
(*t*) Mac. P. C. 76.
(*u*) 2 Web. P. C. 243.

specification gives details which are not necessary to the invention, which of themselves do not constitute an invention, and which are merely put in for the purpose of misleading the public as to either what is the nature of the invention or how it is to be carried into effect, then the patent will be void. Bailey, C. J., in *Lewis* v. *Marling* (*v*), said: "If the party knew that it was unnecessary the patent would be bad, on the ground that this was deception; but if he thought it was proper, and only by a subsequent discovery finds out it is not necessary, I think that it forms no ground of objection."

If the **extraneous matter** is put into the specification, *bonâ fide* thinking that it was necessary, the patent will not be held to be void; if it was put in *malâ fide*, with the intention of deceiving or knowing it was extraneous and useless, the patent would be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from successfully carrying out the invention, whether it is put in *malâ fide* or *bonâ fide*, the patent will be void. It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of *bonâ fide* on the part of the inventor (*x*).

We now come to that portion of the specification which is described as "**the claim.**" By sect. 5, sub-sect. 5, of the Act of 1883, it is provided that "*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.*" This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of this Act, the necessity of the inventor making a distinct and unambiguous claim.

(*v*) 1 Web. P. C. 496.

(*x*) *Simpson* v. *Holliday*, 20 Newton's London Journal, N. S. 108. *Crompton* v. *Ibbertson*, 1 Web. P. C. 83; *Bickford* v. *Skewes*, 1 Web. P. C. 218; *Neilson* v. *Harford*, 8 M. & W. 806.

He **must not claim too much,** and yet he **must claim sufficient** to show a useful manufacture, and he must distinguish in his claim what it is that is new in the process which he has described and what is old. So far as this goes, there is no doubt that the old law provided for similar declarations on the part of the inventor.

In *Bovill* v. *Moore* (*y*), Gibbs, C. J., said: "If the plaintiff has in this specification asserted to himself a larger extent of invention than belongs to him, if he states himself to have invented that which was well known before, then the specification will be bad, because that will affect to give him, through the means of this patent, a larger privilege than could be legally given to him." In the case of *Gibson* v. *Brand* (*z*), Tindall, C.J., said: "Looking at the specification in the case, it appears to me that this patent cannot be supported at law, because the plaintiffs have in the course of it claimed more than they are entitled to."

The Court must be taken to distinguish between **describing too much and claiming too much.** In the course of a well-drawn specification it is frequently necessary to describe something which is old, and if, provided the claim says that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent. But if two methods of doing a thing are described, one of which will answer and the other will not, it will be interpreted, unless one of them is specifically disclaimed, that both parts are claimed as being new and useful, and one of them not being useful the patent will be invalidated, because it is said there is a false suggestion in the specification (*a*). In *Rushton* v. *Crawley* (*b*), Malins, V.-C., said: "The public

(*y*) Dav. P. C. 404.
(*z*) 1 Web. P. C. 634.
(*a*) *Simpson* v. *Holliday*, 13 W. R. 578; L. R., 1 H. L. 315, per Lord Westbury.
(*b*) L. R., 10 Eq. 527.

must be told in very distinct language in every specification what are the articles they may use and what they may not use. Therefore, if a man makes a discovery, and instead of limiting himself in his specification to that which properly is a discovery (if it be one), makes his specification too extensive, and claims more than he is entitled to claim, that is calculated to embarrass the public; that is, I apprehend, a fatal objection to the patent."

In reading specifications, one frequently comes across a claim in these words: "I claim as my invention the appliances and combinations hereinbefore described." This claim is perfectly good (c), provided there is nothing described in the patent which is old. If there be anything old, the claim should proceed: "I do not claim so-and-so, and so-and-so, as part of my invention."

Under the old law, if no claim was inserted the patentee was taken to claim everything that was described in the specification (*d*), it not being absolutely necessary that there should be a claim in the specification at all, provided nothing was described in the specification which could be shown to have been anticipated (*e*). Since the Act of 1883 it has been held by the Court of Appeal that the enactment in sect. 5 that a complete specification must end with a distinct statement of the invention claimed, **is directory only,** and when letters patent have been granted, they will not be invalid because it has not been complied with (*ee*). If the invention be for an **improvement upon an old process** very great care should be taken that the improvement alone is made the subject of the claim; so if it be for a **combination of old well-known parts,** care must be taken that it be clearly shown that the patentee claims the combination, and not the

(c) *Seed* v. *Higgins*, 8 H. L. C. 550.

(d) *Tetley* v. *Easton*, 2 C. B. N. S. 706.

(e) *Lister* v. *Leather*, 8 E. & B. 1004.

(ee) *Siddell* v. *Vickers*, 39 L. R., Ch. D. 92.

parts. James, V.-C., in *Parkes* v. *Stephens* (*f*), said: "It is obvious that a patentee does not comply as he ought to do with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy. And if a person desiring to find out what was claimed as new would have to get rid of a large portion of the specification, by eliminating from it all that was old and commonplace, all that was the subject of other patents, or of other improvements, bringing to the subject not only the knowledge of an ordinary skilled artizan, but of a patent lawyer or agent."

In *Gandy* v. *Reddaway* (*g*), the claim was "constructing belts or bands for driving machinery of cotton canvas or duck 'woven hard' and stitched and saturated or soaked with oil, such as linseed oil or any combination thereof, as herein described or set forth, or any modification thereof." It was proved that cotton canvas woven hard was in the trade divided into classes numbered 1—10. Of these, only 2, 3, and 4, would practically answer to carry out the invention; anyone attempting to use the other numbers would fail; certain numbers would crack if used on small pulleys. Pearson, J., dismissed the action and was affirmed by the Court of Appeal on the ground that the claim was too large. And where a patent is taken out for a combination, it is not material to its validity that the specification should point out what parts are old and what are new, though, if an alleged infringement consists only in taking part of the combination, it is necessary that the patentee should in his specification have claimed the part so taken as new (*h*). If the whole combination constitutes the novelty of the invention the whole combination alone should be claimed, and subject to the substitution of equivalents and evasion, there will be no infringement

(*f*) L. R., 8 Eq. 365.
(*g*) 2 P. O. R. 49; Griffin P. C. 740.
(*h*) *Proctor* v. *Bennis*, 36 Ch. D. 101.

unless the whole combination is taken; but if there is *merit and novelty* in *subordinate integers* or *subordinate combinations* they should be specially claimed, otherwise there will be no infringement in taking them. But in the case where there is *novelty in the result* of using the whole combination, and only the whole combination is claimed, then the Court will protect the patentee from infringement by taking the essence of the combination. *Proctor* v. *Bennis* (*supra*).

In *Harrison* v. *The Anderston Foundry Co.* (*i*), it was finally held by the House of Lords that if **the combination and application of old machinery** be new and beneficial the invention of this combination may be protected by a patent. The specification commenced: "The invention consists of a new or improved simple and most efficient mode of and arrangement of mechanism for connecting the set or sets of compound or multiple shuttle-boxes of looms for weaving stripe, check or other ornamental or figured fabrics requiring two, three or more shuttle-boxes in each set." The specification then described in detail and by reference to drawings the arrangement of mechanism in question, and then continued: "What we believe to be novel and original, and therefore claim as the invention secured to us by letters patent, is—(1) The construction and arrangement of the parts and portion of the mechanism, and (2) a shuttle-box moving and holding mechanism as herein distinguished generally for actuating the shuttle-boxes of power-looms, all substantially in the new or improved manner herein described and shown in the drawings or any mere modification thereof." A great number of the parts of the machine were admittedly old, and one of the questions in this case was, whether the first claim above set forth was a sufficient claim to a combination. Lord Cairns, in giving judgment, said: "It is as I

(*i*) L. R., 1 App. Ca. 574.

read it a claim for a combination, that is to say, a combination of all the movements going to make up the whole mechanism described; it must, for the present at least, be assumed that this combination, as a combination, is novel, that it is, to use the words of the Lord President, *a new combination of old parts to produce a new result* or to produce a known result in a more useful and beneficial way; it is not doubted that a combination such as this is may be the subject of a patent. What, then, are the objections to the first claim viewed as a claim for the combination? The first is an objection said to be founded upon the case of *Foxwell* v. *Bostock* (*k*), decided by the late Lord Westbury. It is said to be determined in that case that where there is a patent for a combination there must be a discovery or explanation of the novelty, and the specification must show what is the novelty and what the merit of the invention. I cannot think that, as applied to a patent for a combination, this is or was meant to be the effect of the decision in *Foxwell* v. *Bostock*. If there is a patent for a combination the combination itself is *ex necessitate* the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In the same case Lord Hatherley said: "The judges extended, as it appears to me with great respect, the doctrine of *Foxwell* v. *Bostock* in their application of it in this case; it was there held, and that I think was all that was held, that it is not competent to a man to take a well-known existing machine, and, having made some small improvement, to place that before the public and say, 'I have made a better machine: there is this sewing-machine invented by so-and-so, I have improved upon that. That is mine! it is a much better machine than his;' that will not do; you must state clearly and distinctly what it is in which you say you have made an improve-

(*k*) 4 De G., J. & S. 298.

ment. To use an illustration which was adopted, I think, by James, L.J., in another case, 'I think it will not do if you invented the gridiron pendulum to say, I have invented a better clock than anybody else, not telling the public what you have done to make it better than any other clock which is known.'"

In *Moore* v. *Bennett* (*l*), Selborne, L.C., in giving judgment in the House of Lords, said: "Your lordships have not at all to consider whether in the case of *Foxwell* v. *Bostock* the decision arrived at was correct or not; nor have you to consider whether, when interpreted with reference to the facts of that case, the language used by the very eminent and able judge who decided it may not be susceptible of an interpretation which would make that language correct in point of law. But, my lords, I feel that your lordships cannot refuse to regard the decision in *Foxwell* v. *Bostock* in the light in which you have already explained, and interpreted, and commented upon it by your own decision in the case of *Harrison* v. *The Anderston Foundry Co.*, and so explained, it appears to me, to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but **you must condescend upon that which is improved**. . . . . The case of *Foxwell* v. *Bostock* was qualified or explained in *Harrison* v. *The Anderston Foundry Co.* It was treated as an authority in such a way as to make it impossible to apply it to the present case, where, looking at the specification and at the evidence, it is perfectly clear that no such general combination as this had been at any time used, and where the material and important parts of the two arrangements and

(*l*) Griffin P. C. 158.

combinations, which are described, are clearly, plainly and intelligibly described. It would, in my judgment, be in direct contradiction to the decision in *Harrison* v. *The Anderston Foundry Co.* to hold the specification bad."

In *Clark* v. *Adie* (*m*), Lord Hatherley said, speaking of *Foxwell* v. *Bostock*: "You must in some way or other inform those whom you are dealing with, by which I mean the general public, whom you wish to exclude for a certain limited number of years from using your invention, you must inform them in some mode or other whether you have sub-divided, if I may so term it, your machine into these separate parts and claim for each the merit of novelty, or whether you are simply making a combination of things *per se* old but which have never been used before in combination, and which make up, as you say, your machine, for which you claim protection, as a novel and useful machine."

These three judgments of the House of Lords show the extent to which the law went prior to the Act of 1883. We have seen that since the Act of 1883 the claim is an absolute essential, and the words of the statute are, "*A distinct statement of the invention claimed.*" To what extent the words "a distinct statement" will be construed it is at present difficult to say; but it will undoubtedly be advisable for inventors to be more careful that their claims are more accurately defined, it being very probable that the law as it at present stands will be held to be much more stringent in its requirements than it was before the Act of 1883.

(*m*) L. R., 2 App. Ca. 328.

CHAPTER V.

AMENDMENT OF SPECIFICATIONS.

THE Patents, &c., Act, 1883, provides for the amendment of specifications in two ways, **compulsorily** and **voluntarily.** We have seen that sect. 6 directs that the comptroller shall refer the specification to an examiner. Sect. 7, as amended by sect. 2 of the Patents, &c., Act, 1888, provides that (1), "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has 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 direct, bear date as from the time when the requirement is complied with.*" Sub-sects. 2, 3, 4, provide for an appeal to the law officer; and sub-sect. 5 gives directions as to what should be done when there are two applications for substantially the same invention.

Sect. 9, sub-sect. 1, requires that the examiner shall report to the comptroller as to "*whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.*" If the examiner reports that these conditions have not been complied with, the comptroller *may* refuse to accept the complete specification until it has been amended to his satisfaction, subject to appeal to the law officer.

Sub-sect. 3: The law officer shall, if required, hear the applicant and the comptroller, and may make an order

determining whether, and subject to what conditions, if any, the complete specification shall be accepted. By subsect. 4 the application is rendered void, except in the case of an appeal, unless a complete specification is "*accepted*" within twelve months from the date of application. Sect. 94 provides: "*Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification . . . . without (if so required within the prescribed time by the applicant) giving the applicant the opportunity of being heard personally or by his agent.*"

These provisions of the law were novel at the date of the Act of 1883. It will be particularly observed that **compulsory amendment** is strictly **limited to matters of form.** The comptroller has no power to order an amendment on the ground that too much is claimed, or that there is want of novelty, or that the invention is not subject-matter for a patent. It is very difficult to predicate what judicial decisions will be given to the words "that the nature of the invention is not fairly described." Is the examiner to be in the position of an expert witness, and to decide whether or not the description is sufficient to enable a skilled artizan to carry the invention into effect within the meaning of Jessel, M.R., in *Plimpton* v. *Malcolmson* (*a*)? or is he merely to see that the language is correct, and that, without going technically into the matter, the specification *appears* to fairly describe the invention? If the former is his province, it is difficult to see how it is to be carried into effect, since there is no machinery in the Act for the receiving of skilled evidence, such as would be necessary for the purpose of arriving at a satisfactory conclusion upon such a point. The applicant or his agent are alone to be heard. It is true that by sect. 38, where the applicant *appeals* he may call witnesses before the law officer, but surely the statute

(*a*) L. R., 3 Ch. D. 568.

does not contemplate that questions should be gone into which, it is evident, can only be decided on appeal, and even then not satisfactorily without the procedure and care of a regular formal trial.

Under such circumstances, it may fairly be presumed that the meaning of the section is, that the examiner shall report whether the specification, **on the face of it,** appears to fairly describe the invention (*cc*).

In construing sect. 9, it will probably be held that a minute and scientific inspection of the specification is not within the contemplation of the statute.

Sect. 18 provides for the **amendment** of the specification by the applicant or patentee. There are several reported cases showing that at common law mere clerical errors in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (*b*). *In re Gare's Patent* in 1884 (c), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patent, &c., Act, 1852, and said, "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c., Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, *or which is otherwise to be considered as a record under the authority of the Master of the Rolls.* So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

It would appear from the words printed in italics that

(*b*) *In re Sharp's Patent*, 1 Web. P. C. 645. *In re Nickel's Patent*, 1 Web. P. C. 649. *Re Johnson's Patent*, 5 Ch. D. 503.

(*c*) 26 Ch. D. 105.

(*cc*) *Brown's Patent*, 2 Griffin P. C. 1.

the jurisdiction of the M.R. is still intact with reference to amendments after sealing.

We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The **common law power** of amendment being found **insufficient** for the purposes of justice in such cases, the Act 5 & 6 Will. 4, c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent*, &c.," with the leave of the law officer, might **disclaim** any part of the "title of the invention or of the specification, stating the reason for such disclaimer"; or might, with such leave as aforesaid, "enter a **memorandum of** any **alteration** in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c." The case of *Spilsbury* v. *Clough* (*d*) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original **patentee, or his assignees**, or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any **disclaimer or amendment** made by the patentee was entirely **at his own peril**, and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The provisions of sect. 18 of the Act of 1883, as amended so far as sub-sect. 10 is concerned by sect. 5 of the Patents, &c., Act, 1886, are as follows:—

"(1) *An applicant or a patentee may from time to time, by request in writing left at the Patent Office, seek leave to*

(*d*) 2 Q. B. 466.

amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same."

"Disclaimer correction or explanation" does not include the amendment of a specification by the insertion of subsequently ascertained knowledge (*e*).

Under this section there is no power to amend the title, and when a complete specification is filed with a narrower title than the provisional, the proper course for the C. G. to adopt is to amend the title of the provisional under sect. 7, or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (*f*) (this latter course it appears to the author would be dangerous). Sect. 18 only applies to amendment after acceptance of the complete specification; all amendments before acceptance are under sects. 7 and 9 (*g*). The law officer will not in the absence of satisfactory explanation permit repeated applications to be made for the same proposed amendment (*h*).

Prohibition will not lie to the law officer in the exercise of his discretion under this section, *Ex parte Simon*, Times, Aug. 6, 1888, C.A.

"(2) *The request, and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.*

"(3) *Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.*"

(*e*) Per Sir R. Webster in *Beck* v. *Justice*, 2 Griffin P. C. 10.

(*f*) Per Sir R. Webster, *Dart's Patent*, Griffin P. C. 307.

(*g*) Per Sir R. Webster, *Jones' Patent*, Griffin P. C. 313.

(*h*) *Arnold's Patent*, 2 Griffin P. C. 5.

The comptroller exercises the power to impose conditions given in express terms to the law officer under sub-s. 4 (*i*). In *Codd's Patent* (*j*), he ordered as a condition of allowing an amendment (1), that no proceedings be taken against opponent A. in respect of infringements committed prior to the 1st January, 1884; (2), that the applicant pay to opponent A. 10 *guineas as and for his costs* of and incident to his opposition to the abortive application of 10th July, 1884. It is however clear that the C. G. has no power to give costs as a condition of amendment (*k*).

"(4) *The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and* **subject to what conditions,** *if any, the amendment ought to be allowed.*"

In *Allen's Patent* (*l*) application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring any action or bring any proceedings whatever against them or any of their customers, &c., in respect of any *pipes* which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision. "I have carefully considered the question whether in allowing this amendment I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act, I find that they imposed as a condition

(*i*) *Hearson's Patent*, Griffin P. C. 309.

(*j*) *Codd's Patent*, Griffin P. C. at p. 307.

(*k*) *Pietschmann's Patent*, Griffin P. C. 314.

(*l*) 2 Griffin P. C. 3.

of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases as reported in Griffin's P. C., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act. No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification, by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition."

In *Cheeseborough's Patent* (*n*) the conditions were that no action should be brought with reference to any lamps *made* sold or used before the date of the amendment, and that any lamps so made might be used or sold after the date of the amendment without infringing. In the case of a second disclaimer the law officer will be disinclined to give costs to the patentee even if successful (*o*).

"(5) *When no notice of opposition is given, or the*

(*n*) Griffin P. C. 303. See also the terms imposed in *Westinghouse Patent*, Griffin P. C. 315.

(*o*) *Haddan's Patent*, 2 Griffin P. C. 12.

person so giving notice does not appear, the comptroller shall determine whether, and **subject to what conditions,** *if any, the amendment ought to be allowed.*

"(6.) *When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.*

"(7) *The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether and subject to what conditions, if any, the amendment ought to be allowed.*

"(8) *No amendment shall be allowed that would make the specification as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.*"

An amendment will not be allowed which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (*p*).

"(9) *Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud, and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.*

"(10) *The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.*"

In *Cropper* v. *Smith* (*q*) the comptroller having declined leave to amend a specification by reason of the 10th sub-sect. of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was "an action for infringement or other legal proceeding." Application was made to the Court under

(*p*) *Heath and Frost's Patent*, Griffin P. C. 311.
(*q*) L. R. 28 Ch. D. 148.

sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the comptroller from the power of amending the specification under sect. 18.

In *Codd* v. *Bratby* (*r*), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the comptroller.

Sect. 19. "*In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs or otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.*"

Where more than one action is pending, the leave of the Court must be obtained under this section in each action, otherwise the amendment will not be allowed, and each order must be filed under rule 55 (*infra*) (*s*).

In *Codd* v. *Bratby* (*supra*), in giving liberty to amend under this section, Chitty, J., said, "It is conceded for the applicant, first, that the amended specification is not to be put in evidence at the trial; secondly, that no evidence is to be given of any infringement prior to the amendment of the specification. Besides that, it is conceded that the applicant must pay the costs of this application and all the costs that have been thrown away in the action;" then as to the contention that a condition should be imposed on the plaintiff that he should not sue the defendants on the

(*r*) Griffin P. C. 56; 1 Patent Office Reports, 209.

(*s*) *Codd's Patent*, Griffin P. C. 305.

amended specification for future infringements, his Lordship said, "The result of my acceding to this part of the argument would be, that I should be giving to the defendants practically and substantially a license to infringe the plaintiff's patent when amended . . . . in the circumstances of this case, that would be going too far . . . . There may be cases in which it would be right to impose such a term. I am not satisfied in the case before me on the evidence, that the defendants are right in their attempt to impute knowledge to the plaintiff many years ago of the invalidity of his patent; if that point were made out, I think the case might stand on a different footing, because then I should have the case of a patentee with knowledge of a defect in his patent, lying by until a very few months of the expiration of his patent; and I should have on the other side the defendants saying that they were aware of the invalidity of the patent, that they were advised that the patent was invalid, and that they set up a trade and incurred great expenditure on the faith that the patent was invalid . . . ." See also as to terms imposed under this section, *Singer* v. *Stassen* (*t*), *Fuzee Vesta Co.* v. *Bryant & May* (*tt*), *Bray* v. *Gardner* (*u*), *Haslam Foundry Co.* v. *Goodfellow* (*v*), also *Gaulard* v. *Lindsey* (*w*).

Liberty to amend under this section will not be given after judgment (*x*).

Sect. 20. "*Where an amendment, by way of disclaimer, correction or explanation, has been allowed under this Act no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfac-*

(*t*) 50 L. T. 326, Griffin P. C. 207.

(*tt*) 34 Ch. D. 458; 56 L. J. Ch. 187; 56 L. T. 110.

(*u*) 34 Ch. D. 668; 56 L. J. Ch. 497; 56 L. T. 292.

(*v*) 37 Ch. D. at p. 121.

(*w*) W. N. Feb. 4, 1888.

(*x*) *Lawrence* v. *Perry*, Griffin P. C. at p. 148.

tion of the Court that his original claim was framed in good faith and with reasonable skill and knowledge."

Sect. 46 defines the word "patentee," referred to in sect. 18, sub-sect. (1), as meaning "*The person for the time being entitled to the benefit of a patent.*"

It will be observed that the **amendmen**t under the new Act are **to be by disclaimer, correction or explanation**, provided the amendment does not cause the specification to claim an invention **substantially larger or different.** The Act of Will. IV., after using the words "disclaimer" and "alteration," provided that no extension should take place in the "**exclusive right**" granted by the letters patent.

It was always a question of great difficulty whether or not a disclaimer or alteration extended the "exclusive right" of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. Mr. Justice Maule's view of the Act of Will. IV. was:—"Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer" (*y*).

Romilly, M.R., in the same case (*z*), at the Rolls, said:—"It is proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they

(*y*) *R.* v. *Mill*, 20 L. J., C. P. at page 24; 10 C. B. 379; 15 Jur. 59.

(*z*) 14 Beavan, at page 315.

have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in Macrory's Patent Cases at page 116, where Sir Richard Bethell, when Solicitor-General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original clause being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said:—"Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged" (*a*).

The case of *Ralston* v. *Smith* (*b*) shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle. Under the Act of 1883 it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different. It is presumed that the law officers will not find so much difficulty in dealing with these words as with the words of the old statute. Moreover, an **amendment once made cannot afterwards be objected to** on any ground whatever, excepting that of **fraud.**

The amendment becomes part and parcel of the original specification in all courts and for all purposes.

Under the Statute of Will. IV. no disclaimer or amendment could be given in evidence in any action or suit (save

(*a*) *Foxwell* v. *Bostock*, 4 De G. J. & S. at page 306; 12 W. R. 723; 10 L. T. N. S. 144.

(*b*) 11 H. L. C. 223; 20 C. B. N. S. 28; L. T. N. S. 1.

and except in any proceedings by *scire facias*) pending at the time the disclaimer or amendment was enrolled. The object of this was obvious. It would have been unjust that a defendant should be held guilty of infringing a patent when at the time the action was brought against him the patent was void. The saving clause relating to *scire facias* was always exercised subject to just provision as to costs, and was inserted with a view to prevent a patent being repealed on account of some trifling error which might have been cured by disclaimer or alteration. The entry of a disclaimer under the old Act did not make a void patent valid *ab initio*, "so as to make any person a wrongdoer by relation," and in *Perry* v. *Skinner* (c) it was held, that the words "from thenceforth" must be read into the specification. Proceedings by *scire facias* are abolished by sect. 26 of the Act of 1883, and a petition to the Court is substituted, the grounds for the petition being the same as heretofore in *scire facias*. Although we have seen that sub-s. 10 of sect. 18 prohibits any amendment *under that section* pending legal proceedings (including proceedings by way of revocation), sect. 19 provides machinery for saving a patent in the event of the Court or judge being of opinion that **a disclaimer** should be allowed upon such terms as may appear just (*d*). It will be observed that the Court or judge have no power to permit amendment by "correction or explanation" under this section.

In *Dudgeon* v. *Thompson* (*e*), an interdict granted prior to the amendment was refused to be enforced after the amendment, on the ground that the amendment materially altered the patent, and that it was quite possible that there was no infringement of the patent as altered. In *Kynoch*

(*c*) Hindmarch, p. 207; 2 M. & W. 471; 1 Web. P. C. 250; 6 L. J. Ex. 124.

(*d*) As to what are just terms, see *supra*, pp. 107 to 111, and *In re Smith's Patent*, Macr. P. C. 232; *In re Medlock's Patent*, Newton, London Journal, New Series, vol. 22, p. 69.

(*e*) L. R., 3 App. Cases, 34.

v. *National Arms Company, Limited* (*f*), it was held that the law officer could not order an applicant for leave to disclaim to pay costs. Sect. 38 of the Act of 1883 cures this defect, giving **the law officer full discretion as to costs** (*ff*), with provision that his order may be made a rule of Court.

Sect. 20 speaks for itself; may be it is intended to overrule *Perry* v. *Skinner* (*g*), quoted above. Under the Act of Will. IV., when a patentee sought to disclaim it was necessary that he should give his reasons for the proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment, whatever the form of the amendment may be. The reasons will, of course, vary with each case. Either that the patentee has discovered that parts of the invention claimed are not new, or are useless, or are not sufficiently described, or that they will not work. It will be observed that the **reasons** are not required to be advertised. The subject of opposition to the amendment proposed will be dealt with in the next chapter. It may be observed that there is nothing in the Act of 1883 to withdraw from the Master of the Rolls the common law power of amending clerical errors in specifications. See *In re Johnson's Patent* (*h*).

(*f*) 37 L. J. N. S. 31.

(*ff*) As to how this discretion has been exercised, see *infra*, "Practice."

(*g*) 2 M. & W. 471.

(*h*) L. R., 5 Ch. D. 503; and *In re Gare's Patent*, 26 Ch. D. 105, *supra*, 104.

CHAPTER VI.

OPPOSITION.

SECTION 10 of the Act of 1883 provides that upon acceptance of the complete specification, but before sealing the patent, the comptroller shall advertise the acceptance, and that then the application and specifications, with the drawings, if any, shall be open to public inspection.

Section 11, as amended by the Patents, &c., Act, 1888, is as follows:—(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 to the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him,*

"*Or from a person of whom he is the legal representative,*

"*Or on the ground that the invention has been patented in this country on an application of prior date,*

"*Or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,* **but on no other ground.**"

Prior to the passing of this Act any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda* (*a*)), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's*

(*a*) Hindmarch, at page 534.

Patent (*b*)), but it was always considered necessary that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent* (c), and also *In re Vincent's Patent* (*d*)). If there was any doubt the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial. These two latter cases indi-

cate the course the law officer should take, where the ground of opposition is **an allegation that the applicant has obtained the invention from the opposing party.** Such a question might very frequently raise questions of fact of great delicacy, and the question of the credibility of witnesses. Such questions should be left for trial in open court, more particularly as it will be observed that any such opposing party has an ample and unfettered remedy by petition to revoke the patent under sect. 26. In *Edmunds' Patent* (*e*), Sir R. Webster, A.-G., said :—"I am clearly of opinion that under the circumstances the comptroller-general was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas if the patent is sealed the question can be raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings." In this case the law officer held that, in the absence of breach of contract or duty, the words "the applicant having obtained the invention from him" in the 11th section did not apply to the obtaining the invention from a person abroad.

It frequently happens that the law officer is of opinion that **both** the applicant and the opponent **contributed materially to the invention.** In such case terms will be imposed giving both parties an interest in the

(*b*) 6 De G., M. & G. 420; 25 L. J. Ch. 456; 4 W. R. 473.

(*c*) 14 W. R. 551.

(*d*) L. R., 2 Ch. 341.

(*e*) Griffin P. C. at page 283. See also *Firchter's Patent*, Griffin P. C. 284.

patent (*ee*). In *Dowd and Wadley* (*f*), upon the question of **workman and master,** Sir H. Davey said:—"I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them."

The other two grounds of opposition are such as can readily be proved or disproved, hence the power of the law officer can be exercised with less prejudice to the interests of justice. In *Cummings' Patent* (*ff*), Sir Henry James, although of opinion that the applicant's invention and that which formed the ground of opposition were very nearly the same, thought there was just sufficient difference (although a very slight difference) to justify him in affirming the comptroller-general's decision. He felt, too, that if he refused a patent his decision would be final. It will make no difference in the exercise of the discretion of the law officer upon the report of the comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, that the validity of the first patent is in dispute (*g*).

"**On the ground that the invention has been patented in this country**" will not give a locus standi for opposition where only a provisional protection has been granted for the previous invention (*h*); but it is otherwise where the opponent has brought himself within the terms of sect. 15 (*i*). If the invention, the subject-matter of applicant's specification, is fully described in the specification relied on

(*ee*) *Russell's Patent*, Goodeve, P. C. 589; *Luke's Patent*, Griffin P. C. 294; *Evans & Otway's Patent*, Griffin P. C. 279; *Garthwaite's Patent*, Griffin P. C. 284.

(*f*) 2 Griffin P. C. 26.

(*ff*) Griffin P. C. 277; also *Jones's Patent*, 2 Griffin P. C. 33.

(*g*) *In re Manceaux's Patent*, L. R., 6 Ch. 272.

(*h*) *Bailey's Patent*, Griffin P. C. 269; *Dundon's Patent*, Griffin P. C. 278.

(*i*) *L'Oiseau and Pierrard*, 2 Griffin P. C. 36.

in opposition, the patent will not be allowed to go, notwithstanding that it is not made the subject of claim in the opposing specification (*k*). But when a patent is opposed on this ground, it is not open to the applicant to show that the invention, although described in the opponent's complete specification, is not contained in his provisional (*l*). The author ventures to hope this decision will be reconsidered, although it is one of Sir Richard Webster's. It is founded upon the fact that the applicant is not entitled to dispute the validity of the opponent's patent. But is this quite the point? Is it not a question of priority? The opponent's provisional was filed in March, 1885, and his complete in December, 1885. The applicant's provisional was filed in July, 1885, and his complete in April, 1886. Now if the invention contained in the applicant's provisional was not contained in the opponent's provisional, it is perfectly clear that the applicant was the first inventor. The decision in this case would lead to this hardship—that where people are racing after an invention, as is frequently the case, and A. has filed a provisional for no matter what, and afterwards hears that B. has made the desired discovery, A. can, by including B.'s invention in his complete, say to B., "I can oppose your grant. It is true my patent is invalid, but I can prevent you getting a patent by opposing, and you will not be permitted to enter into the question as to who was the real inventor, so you can get no patent, no matter how fraudulent my conduct may be, because fraud on the part of the opponent is not within the 11th section." Since the above lines were in type the hardship indicated has been removed by sect. 4 of the Patents, &c., Act, 1888, amending sect. 11, sub-sect. 1, of the Act of 1883, quoted *supra*.

Under this section it will make no difference whether the patent upon which the opposition is founded has expired or not (*m*).

(*k*) *Von Buch's Application*, 2 Griffin P. C. 40.

(*l*) *Green's Patent*, Griffin P. C. 286.

(*m*) Per Gorst, S.-G., *In Lancaster's Patent*, Griffin P. C. 293.

A question has arisen as to whether, when a patent is antedated, pursuant to the provisions of sect. 103 (*infra*), and when an application is made for letters patent for the same invention to another applicant, between the date to which such patent is antedated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17th, 1888, held in the matter of *Everitt's Patent* and *L'Oiseau and Pierrard's* opposition (*n*), that although the opponent's patent would override the applicant's by reason of the antedating, still that for the purpose of opposition the opponents had no locus standi. Sir R. Webster had, on December 7th, 1887, allowed L'Oiseau and Pierrard's patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent* (*o*).

In *Stubbs' Patent* (*p*), Sir R. Webster said:—"As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course I need not remind you that **stopping a patent is a very serious step**, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical. . . . I shall, as a rule, allow **costs to follow the event.**"

The second sub-section provides:—"*Where such notice is given, the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.*

(*n*) 2 Griffin P. C. 28. (*o*) 2 Griffin P. C. 36.
(*p*) Griffin P. C. 298.

(3) "*The law officer shall, if required, hear the applicant and any person so giving notice, and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.*"

In *Heath and Frost's Patent* (*q*), Sir E. Clarke said :— "It appears to me that by sect. 11 it is quite clear that the only class of persons who **are entitled to be heard** in opposition before the law officer, are persons who are interested with a real and legitimate interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."

The law officer ought not to interfere with the decision of the comptroller unless it is clearly wrong (*r*), nor ought he to permit amendment in the opposition by substituting another opponent when it has been decided that the original opponent has no locus standi (*s*) ; but otherwise where the original opponent is dead (*ss*).

(4) "*The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the treasury shall appoint.*"

Sect. 38 of the Act gives power to the law officers to examine witnesses on oath, to make rules from time to time regulating references and appeals, together with the practice and procedure before them, and in such proceedings they may make such orders as to costs as they may deem just, such orders to be enforceable as rules of Court.

In the absence of opposition, or in the event of any opposition being decided in favour of the patentee, the patent will be sealed. (Sect. 12.)

(*q*) Griffin P. C. at p. 290.

(*r*) Per Herschell, S.-G., *In Glossop's Patent*, Griffin P. C. 286.

(*s*) *In Heath and Frost's Patent*, Griffin P. C. 290.

(*ss*) *Lake*, 2 Griffin P. C. 35.

Provisions are made in sect. 18 for opposition to the amendment of any specification—opposition to an amendment may be made upon any ground—the only restriction being that the opposition must, in the opinion of the law officer, be by a person entitled to be heard. **Any person who would be injuriously affected by a void patent becoming valid is a person entitled to be heard** (*t*).

For *practice* cases the reader is referred to those quoted under the head of "Practice—Opposition," *infra*.

(*t*) See the conditions imposed in *Re Medlock's Patent*, reported in Newton's London Journal, New Series, vol. 22, p. 69, and also in *Re Smith's Patent*, Macr. P. C. 232, in which cases it appears that great care was taken to protect the vested interests of persons who had acquired rights by reason of the imperfect condition of the original specification.

CHAPTER VII.

THE GRANT.

Prior to the Act of 1883 letters patent were issued under **the great seal of England,** and, consequently, by the Lord Chancellor, as keeper of the great seal. The process of sealing a patent was surrounded with all the formalities and expense which surrounds an important Act of State. Letters patent derived their authority from the fact that the great seal was attached to them, for "all the king's subjects are bound to take notice of the king's great seal" (*a*). Sect. 84 of the Act provides : "*There shall be* **a seal for the Patent Office,** *and impressions thereof shall be judicially noticed and admitted in evidence;*" and sect. 12 : (1) "*If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office.* (2) *A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom.*" Form D. in the first schedule to the Act gives the form in which in future letters patent are to be issued.

By sect. 33, "*Every patent may be in the form in the first schedule to this Act, and shall be* **granted for one invention only**, *but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding, to take any objection to a patent on the ground that it comprises more than one invention.*"

(*a*) *East India Co.* v. *Sandys*, Skin. 225.

The Comptroller may refuse to accept an application on the ground that the specification contains more than one invention. The question as to what in truth is one invention is consequently of importance. In *Jones's Patent* (*b*), Sir Farrer Herschell, S.-G., said: "It seems to me that the general object of the invention is the test by which the question of one invention must be decided. If you have a particular general object of an invention to make rails rest more securely, and you describe one or two or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention; but if there is no common purpose so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them except that both are used in connection with rails, and it strikes me that would be two inventions."

Letters patent consist of six material parts:—

1st. The address.
2nd. The recitals.
3rd. The grant.
4th. The prohibition.
5th. The conditions.
6th. The construction of the grant.

THE ADDRESS.

The address is a public address from the sovereign to "all to whom these presents shall come." Mr. Hindmarch gives the reason for this as being, that it contains bargains made between the public and patentee (*c*).

(*b*) Griffin P. C. 265; *Hearson's Patent*, Griffin P. C. 266; and *Robinson's Patent*, Griffin P. C. 267.
(*c*) Page 40.

THE RECITALS.

The recitals are four in number. **The first** recites the patentee's name and address, that he has made a declaration that he is in possession of an invention and is followed by the title of the invention. That he has declared that he is the true and first inventor of the invention, and that the same is not in use by any other person to the best of his knowledge and belief.

It will be remembered that previously to the Act of 1883, there were two forms in use; one when the inventor was the first and true inventor, and the other for a communicated invention; the latter running, "that in consequence of a communication from a foreigner residing abroad, he is in possession of an invention, &c." We have seen that communications from abroad have, in all probability, been abolished by the Act of 1883, and that if he would avoid making a false suggestion, and so destroy his patent, the inventor must himself become the patentee (*d*).

This recital contains the "**suggestions**" which have been made to the sovereign prior to the patent being granted and the representations upon which it has been granted. If either of these suggestions or representations be untrue the patent is void. We cannot do better to illustrate the exact meaning of a **false suggestion** than to quote the language of Parke, B., in *Morgan* v. *Seaward* (*e*). In that case the false suggestion complained of was in the title of the specification, which it was alleged did not disclose the true nature of the invention. "This brings me to the question," said the learned judge, "whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so; and upon the authorities we feel obliged to hold that the patent is void upon the ground of fraud on the

(*d*) Ante, pp. 7 and 21.
(*e*) 2 M. & W. 544; 1 Web. P. C. 187; 6 L. J. Ex. 153.

Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person (*f*). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as in *Hill* v. *Thompson* (*g*); *Brunton* v. *Hawkes* (*h*); for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or in other words the Crown being deceived in its grant, the patent is void, and no action maintainable upon it. We cannot help seeing on the face of this patent, as set out in the record, that an *improvement* in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis* v. *Marling* (*i*), this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed on the attention of the Court or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not vitiate the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself, as one of

(*f*) *Travell* v. *Carteret*, 3 Levinz, 135; *Alcock* v. *Cooke*, 5 Bing. 340.

(*g*) 8 Taun. 375.

(*h*) 4 B. & Ald. 541.

(*i*) 10 B. & C. 22.

the subjects of it which may make a difference." It will be observed here that the learned judge draws a careful difference between an insufficient description in the specification and a false suggestion. In the cases cited below letters patent were held void for false suggestion (*k*). And the following cases are illustrations of the distinction drawn by Mr. Baron Parke:—*Lewis* v. *Marling* (*supra*) and *Haworth* v. *Hardcastle* (*l*). Also *Bainbridge* v. *Wigley* (*m*); *Hill* v. *Thompson* (*n*).

The **second recital** deals with the prayer of the application for the grant.

The **third recital** recites that a complete specification has been filed, particularly describing the nature of the invention. Here, again, a **false suggestion** will avoid the patent, so that if the complete specification is imperfect, the patent will be void upon two grounds, the one being the failure of consideration, and the other the false suggestion; and a false suggestion is equally fatal whether it is wilfully false or otherwise.

The **fourth recital** gives the common law motive for the grant, which is the encouragement of inventions for the public good. There will be something analogous to a false suggestion if the subject-matter of the patent be immoral or illegal, and hence the patent will at common law be void. By sect. 86 of the Act the comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality. A serious oversight in the Act appears to be that there is no appeal from the comptroller when he exercises the power given by this section.

(*k*) *Jessop's Case*, 2 H. Bl. 489; *R.* v. *Wheeler*, 2 B. & Ald. 345; *Felton* v. *Greaves*, 3 C. & P. 611.

(*l*) 1 Bing. N. C. 182.

(*m*) 1 Carp. P. C. 270.

(*n*) 1 Web. P. C. 239.

THE GRANT.

"Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c., give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise and vend the said invention . . . . 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."

This language is intended to preserve intact the **royal prerogative** to grant or withhold a patent—which right was by the common law absolute and undoubted. We have seen that this prerogative is carefully preserved by sect. 116 of the Act.

It is the granting portion of the letters patent which creates the property in the invention. We have seen that this species of property is purely artificial in its nature; it is the most equitable and natural method which the state can devise for the reward and encouragement of inventors; it is merely a right yielding nothing until the invention is made practically useful to humanity. **A trade mark** is also an exclusive right, but it **differs from a patent,** insomuch that it has not merit and the benefit of mankind as its consideration. A trade mark is only a right to guarantee the genuine origin of an article. Anyone else may make the article, but they are only prevented from stamping it with the same mark. A patent prevents the public from making the article or using the invention. There is no property which partakes of the nature of an exclusive right save that of a patent, copyright, or trade

mark. There is no exclusive right in **a secret**. A man may only use a secret to his own profit so long as no one is in a position, by reason of knowing the secret, to use it. But the original possessor of a secret cannot, by any process of law, prevent a person from acquiring the knowledge of his secret, or, having acquired it, from making such use of it by publication or otherwise, as he may think proper (*o*). In *Newbury* v. *James* (*p*), although an agreement had been made **to preserve a secret**, the Court **refused to grant an injunction** on the ground that there was no means of enforcing it. Lord Eldon, L. C., said in *Williams* v. *Williams* (*q*), "So far as the injunction goes to restrain the defendant from communicating the secret upon general principles, I do not think that the Court ought to struggle to protect this sort of secrets in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public."

If the **plaintiff's secret**, however, be one which he **intends to patent**, and the defendant has acquired the information during the progress of experiments, or from the confidence of the plaintiff, he will not be allowed to make such use of the knowledge so acquired as to subsequently invalidate the plaintiff's patent, or to take out a patent for the invention himself, and if he do, he will be liable in damages to the plaintiff (*r*). It will be observed that the word "patentee" is used in the grant; the old form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 46th section, construed as being "*the person for the time being entitled to the benefit of a patent*;" we shall see presently

(*o*) *Canham* v. *Jones*, 2 Ves. & B. 218.

(*p*) 2 Mer. 446.

(*q*) 3 Mer. 157.

(*r*) *Smith* v. *Dickenson*, 3 B. & P. 630.

that this includes assignees, executors and administrators, together with receivers and trustees in bankruptcy, but the subject of the devolution of patent rights is too extensive and important to be dealt with under this head.

THE PROHIBITION.

The prohibition in the patent commands "all our subjects, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

It is very difficult to understand the form of letters patent which is appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the "penalties" referred to in the prohibition are, and how are they to be put in force or recovered? The Act certainly does not mention penalties as a form of punishment for infringers.

THE CONDITIONS.

We find in the "conditions" that the grant is to be avoided "if it should appear to us, &c., or six or more of our Privy Council, that this our grant is contrary to law

or prejudicial or inconvenient to our subjects generally, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the patentee is not the first and true inventor thereof within this realm as aforesaid." This proviso raises some questions of importance. The only proceedings mentioned in the Act for the repeal of letters patent are proceedings in the High Court of Justice. What is the proceeding before "six of our Privy Council"? It can scarcely be believed that reference is here made in a new codifying Act to the old prerogative claim of power to revoke, which has not been put in practice for two hundred and fifty years. If it be intended to have such a system of avoiding patents, surely it would be well to provide for it in a more certain manner than merely to mention it as one of the conditions in the patent itself. In the next place we find here, for the *first time*, *an intimation* that "**novelty**" means novelty within the kingdom; in the recitals of the patent it is recited as being novelty universally, and throughout the Act itself we find that "novelty" is not limited to novelty within the kingdom. Again, we find here for the first time the inventor described as "the first and true inventor **within this realm.**" In the Act and in the recitals of the patent he is described as the "first and true inventor." We have shown that the omission of the words "within this realm" makes an immense difference not only in the class of persons who may be grantees of letters patent, but also in the nature of the evidence of "prior user" which may be given in an action either for infringement or revocation. The ambiguity of the form of letters patent which is given, and the by no means clear provisions of the Act upon these matters, will in all probability result in a plentiful crop of litigation (*s*).

(*s*) See *Marsden* v. *The Saville Street, &c., Co., Limited*, L. R., 3 Ex. D. 203, and *Rolls* v. *Isaacs*, L. R., 19 Ch. D. 268.

The next proviso is one for the determination of the patent in the event of the prescribed **fees not being paid,** and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee upon reasonable terms and conditions.

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*u*). But should the Crown have employed **a contractor,** as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There being two methods of infringing; first, making and vending; and secondly, using. The contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (*x*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorize others who are not their officers, servants, or agents, to use a patented invention without a license from the patentee;" and Lord Selborne added, "I agree with the Court of Queen's Bench that this decision (*Feather* v. *R.*) is not to be extended by any reasoning from the convenience of the Crown, or of the public service, or from any idea that it practically comes to the same thing, whether the Crown manufactures itself or gives orders to other manufacturers."

The right of the Crown to use a patented invention for the public service without being under any obligation to remunerate the inventor has been abolished by sect. 27 of the Act of 1883.

(*u*) *Feather* v. *R.*, 6 B. & S. 257. *Arms Co.*, L. R., 10 Q. B. 130;
(*x*) *Dixon* v. *The London Small* L. R., 1 App. Cas. 641.

(1) "*A patent shall have to all intents the like effects as against her Majesty the Queen, her heirs and successors, as it has against a subject.*

(2) "*But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors* (*y*), *or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.*"

Sect. 44 deals with the acquisition by the Secretary of State for War of any inventions dealing with instruments or munitions of war, and with the non-publication of specifications describing such inventions, and generally with the preservation for the public benefit of the secret of them.

THE CONSTRUCTION.

"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." These words are inserted in the patent for the purpose of preventing the common rule of construction of grants of the Crown when founded upon a petition being read most strongly against the grantee. This favourable construction will not, however, in any way save the validity of the patent if it can be shown to have been granted upon a false suggestion

(*y*) *Dixon* v. *London Small Arms Co., supra.*

CHAPTER VIII.

THE DEVOLUTION OF A PATENT.

We have seen that a "**patentee**" is "the person for the time being entitled to the benefit of a patent." This includes the first inventor and any person or persons in whom the patent may have become vested by operation of law or by assignment.

The property of a patent passes, **by operation of law,** when the patentee dies or becomes **a bankrupt.** Upon the **death of** a patentee his interest in the property passes to his executors or administrators as the case may be in the like manner to the rest of his personal estate. Any step which in the Act is required to be taken by the patentee, may be taken by the executor or administrator, and sect. 34 of the Act provides that—"(1) *If a person, possessed of an invention, dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.*" This undoubtedly, seeing the terms of the grant itself, will mean his legal **pers ' representative.** Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male, such, for instance, as patents of nobility. The Act proceeds—"(2) *Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.*"

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee or assignee in

bankruptcy (*a*). It is doubtful whether the doctrine of apparent possession can be said to affect a patent right. The Lord Chancellor, in 1812, seems to have thought that it did (*b*). This, however, can hardly be quoted as an authority. The persons in whom the patent vests, by reason of bankruptcy, are placed in all respects in the position of the original patentee, and may sue in respect of infringements (*c*).

The second method of devolution is **by assignment,** *inter vivos.* This may be done either by absolute assignment of the whole of the patent, or by absolute assignment of the patent right for a limited area, or by assignment by way of mortgage, or by the grant of licenses.

The right of the original inventor to assign the exclusive right which has been granted to him is recognised in the patent itself, which is granted to the said A. B., his executors, administrators or assigns. Without these words of limitation the property in the patent right would be merely personal, attaching to the person of the first inventor and becoming extinguished by his death.

The patent itself being a deed the **assignment must be** also **by deed** (*d*). So, also, **licenses should be under seal,** the prohibition in the grant itself being "without the consent, license or agreement of the said patentee in writing under his hand and seal."

A license granted by a patentee, but not under seal, is, however, not void in the sense that the licensee, having used the patent, is not bound to pay the royalties contracted for. In *Chanter* v. *Dewhurst* (*e*), it was held that the defendants having obtained the license they had bargained for, and kept it, were bound to pay for it; and

(*a*) *Hesse* v. *Stevenson*, 3 B. & P. 565, also *Bloxam* v. *Elsee*, 9 D. & R. 215; *M'Alpine* v. *Mangnall*, 15 L. J., C. P. 298.

(*b*) See *Ex parte Granger*; Godson on Patents, 2nd ed. p. 225.

(*c*) *Bloxam* v. *Elsee*, *supra*.

(*d*) Co. Lit. 9 b, 172 a.

(*e*) 12 M. & W. 823.

secondly, that the license was not void as not being under seal. Baron Alderson said: "The defendants, in making the machine in question, are merely acting as agents for the patentee . . . . in my opinion a license, for this purpose, need not be under seal."

Although the words of the grant are "under his hand and seal," the document is not a deed since it need not be delivered as a deed, nor need it be stamped as such (*f*).

By sect. 36 of the Act, "*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.*" Having assigned a patent, the original patentee cannot manufacture the patented article, and when an action is brought against him by his assignee he cannot set up that the patent was not valid; **he is estopped by his deed** (*g*), that is by the deed of assignment, but when the assignment is by operation of law there is no such estoppel. In *Cropper* v. *Smith* (*h*), in 1873 Letters Patent for improvements in lace machines were granted to H., who, in 1877 went into liquidation and the patent was sold by the trustee to the plaintiffs. H. afterwards entered into partnership with S., and this action was brought against S. and H. to restrain them from infringing the patent, held that H. was not estopped from disputing the validity of the patent either by matter of record, on the ground that the letters patent were of record; or by deed, by reason of the specification being under his seal; or by matter *in pais* on the ground of the statements in his petition to the Crown, there being nothing to show that the plaintiffs bought on the faith of those statements. (But see Bankruptcy Act 1883, sect. 50, subsect. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (*i*).

(*f*) *Chanter* v. *Johnson*, 14 M. & W. 408.

(*g*) *Oldham* v. *Langmead*, cit. in *Hayne* v. *Maltby*, 3 T. R. 439.

(*h*) L. R., 26 Ch. D. 700.

(*i*) Per Fry, L. J. at p. 712;

Where the plaintiff, **fraudulently asserting** that he had a right **to a patent**, induced the defendant to come to terms with him for a license to use that patent, the defendant, in an action upon that agreement, is not estopped from alleging the want of title in the plaintiff as a defence (*k*). But it would be otherwise in the absence of fraud and where both parties are innocent, in that case the assignee or licensee would not be allowed to set up as a defence the bad title of the assignor or licensor (*l*).

In *Bowman* v. *Taylor and others* (*m*), the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a license under seal for the use of the plaintiff's patent. The defendants defended on the grounds (1) that the invention was not a new invention, (2) that the plaintiff was not the first and true inventor, (3) that the specification was not sufficient—pleas which in effect endeavoured to put in issue the validity of the plaintiff's title. Upon demurrer, Taunton, J., said, "The law of estoppel is not so unjust or absurd as it has been too much the custom to represent. The principle is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted. The question here is, whether there is a matter so asserted by the defendant under his hand and seal that he shall not be permitted to deny it in pleading. It is said that the allegation in the deed is made **by way of recital**, but I do not see that a statement such as this is the less positive because it is introduced by a 'whereas.' Then the defendant has pleaded that the supposed invention in the declaration and letters patent mentioned was not nor is a new invention. These words 'was not nor is a new in-

affirmed House of Lords, 10 App. Cases 249. See also *London and Leicester Hosiery Co.* v. *Griswold*, Griffin P. C. p. 154.

(*k*) *Hayne* v. *Maltby*, 3 T. R. 438.

(*l*) See *Taylor* v. *Hare*, 1 Web. P. C. 292, 293.

(*m*) 2 A. & E. 278.

vention' must be understood in the same sense as the words 'had invented' in the recital of the deed set out in the declaration, and must refer to the time of granting the patent, and if the invention could not then be termed a new invention, it could not, I think, have been truly said in the deed, that the plaintiff 'had invented' the improvements in the sense in which the deed uses the words. Then the plea directly negatives the deed, and comes within the rule that a party shall not deny what he has asserted by his solemn instrument under hand and seal." The learned judge then proceeds to distinguish *Hayne* v. *Maltby* (*n*), but for some reason does not refer to the element of **fraud** in that case, which certainly would take it out of the operation of the doctrine of estoppel.

Where, however, the **license is not under seal** there will be **no estoppel**, and the defendant may show the invalidity of the plaintiff's patent by way of showing failure of consideration (*o*).

Besseman v. *Wright* (*p*) was decided on the ground of partial as against total failure of consideration, and has no reference to the doctrine of estoppel, although it seems sometimes to have been thought that it had.

In *Clark* v. *Adie* (*q*), James, L. J., said, "A licensee cannot under any pretence whatever bring his licensor into litigation as to the novelty of any part of the patent." This case was afterwards affirmed in the House of Lords (*r*). But it appears that if the license has been determined prior to the expiration of the term of the patent the ex-licensees may contest the validity of the patent, notwithstanding the covenants or recitals in the license (*s*). In giving judgment, Lord Cottenham said, "That is exactly coming to the point which I put, whether, at law, the party was estopped from

(*n*) 3 T. R. 438.

(*o*) *Chanter* v. *Leese*, 1 Web. P. C. 295.

(*p*) 6 W. R. 719.

(*q*) L. R., 3 Ch. D. 144.

(*r*) L. R., 2 App. Cas. 423.

(*s*) *Neilson* v. *Fothergill*, 1 Web. P. C. 287.

disputing the patentee's right, after having once dealt with him as the proprietor of that right. And it appears from the authority of that case (*Hayne* v. *Maltby* (*t*)), and from the other cases, that from the time of the last payment (*i.e.* expiration of license), if the manufacturer can successfully resist the patent right of the party claiming the rent, that he may do so in answer to an action for the rent for the use of the patent during that year." The language is not clearly reported, but this appears to mean—to an action for the use and occupation, so to speak, of the patent after the expiration of the license.

The following cases have been decided uniformly, and show that parties to a deed of assignment or license are estopped from denying the validity of the patent, and that there is no implied **warranty** on the part of the assignor or licensor. *Cutler* v. *Bower* (*u*), *Smith* v. *Scott* (*x*), *Walton* v. *Lavater* (*y*), *Norton* v. *Brooks* (*z*), *Crossley* v. *Dixon* (*a*).

Where the license is by parol and has been acted upon, and so long as the licensee has thought fit to claim the benefit of it, he is estopped from denying the validity of the patent, but no term being fixed for the duration of the verbal license he may determine it at any time (*b*). As to estoppel by judgment, see *Goucher* v. *Clayton* (*bb*).

When the defendant has assigned his patent to the plaintiff, he cannot afterwards deny the validity of his own patent—*Walton* v. *Lavater*, *supra*. A licensee cannot take advantage of a judgment obtained by third parties against the patentee declaring the patent bad (*c*). But a licensee,

(*t*) 3 T. R. 438.

(*u*) 11 Q. B. 973.

(*x*) 6 C. B., N. S. 771, and 28 L. J., C. P. 325.

(*y*) 8 C. B., N. S. 162.

(*z*) 7 H. & N. 499.

(*a*) 10 H. L. Cas. 293.

(*b*) *Crossley* v. *Dixon*, 32 L. J. Ch. 617.

(*bb*) 34 L. J. Ch. 239.

(*c*) *The Grover and Baker Sewing Machine Co.* v. *Millard*, 8 Jur., N. S. 713.

in an action by the patentee, may claim to place the most **favourable construction** on the specifications, which will support the validity of the patent, if another construction would make it bad (*d*).

An assignment of patent rights in a **partnership** dissolution deed will estop the retiring partner from subsequently setting up the invalidity of the patent by way of defence to an action brought by his late partners (*e*). But where the plaintiff and defendant had been partners, and had worked as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, held that plaintiff was not estopped from denying the validity of the patent (*f*). And where partners are joined as defendants in an action for infringement, and one is assignor of the patent, the other is not debarred from setting up the pleas of invalidity (*g*).

Fraudulent agreements for the assignment of patents, such, for instance, as bubble patents, will be set aside (*h*). But in the absence of fraud the agreement will be enforced, and it is no defence to the action that the plaintiff has not invented the alleged invention (*i*).

Executors may assign a patent prior to registration of the probate (*k*).

Specific performance of an agreement to assign letters patent may be decreed (*l*). Even though the agreement be to assign patents for future inventions (*m*).

Licenses differ from assignments, in that the patentee

(*d*) *Trotman* v. *Wood*, 16 C. B., N. S. 479.

(*e*) *Chambers* v. *Crichley*, 33 Beav. 374.

(*f*) *Axmann* v. *Lund*, L. R. 18 Eq. 330; 22 W. R. 789.

(*g*) *Heugh* v. *Chamberlain*, 25 W. R. 742.

(*h*) *Lovell* v. *Hicks*, 2 Y. & C. 46.

(*i*) *Smith* v. *Buckingham*, 18 W. R. 314.

(*k*) *Ellwood* v. *Christy*, 10 Jur., N. S. 1079.

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

(*m*) *Printing and Numerical Registering Co.* v. *Sampson*, L. R. 19 Eq. 462; 44 L. J., Ch. 705.

granting a license does not part with his whole interest, but grants merely a right to use the patent for the whole term or any portion of the whole term. The license may be exclusive or otherwise.

Sect. 22 of the Act of 1883 provides for the granting of **compulsory licenses.**

"*If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—*

"*(a) The patent is not being worked in the United Kingdom; or,*

"*(b) The reasonable requirements of the public with respect to the invention cannot be supplied; or*

"*(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.*"

These provisions are entirely novel; "(a) and (b)" are capable of being reasonably construed, as to "(c)" it is difficult to understand how the Board of Trade will come to a decision as to whether "a person is prevented from working or using, to the best advantage, an invention of which he is possessed." The "invention" must be protected by letters patent (see the construction given in sect. 46).

The proceedings under sect. 22 will be regulated by rules to be made by the Board of Trade in pursuance of the power given by sect. 101, sub-sect. 1 (g), and sub-sects. 3, 4 and 5.

Money paid by a licensee for royalties cannot be recovered when it is ascertained that the patent was void *ab initio* (*n*). And if the licensees have kept the

(*n*) *Taylor* v. *Hare*, 1 B. & P. (N. R.) 260.

license and used it, the licensor can recover from them the agreed royalties, although the patent may have been void and the license not under seal (*o*). But otherwise, if the licensor knew from the first that the patent was void (*p*). But if the consideration for the money paid is that an application for a patent should be made and a license to use the patent granted, no application being made for the patent, there is a total failure of consideration, and the price paid may be recovered (*q*). **A license is not assignable** (*r*). A license to a man and his assigns means a license with power to licensee to sub-license (*idem*). A licensee may covenant not to manufacture without applying the patented invention; such a covenant is not in restraint of trade (*s*). **A license may be created by parol,** but if no time is fixed for its duration it may be determined at will, and after the determination there will be no estoppel to the ex-licensee to dispute the validity of the patent (*t*). A patentee having granted a license cannot prevent anyone **vending the articles** which have been made in pursuance of the license (*u*). And an inventor selling the patented article abroad cannot restrain its importation and sale in this country. Although an assignee of the patent in this country might restrain the importation of an article made by the original inventor or his assignee abroad (*x*). A **latent ambiguity** in a license by deed may be explained by parol evidence in the same manner as other deeds (*y*). A licensor may in the license deed stipulate for a forfeiture in the event of royalties not

(*o*) *Chanter* v. *Dewhurst*, 12 M. & W. 823.

(*p*) *Chanter* v. *Leese*, 4 M. & W. 295.

(*q*) *Knowles* v. *Bovill*, 22 L. T. N. S. 70.

(*r*) Per Maule, J., in *Bower* v. *Hodges*, 22 L. J., C. P. 198.

(*s*) *Jones* v. *Lees*, 1 H. & N. 189.

(*t*) *Crossley* v. *Dixon*, 10 H. L. Cas. 293; L. J., 32 Ch. 617, H. L.

(*u*) *Thomas* v. *Hunt*, 17 C. B., N. S. 183.

(*x*) *Betts* v. *Willmott*, L. R., 6 Ch. 239.

(*y*) *Roden* v. *The London Small Arms Co.*, 46 L. J., Q. B. 213.

being paid (*z*), but such forfeiture may be waived (*a*). The licensor may also agree that he will take all necessary steps to support the validity of the patent (*b*).

Sect. 23 of the Act provides :—"(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 licenses under patents and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed;* (2) *the register of patents shall be* primâ facie *evidence of any matters by this Act directed or authorized to be inserted therein;* (3) *copies of deeds, licenses and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.*"

By sect. 85, "**There shall not be entered in any register** *kept under this Act, or be receivable by the comptroller, any notice of any* **trust,** *express, implied, or constructive.*" Sect. 87, as amended by sect. 21 of the Patents, &c., Act, 1888, provides for the entry in the register at the request of the person becoming entitled, of any assignment or transmission of interest. The person registered shall have power to deal with such interest as he has registered, absolutely: "*Provided that any equities in respect of such patent, &c., may be enforced in like manner, as in respect of any other personal property.*" Sect. 88, as amended by sect. 22 of the Patents, &c., Act, 1888, deals with the inspection of registers, and the obtaining of certified copies. By sect. 89 sealed copies are to be received in evidence.

(*z*) *Tielens* v. *Hooper*, 5 Ex. 830.
(*a*) *Warwick* v. *Hooper*, 3 M. & G. 60.
(*b*) *Henderson* v. *Mostyn Copper Co.*, L. R., 3 C. P. 202.

Sect. 90, as amended by sect. 23 of the Patents, &c., Act, 1888, empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of persons aggrieved, and upon sufficient cause shown. The comptroller may himself correct errors in registers which are merely of a clerical nature, sect. 91.

The comptroller may refuse to enter upon the register of patents a document dated before the patent, upon the ground that it does not contain a sufficient proof of title (*c*).

Sect. 35 of the **Act of 1852,** after providing for the registration of proprietors, assignments, &c., of patents, proceeded: "Provided always, that, until such entries shall have been made, the grantee or grantees of letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all licenses and privileges thereby given or granted."

It will be observed that the Act of 1883, quoted above, **materially differs from this enactment.** Hence *Chollett* v. *Hoffman* (*d*), and *Hassall* v. *Wright* (*e*), will not now apply.

Prior to the Act of 1883, the High Court of Justice exercised jurisdiction to alter and amend the register of patents (*f*).

The register should be amended whenever a fraudulent entry has been made. A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a license to work and use to A. B.'s assignment was first registered:—Held, that B. had **constructive notice** of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A., subsequently entered (*g*).

(*c*) *In re Parnell's Patent*, 5 P. O. R. 126.

(*d*) 7 Ell. & B. 686.

(*e*) L. R. 10 Eq. 509; 40 L. J., Ch. 145.

(*f*) *In re Morgan's Patent*, 24 W. R. 245.

(*g*) *In re Mosey's Patent*, 25 Beav. 581.

CHAPTER IX.

EXTENSION OF TERM OF PATENT.

SECT. 25 of the Act of 1883 provides:

"(1) **A patentee** *may, after advertising in manner directed by any rules made under this section his intention to do so, present a* **petition to her Majesty in Council,** *praying that his patent may be extended for a further time; but such petition must be presented at least six months before the time limited for the expiration of the patent.*"

"*A patentee*" is by section 46 construed as "*the person for the time being entitled to the benefit of a patent,*" therefore a mortgagee who is unpaid must be joined for the purpose of petitioning for an extension (*a*).

The period of six months limited by this sub-section will not apply to patents granted before the 1st Jan. 1884. With regard to such patents the provisions of 5 & 6 Will. IV. c. 83, will apply, and applications for extension may be made at any time prior to the expiration of the patent; this is by reason of the 113th section of the Act of 1883 (*aa*). But once a patent is extended it becomes a new patent, and the whole of the Act of 1883 applies to it (*b*).

"(2) *Any person may* **enter a caveat** *addressed to the Registrar of the Council at the Council Office, against the extension.*

"(3) *If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council,*

(*a*) *Church's Patent*, Griffin P. C. 256.

(*aa*) *Branden's Patent*, L. R. 9 App. Cas. 589; 53 L. J., P. C. 84.

(*b*) *Cocking's Patent*, 2 P. O. R. 151.

the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

"(4) *The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.*

"(5) *If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term, not exceeding seven, or, in exceptional cases, fourteen years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.*"

It is the practice to grant a new patent, such new patent being subject to the conditions in the Act of 1883 (*c*).

"(6) *It shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.*

"(7) *The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.*"

These provisions have made **no substantial alteration in the law.** Prior to the Act 5 & 6 Will. IV. c. 83, there was no power in the Crown to extend the duration of letters patent, and should an inventor have desired to

(*c*) *Smith's Patent*, Griffin P. C. 263.

apply for an extension of the term of his grant, he could only do so by applying for and obtaining a **special Act of Parliament** in his favour. The Act of Will. IV., and the amending Act of 2 & 3 Vict. c. 67, introduced the method of petitioning and obtaining an extension to the Privy Council.

It had been found that the procedure to obtain an Act upon each occasion, when an extension was sought, was too costly and cumbrous, hence the modern course of procedure was devised.

This being shortly the origin of the jurisdiction of the Privy Council, at first an impression gained that the Privy Council were to put themselves in the position of Parliament, and not in that of a court of law, in considering the claims of applicants who appeared before them; that they were to weigh the claims of the **public interest** very heavily in the balance as against the inventor. In *Re Soame's Patent* (*cc*) Lord Brougham said: "If this case were to be disposed of upon the ground which in arguing such cases have sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent; but that, moreover, the case is to be tried here as on a bill in parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no bill would ever have passed through the two houses of parliament."

The true construction is, however, not so severe as that, although still sufficiently severe. In *Re Morgan's Patent* (*d*) Lord Brougham said: "It is by no means their (the Privy Council) course to put themselves precisely in the situation of the Legislature, and never to grant an extension where an Act of Parliament would not have been obtained. At

(*cc*) 1 Web. P. C. 729.

(*d*) 1 Web. P. C. 737.

the same time there are some limits to this. They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the Legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of parliament."

Such is **the spirit in which the Privy Council will approach the subject** of an extension, not benevolently to the applicant, but still with not so stern a regard to the interests of the public as parliament would entertain.

In considering their decision the Privy Council will consider:—

1. The nature and merits of the invention in relation to the public.
2. The adequacy or inadequacy of the profits made by the inventor as such.
3. The circumstances of the case.

In *Re Erard's Patent* (*dd*) Lord Lyndhurst said: "In cases of this kind we expect a very strong **case of hardship** to be made out as well as a strong case upon the **utility of the invention;**" and the same privy councillor in *Soame's case* (*e*) said, "We consider the invention as very meritorious, the result of a great deal of labour, care, and science, and that it is extremely useful in its effects. We are satisfied by reasonable evidence that the party has sustained very **considerable loss**, and under these circumstances we think that the period ought to be extended."

It will be observed that the three considerations for the Privy Council laid down by the Act of 1883 are almost identical to the grounds of extension as given by Lord Brougham in *Re Derosne's Patent* (*f*): "The parties must show in the first place some invention, in the next place a benefit to the public, and in the third place that they have not had adequate remuneration."

(*dd*) 1 Web. P. C. 557. (*e*) 1 Web. P. C. 729.
(*f*) 2 Web. P. C. 4.

It is immaterial whether or not the application is opposed. The Privy Council will require every necessary ground for extension to be **strictly proved** before they advise an extension (*g*), and this even though the Crown through the attorney-general consents (*h*).

"The merit of an **importer** is less than of an inventor. We are sitting judicially, and it is an argument against the patent that it is imported and not invented. I do not say it takes away the merit, but it makes it much smaller (*i*)."

Extension of the term will be granted to **assignees,** as they have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (*j*).

"Merit" here means the consideration which has been given to the state for the patent; it does not mean the merit of the inventor, but the **merit of the consideration** which he has given. An inventor may have diligently worked for years in a most deserving manner, and yet have produced an improvement of the most trifling nature—the merit of the person in this case will not be considered. On the other hand, the invention, although a great one, may have been handed to him from abroad without thought or trouble on his part. This is what Lord Brougham contemplates when he says that the merit of an importer is less than that of an inventor. Again, the invention may have been a very simple one, produced by an inventor with a moment of thought, and yet of great importance to the world. This latter case would be one of merit—simplicity of an invention being an element of its value (*k*).

(*g*) *In re Perkin's Patent*, 2 Web. P. C. 6.

(*h*) *In re Cardwell's Patent*, 10 Moo. P. C. C. 488.

(*i*) Per Lord Brougham, *In re Soame's Patent*, 1 Web. P. C. 729.

(*j*) See *In re Napier's Patent*, 13 Moo. P. C. C. 543.

(*k*) *In re Muntz' Patent*, 2 Web. P. C. 113.

In *Bailey's Patent* (*kk*), Lord Blackburn said: "What the statute says is that the judicial committee shall, in considering their decision, have regard to the *nature and merits of the invention* before that evidence has been called which shows what can hardly be disputed, viz., that the invention which is the subject of the patent, is a beneficial invention; but as to the petitioner showing that there was any *special or peculiar advantage* in the invention in relation to the public to entitle the patentee to the large reward of an extension of his patent, their lordships are of opinion that he has totally failed to do so."

The Privy Council will not inquire into the **novelty or utility** of a patent, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention (*l*).

Non-user of the patent creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*m*). But the same objection being raised *In re Hughes' Patent* (*n*), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*o*).

In *Re Betts' Patent* (*p*) Lord Chelmsford said, "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the

(*kk*) Griffin P. C. at p. 254.

(*l*) *In re Saxby's Patent*, L. R., 3 P. C. 292; *Stewart's Patent*, 3 P. O. R. 7.

(*m*) See *In re Allan's Patent*, L. R. 1 P. C. 507, where an application was rejected on that ground.

(*n*) L. R., 4 App. Cas. 174.

(*o*) See also *In re M'Dougal's Patent*, L. R., 2 P. C. 1, and *In re Herbert's Patent*, L. R., 1 P. C. 399.

(*p*) 1 Moo. P. C. C., N. S. 49.

real benefactor to the public, and is entitled to claim that description of **merit** which constitutes one of the grounds for extending the term of a patent" (*q*).

Merit is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Privy Council must of necessity, therefore, be decided upon the facts of that particular case. It is otherwise with the other necessary condition for an extension, viz., the inadequacy of the remuneration of the inventor. Here figures can be dealt with, and a nearer approach to uniformity of decision obtained. It is possible, therefore, to gather from the various decisions a reasonably accurate set of rules for the guidance of the applicant for an extension on the ground of the inadequacy of the remuneration.

The **sufficiency of the remuneration** will be estimated with a view to the **importance of the invention** and the **benefit the public** have derived from it. That which would be ample remuneration for one patent would be considered inadequate for another. Refining sugar by filtering it through animal charcoal was an invention of great value and importance. The patent was extended for six years on the ground that although there had been a considerable profit, it bore no relation to the great merit of the invention (*r*). So *In re Newton's Patent* (*s*) the Privy Council granted an extension on the ground that there had not been sufficient remuneration considering the value of the invention.

An English patent may be renewed though a foreign one has been taken out and allowed to expire (*t*).

If the patentee is a manufacturer of the patented article, the Privy Council will not endeavour to distinguish accurately **his profits** as a patentee from his profits **as a**

(*q*) Also see *In re Hill's Patent*, 1 Moo. P. C. C., N. S. 258 at page 265.

(*r*) *In re Derosne's Patent*, 2 Web. P. C. 1.

(*s*) 14 Moo. P. C. C. 156.

(*t*) *In re Adair's Patent*, L. R., 6 App. Cas. 176.

manufacturer, but will consider the gross amount of profits (*u*). In this case Lord Brougham said: "We cannot weigh in golden scales the proportions between manufacturers' profits and patentees, but we must take it in the gross, and apply our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing, nor in his favour straining. We must ascertain whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

The ground of this view of the case appears to be that the possession of the patent has placed the manufacturer in an advantageous position in obtaining orders (*x*).

In the accounts which the patentee must file upon an application for an extension, when he is a **manufacturer of the patented article** he should, so far as possible, distinguish profits as a manufacturer from profits as a patentee (*y*); and in cases where it can be shown that the reasoning in *Johnson's case* (*supra*) does not apply, he will be allowed to deduct his profits as a manufacturer before an estimate is taken of his profits as a patentee (*z*).

But where he ascribed two-thirds of the profits to the manufacturer, and only one-third to the patent, it was held to be unreasonable (*a*).

It will be observed that the cases quoted above appear to conflict with the principles laid down by Lord Brougham in *Muntz' case* (*b*). These words cannot be read as meaning that no regard whatever will be paid to the fact, that a great portion of the patentees' plant, expenditure,

(*u*) *In re Muntz' Patent*, 2 Web. P. C. 113.

(*x*) *In re Johnson's Patent*, 8 Moo. P. C. C., N. S. 282.

(*y*) *In re Betts' Patent*, 1 Moo. P. C. C., N. S. 49.

(*z*) Ib.

(*a*) *In re Hill's Patent*, 1 Moo. P. C. C., N. S. 258, and *Duncan & Wilson's Patent*, 1 P. O. R. 257.

(*b*) 2 Web. P. C. at page 120.

or time, is devoted to the business of an ordinary manufacture, from which some profits would be derived, even if no patent were in existence, but that no attempt will be made to go into minute details of figures. The profits will be treated in gross, and then their lordships will apply their general knowledge, as men of the world, in coming to a conclusion as to how much the patentee has received from the profits of his invention.

In estimating profits, a deduction will be allowed for the **expenses of experiments** in bringing the invention to perfection (*c*). And also in respect of the **costs of litigation** necessary to maintain the validity of the patent, and to restrain infringers (*d*). But not where actions have been compromised, improvidently, and costs abandoned without sufficient reason (*e*). The **expenses of taking out the patent** will be allowed as a deduction (*f*). So also will the **expenses incurred in bringing the invention in general public use** (*g*). And a deduction will be allowed in respect of the **personal expenses of the patentee,** and by way of salary for the exclusive devotion of his time in bringing the patent into practical operation and public notice (*h*). A patentee residing in America, for the purpose of getting the patented article into general use in England, employed **an agent**, and allowed him half profits. This half was allowed to be deducted (*i*).

But, on the other hand, the patentee must add to his profits the profits arising out of the manufacture of the patented article, even though intended for exportation (*k*). So also he must add the **profits** which have been made **by**

(*c*) *In re Bates' Patent*, 1 Web. P. C. 573.

(*d*) *In re Galloway's Patent*, 1 Web. P. C. 724.

(*e*) *In re Hills' Patent*, 1 Moo. P. C. C., N. S. 258.

(*f*) *In re Roberts' Patent*, 1 Web. P. C. 739, and *In re Kay's Patent*, 1 Web. P. C. 568.

(*g*) *In re Galloway's Patent*, supra.

(*h*) *In re Carr's Patent*, L. R., 4 P. C. C. 539.

(*i*) *In re Poole's Patent*, 4 Moo. P. C. C., N. S. 452.

(*k*) *In re Hardy's Patent*, 6 Moo. P. C. C. 441.

his **licensees** (*l*). And in *Re Johnson's* patent, Lord Justice James said: "Their lordships are of opinion, that where the question to be considered is, whether an invention has been sufficiently remunerated or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee or the person who claims the right of the patentee, *whether it be in one country or another.*"

We have seen by sub-section 6 of the section of the Act of 1883, now under consideration, the rules of the Privy Council, which have been heretofore in force, are to continue until amended or altered.

Rule 9 is as follows:—"A party applying for an extension of a patent . . . . must lodge at the council office six printed copies of the specification, and also four copies of the **balance sheet of expenditure and receipts** relating to the patent in question, which accounts are to be proved on oath before the lords of the committee at the hearing." This must be done within one week of the hearing: rule 10.

The judicial committee will not enter into the accounts in a case for extension unless they have been filed in accordance with this rule (*m*).

But in exceptional cases, the filing of perfect accounts may be excused (*n*). Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition, to the effect that not only had there been no profits, but a considerable loss (*o*).

The **account** of profit and loss ought to be **clear and**

(*l*) *In re Trotman's Patent*, L. R. 1 P. C. 118; 3 Moo. P. C. C., N. S. 488.

(*m*) *In re Johnson's* and *Atkinson's Patent*, L. R., 5 P. C. 87; and see *In re Yates'* and *Kellett's Patent*, L. R. 12 App. Cas. 147.

(*n*) *In re Love's Patent*, 10 Jur. 363.

(*o*) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

precise (*p*). The application will be refused if the petitioner's accounts are unsatisfactory (*q*). The accounts furnished by the petitioner not containing sufficiently full and accurate information in respect of the patent, or the remuneration received by him, the judicial committee declined to recommend a prolongation of the term (*r*). In one case, the accounts being *primâ facie* unsatisfactory, the judicial committee directed the question of accounts to be taken before considering the merits of the invention (*s*). And where the accounts were *primâ facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (*t*). The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence (*u*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner.

Where a patentee, whether English or foreign, has obtained **foreign patents**, they **should be stated** in a petition for prolongation, and the fullest information afforded as to the profits thereof. A patentee should preserve the clearest evidence of everything which has been paid or received on account of the patent. Whether or not his remuneration has been adequate, his furnishing a satisfactory account is a condition precedent to his obtaining an extension of his term (*v*), and no alteration has been made in this respect by sect. 25, sub-sect. 4 of the Act of 1883 (*x*).

(*p*) *In re Betts' Patent*, 1 Moo. P. C. C., N. S. 49.

(*q*) *In re Trotman's Patent*, 3 Moo. P. C. C., N. S. 488.

(*r*) *In re Clark's Patent*, 7 Moo. P. C. C., N. S. 255.

(*s*) *In re Wield's Patent*, L. R., 4 P. C. 89.

(*t*) *In re Houghton's Patent*, L. R. 3 P. C. 461; 7 Moo. P. C. C., N. S. 309.

(*u*) *In re Hutchinson's Patent*, 14 Moo. P. C. C. 364.

(*v*) *In re Adair's Patent*, L. R., 6 App. Cas. 176.

(*x*) *Newton's Patent*, 9 App. Cas. 592.

The third head of subjects to be inquired into, upon an application for prolongation, consist of the various grounds of objections to an extension which have been allowed hitherto by the committee, and which are included in the general term used in sub-sect. 4, viz., "**All the circumstances of the case.**"

That the invention has not been brought into **public use** is a good ground of objection (*y*). So is **negligence** on the part of the patentee **in restraining infringement** (*z*). That the **invention was practically useless** as originally described in the specification, but was subsequently made practicable by subsequent improvements, introduced from abroad, is also a good ground for objection (*a*). But, otherwise, where the invention was useful and meritorious, in its original form, subsequent improvements form no ground in support of objection (*b*). When the non-profitable use of the patent has been caused by the fault of the patentee himself, objection will be allowed (*c*). So also where a patentee has **delayed, intentionally,** putting his invention into practice, unless he can show that shortness of funds, or other reasons, placed it out of his power to avoid the delay(*d*).

We have seen that the novelty or utility of a patent will not be inquired into, except so far as they bear upon the merit of the invention. Nor will the validity of the patent be inquired into, excepting in cases where it is **obvious the patent is invalid**. In *Re Hills' Patent* (*e*), Sir J. T. Coleridge said: "Their lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent

(*y*) *In re Pinkus' Patent*, 12 Jur. 233.

(*z*) *In re Simister's Patent*, 1 Web. P. C. 721; also *In re Pinkus' Patent*, supra.

(*a*) *In re Woodcroft's Patent*, 1 Web. P. C. 740.

(*b*) *In re Galloway's Patent*, 1 Web. P. C. 724.

(*c*) *In re Patterson's Patent*, 6 Moo. P. C. C. 469.

(*d*) *In re Norton's Patent*, 1 Moo. P. C. C., N. S. 339.

(*e*) 1 Moo. P. C. C., N. S. 258.

which is manifestly bad; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of **want of novelty** and **want of utility**, so far as they affect the validity of the patent. Indeed the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account; and in their lordships' judgment they are right in that contention. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it" (*f*).

An illustration of what is meant by the patent being **clearly bad** is given in *Re M'Innes' Patent* (*g*). The patent was for a metallic soap to be used for the purpose of preserving metals from rust. The specification was very widely worded. Sir W. Earle said, "Their lordships taking into consideration with reference to the public interest that the individual substance for the application of which the patent is sought to be prolonged is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it is. On the whole, therefore, their lordships are of opinion that they ought not to recommend her Majesty under such circumstances to grant a prolongation."

In consequence of sect. 25 of the Patent Law Amendment Act, 1852, and of sect. 7 of 16 & 17 Vict. c. 115,

(*f*) Per Lord Langdale, M. R., *In re Pinkus' Patent*, 12 Jur. 233.

(*g*) 5 Moo. P. C. C, N. S. at p. 78.

which provided that letters patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent, and that any prolongation of letters patent should be made subject to that condition. **An inquiry into foreign patents** and their duration was always an essential element of the proceedings before the Privy Council (*h*).

These Acts are, however, specifically repealed, and by sect. 45, sub-sects. 2 and 3, of the Act of 1883 it is provided, "*Every patent granted* **before** *the commencement of this Act, or on an application there pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses. In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.*"

Thus it will be seen that after the commencement of the Act any prolongation of letters patent will be made regardless of foreign patents or their duration, saving with regard to the profits thereof, *ante*, p. 155.

Prior to the Act of 1883 it had been held, in a series of cases, that **executors and administrators** of a grantee of letters patent might petition for an extension (*i*). So might the assignee of a patent, even though a public company (*k*). So might the executor of an assignee (*l*).

(*h*) *In re Bodmer's Patent*, 8 Moo. P. C. C. 282; *In re Aubé's Patent*, 9 Moo. P. C. C. 43; *In re Newton's Patent*, 15 Moo. P. C. C. 176; *In re Betts' Patent*, 1 *Moo.* P. C. C., N. S. 49; *In re Poole's Patent*, 4 Moo. P. C. C., N. S. 452; *In re Normand's Patent*, 6 Moo. P. C. C., N. S. 477; *In re Winan's Patent*, 8 Moo. P. C. C., N. S. 306; *In re Johnson's Patent*, 8 Moo. P. C. C., N. S. 282; *In re Blake's Patent*, L. R., 4 P. C. 535.

(*i*) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

(*k*) *In re Norton's Patent*, 1 Moo. P. C. C., N. S., 339.

(*l*) *In re Bodmer's Patent*, 1 Moo. P. C. C. 469.

The Act of 1883 gives **a patentee** the right to petition, and, bearing in mind that the **definition of the word patentee** is by sect. 46, "*Any person for the time being entitled to the benefit of a patent,*" it will be observed that the greatest latitude is given as to persons who may petition. The committee will still regard different classes of petitioners in different lights.

In *Re Norton's Patent*, quoted above, Sir John Romilly, then Master of the Rolls, said, "Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

And in *Re Pitman's Patent* (*m*) Sir J. W. Colvile said: "There are no doubt cases in which their lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit as it may be said of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general rule which their lordships entertain in applications on the part of assignees is, as was stated by Lord Brougham in *Re Morgan's Patent* (*n*), that by so doing 'they are, though not directly yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not

(*m*) 8 Moo. P. C. C., N. S. 293.

(*n*) 1 Web. P. C. 737.

remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent.'"

There is no case showing that an extension has ever been granted to licensees; but it may be suggested that at any rate *exclusive* licensees are "persons for the time being entitled to the benefit of a patent," although, of course, very exceptional circumstances indeed would have to be shown to warrant an extension to them.

It is difficult to estimate the effect of sect. 36 of the Act of 1883 upon this branch of the subject. Sect. 36 provides 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.*"

Will the Privy Council, on the application of an assignee for a portion of the kingdom, extend the patent for that portion, or must all parties to the patent join in the petition?

It is evident that whilst one district assignee of an electric light patent, for example, may have been amply remunerated, another may not have been remunerated at all, owing to the action of local authorities or other matters entirely beyond the assignee's control. How could the committee in justice refuse the latter an extension? On the other hand, how could they grant it to the other?

Then again, if a patent may be extended for one district and not for another, we shall have the enormous practical difficulties and public inconveniences of an article being patented in one county and free in another, a state of affairs which, we venture to say, would be intolerable to the public.

Any person may enter a **caveat against the extension,**

and may be heard at the bar in support of their opposition; and where unreasonable opposition is offered, they will be ordered to pay the petitioner's costs (*o*). But where the opposition is well founded and successful, costs will be allowed to the opposing party (*p*). If the petition be **abandoned**, **costs will be given to opposers,** and they need not give the petitioner notice of their intended application for the same (*q*). Where the petitioner had fairly and honestly stated his case, both the things against and the things for him in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration.

Where two or more parties have opposed the petition separately and successfully, the committee will sometimes order a **fixed sum** to be paid by the petitioner to the opponents, to be apportioned between them in lieu of saddling him with several separate sets of **taxed costs** (*r*). We thus see that, whilst on the one hand an unwarranted application for an extension may be very costly, unreasonable opposition may be equally so.

An extension of a patent having once been granted, the Privy Council have no jurisdiction to entertain a petition for a **further prolongation**, their power being exhausted; and this objection may be taken by an opposing party, even though omitted from the objections filed by them (*s*).

The rules of practice to be observed upon application for extensions of letters patent will be found hereafter.

(*o*) *In re Downton's Patent*, 1 Web. P. C. 565.

(*p*) *In re Westrupp and Gibbins' Patent*, 1 Web. P. C. 554.

(*q*) *In re Bridson's Patent*, 7 Moo. P. C. C. 499. See, however, *In re Milner's Patent*, 9 Moo. P. C. C. 39.

(*r*) *In re Jones's Patent*, 9 Moo. P. C. C. 41. Also *In re Hills' Patent*, 1 Moo. P. C. C., N. S. 258, and *In re Wield's Patent*, 8 Moo. P. C. C., N. S. 300; *Newton's Patent*, 9 App. Ca. 592.

(*s*) *In re Goucher's Patent*, 2 Moo. P. C. C., N. S. 532.

CHAPTER X.

CONFIRMATION.

THE statute 5 & 6 Will. IV. c. 83, provided a remedy for cases of hardship, such as, where an invention had been invented or used and subsequently abandoned before the date of the patent in a manner unknown to the patentee at the time of his application. There would be a sufficient prior user to invalidate the patent, and yet there would be great merit probably in the patentee, and a great benefit to the public. The patentee might petition the Privy Council to confirm the patent, that is, to declare it valid, notwithstanding such prior user. The proceedings on such a petition were similar to those upon a petition for extension.

The Act of 1883 repeals the statute 5 & 6 Will. IV. c. 83, and with it all proceedings for confirmation; and this method of clothing an invalid patent with validity is abolished. A perusal of sect. 45, sub-sects. 2 and 3, shows that this applies to patents existing at the commencement of the Act, as well as to those to be hereafter applied for and granted.

It is not strictly the purpose of a law work to criticise the enactments of the legislature, saving in their construction and application from an administrative point of view, otherwise a great deal might be said as to the advisability of abolishing that which was intended for and operated merely as a relief under very hard and exceptional circumstances.

CHAPTER XI.

REMEDIES OF THE PATENTEE AND OF THE PUBLIC—ACTION FOR INFRINGEMENT.

An action for infringement is the remedy which the patentee has, and the means which is given to him for enforcing his patent privileges.

The courts are bound to take notice of the patent, and are bound to give legal effect to it, provided it cannot be shown to have been granted contrary to law.

PARTIES TO THE ACTION.

The Act of 1883 gives no directions as to what persons may be **plaintiffs or defendants** in an action for infringement, and therefore leaves the question of the parties to the action as it was before the passing of the Act.

The **original grantee**, it is obvious, so long as he has not parted with the whole of his interest in the patent, may be a plaintiff. And so may the **assignee** of a patent (*a*), even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*).

The **assignee of a portion** of a patent may sue for an infringement of that part. Erle, C.J., in giving judgment in *Dunnicliff* v. *Mallett* (*c*), said: "The question is

(*a*) *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838.

(*b*) *Walton* v. *Lavater*, 8 C. B., N. S. 162.

(*c*) 7 C. B., N. S. 209.

whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and severable. . . . Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action." The plaintiff in such an action would not be allowed to sever his part from the rest of the patent, and he would be liable to be defeated if it could be shown that the patent in any of its parts was void. But, on the other hand, he would have to show that his part alone would have been sufficient to support a patent, *i.e.*, that it contains a new and useful invention. Sect. 33, however, of the Act of 1883, provides, "*Every patent . . . shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.*"

By sect. 36, "*A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*" The **assignee for a district** will be in a position to bring an action for infringement, but it is obvious that the infringement must be within his district, otherwise he will be unable to prove damage.

One of several joint owners of a patent may bring an action in his own name to restrain infringement, or for damages, without joining his other co-owners (*d*), and he may sue alone for an account of profits, and for payment to

(*d*) *Sheehan* v. *Great Eastern Rail. Co.*, L. R., 16 Ch. D. 59; *Dent* v. *Turpin*, 2 J. & H. 139.

the plaintiff of such part of such profits as the plaintiff should be entitled to.

Abinger, C.B., in *Derosne* v. *Fairie* (*e*), said that "a mere **licensee** could maintain no action against anyone else for the infringement of a patent." He might, however, **use the name of the grantor** of the license for the purpose provided he were an **exclusive licensee** (*f*).

A mere licensee would have no exclusive right to use the invention; he is only a person who is permitted to use it. The grantor of such a license might grant a dozen other such licenses without prejudicing the rights of the license; but an exclusive licensee has a right of property in the monopoly, and stands very much in the same position as an assignee for a district. The term exclusive, as applied to a licensee, meaning exclusive within an area.

When the exclusive licensee finds it necessary to protect his rights by bringing an action in the name of the licensor he is liable to give the licensor security for the costs (*g*) which, in the event of defeat, the licensor would have to pay. The right, however, to assign for particular districts will make this branch of the subject unimportant, since exclusive licenses were only a scheme for the purpose of, in effect, assigning for districts.

The **assignees or trustees** in bankruptcy of a patentee may maintain action for infringement in their own name (*h*), and so may the **executors or administrators** of a patentee.

As defendants, a person physically using a patented invention is liable, such as a **contractor** (*i*). When a person in the position of **a servant** uses a patented invention, the master, in law, is the person who physically uses

(*e*) 1 Web. P. C. 154.

(*f*) *Renard* v. *Levinstein*, 2 Hem. & M. 628.

(*g*) *Evans* v. *Rees*, 2 Q. B. 334; *Spicer* v. *Todd*, 1 D. P. R. 306.

(*h*) *Bloxam* v. *Elsee*, 6 B. & C. 169.

(*i*) *Denley* v. *Blore*, 38 Lond. Jour. 224.

the invention as well as the servant, and the master may be sued. If a servant uses an invention in the course of his employment the master is liable, even though the master has told the servant to avoid infringing the patent (*k*). The **directors of a company** whose servants infringe an invention are personally liable (*l*).

An architect specifying the use of a patented invention is not liable (*m*).

Aliens infringing a patent in this country by vending or otherwise are liable if they come within the jurisdiction of the courts (*n*). A person ordering goods to be made in England which are an infringement of a patent, although intended for exportation to him abroad, infringes the patent. "He that causes or procures to be made may be well said to have made himself." Per Tindal, C. J. (*o*).

(*k*) *Betts* v. *De Vitre*, L. R., 3 Ch. App. Cas. 429.

(*l*) Ibid.

(*m*) *Denley* v. *Blore*, 38 Lond. Jour. 224.

(*n*) *Caldwell* v. *Vanvlissengen*, 9 Hare, 415.

(*o*) *Gibson* v. *Brand*, 11 L. J., C. P. 177.

CHAPTER XII.

THE CAUSE OF ACTION—INFRINGEMENT.

THE infringement of a patent is the doing that which the patent prohibits from being done (*a*). The words of the Royal Command are as follows: "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, &c."

There is no duty cast upon a patentee to inform persons that what they are doing amounts to an infringement of his patent, and he is not estopped by omitting to give such information, although he knew of the infringement, from subsequently bringing his action (*b*).

The **question of infringement** or no infringement is one of fact, and therefore **is for the jury** (*c*). But this refers to the mere infringement alone within the meaning of

(*a*) *Walton* v. *Bateman*, 1 Web. P. C. 613.

(*b*) *Proctor* v. *Bennis*, 36 Ch. D. 740.

(*c*) *Walton* v. *Potter*, 1 Web. P. C. 585; *De la Rue* v. *Dickenson*, 7 E. & B. 738.

Tindal, C. J., in *Muntz* v. *Foster* (*d*), when he told the jury that "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff."

If the patent is invalid there can be no infringement in the sense that a patent which has no legal existence cannot be infringed. But assuming that it has a legal existence, the question is for the jury. This explains the apparently contradictory decision in *Curtis* v. *Platt* (*e*) in the House of Lords. The question of infringement was there taken as involving the validity of the patent.

It is equally an infringement whether the defendant acted in **ignorance** of the plaintiff's patent or not. In *Heath* v. *Unwin* (*f*), Parke, B., delivering the judgment of the Court, said:—"There was therefore no intention to imitate the patentee's invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all." This judgment certainly gives an erroneous impression of the law, and Shadwell, V.-C., when the same case came before him (*g*), said:—"The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury) he is answerable for the consequences." In *Stevens* v. *Keating* (*h*) the Lord Chancellor disapproved of the case in the Court of Exchequer; "and I must decline to act upon the principle which it lays down."

Subsequently, when *Heath* v. *Unwin* came before the House of Lords, the opinion of the judges being taken,

(*d*) 2 Web. P. C. 99.
(*e*) L. R. 1 H. L. 337; 35 L. J., Ch. 852.
(*f*) 14 L. J., Ex. at p. 156.
(*g*) 15 Sim. 553.
(*h*) 1 Mac. & G. 659.

Parke, B. (*i*), acknowledged the error into which the Court had fallen, and approved of *Stevens* v. *Keating*.

In *Stead* v. *Anderson* (*k*), Wilde, C.J., tersely puts it:—"The question of infringement depends not on what the defendant intends, but on what he does."

So it is **immaterial whether the defendant was aware** that the thing was patented or not, since in law every person in the realm is taken to have notice of a patent in the same way that he is taken to be aware of the law (*l*).

And the converse is also sound—if a person intending to infringe a patent does not in fact do so, he will not be taken to have infringed (*m*).

In *M'Cormick* v. *Gray* (*n*) the specification, after describing several parts of reaping machines, including some cutting blades of peculiar construction, claimed: "The construction of reaping machines according to the improvements before described—that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels, respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed."

The defendant made and sold cutting blades similar to those described by the plaintiff's patent, which were *capable of being used* in the plaintiff's reaping machine. Bramwell, B., in giving judgment, said:—"A man could not make the blade of a knife without infringing this person's patent, because you may intend to put it into a machine, or you may not. I think it is a very clear case, and I am satisfied there is no difference between making a thing with one

(*i*) 25 L. J., C. P. at p. 19; 5 H. L. Cas. 505.

(*k*) 2 Web. P. C. 156.

(*l*) *Walton* v. *Lavater*, 29 L. J., C. P. 275; *Curtis* v. *Platt*, 11 L. T., N. S. 245.

(*m*) *Newall* v. *Elliott*, 10 Jur., N. S. 954.

(*n*) 31 L. J., Ex. 42.

intent and making it with another, because I always understood, that if a man may do a thing, he may do it with whatever intent he pleases." It will be observed, that in this case, to make the knives was no infringement, and there was no evidence of the defendant having applied them to reaping machines (*o*).

Thus we see that infringement, as taken apart from the question of validity, is a matter of fact, and that intention is not material to the conclusion.

To prove infringement, it must be shown that there is **a substantial resemblance** (*p*). The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification (*q*).

A patented article sold by a patentee carries with it the right of being used and sold anywhere (*r*).

It is impossible to surmise how the Courts will deal with sect. 36 of the Act of 1883, which enables a patentee to assign his patent for any place or part of the kingdom as effectually as if the patent were originally granted to extend to that place or part only.

Supposing a patentee to assign a patent for making brushes for London to A, and for Liverpool to B. Will the purchaser of brushes from A in London be infringing the rights of B by using the brushes in Liverpool, and will he be liable to an action? If he is not liable to be sued, of what use is the right of assignment for a part only, since the assignee, for one place, could make the brushes in that place, and sell them universally to the detriment of assignees for other places.

The amount of prior user which will be sufficient to invalidate a patent, differs considerably from the amount **of user** which will be held to infringe a patent: "these

(*o*) See, however, *Bancroft* v. *Warden*, Romilly's Notes of Cases, 103.

(*p*) *Stead* v. *Anderson*, 2 Web. P. C. 151.

(*q*) *Croll* v. *Edge*, 19 L. J., C. P. at p. 264.

(*r*) *Betts* v. *Willmott*, L. R., 6 Ch. App. Cas. 239.

are different questions, depending on wholly different considerations, the one upon the extent of previous knowledge, the other upon the effect of the grant" (*s*).

In *Barlow* v. *Baylis* (*t*) the patent was for "improvements in manufacturing metal nuts, and in machinery for stamping, forging and rolling the same." Action for infringement; defence anticipated by Berry. It was contended by the plaintiff that Berry's machine would not work. Brett, J., in summing up to the jury, said:—"Now the first question about Berry's machine which I will ask you is this: Was Berry's ever a machine or invention in this sense, that a workman could, from his specification and drawings, make the machine described by him so that it would, more or less badly, do the work required of it? because, in my opinion, if it would not, I do not say perfectly, but if it would not do the work required 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 it from being a machine."

The jury found that Berry's machine would not do the work more or less badly. Judgment for plaintiffs. Judgment upheld by the Court of Common Pleas.

In *Brereton* v. *Richardson* (*u*), infringement of a patent for "a new and improved tricycle," alleged prior user by Jackson and his family; reply that this was merely an experimental user. Field, J., said:—"Their driving to Cheam, Worcester Park, and Malden, going about on business night and day, and for pleasure; and the public notoriety which the thing had excited in the neighbourhood, so that it was called 'Jackson's patent threshing machine,' all

(*s*) Per Turner, V.-C., in *Caldwell* v. *Vanvlissengen*, 9 Hare, 428; *Newton* v. *Grand Junction Rail. Co.*, 5 Ex. 331.

(*t*) Griffin P. C. at p. 44.

(*u*) 1 P. O. R. 166.

satisfy me that, provided I am right in holding that the thing was substantially the same, it was publicly used. A question of difficulty occurred to my mind as to what degree of public user is enough when you have to deal with a thing like that. I quite understand that if there were at this moment an axle running under an omnibus which I could not see, it might or might not be a public user. I think it would be a public user." Action dismissed with costs.

We have seen that by sect. 33 of the Act of 1883, a patent may still contain more than one claim, and in such a case, provided every claim which is made is valid, a patent may be infringed by infringing any one claim. In *Gillett* v. *Wilby* (*x*), Coltman, J., said :—" If they are all new (the parts claimed), and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." In *Newton* v. *The Grand Junction Rail. Co.* (*y*), Pollock, C.B., said :—" But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies ; and if he has used that part for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement," and in *Sellers* v. *Dickenson* (*z*), the same judge said :—" There may be an **infringement by using so much of a combination as is material** . . . if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent."

" Where a patent is for a combination of two, three,

(*x*) 9 Car. & P. 336. (*y*) 5 Ex. 331.

(*z*) 5 Ex. 324.

or more old inventions, a user of any of them would not be an infringement of the patent; but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent" (*a*).

Speaking of this case in *Clark* v. *Adie* (*b*), James, L.J., said:—"Upon the authority of *Smith* v. *L. & N. W. Railway Co.*, it has been strongly contended before us that whenever there is a patent for a combination, that patent gives protection, not indeed to every distinct thing that enters into the combination, but to every combination, arrangement and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification. This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority, short of the House of Lords, in applying such a doctrine. If a patent for a combination of several parts is in reality a patent, and gives really a monopoly for every combination of any two or more of those parts, then it follows, from the very first principle of patent law, that if any conceivable combination of any two or more parts was old, the patent would be bad. On the other hand, if the patentees say, 'No, we do not claim to protect every combination of those parts, but only those subordinate combinations, or parts of the combination, which are new and useful,' then such a claim would be entirely inconsistent with the leading case of *Foxwell* v. *Bostock* (*c*), which, we may be permitted to say, is as good sense as it is sound and intelligible law . . . I will state what we conceive to be the real principle which

(*a*) Per Campbell, C. J., in *Smith* v. *L. & N. W. Rail. Co.*, 2 E. & B. 76; *The Patent Bottle Envelope Co.* v. *Seymer*, 5 C. B., N. S. 172.

(*b*) L. R., 10 Ch. App. Cas. 674.

(*c*) 12 W. R. 723. See also *Harrison* v. *Anderston Foundry Co.*, pp. 98—99, *supra*.

underlies the case of *Lister* v. *Leather* (*d*), and which reconciles it with the other cases, and with general principles, and common sense. A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact every, or almost every patent, is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or **substance of the invention** underlying the mere accident of form, and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact, whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination."

In *Nordenfelt* v. *Gardner* (*e*), Brett, M.R., said:—"The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement, or it may have that combination with some alteration. The alteration of a combination as it seems to me may be by addition or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same; and in any case, notwithstanding such colourable alteration, there may be an infringement. An *alteration by addition* may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by showing distinctly what the addition is so as to show what the improvement is. An *alteration by subtraction*, if it were

(*d*) 8 E. & B. 1004. (*e*) 1 P. O. R. 65.

more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things, it would be a combination of different things; and if the combination were altered by a material subtraction, I should think that it was a new combination. But an *alteration by substitution*, that is, by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and a putting in of a new material element which is different from any of the elements of the former."

Where, however, the **application** by the defendant of a portion of the invention of the plaintiff is **for a different object**, and with a view of carrying out a principle totally newly discovered by the defendant, and which was unknown to the plaintiff, there is no infringement, although at first sight there appears to be some similarity of process (*f*).

We have seen that sect. 5, sub-sect. 5, provides that a complete specification must conclude with a distinct statement of the invention claimed; so that, if the invention be a combination, it must be so stated; if for parts, they must be claimed. There is no **infringement** if the defendant cannot be shown to have infringed, directly or indirectly, **a part or parts of the claim** (*g*). In *Lister* v. *Leather* (*h*) it was held that a valid patent for an entire combination, or for a process, gives protection to every part that is new and material, for the purpose of effecting that particular combination or process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. In future, if any parts are

(*f*) *Newton* v. *Vaucher*, 6 Ex. 859. See also *Morewood* v. *Tupper*, 3 C. L. Rep. 718.

(*g*) *Jackson* v. *Wolstenhulmes*, Griffin P. C. 134.

(*h*) 8 E. & B. 1004.

desired to be protected, as well as the combination or process, the claim will have to be so drawn as to include those parts.

The jury will always have to consider whether the infringing machine process or combination is a **substantial imitation** (*i*). No fine lines can be drawn as to what amounts to substantial imitation. In *Clarke* v. *Adie* (*k*), in the House of Lords, Lord Blackburn said :—"I incline to agree with what was said in the Exchequer Chamber in the case of *Lister* v. *Leather* (*l*), that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B, and C is or is not using part of that invention, nor can you decide in the abstract the other question, which was somewhat discussed in the case of the sewing machine (*Foxwell* v. *Bostock*) (*m*), whether or no the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister* v. *Leather*, before deciding it, to have before me the nature of the machine, in order that I may see what A, B, and C are, and what is their relation to each other."

In *Parkes* v. *Stevens* (*n*), James, V.-C., said :—"The authority of that case (*Lister* v. *Leather*) has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination . . . the judgment if read well will be found to give no warrant whatever for such, I must call it, baseless notion. The law is summed up thus. The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is

(*i*) *Thomas* v. *Foxwell*, 5 Jur. N. S. 39.

(*k*) L. R., 2 App. Cas. 335.

(*l*) 8 E. & B. 1004.

(*m*) 12 W. R. 723.

(*n*) L. R., 8 Eq. 358.

new and material *for that process*, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention ; and the question in every case is a question of fact—is it really and **substantially a part of the invention** " (*o*). This judgment was affirmed on appeal (*p*).

If a man in the course of producing an improved combination substantially uses a combination which already forms the subject of a patent he thereby infringes the patent, notwithstanding that the combination he is making has a different end in view than that which has been patented (*q*).

But, on the other hand, where a patent is for a combination a person who takes a new and material part of the combination, but **not for a similar or analogous purpose** to that to which it was applied in the patent, does not infringe the patent (*r*).

If the invention be for a combination or process whereby an already well-known object is produced, it will be no infringement to make **another combination**, even **of the same materials** (provided they be also old and well-known), for the purpose of attaining the same object, for the patent is for the *means* of attaining the object, and if other means are employed there is no infringement. The patent is also for the *method* of combining the old and well-known materials, and if **another method** is adopted there is no infringement (*s*).

When the defendant has set himself to work to **evade the plaintiff's patent** by fraudulently making a colourable

(*o*) See also *Wright* v. *Hitchcock*, L. R., 5 Ex. 37 ; on the other side *White* v. *Fenn*, 15 W. R. 348.

(*p*) 5 Ch. Ap. Cas. 36.

(*q*) Per Lord Westbury in *Cannington* v. *Nuttall*, L. R., 5 H. L. at p. 230.

(*r*) *Lister* v. *Eastwood*, 9 L. T., N. S. 766.

(*s*) *Curtis* v. *Platt*, in the House of Lords, 35 L. J., Ch. 852 ; L. R., 1 H. L. 337.

imitation, or substituting a mechanical or chemical equivalent, the cases show that the Courts will look strictly at what he has done, and will take care that he does not overstep the line which he is endeavouring to keep within.

The question of fraudulent evasion is, as we have shown, one of fact. "A slight departure from the specification, for the purpose of evasion only, would, of course, be a fraud upon the patent; and therefore the question will be, whether the mode of working by the defendant has or has not been essentially or substantially different" (*t*).

In *Dudgeon* v. *Thompson* (*u*) Lord Cairns makes strong objection to the use of the term **colourable imitation**, in connection with the infringement of patents, and proceeds:—"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that the whole of it may be said, as is said in this injunction, Here is a machine, which is either the plaintiff's machine, or differs from it only colourably. But underlying all that there must be a taking of the invention of the plaintiff. There used to be a theory in this country, that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know 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. My lords, 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

(*t*) Per Dallas, J., in *Hill* v. *Thompson*, 1 Web. P. C. 242.
(*u*) L. R., 3 App. Cas. at p. 43.

must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

Summing up the cases, therefore, we come to this. Strictly speaking, there is no such thing as a colourable imitation: either the defendant has infringed the thing specified or he has not. At the same time there is an essence or substance to every invention underlying the mere accident of form or words. If the defendant has imitated and adopted the **essence of the invention** he will not be allowed to escape because he has not adopted the form or words in which the essence of the invention is clothed (*x*).

There is a description of imitation which is produced by the substitution of **chemical or mechanical equivalents.** To the unscientific eye there is a total dissimilarity between the infringing machine or process and the original; but, none the less, it is a mere imitation—it is a robbery of the ideas and intentions of the first inventor, but a robbery conducted in a scientific manner.

We have seen that a patent cannot be granted for the

(*x*) *Thorn* v. *The Worthing Skating Rink Co.*, L. R., 6 Ch. D. 415; *Flower* v. *Lloyd*, W. N. 1877, p. 132; *Barrett* v. *Vernon*, 45 L. T. (N. S.) 755; *Bailey* v. *Roberton*, L. R., 3 App. Cas. 1055. And the older cases, *Bovill* v. *Moore*, Dav. P. C. 405; *Forsyth* v. *Riviere*, 1 Web. P. C. 97; *R.* v. *Lister*, Web. P. L. 80; *Minter* v. *Wells*, 1 Web. P. C. 130; *Morgan* v. *Seaward*, per Alderson, B., 1 Web. P. C. 171; *Walton* v. *Potter*, 1 Web. P. C. 586; *Neilson* v. *Harford*, 1 Web. P. C. 310; *Walton* v. *Bateman*, per Cresswell, J., 1 Web. P. C. 616; *Muntz* v. *Foster*, per Tindal, C. J., 2 Web. P. C. 101; *Russell* v. *Ledsam*, 14 M. & W. 580; *Gamble* v. *Kurtz*, 3 C. B. 425; *Stead* v *Anderson*, 2 Web. P. C. 156; *Unwin* v. *Heath*, 25 L. J., C. P. 8; *Curtis* v. *Platt*, 35 L. J., Ch. 852; *Murray* v. *Clayton*, L. R., 7 Ch. App. Ca. 585.

discovery of a mere principle (*y*), but that, if the principle when discovered is at the same time applied, a valid grant may be made for the application of the principle. The essence of the patent is the fact of applying the newly-discovered principle to a particular end. Now a mechanical or chemical **equivalent is another method** of producing the same result, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity of any inventive power whatever. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent is taken out which consists of three parts. An equivalent may be substituted for each part, so that in effect the whole invention may be changed and yet there may be a most flagrant infringement.

Take, for instance, the case of *Stevens* v. *Keating* (*z*). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime) by admixing it with pearlash (carbonate of potash) and sulphuric acid. Chemically, the effect was this: Sulphate of potash was produced; this, combined with the sulphate of lime, produced a double salt, which, when submitted to a high temperature and subsequently ground to a fine powder, constituted the cement. The principle of this discovery was that sulphate of lime combined with salts of potash or soda, and when so combined, produced a substance which set very hard. The defendant substituted for the pearlash and sulphuric acid a chemical equivalent, borate of soda (borax), and heated that with gypsum, producing in the same manner a double salt, and with the same resulting property of setting. This was properly held to be an infringement.

"Equivalents which are not known at the time of the patent as equivalents and afterwards are found to answer

(*y*) Ante, p. 23.

(*z*) 2 Web. P. C. 181.

the same purpose, are not included in the specification. They are new inventions." Per Baron Parke (*a*).

In *Russell* v. *Cowley* (*b*) the invention claimed was that of bringing to a welding heat a long piece of iron of the proper quality; after having turned up its edges and drawing it through a hole of the proper size of the intended tube, so as to compress together the edges and give it a complete circular form. The defendants turned up the skelp, and, after heating it in the furnace, passed it through two rollers with grooves:—Held, that the two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed under the patent (*c*).

In *Curtis* v. *Platt* (*d*), Wood, V.-C., said:—"Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machine for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because otherwise that would be to say that the whole world is to be precluded from achieving some desirable and well known object which everybody

(*a*) *Unwin* v. *Heath*, 2 Web. Pat. Cases, 314.

(*b*) 1 Web. P. C. 463.

(*c*) See also *Jupe* v. *Pratt*, 1 Web. P. C. 146; *The Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; *Hancock* v. *Moulton*, Johnson's Patentees' Annual, 3rd ed. 208; *Bateman* v. *Gray*, Mac. P. C. 102; *Simpson* v. *Holliday*, 20 Newton's Lond. Journ. (N. S.) 111; *United Telephone Co.* v. *Harrison, Cox, Walker & Co.*, L. R., 21 Ch. D. 720.

(*d*) L. R., 3 Ch. D. 136 (note).

has had in view for years. In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object."

There are three ways in which a patent may be infringed :—

1. By making the patented article or working the process.
2. By using.
3. By selling.

BY MAKING.

A person may infringe a patent by making the article himself, or by his agent, or by his servants. The agent and servants, it is true, will be considered as equally infringing the patent, and actions may be brought against them individually, but that in no way absolves the person who employs them for that purpose. In *Sykes* v. *Howarth* (*e*) a patent consisted of the application of cards or strips of leather covered with wire or rollers at "wide distances." A person who contracted to clothe rollers and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only and did not include the nailer's work. In giving judgment, Fry, J., said :—"I have come to the conclusion that the nailer must be deemed to have been the agent, for the purpose of nailing on, of the defendant . . . . . there is a contract to clothe in the manner prescribed by the particulars given to the defendant, and that contract was carried into effect by a person paid by the defendant—the defendant himself receiving the total

(*e*) L. R., 12 Ch. D. 826.

amount for which he contracted. The consequence is that in my judgment all the defences fail."

We have seen that **it is an infringement to colourably imitate an invention.** It is no infringement to make, use, or vend the elements which afterwards enter into the combination. In *Townsend* v. *Haworth* (*f*), Jessel, M. R., said:—"The chief of these chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser coming to him says, 'I want your compound because I want to preserve my cloth from mildew. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer, because he knows that the purchaser intends to make use of it for that purpose."

The working and making must be by way of using the invention, as distinguished from **experimenting** with it, so as to operate as an infringement. In *Higgs* v. *Godwin* (*g*) the patent was for obtaining a commercially saleable manure by treating sewage with slaked lime. The defendant used the process by way of experiment to purify

(*f*) L. R., 12 Ch. D. 831, note.

(*g*) E. B. & E. 529. See also *Jones* v. *Pearce*, 1 Web. P. C. 122, and *Muntz* v. *Foster*, 2 Web. P. C. 93 and 96; *Holmes* v. *L. & N. W. R. Co.*, 12 C. B. 831; *Nobel's Explosives Co.* v. *Jones*, 8 App. Cases at pp. 10 and 13; *Von Heyden* v. *Newstadt*, 14 Ch. D. 230; *Betts* v. *Nielson*, 6 N. R. 221; *Wright* v. *Hitchcock*, L. R., 5 Ex. 37; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826.

water—Held no infringement. In *Frearson* v. *Loe* (*h*), Jessel, M. R., adverting to this branch of the subject, said:—"The other point raised was a curious one and by no means free from difficulty, and what occurred with regard to that was this: that the defendant at various times made screw blanks, as he said, not in all more than 2 lbs., by various contrivances, by which no doubt screw blanks were made; according to the plaintiff's patent of 1870, as well as that of 1875, they seem to have been an infringement of both. He said he did this merely by way of experiment, and no doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment and not for a fraudulent purpose ought not to be considered within the meaning of the prohibition, and if it were, it is certainly not the subject for an injunction."

To purchase infringing articles for the purpose of instructing pupils and to enable them to pull them to pieces and put them together again, is not mere experimental user and amounts to infringement (*i*).

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions sometimes arose as to whether persons acting in the **service of the Crown** might manufacture a patented article or use a patented process.

(*h*) L. R., 9 Ch. D. 48.
(*i*) *United Telephone Co.* v. *Sharples*, 29 Ch. D. 164.

When the persons using the invention were servants of the Crown, and acting in pursuance of their duty as servants, they were protected; but if they were contractors contracting with the Crown they were not protected, but stood in exactly the same position as other subjects (*k*).

Sect. 27 of the Act of 1883 provides that a patent should bind the Crown, but that the Crown may use the invention "by agents or *contractors*" on terms to be before or after the use agreed upon.

BY USING.

It frequently occurs that very fine questions arise as to what constitutes **using** a patented invention. The general rule may be thus stated: That if the defendant has put the invention to the purpose for which it was intended he has used it in this country. In the case of *Nielson* v. *Betts* (*l*), in the House of Lords, the facts were as follows: Betts, the plaintiff in the suit, was the patentee of an invention for the manufacture of capsules for the purpose of covering bottles of liquid (wine, beer, or otherwise), and protecting them from the action of the atmosphere. Betts' patent did not extend to Scotland. Nielson and his co-appellants, defendants in the suit, were persons who bottled beer in Glasgow for the Indian market. They bottled the beer and covered it with capsules, which were made in Germany in pursuance of Betts' specification. The beer was shipped by the appellants in vessels which called at Liverpool to complete their cargoes; on some occasions the beer was transhipped in England, but no cases of beer were opened, nor was any of the beer sold in this country. Held, by the House of Lords, that, inasmuch as the object of Betts'

(*k*) *Dixon* v. *The London Small Arms Co.*, L. R., 10 Q. B. 130, and L. R., 1 App. Cas. 632, reversing decision of Court of Appeal, L. R., 1 Q. B. D. 384; also *Feather* v. *R.*, 6 B. & S. 257.

(*l*) L. R., 5 H. L. 1.

invention was to make a capsule that would preserve the beer, whilst the beer was in England it was being preserved by the use of Betts' invention, and consequently that there was an infringement of the patent. Lord Chelmsford, in giving judgment in the Court below, said:—"It is the employment of the machine or article for the purpose for which it was designed which constitutes its active use, and whether the capsules were intended for ornament or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent to England, and had been afterwards sold here, there can be no doubt, I suppose, that this would have been an infringement, because it would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer."

The case of *Nobel's Explosives Co.* v. *Jones, Scott & Co.*(*m*), is instructive upon the question of user. The subject of the plaintiff's patent, dynamite, is a mechanical compound of nitro-glycerine and infusorial earth. The compounding of nitro-glycerine in this manner is done for and effects the purpose of rendering it less liable to explosion from concussion. The object of the patent was, therefore, to enable nitro-glycerine to be kept and handled with safety. Held, by Bacon, V.-C., that the mere storage of dynamite made abroad, and only landed in this country for the purpose of transhipment, amounted to an infringement of the plaintiff's patent. This decision was reversed in the Court of Appeal, but upon another point, to be mentioned presently, and without in any manner impugning the correctness of the Vice-Chancellor's decision on this question.

(*m*) L. R., 17 Ch. D. 721. See also *The Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 689.

In the case of *Caldwell* v. *Vanvlissengen* (*n*), it was held by Turner, V.-C., that **foreign ships coming into British ports,** fitted with screw propellers, which were made in pursuance of the specification of an English patent, thereby infringed the patent. If the injunction which was granted be carefully read, it will be found to amount to a restraint from propelling the vessels with the propellers, not from having the ships merely fitted with them. Legally speaking, the user of propellers differs from that of capsules or dynamite in this important respect, that the one is in use only when in motion; the others are at use, the one when merely affixed to the bottles, and the other when merely in possession. Subject to the applicability of the arguments adduced in the case of dynamite, it is submitted that **mere possession,** unaccompanied with user, does not constitute an infringement of letters patent, unless the possession is of such a character as to import **a threat to use.** But in *The United Telephone Co.* v. *The London Globe Telephone Co.* (*o*), Bacon, V.-C., said: "That the defendants are in possession of instruments made in infringement of the plaintiff's patent is confessed by them and placed beyond the possibility of question, and that of itself gives to the plaintiffs a right to ask for an injunction to restrain the defendants from making use of that which by their own confession is an unlawful possession, and would be, if used, I presume, an unlawful use . . . . the defendants excuse themselves . . . . next on the ground that it is not their intention to use them. If it is not their intention to use the instruments, then the injunction asked for can do them no harm. That would not be enough to dispose of the case, but it is the right of the plaintiffs to have an injunction against the defendants who have the means to the extent of 800 machines of injuring their patent rights."

(*n*) 21 L. J., Ch. 97.

(*o*) 26 Ch. D. 766.

In the case of *Adair* v. *Young* (*p*), certain pumps, which were an infringement of the plaintiff's patent, were fitted on board a British ship. There was no evidence of their having been used. Held, by the Court of Appeal, that there had been no infringement, but as there was **evidence of an intention to use** the pumps, an injunction would be granted against the use of the pumps.

Sect. 43 of the Act of 1883 provides:—"(1) *A patent shall not prevent the use of an invention for the* **purposes of the navigation of a foreign vessel** *within the jurisdiction of any of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.* (2) *But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges, for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.*"

A patent is not infringed by being used on board an English vessel abroad (*q*).

In the case of *Nobel's Explosives Co.* v. *Jones & Scott* (*r*), mentioned above, the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiff's patent, they having merely acted as Custom House agents for the transhipment of the dynamite, and their functions being confined to

(*p*) L. R., 12 Ch. D. 13.
(*q*) *Newall* v. *Elliott*, 10 Jur., N. S. 954.
(*r*) 17 Ch. D. 721.

obtaining papers necessary for such transhipment, and that they never had any ownership in or exercised any control over the dynamite.

This decision shows that the Courts will not recognize that a person infringes a patent by **aiding and abetting,** so to speak, another to do so. There must be some actual infringement on the part of the defendant (*s*).

SELLING.

A person infringes letters patent who sells the patented article within this realm. It is a putting in practice of the invention within the terms of the grant.

Lending is not selling (*t*).

The **purchase** of the patented article is not of itself an infringement of the patent, nor is the **mere possession,** since these do not come within the prohibition in the grant, which is against making use of, or putting in practice, the said invention (*u*).

This is always with exceptions such as in the case of dynamite, where the mere possession involves *ex necessitate* the use ; and the **importation** of the patented article will not of itself amount to an infringement.

The possession of the patented article, combined with **exposure for sale,** if no sale is in fact effected, is no infringement (*x*).

But the making of the patented article, as we have seen, is an infringement, whether a sale was effected, or attempted or not (*y*).

Where the patent is for a process the manufacture of an article by the process abroad and sale in this country

(*s*) See also *Townsend* v. *Haworth*, L. R., 12 Ch. D. 831 ; *Sykes* v. *Howarth*, 12 Ch. D. 826.

(*t*) *United Telephone Co.* v. *Henry*, Griffin, P. C. 228.

(*u*) See *Minter* v. *Williams*, 1 Web. P. C. 135.

(*x*) Ibid.

(*y*) *Muntz* v. *Foster*, 2 Web. P. C. 101 ; *Oxley* v. *Holden*, 8 C. B. (N. S.) 666.

is an infringement. In *Elmslie* v. *Boursier* (*z*), Sir W. M. James, V.-C., said :—"It is said that tinfoil can be made by the plaintiff's process at less cost than by the old method ; and it is conceded that nobody in England can use the plaintiff's process of making cast tinfoil as distinguished from rolled tinfoil without a license from the plaintiff. If that cannot be done in England it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted 'the whole profit, benefit, commodity, and advantage' arising from the patent. It would be a short mode of destroying 'every profit, benefit, commodity, and advantage' which a patentee could have from such a thing, if all that the man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee."

In *Walton* v. *Lavater* (*a*) Erle, C. J., said :—"But it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article ; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented or of the infringement, it would be sufficient evidence of infringement that the defendant had imported and *sold*" (*b*).

(*z*) L. R., 9 Eq. at p. 222.
(*a*) 29 L. J., C. P. 275.
(*b*) See also *Wright* v. *Hitchcock*, L. R., 5 Ex. 37 ; 39 L. J., Ex. 97.

Selling known chemical substances with knowledge of and with a view to their being used for the purpose of infringing a patent is no offence, provided the vendor takes no actual personal part in the infringement (*c*).

A patentee selling the patented article sells with it the right of free disposition as to that article, and if he sells the article in France, the purchaser may import and sell it in England. Lord Hatherley, in *Betts* v. *Willmott* (*d*), said:—"Inasmuch as he has the right of vending the goods in France, or Belgium, or England, or in any other quarter of the globe, he transfers with the goods necessarily the license to use them wherever the purchaser pleases. When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his license to sell the article, or to use it wherever he pleases *as against himself*."

Where the defendants were owners of patents in Belgium and England for an invention for making glass lamp globes by a deed executed in Belgium, granted a license to the plaintiffs to manufacture under their invention in Belgium but not elsewhere. The plaintiffs under this license having manufactured articles in Belgium and sold them in England, it was held by the Court of Appeal, affirming Pearson, J., that the grant of the license to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (*e*).

And when the patentee has assigned his patent in France and kept it to himself in England, the French assignee may not, nor may a purchaser from him import and

(*c*) *Townsend* v. *Haworth*, L. R., 12 Ch. D. 831; *Sykes* v. *Howarth*, L. R., 12 Ch. D. 826.

(*d*) L. R., 6 Ch. App. Cas. at p. 245.

(*e*) *Société Anonyme des Manufactures de Glaces* v. *Tielghman's Patent Sand Blast Co.*, 25 Ch. D. 1.

vend or use the goods made in France in England (*f*). In this case the sale of the article can only imply such license as the vendor himself has, and the vendor has no right to sell in England.

Conversely, if the patentee had assigned his patent rights in England, he could not manufacture in France and sell in England, and the sale of an article in France would carry with it no implied right to import into or sell in England. But if the rights under the patent are vested in one and the same person for both France and England, or if there are no monopoly rights in France but only in England, the patentee could make and sell in France and could not restrain the purchaser from selling or using the article in England, unless indeed there was a special agreement for that purpose; and then such agreement could not be held to attach to the article so as to prevent any person in whose hands it might come from importing it (*g*).

(*f*) See the rule laid down in *Caldwell* v. *Vanvlissengen*, 9 Hare, 415.

(*g*) *Betts* v. *Willmott*, 6 Ch. App. Cas. 239.

CHAPTER XIII.

THE REMEDY—INJUNCTION.

THE remedy sought or granted in an action for infringement may consist of an injunction, together with an account of sales and profits, or damages.

The judicature acts and the rules which have been made for the governing of the practice of the courts have introduced great changes in the method of procedure. The old practice of moving for an injunction by a suit in the Court of Chancery, and of trying the validity of the patent at common law has disappeared; and in its place the patentee seeking to enforce his rights commences but **one action in which he claims, and if entitled to, obtains every remedy** which was formerly granted to him by the dual process.

Every patentee proceeding against an infringer must prove the validity of his patent and his title to an injunction; that being so, and the right to the injunction hanging so completely upon the question of validity, it is obvious that the new procedure and the new power of both divisions of the High Court of Justice to grant complete and sufficient remedies and to try every question is of great advantage to persons in possession of patent rights.

There are two forms of injunction, the interlocutory injunction and the perpetual injunction.

The interlocutory injunction stands very much upon the same footing, and will be granted for similar reasons

and upon the same conditions that an injunction was formerly awarded by the Court of Chancery when an action was directed to be tried at common law.

The perpetual injunction is granted after trial, and binds the parties against whom it is granted during the continuation of the term of the patent.

An interlocutory injunction will be granted whenever there has been such **working, user and enjoyment** of the patent rights by the patentee as will satisfy the Court that there are strong *prima facie* reasons for acting on the supposition that the patent is valid.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge* v. *Richardson* (*a*), said:—"It is then said in cases of this sort the universal rule is that if the title is not clear at law the Court will not grant or sustain an injunction until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent and puts his invention in execution and has proceeded to a sale, that may be called possession under it; however doubtful it may be whether the patent can be sustained, this Court has lately said **possession under a colour of title** is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only colour and not real title."

And in *Gardner* v. *Broadbent* (*b*) Sir J. Stuart, V.-C., said:—"I wish it to be understood that the law of the Court is that laid down by Lord Eldon in the *Universities of Oxford and Cambridge* v. *Richardson*."

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be

(*a*) 6 Ves. 689.

(*b*) 2 Jur., N. S., 1041.

considered by the Court sufficient reason for granting an interlocutory injunction.

Where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory injunction will be granted. In *Dudgeon* v. *Thompson* (*c*) Jessel, M. R., said :—"The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

So in *Betts* v. *Menzies* (*d*), Wood, V.-C., said :—"The law of this Court is, that where the patentee has had long enjoyment, then he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful." On the other hand, we find Lord Westbury laying it down in *Hills* v. *Evans* (*e*) :—"It is the habit and the rule of the Court not to grant that injunction (to restrain infringement), at all events until the hearing, and **not to make it perpetual unless the legal validity** of the patent has been **conclusively established.**"

Sometimes an application for an interim injunction is advisable where there has not been long user of the patent, or a decision in favour of the patentee. In such cases the plaintiff must be prepared to give *primâ facie* satisfactory evidence of the validity of his patent (*f*).

These decisions certainly appear contradictory, but

(*c*) 30 L. T. R., N. S. 244; P. C. 95.

also *Russell* v. *Cowley*, 2 Coop. C. C. 59 (n.); but see *Crosskill* v. *Evory*, 10 L. T. 459.

(*d*) 3 Jur., N. S. at p. 358. See also *Davenport* v. *Goldberg*, 2 H. & M. 282; *Penn* v. *Bibby*, 3 L. J., Eq. 308; *Muntz* v. *Foster*, 2 Web.

(*e*) 4 De G., F. & J. at p. 289.

(*f*) *Gardner* v. *Broadbent*, 2 Jur., N. S. 1041; *Davenport* v. *Jepson*, 1 N. R. 173; *Renard* v. *Levinstein*, 10 L. T., N. S. 177; and cases quoted at pp. 218—220, infra.

perhaps this principle may be gleaned from them—that the Court will consider the **balance of convenience** in each particular case. If it should appear that irremediable injury will be sustained by the defendant if an injunction goes which may afterwards appear unfounded, the Court will require a very strong case to be made out by the plaintiff before granting such an injunction (*g*), and the converse would equally appear.

In *Bickford* v. *Skewes* (*h*), Shadwell, V.-C., said:—"I have nothing to do with any other case than the case before me."

The Court will not infrequently **grant or refuse** the **injunction** until the hearing **upon terms**; the terms on the plaintiff being that he shall be answerable in damages, or on the defendant that he shall keep an account of the material manufactured, or of the articles sold, in pursuance of the patent process. And in considering which course should be adopted the Court will be influenced chiefly by the balance of convenience and the probability of injury to either side (*i*).

In *Plimpton* v. *Spiller* (*k*), James, L. J., said:—"The Court, not forming an opinion very strongly either one way or the other whether there is an infringement or not, but considering it as a fairly open question to be determined at the hearing, and not to be prejudiced by any observations in the first instance, reserves the question of infringement as one which will have to be tried at the hearing and which it will then have to consider. There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo*—for that is really what the Court has to do, to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, 'We will not stop a going

(*g*) *Neilson* v. *Forman*, 2 Coop. 61 (n.).

(*h*) 1 Web. P. C. 213.

(*i*) *Neilson* v. *Thompson*, 1 Web. P. C. 278; *Bridson* v. *M'Alpine*, 8 Beav. 229.

(*k*) L. R., 4 Ch. D. 289.

trade. We will not adopt a course which will result in a very great difficulty in giving compensation on the one side or on the other. We have to deal with it as a practical question, in the best way we can.' I think, on the whole, that the Master of the Rolls has made the right order, viz., by granting the injunction and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make if he should ultimately turn out to be in the wrong, and that it would not be right in this case merely to put the defendant upon the terms of keeping an account which, I conceive, might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right." In the same case the present Master of the Rolls, Sir W. B. Brett, said :—"There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers."

Injunctions are now granted pursuant to the Judicature Act, 1873, sect. 25, sub-sect. 8 :—"A mandamus or an injunction may be granted, or a receiver appointed, by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made, either unconditionally or upon such terms and conditions as the Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any

cause or matter, to prevent any threatened or apprehended waste or trespass, such injunction may be granted, if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act sought to be restrained under any colour of title; and whether the estates claimed by both, or either of the parties, are legal or equitable."

It will be observed that this section confers upon the Court very wide limits within which, in its discretion, it may grant injunctions. It sweeps away a great deal of the technical rules which had been from time to time laid down by the Court of Chancery for the granting of injunctions, and it practically substitutes for them the opinion of the judge trying each particular action as to the balance of convenience upon a consideration of the facts of the case.

The basis of an injunction is the threat actual or implied on the part of the defendant, that he is about to do an act which is in violation of the plaintiff's rights; so that not only must it be clear that the plaintiff has rights, but also that the defendant has done something which induces the Court to believe that he is about to infringe those rights.

The fact that he has been guilty of an infringement of the patent rights will, under circumstances, be evidence that he intends to continue his infringement, but whether he has actually infringed the patent or not, it will be sufficient if he has **threatened to infringe it.** Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.

In *Frearson* v. *Loe* (*j*), Jessel, M. R., said :—"I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee, without

(*j*) L. R., 9 Ch. D. at p. 65.

infringement having been proved; but, in my opinion, on principle there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think for this reason: where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury, where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury, as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed, and about to be carried into execution, to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course it must be plain that what is threatened to be done is an infringement."

The actual infringement of the patent is taken by the Court to imply an intention to continue the infringement, notwithstanding any promises not to do so, and an injunction will be granted. Vice-Chancellor Shadwell, in *Losh* v. *Hague* (*k*), said:—"If a threat had been used, and the defendant **revokes the threat**, that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make not to do the same thing again."

(*k*) 1 Web. P. C. 200.

If the fact of actual infringement is relied upon, and not a mere threat, it will be necessary to show very clearly that what has been done amounts to an infringement. In *Hancock* v. *Moulton* (*l*), it was held that the evidence must be so perfect, that if it were a motion to commit for the breach of an injunction, the Court would commit upon it. If the evidence of infringement is conflicting, either by reason that it is denied that the acts complained of were done, or that such acts as were done did not amount to an infringement of the patent, the Court should not grant an interim injunction before the hearing of the action (*m*).

If the evidence relied upon for the injunction is the sale by the defendant of the patented article, and not the manufacture, the plaintiff must show that such patented article was not made by himself or his licensees (*n*).

In the case of *Adair* v. *Young* (*o*), the defendant was the captain of a ship which was fitted with certain pumps which were an infringement of the plaintiff's patent. No act of using the pumps was proved; but it was shown that the ship was not supplied with other pumps. It was held that the possession of the pumps under such circumstances, although not of itself amounting to an infringement, was evidence upon which the Court would act that the defendant intended to use the pumps, should occasion require. And the Court, Brett and Cotton, L. JJ., James, L. J., dissenting, granted an injunction.

Lord Justice James, in giving his reasons for dissenting, said:—"I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented. Now, a master who comes on board ought not to be answerable on the ground that, when

(*l*) M. Dig. 506.

(*m*) *The Electric Telegraph Co.* v. *Nott*, 2 Coop. 41.

(*n*) *Betts* v. *Willmott*, L. R., 6 Ch. App. Cas. 239.

(*o*) L. R., 12 Ch. D. 13.

he takes the command, there is on board a pump which infringes the patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of the ship; he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. An injunction, therefore, can only be granted on the principle of *quia timet*, and in applying that principle I think that it would be a right exercise of the discretion of the Court not to grant an injunction against a master who has done nothing wrong when there is no difficulty in finding and suing the owner of the ship."

The Court, however, seem to have been of opinion that the ground upon which an injunction should be granted is not whether the defendant has done anything wrong or not, but whether there was evidence of an intention to use the patented invention. The Court held that the circumstances of the case showed an intention in the captain to use the invention.

No injunction will be granted where the patentee has **not proceeded with reasonable speed** to prosecute infringers (*p*). But in cases where there are several infringers he is not justified in commencing a vast multitude of actions and applying for injunctions in each (*q*). His proper course is to "select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them; 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you will not object on the ground of delay, I do not mean to file bills against all of you at once.

(*p*) *Losh* v. *Hague*, 1 Web. P. C. 201; *Bacon* v. *Jones*, 4 My. & Cr. 438; *Bridson* v. *Benecke*, 12 Beav. 1.

(*q*) *Foxwell* v. *Webster*, 3 N. R. 103, at p. 180.

Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you.' I do not think any court could complain of a patentee for taking the course I am suggesting" (*r*).

Where machines have been manufactured or articles made in infringement of patent rights, an injunction will be granted to prevent their use or sale even after the patent has expired (*s*).

The injunction falls with the **expiration of the patent** (*t*).

After trial and judgment, and upon application for a perpetual injunction, when the nature of the infringing matter will permit of it, an order will be made that the articles (machinery or otherwise) **be delivered up to the plaintiff or destroyed** (*u*). This was done in *Plimpton* v. *Malcolmson* (supra); the reference to this cause is M.R., 28th Jan., 1876, B. 381. An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and that they be destroyed, *Betts* v. *De Vitre*, V.-C. W., 1865, A. 119. The defendant will also be ordered to make discovery upon oath of the articles or machinery which he may have in his possession, and which infringe the plaintiff's patent, so that they may be delivered up and destroyed; this was done in *Tangye* v. *Scott*, V.-C. W., 12th Feb., 1866, B. 461. **The right of property in the articles** which infringe the patent remains

(*r*) Per Sir W. Page-Wood, V.-C., *Bovill* v. *Crate*, L. R., 1 Eq. at p. 391. See also *Hancock* v. *Moulton*, M. Dig. 506; *Smith* v. *The London and South Western Rail. Co.*, Kay, 408.

(*s*) *Crossley* v. *Beverley*, 1 Web. P. C. 119; *Crossley* v. *The Derby Gas Light Co.*, 4 L. J., Ch. 25. See also *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727.

(*t*) *Daw* v. *Eley*, L. R., 3 Eq. 496.

(*u*) *Frearson* v. *Loe*, L. R., 9 Ch. D. at p. 67; but see *United Telephone Co.* v. *London & Globe Telephone Co.*, 26 Ch. D. at p. 776.

in the infringer, although the Court may order the articles to be destroyed (*x*).

These mandatory orders are never made except after trial, and when the plaintiff has fully established to the satisfaction of the Court the validity of his patent and the fact of the defendant's infringement.

An injunction having been granted to restrain the defendant from infringing a patent for the manufacture of telephones: It was held to be a breach of the injunction to sell the separate parts of the patented telephones which anyone might put together (*y*).

DAMAGES.

In addition to an injunction, the defendant may be entitled, when there has been actual infringement as distinguished from an intention to infringe, to either damages or an account of sales and profits.

He is **not entitled to both damages and an account,** but he must elect which he will take (*z*). An account of sales and profits amounts to a condonation of the infringement (*a*).

The **measure of damage** is the loss which the plaintiff has actually sustained, irrespective of the costs of the action. The question of damages is not synonymous with an account of profits, the basis of calculation being entirely different. In calculating damages, the Court will not take into account any **manufacturer's profit** which the plaintiff might have made (*b*). But it is submitted that considera-

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

(*y*) *United Telephone Co.* v. *Dale*, 25 Ch. D. 778.

(*z*) *De Vitre* v. *Betts*, L. R., 6 H. L. 319; *Neilson* v. *Betts*, L. R., 5 H. L. 1; *Needham* v. *Oxley*, 11 W. R. 852.

(*a*) Per Lord Westbury, *Neilson* v. *Betts*, supra.

(*b*) *Penn* v. *Jack*, L. R., 5 Eq. at p. 86.

tion should be had where the patentee is the manufacturer, and has granted no licenses, to the damage which he has sustained by reason of the **commercial competition** to which he has been subjected.

In estimating damages, the Court will inquire into the **extent of infringement** and the amount of goods manufactured by the defendant, care being taken to distinguish this inquiry from that as to sales and profits. In the one case the quantity of business is inquired into, in the other the amount of profit. It is evident that the smaller the price at which the articles have been sold, the greater the damage to the patentee by reason of the market depreciation of the profits to be made by his invention by reason of the competition.

In *Betts* v. *De Vitre* (*c*), Sir W. Page-Wood, V.-C., said :—" I confess it appears to me that if the damages are to be assessed, it would be proper to take the identical course that was taken in *Hills* v. *Evans*, for this reason, that damages of this description, namely, damages for the infringement of a patent where there has been no license granted at any time for the use of that patent, can only be ascertained on those very vague and guess-like data which, it appears, juries have been obliged to act upon in ascertaining what the actual loss has been that has occurred to a patentee by the user by some wrongdoer of his patent right. The difficulty one sees must be very great where there are no licenses existing. Where there are licenses existing, the difficulty would be next to nothing, because you would simply ascertain the amount sold, and fix the wrongdoer with that amount."

In *Penn* v. *Jack*, licenses had been granted, and the same Vice-Chancellor fixed the amount of damage at the amount which would have been received had the defendant been working under a license.

(*c*) 34 L. J., Ch. 291.

In the *United Horse-nail Co.* v. *Stewart* (*d*), a Scotch case, the Lord Ordinary (Kinnear) said:—"It appears to me to be a fair enough ground for estimating their damages to take the whole profits which they would have made upon the sales actually made by the defenders, if the defenders had not interfered so as to prevent the pursuers effecting those sales themselves. That would mean the difference between the cost of manufacture and the prices at which they were selling at the time to their agent." The learned judge proceeded to state that damages by way of compensation for competition were reasonable enough, but that in the particular case before him the evidence did not justify such damages.

Where licenses have been granted, no account will be taken of profits which have been lost by reason of competition (*e*).

Where bills to restrain the infringement of a patent have been filed against both the person who manufactures, and the person who uses the article, and issues of fact have been found for the plaintiff, it is the right of the plaintiff to have, not only an account against the manufacturer, but also damages against the person using the article, wherever it be found (*f*).

In aid of the inquiry as to damages, directed by the judgment for a perpetual injunction, **the defendant must give full discovery**, and will be required to set out the names and addresses of the persons to whom machines, made in infringement of the patent have been sold; but not the names of the agents concerned in the transaction (*g*).

(*d*) Griffin P. C. 217; see as to measure of damages based upon special conditions, *United Telephone Co.* v. *Walker*, 56 L. T. 508.

(*e*) *Penn* v. *Jack*, L. R., 5 Eq. at p. 85.

(*f*) Head note to *Penn* v. *Bibby*, L. R., 3 Eq. 308.

(*g*) *Murray* v. *Clayton*, L. R., 15 Eq. 115.

ACCOUNT OF SALES AND PROFITS.

In cases where it is deemed to the advantage of the plaintiff, he may elect, in lieu of damages, to take an account of sales and profits; that is, to condone the infringement upon the footing that the defendant has been acting as the plaintiff's agent in selling or using the invention.

The plaintiff will not, however, be allowed to claim an account **if he has tacitly permitted the defendant to infringe his patent,** relying upon an ultimate account of profits. In *Crossley* v. *The Derby Gas Light Co.* (*h*), Lord Brougham said:—"It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on spending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit without having ever been exposed to share in the losses which might have been sustained. Upon this the defendants rely; but it was to be considered, on the other hand, whether the plaintiff did not explain the delay which has taken place, and whether the conduct of the defendants has not been such as to lull the plaintiff's suspicions to sleep."

Prior to the Judicature Acts it was held a rule in Courts of Equity, that in consequence of the terms of 21 & 22 Vict. c. 27, no relief could be awarded for damages or an account, unless an injunction could be granted at the same time. All other relief being merely incidental to the injunction (*i*). Thus, where a **patent had expired** after bill filed, but before an injunction could be granted, the Court declined to consider the question of damages (*k*). But now, in pursuance of sect. 24, sub-sect. 6, of the Judicature Act, 1873, a Court of Equity may give full relief; and so, wherever a court of

(*h*) 1 Web. P. C. 120.

(*i*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727.

(*k*) *Betts* v *Gallais*, L. R., 10 Eq. 392.

law would, prior to the passing of the Act, have granted damages or an account, similar orders will be made by either branch of the High Court of Justice, irrespective of the question of injunction.

Where it appears at the trial that **the defendant has made no profit,** although the plaintiff may be entitled to damages, he will not be entitled to an account (*l*).

Where the defendant has acted in ignorance of the patent, and before action has offered to submit to an account and to pay to the plaintiff the amount of profits, the Court should exercise its discretion in disallowing costs (*m*), although it may grant the injunction. In such a case the plaintiff will proceed to an account at his peril, running the risk of nothing being found due.

The practice of the Courts as to injunctions, damages, and accounts, will be dealt with hereafter under the head of "Practice."

(*l*) *Bacon* v. *Spottiswoode*, 1 Beav. 387.

(*m*) *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

CHAPTER XIV.

REVOCATION.

We have seen that the patentee has his remedy in an action for infringement. The public has also a remedy by petition for revocation.

Sect. 26 of the Act of 1883 provides :—

"(1) *The proceeding by* **scire facias** *to repeal a patent is hereby* **abolished**.

"(2) **Revocation** *of a patent may be obtained on petition to the Court.*

"(3) *Every ground on which a patent might, at the commencement of this Act, be repealed by scire facias shall be available by way of defence to an action for infringement, and shall also be a ground of revocation.*

"(4) *A petition for revocation of a patent may be presented by :—*

"(a) *The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.*

"(b) *Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.*

"(c) *Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.*

"(d) *Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.*

"(c) *Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold within this realm before the date of the patent anything claimed by the patentee as his invention.*

"(5) *The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.*

"(6) *Particulars delivered may be from time to time amended by leave of the Court or a judge.*

"(7) *The defendant shall be entitled to bring in and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.*

"(8) *Where a patent has been revoked on the ground of fraud the comptroller may, on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.*"

Practically speaking, scire facias had fallen into desuetude before the passing of this Act; other methods of disputing the validity of patents were found, or thought to be, more to the advantage of persons opposing them. It is presumed, however, that the new procedure will find more favour, being simpler, more speedy, and more similar to the ordinary action for infringement than the old action of scire facias.

The grounds upon which a patent may be revoked are similar to those upon which it might have been can-

called by scire facias (*a*). These are in the Fourth Institute said to be: "*Firstly*, when the king by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a scire facias to repeal the second patent; *secondly*, when the king granteth anything that is grantable upon a false suggestion, the king by his prerogative jure regio may have a scire facias to repeal his own grant. When the king doth grant anything which by law he cannot grant, he jure regio (for the advancement of justice and right) may have a scire facias to repeal his own letters patent."

And it was held in *Sir Oliver Butler's case* (*b*), that "where a patent is granted to the prejudice of the subject, the king, of right, is to permit him on his petition to use his name for the repeal of it in a scire facias at the king's suit, and to hinder multiplicity of actions upon the case."

Thus it will be seen that formerly any person might, on behalf of the public, proceed by scire facias to repeal a patent, although security for costs was required. Sub-sect. 4 of sect. 26 has very considerably narrowed and limited this general right.

Practically speaking, any ground which may be set up as a defence to an action for infringement may be employed as a ground for revocation—such as that the person to whom the letters patent were granted was not the first and true inventor, or that the invention was not new or useful, or that it was not true that the invention had not been practised before, or that the said invention did not come within the meaning of the words "a new manufacture," or that the specification was insufficient and did not disclose the nature of the invention.

The petition is to be presented to the High Court of Justice in England or in Ireland. By sect. 109 it is provided: (1) "*Proceedings in Scotland for revocation of a*

(*a*) 4 Inst. 88. (*b*) 2 Vent. 344.

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 in respect to Ireland we find that, by sect. 110, "*All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.*"

The general result of these sections seems to be that the proceeding for revocation may be taken in any part of the United Kingdom, and that the question may be dealt with by the Courts of either portion independently; so that it will be possible for letters patent to have been cancelled so far as England is concerned, and yet to continue in force for Scotland and Ireland, and vice versâ.

It will be observed that in sect. 26, sub-sect. 4 (c and d), "*Any person* alleging *that he, &c. . . . . may petition,*" and by sub-sect. (3), any ground which might be available for scire facias may form the ground for revocation.

In *Re Avery's Patent* (*c*), it was held by Stirling, J., and the Court of Appeal, that this applied only to cases of actual fraud, and would not be extended to questions of mistake, though the consequences might be to deprive the inventor of his patent rights. Cotton, L. J., said:—"If it is made out that the present petitioner, Avery, is a person who brings himself within that clause, and *satisfies the Court* that the patent was obtained in fraud of his rights, then we should have to go into the other question, namely, whether the patent is or is not good" . . . . (at p. 325), "an act, to be 'in fraud of his rights,' to my mind must involve an attempt by the agent to deprive the principal of something, or to gain for himself something at the expense of his principal."

(*c*) L. R., 36 Ch. D. 307.

We have dealt with the several grounds of revocation in previous chapters, under the title of Infringement, and it will be unnecessary to do more here than to refer the reader to them. In a subsequent chapter will be found the practice to be observed in the course of proceedings for revocation.

CHAPTER XV.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

Sects. 103 and 104 of the Patents, &c., Act, 1883, give power to the Crown to enter into arrangements with foreign and colonial governments with respect to the mutual protection of patent rights. And, in respect to any foreign State which has entered into such arrangements, any person who has applied for protection for any invention in any such 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 the *application* (*a*) in such foreign State, provided that the application for letters patent in this country is made within seven months from the date of the application for protection in such foreign State.

Then follows a provision that a patent granted under such circumstances shall not entitle the patentee to bring actions in respect of infringements which may have happened prior to the date of the acceptance of his final specification.

It will be dangerous for persons to adopt foreign discoveries or inventions before the expiration of the seven months from the date of the foreign application: for, in the event of a patent being applied for under this section, the whole of the capital invested in the adoption of such invention may be found to have been lost. Regard particularly being had to the fact that by sub-sect. 2 any use

(*a*) Patents, &c., Act, 1885, sect. 6.

of the invention in this country within the seven months by any number of persons will in no way invalidate the patent rights subsequently obtained; and that the persons who have used the invention will not have obtained any vested rights to continue the use of the invention.

The application for a patent under this section must be made in the same manner as ordinary applications. The section only applies with respect to such foreign States with respect to which her Majesty shall from time to time, by Order in Council, declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.

Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, her Majesty may, by Order in Council, apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

Orders in Council in pursuance of this section shall have the like effect as if the provisions they contain had been incorporated in the Act.

Practice.

CHAPTER I.

ACTION FOR INFRINGEMENT.

An action for infringement is commenced **by writ** issued out of the High Court of Justice.

Subject to the special provisions of the Patent, &c., Act, the rules of the Supreme Court apply to actions for infringement of patents and petitions for revocation (*a*).

The writ may be endorsed merely **for damages** for infringement, *or* **for an account** of sales and profits, *and* it may be endorsed for an injunction claiming that the defendant may be restrained from continuing to infringe the patent (*b*), and for a mandatory order that the defendant may be ordered to deliver up to the plaintiff the articles made in infringement of the patent which are in his custody or power, or in the custody or power of his servants or agents, so that they may be broken up or destroyed (*c*). The plaintiff may not claim both an account of sales and profits and damages for infringement; the two claims being inconsistent, since, if an account is taken, the infringement is condoned (*d*).

Service of a writ in Scotland for an infringement in England will be allowed (*e*).

(*a*) Haddan's Patent, 54 L. J. Ch. 126; Griffin, P. C. 108.

(*b*) Form, p. 287.

(*c*) Form, p. 287. See *Tangye* v. *Stott*, 14 W. R. 386; *Betts* v. *De Vitre*, 34 L. J., Ch. 289.

(*d*) Per Lord Westbury in *Neilson* v. *Betts*, L. R., 5 H. L. 1. See also *De Vitre* v. *Betts*, L. R., 6 H. L. 321; *Needham* v. *Oxley*, 11 W. R. 852. But see *Hills* v. *Evans*, 4 De G. F. & J. 288.

(*e*) *Speckhart* v. *Campbell, Achnach & Co.*, Solicitors' Journal, Feb. 2, 1884.

CHAPTER II.

PARTIES.

THE parties to the writ may be—**as plaintiffs**, any person for the time being entitled to the benefit of the patent. **An ordinary licensee** cannot be plaintiff, as he is merely licensed to use, and not entitled to any monopoly ; but an **exclusive licensee** may sue, using the name of the grantor of the licence in the action (*a*). **An assignee** may sue in his own name, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*). An assignee of a portion of a patent may be plaintiff (*c*); so, also, it is submitted, may an assignee for a place or part of the United Kingdom, under sect. 36 of the Act of 1883. **Assignees or trustees under a bankruptcy petition** may sue (*d*), and an assignee may maintain an action, although the assignment has not been registered (*e*). One of several joint owners may recover (*f*), **and one of several co-owners** of a patent has a right to sue alone for the recovery of profits due for the use of a patent ; and an objection by a defendant that other persons should have been joined as plaintiffs should be made promptly under Rules of Court

(*a*) *Renard* v. *Levinstein*, 2 H. & M. 628.

(*b*) *Walton* v. *Lavater*, 8 C. B., N. S. 162 ; *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838.

(*c*) *Dunnicliffe* v. *Mallett*, 7 C. B., N. S. 209.

(*d*) *Bloxam* v. *Elsee*, 6 B. & C. 169.

(*e*) *Hassall* v. *Wright*, L. R., 10 Eq. 509.

(*f*) *Davenport* v. *Richards*, 3 L. T., N. S. 503.

1875, Ord. XVI. rules 13 and 14, and may not be postponed till the hearing, where no impediment exists to raising the objection at once (*g*).

A mere agent to introduce, sell, and grant licences for the use of a foreign patent in this country is not entitled to take proceedings to restrain infringement (*h*).

As defendants, all persons physically infringing, or threatening to infringe, the patent may be joined. An **architect**, specifying the use of a patent, should not be joined, but the **contractor** doing the work may (*i*). The **directors of a company** may be sued in their personal capacity for an infringement by the servants of the company (*k*). Where the principals are out of the jurisdiction, the court will restrain the manager or workmen (*l*).

(*g*) *Shehan* v. *Great Eastern Rail. Co.*, L. R., 16 Ch. D. 59.

(*h*) *Adams* v. *North British Rail. Co.*, 29 L. T., N. S. 367.

(*i*) *Denley* v. *Blore*, 38 Lond. Jour. 224.

(*k*) *Betts* v. *De Vitre*, L. R., 3 Ch. 441.

(*l*) See *Betts* v. *Neilson*, 13 W. R. 804; 12 L. T., N. S. 489.

CHAPTER III.

INTERLOCUTORY INJUNCTION.

An interlocutory injunction may be granted **ex parte**, after the issue of the writ, and before service. An ex parte injunction will only be granted when it can be shown that great injury will accrue to the plaintiff by delay, and when he can clearly establish his title and the fact of infringement (*a*). Interlocutory injunctions are always upon terms as to damages (*b*).

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or with leave, upon notice of motion to be served with the writ.

By sect. 25 of the Judicature Act, 1873, sub-sect. 8: "A mandamus or an injunction may be granted, or a receiver appointed by an interlocutory order of the Court, in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made either unconditionally or upon such terms and conditions as the Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any cause or matter to prevent any threatened or apprehended waste or trespass, such injunction may be granted if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act

(*a*) *Gardner* v. *Broadbent*, 2 Jur., N. S. 1041.

(*b*) *Graham* v. *Campbell*, L. R., 7 Ch. D. 490.

sought to be restrained under any colour of title; and whether the estates claimed by both or either of the parties are legal or equitable."

Ord. L. rule 6, directs that: "An application for an order under sect. 25, sub-sect. 8, or under rules 2 or 3 of this order, may be made to the Court or a judge by any party. If the application be by the plaintiff for an order under the said sub-sect. 8, it may be made either ex parte or with notice . . . . ."

A master of the Queen's Bench Division has no power to grant an injunction. Order LIV. rule 12.

An interlocutory injunction will only be granted when there is a fair **primâ facie case of validity.** This may be made out by long undisturbed enjoyment, or by the question having been previously tried in a court of law (*c*), or where the defendant has admitted the validity of the patent (*d*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*e*).

In *Hayward* v. *The Pavement Light Co.* (*f*), Kay, J., said, when granting an interlocutory injunction, "The invention has been patented so long ago as 1871, and the validity of the patent has been established by the Court of Appeal."

In *Jackson* v. *Needle* (*g*), Baggallay, L.J., said, "The Court abstains from interfering by injunction in the case of a recently dated patent where there is really a substantial question to be tried." See also the law and authorities quoted *ante*, p. 194 *et seq.*

(*c*) *Dudgeon* v. *Thompson*, 22 W. R. 464; *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37; *Collard* v. *Allison*, 4 My. & Cr. 487; *Stephens* v. *Keating*, 2 Ph. 333; *Bridson* v. *McAlpine*, 8 Beav. 229; *Bridson* v. *Benecke*, 12 Beav. 1, and cases quoted *supra*, under the head "Injunction."

(*d*) *Dircks* v. *Mellor*, 26 Lond. Jour. 268.

(*e*) *Clarke* v. *Fergusson*, 1 Giff. 184.

(*f*) Griffin, P. C. 124.

(*g*) Griffin, P. C. at p. 133. See also *Lister* v. *Norton*, Griffin, P. C. 148.

The injunction may be **refused upon terms** that the defendant keep an account *pendente lite* (*h*). But it is open to the plaintiff to show that if he succeeds the defendant's position is such that he will be unable to pay the damages or the amount of the account (*i*).

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

The affidavit should clearly point out in what the alleged infringement consists (*k*). If the plaintiff is the first inventor, he must distinctly swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient specification (*l*). If the plaintiff is an assignee he must swear to the best of his belief (*m*). The affidavits in either case must state the facts as at the time of swearing, and it is not sufficient to swear that the invention was believed to be new when the patent was granted (*n*). An injunction granted prior to statement of claim will be dissolved if the statement of claim when delivered does not agree with the affidavits upon which the injunction was granted (*o*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the Queen's Bench Division the application is heard by the Judge in Chambers upon a summons.

Forms of injunction upon undertaking as to damages (*p*), and of order refusing injunction upon terms (*q*), will be found in the Appendix.

(*h*) *Jones* v. *Pearce*, 2 Coop. 58; *Mitchell* v. *Barker*, 39 Lond. Jour. 531; *Muntz* v. *Grenfell*, 2 Coop. 61 (n.).

(*i*) *Newall* v. *Wilson*, 2 De G., M. & G. 282.

(*k*) *Hill* v. *Thompson*, 3 Mer. 624; *Betts* v. *Willmott*, L. R., 6 Ch. 239.

(*l*) *Hill* v. *Thompson*, 3 Mer. 624; *Sturtz* v. *De la Rue* (per Lord Lyndhurst), 5 Russ. 329; *Whitton* v. *Jennings*, 1 Dr. & S. 110.

(*m*) *Gardner* v. *Broadbent*, 2 Jur., N. S. 1041.

(*n*) *Hill* v. *Thompson*, 3 Mer. 624.

(*o*) *Stocking* v. *Llewellyn*, 3 L. T. 33.

(*p*) Form 6, p. 290.

(*q*) Form 7, p. 291.

CHAPTER IV.

STATEMENT OF CLAIM.

The Rules of Court of 1883 have rendered the form of pleadings of less importance than hitherto. Ord. XIX. rule 26, provides: "No technical objection shall be raised to any pleading on the ground of any alleged want of form;" but by rule 27 the power of the Court to strike out pleadings on the grounds that they are unnecessary, scandalous, or embarrassing, is preserved.

Ord. XIX. rule 4, requires all material facts to be pleaded, and prohibits the pleading of evidence. Rule 5 is as follows:—"The forms in Appendices (C., D., and E.), when applicable, and when they are not applicable forms of the like character, as near as may be, shall be used for all pleadings, and where such forms are applicable and sufficient, any longer forms shall be deemed prolix, and the costs occasioned by such prolixity shall be disallowed to or borne by the party so using the same, as the case may be."

The forms mentioned relate to pleadings in an action for the infringement of a patent, but there is no provision made for the case where infringement has only been threatened, nor for the case when a mandatory order or an account of sales and profits is required (*a*).

It will be observed that the statement of claim in patent cases, which is rendered obligatory by Ord. XIX. rule 5, contains no allegation as to the matters going to constitute the validity of the patent, nor does it give the date, time, or place of the infringement; but it refers to the particulars of breaches which are delivered "herewith."

(*a*) See Form, p. 294.

CHAPTER V.

PARTICULARS OF BREACHES.

Particulars of breaches were required to be delivered in every action for the infringement of a patent by sect. 41 of the Patent Law Amendment Act, 1852; and now by sect. 29 (1) of the Act of 1883, it is provided :—"*In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or a judge at any subsequent time, particulars of the breaches complained of*; (4) *at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement, or objection of which particulars are not so delivered*; (5) *particulars delivered may be from time to time amended by leave of the Court or a judge.*"

Particulars of breaches are particulars of the times, places, occasions, and manner in which the plaintiff says the defendant has infringed his letters patent. The **defendant must have full, fair, and distinct notice of the case to be made against him** (*a*). In *Bailey* v. *Kynock* (*b*), Sir James Bacon, V.-C., said : "All that is required and provided by the Patent Law Amendment Act, 1852, which has made no alteration in the practice to be observed in these cases, is that the defendants shall not be taken by surprise, and it is the duty of the judge to take care that by the particulars of breaches they shall have full and fair notice of the case that they will have to meet."

(*a*) *Needham* v. *Oxley*, 1 H. & M. 248. (*b*) L. R., 19 Eq. at p. 231.

It had undoubtedly prior to the passing of the Patent Law Amendment Act, 1852, been the practice of the Courts to compel plaintiffs to give particulars of breaches, and the cases which were then decided as to the sufficiency of particulars are applicable now; for then, as now, the object was that the defendant should be warned with reasonable certainty of the case that was to be made against him.

The following clause was ordered to be struck out of the amended particulars (c): "And the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches."

If the particulars delivered are too general the defendant should apply **for further and better particulars.**

If at the trial evidence is tendered which comes within the literal meaning of the particulars it will be admitted, notwithstanding that the particulars are too general, as **the defendant should have objected to the particulars,** and not wait until the trial to take his objection (*d*).

The plaintiff having delivered particulars of breaches specifying certain sales by the defendant of rollers, and in particular to Shaw and Smith, the defendant, in answer to interrogatories, admitted sales to Hirst. Fry, J., in giving judgment, said: "In this case I think I must admit the evidence tendered in respect of Hirst's case. It is said that in respect of those cases which are not mentioned by name in the particulars of breaches, the plaintiff cannot give evidence. It may be that the particulars were not sufficient, or tended to embarrass. But the defendant did not apply for amended particulars, according to the case of *Hull* v. *Bolland*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst

(*c*) *The Patent Type Founding Co.* v. *Richards*, 2 L. T., N. S. 359.

(*d*) *Hull* v. *Bolland*, 25 L. J., Ex. 304.

is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised by *Smith's* or *Shaw's* case, I should probably have given an opportunity to the defendant to bring fresh evidence. I have asked whether there is any witness not here whom the defendants would desire to bring in respect of Hirst's case, and have received no satisfactory answer on that point, and must assume there is no such witness" (*e*).

When the patent consists of two or more processes, or distinct and separable inventions, **particulars of breaches should distinguish which of the processes** it is alleged has been infringed, and should particularly indicate what parts of the defendant's machine or manufactured article are claimed to constitute an infringement; but when the process was one entire invention, the Court declined to compel the plaintiff to point out the particular parts of the specification which were alleged to be infringed. Jervis, C.J., said: "If the two processes described in the specification are wholly distinct from each other, and the defendant's process may be an infringement of the one and not of the other, he ought to have better particulars; but if the whole is substantially one process, he is not entitled to them . . . We must not make the particulars more complicated than the specification (*f*)."

In *Elsey* v. *Butler* (*g*), an action for infringement of a patent for "improvements in the manufacture of lace, in twist lace machinery, and in apparatus employed therein," the following particulars of breaches were held by Pearson, J., to be sufficient:—"The defendant has infringed by the production in a twist lace machine, or in twist lace machines, of lace fabrics in the manner described in the

(*e*) *Sykes* v. *Howarth*, L. R., 12 Eq. 826.

(*f*) *Talbot* v. *La Roche*, 15 C. B. 310. See also *The Electric Telegraph Co.* v. *Nott*, 4 C. B. 462, and *Tilghman's Sand Blast Co.* v. *Wright*, Griffin, P. C. 216.

(*g*) Griffin, P. C. 96.

specification of the said patent, page 3, line 22 to page 9, line 39, or in a manner only colourably differing therefrom; and by the use of the improved combination of apparatus therein described, and also in particular by the production in a twist lace machine, or in twist lace machines, of fabric known as 'Double tie Swiss Net' in the manner described in the specification of the said patent, page 6, line 57 to page 7, line 38, or in a manner only colourably differing therefrom, and by the use of the improved combination of apparatus therein described."

Further particulars of breaches will sometimes be postponed to discovery on the ground that the defendant knows the breaches which he has committed better than the plaintiff (*h*).

Particulars of breaches, as we have seen, may also be ordered in actions which are not strictly actions for the infringement of patents; this is done under the ordinary jurisdiction of the Court (*i*). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiffs that the machines were infringements of his, the defendant's patents, the defendant having pleaded not guilty, the Court ordered the defendant to deliver particulars, showing in what parts the plaintiff's machines were an infringement of the defendant's patents, and pointing out by reference to the page and line of the defendant's specifications, which part of the inventions therein described he alleged to have been infringed (*k*).

(*h*) *Russell* v. *Hatfield*, Griffin, P. C. 204.

(*i*) *Perry* v. *Mitchell*, 1 Web. P. C. 269.

(*k*) *Wren and others* v. *Weild*, L. R., 4 Q. B. 213.

CHAPTER VI.

STATEMENT OF DEFENCE.

The statement of defence in patent actions is now, under the Rules of the Supreme Court, 1883, a very brief and concise document, giving no particulars or details whatever, and remitting the plaintiff to the particulars of objections, and the answers to the interrogatories for information as to the case which is to be made against him. Under Ord. XIX. rule 5, the form given in Appendix (D.) sect. VI. is rendered obligatory. That form merely gives headings of defence which is all that is to be allowed; for instance:—"(1) That the defendant did not infringe the patent; (2) The invention was not new; (3) The plaintiff was not the first and true inventor; (4) The invention was not useful; (5) The patent was not assigned to the plaintiff." And to these might be added:—That the title did not disclose the nature of the invention (*a*); that the title, the provisional specification, and the complete specification, or any two of them, did not substantially refer to the same invention (*b*); that the specification was not sufficient (*c*); that the claim in the specification was not sufficient to distinguish what was new from what was old (*d*); that the patent was obtained in fraud of the defendant, as, for instance, when a person employed to carry out or assist in experiments, applies for letters patent himself, or where the patentee has obtained the invention from the confidence of the defendant.

(*a*) Ante, p. 60 et seq.
(*b*) Ante, p. 67 et seq.
(*c*) Ante, pp. 86—94.
(*d*) Ante, p. 95 et seq.

It will be observed that any one of these defences will be sufficient to constitute a complete defence to the action; and that the greater portion of them are of a nature to require elaborate and costly evidence to prove or disprove them. Too much care cannot, therefore, be taken in preparing a statement of defence to avoid setting up defences which it is not expected will be satisfactorily proved at the trial, regard being had to the provisions of the Rules of 1883 as to costs; otherwise, even if the defendant succeeds in the action, he may be mulcted in heavy costs to the other side.

A statement of defence alleged that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty, as including matters described in certain specifications (stating them). North, J., refused to strike out par. 2 under Ord. XIX. rule 27; the Court of Appeal dismissed the appeal with costs (*e*).

A statement of defence admitted infringement in ten instances and no more, the plaintiffs elected to move for judgment upon such admissions; held that they were entitled to an enquiry as to damages as to these ten instances of infringement and no more, and that all evidence as to any other instances of infringement alleged to have been committed by the defendant must be excluded (*f*).

Where the defendants in an action for infringement have been indemnified by another person or Company, such other person or Company may be joined as a third party under Ord. XVI. rule 48, of the rules of the Supreme Court (*g*).

(*e*) *Hocking* v. *Hocking*, Griffin, P. C. 129.

(*f*) *United Telephone Co.* v. *Donohoe*, 31 Ch. D. 399.

(*g*) *Edison and Swan United Electric Light Co.* v. *Holland*, L. R., 33 Ch. D. 497.

CHAPTER VII.

PARTICULARS OF OBJECTIONS.

SECT. 21, sub-sect. (2) of the Act of 1883, provides:—"*The defendant must deliver with his statement of defence, or by order of the Court, or a judge at any subsequent time, particulars of any objections on which he relies in support thereof*; (3) *If the defendant disputes the validity of the patent, the particulars, delivered by him, must state on what grounds he disputes it; and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him*; (4) *At the hearing, no evidence shall, except by leave of the Court, or a judge, be admitted in proof of any alleged infringement or objection, of which particulars are not so delivered*; (5) *Particulars delivered, may be from time to time amended, by leave of the Court, or a judge*; (6) *On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particulars delivered by them, unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.*"

This last sub-section will make it imperative upon the plaintiff or defendant, who has succeeded in an action, to obtain a certificate from the judge who has tried the case that each one of the particulars delivered by him

has been proved or was reasonable and proper. It will be observed that the words of the section are "*shall not* be allowed any costs;" this leaves no discretion in the Court except as to certifying.

Ord. XIX. rule 6, of the Rules of the Supreme Court, 1883, provides: "In all cases in which the party pleading relies on any misrepresentation, fraud, breach of trust, wilful default, or undue influence, and in all other cases in which particulars may be necessary beyond such as are exemplified in the forms aforesaid, particulars (with dates and items if necessary) shall be stated in the pleading: provided that if the particulars be of debt, expenses, or damages, and exceed three folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading."

It is not easy to reconcile the practice under this rule with the language of the 29th sect. of the Patent Act, or, indeed, with the form of defence given in the form to the rules quoted above. Ord. XIX. rule 6, provides that particulars shall be incorporated with the pleading; on the other hand, the form and the Patent Act seem to indicate a separate document. Hitherto the practice has been to deliver a separate document, and it is apprehended that when the balance of convenience is considered the Courts will hold that in respect of a patent action the practice has remained unchanged.

The particulars of objection may allege that the invention was not new at the date of the patent. It is not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections (*a*).

Particulars of breaches must be distinguished from particulars of objection for want of novelty. In the latter case the particular instances may not be within the

(*a*) *Smith* v. *Cropper*, 10 App. Cas. 249, reversing 26 Ch. D. 700.

knowledge of the patentee and must be specified, in the former, the defendant must know whether and in what respect he has been guilty of infringement (*b*).

Particulars stated that "A particular improvement had been used by A. B. (giving names and addresses), *and divers other people within this kingdom and elsewhere.*" The judges struck out the words "*and divers other people*" (*c*).

The words "carriage builders generally throughout Great Britain" do not sufficiently comply with the statute, nor do the words "used and applied by carriage builders generally;" and the words "in or near London, in or near Liverpool, &c., and in or near various other of the principal towns of Great Britain," are too general (*d*).

Vice-Chancellor Sir W. Page-Wood said in *Morgan* v. *Fuller* (*d*): "An allegation of general user does not of course admit of being met precisely . . . . The real object is to secure to both parties a fair trial" (*e*).

In *Flower* v. *Lloyd* (*f*), Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided (*g*). If the defendants knew that their processes have been used by other persons in London and Birmingham, besides those specified, they must know the persons by whom they have been used, and must give more specific information. I do not say that they need give the name and address of every such person, but they must give fair information. If they can give no further information, the words in question are useless, and too indefinite, and must be struck out."

Prior user.—The objection on the ground of prior user

(*b*) *Ledgard* v. *Bull*, 11 Ap. Cas. 648, P. C.

(*c*) *Fisher* v. *Dewick*, 1 Web. P. C. 551 (n.).

(*d*) *Morgan* v. *Fuller*, L. R., 2 Eq. 297.

(*e*) See also *Jones* v. *Berger*, 1 Web. P. C. 544; *Holland* v. *Fox*, 1 C. L. R. 440; *Palmer* v. *Cooper*, 9 Ex. 231.

(*f*) Solicitors' Journal, 1876, p. 860.

(*g*) *Bentley* v. *Keighley*, 7 M. & G. 652; *Palmer* v. *Wagstaff*, 8 Ex. 840.

must state the time and place when such user occurred; but it will be observed that **the persons by whom used** is not mentioned in sub-sect. (3). The Act, however, does not direct that such particulars shall not be required. The Patent Law Amendment Act, 1852, sect. 41, required that the place of prior user should be given, and was silent as to times or persons. Notwithstanding this, in *Palmer* v. *Cooper* (*h*), Baron Alderson went even further than to require the names of the persons who had used the invention, and the **present addresses** of such persons were ordered to be given, "As otherwise the plaintiff would not know where to go for his evidence." The object of particulars is, in the words of Tindal, C.J. (*i*), "Not, indeed, to limit the defence, but to limit the expense of the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. Under the fifth section (5 & 6 Will. 4, c. 83), therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely." In *Palmer* v. *Cooper* (*h*), Parke, B., said: "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the place named."

It will be evident, therefore, that there are cases where to omit giving the names and addresses of the persons who are alleged to have anticipated the invention would be to supply the plaintiff with objections which would be practically useless.

There are cases where the names and addresses have been refused. In *Carpenter* v. *Walker* (*k*), the objections

(*h*) 9 Ex. 231. See also *Bulnois* v. *Mackenzie*, 4 Bing. N. C. 132; *Galloway* v. *Bleaden*, 1 Web. P. C. 268 (n.).

(*i*) *Fisher* v. *Dewick*, 1 Web. P. C. 267.

(*k*) 1 Web. P. C. 268 (n.).

stated that the invention had been used by "the defendant and divers persons." It was refused to order the defendant either to give the names and addresses of the "divers persons," or to have those words struck out.

It may be argued that the reason of such refusal was that a disclosure was required of the witnesses and case of the defendant. It is obvious that, although it is a recognized principle that one litigant shall not be permitted to inquire as to what witnesses the other is about to call at the trial, still that by far the more important principle is that neither party should be taken by surprise, and that the plaintiff should have a fair opportunity of critically examining every alleged anticipation which may be attempted to be established against him.

It does not of necessity follow that persons who have anticipated the invention should be the only and necessary witnesses of such anticipation. On the whole, therefore, it is submitted that names and addresses of such persons should be given in particulars of objections.

General words are inadmissible in particulars; for instance, expressions such as "and divers other people" (*l*), and "Inter alia at Sheffield, Birmingham, and London" (*m*). But in *Bentley* v. *Keighley* (*n*), Mr. Justice Maule, under special circumstances, allowed the words "and others" to be sufficient.

When the allegation of the defendant is that the patent is void by reason of a portion of the described invention being old, the particulars should clearly distinguish which part is alleged to be old, as well as the times and places of prior user (*o*).

(*l*) *Fisher* v. *Dewick*, 1 Web. P. C. 551 (n.); *Galloway* v. *Bleaden*, 1 Web. P. C. 268 (n.).

(*m*) *Holland* v. *Fox*, 1 W. R. 448; 1 C. L. R. 440.

(*n*) 7 M. & G. 652. See also *Jones* v. *Berger*, 1 Web. P. C. 549.

(*o*) *Heath* v. *Unwin*, 10 M. & W. 684; *Russell* v. *Ledsam*, 11 M. & W. 647.

Evidence will be admitted at the trial, provided the language of the particulars of objections is large enough to admit it; for instance, if the plaintiff has allowed such words as "and elsewhere" to stand until the trial, the defendant will be allowed to give evidence of prior user **anywhere** (*p*). The proper course for the plaintiff to take should the defendant deliver vague particulars is to issue a summons before a judge in chambers for further and better particulars, or, in the alternative, to have the objectionable words struck out (*q*).

In *Sugg* v. *Silber* (*r*), Mellish, L. J., said:—"The authorities cited by Mr. Cave were cases where objections had been taken to the notices of objection at the time when they were delivered, and further and better particulars were asked for. In my opinion there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that, if Mr. Cave was right in saying that the two questions are the same, and that wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial. Nobody would be foolish enough to apply to a judge for further particulars."

Although the objections did not specifically point out that the invention consisted of several claims, yet the objection that the invention is not the subject-matter of a patent, is sufficient to open the objection that the whole, or some particular part of it, is not the subject-

(*p*) *Hull* v. *Bolland*, 25 L. J., Ex. 304; *Sykes* v. *Howarth*, L. R., 12 Eq. 826.

(*q*) *Fisher* v. *Dewick*, 1 Web. P. C. 551 (n.); *Carpenter* v. *Walker*, 1 Web. P. C. 268 (n.); *Holland* v. *Fox*, 1 C. L. R. 440.

(*r*) L. R., 2 Q. B. D. 495.

matter of a patent, and that consequently the patent is bad (s).

The defendant may, by leave of a Court or judge, from time to time, and upon such terms as under the circumstances of the case may be deemed equitable, amend the particulars which he has delivered; this is done by summons.

Page-Wood, V.-C., in *Penn* v. *Bibby* (t), permitted a defendant in his amended particulars, to preface his statement of the specific instances of alleged prior user, with the words "amongst other instances" in order to give him an opportunity to apply for leave to re-amend by inserting any further instances of prior user which he might discover.

Liberty to amend particulars of objections at the trial was given upon terms in *Renard* v. *Levenstein* (u); but in *Moss* v. *Malings* (x), North, J., refused leave, and said:—"*I could only grant it if the defendant showed that he* could not, with reasonable diligence, have discovered the new facts sooner. This he has not done. I must, therefore, refuse the application."

The terms upon which amendment is permitted are, first, that the plaintiff should be at liberty, if he pleases, to discontinue the action, and to be in the same position as to costs, as if the proposed amended particulars had been delivered in the first instance (y), and, secondly, that the defendant should be put under such terms as to costs, as to the judge or Court seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; thereupon he may discontinue or not,

(s) See also *Hull* v. *Bolland*, 1 H. & N. 134; and *Neilson* v. *Harford*, 1 Web. P. C. 331.

(t) L. R., 1 Eq. 548.

(u) 11 L. T. at p. 506.

(x) 33 Ch. D. 603.

(y) *Baird* v. *Moule's Patent Earth Closet Co.*, L. R., 17 Ch. D. 139 (n.); and *Aveling* v. *Maclaren*, same page; also *Edison Telephone Co.* v. *India Rubber Co.*, L. R., 17 Ch. D. 137; and *Ehrlich* v. *Ihlee*, 56 L. T. 819.

as he pleases, paying defendant's costs. The defendant should not be permitted to keep back his most salient objections, and so to entice the plaintiff to proceed and incur costs, and then to amend his particulars at the last moment.

A form of order for further particulars will be found in the Appendix (*z*).

The defendant will not be allowed at the hearing of the action to introduce **evidence of prior user, not disclosed in the particulars of objection,** although such evidence may have only come to his knowledge since the delivery of the particulars of objection. His proper course is to obtain leave by summons or by serving short notice of motion **for leave to amend,** when an order will be made upon the terms mentioned above; and with an added term to delay the trial should it appear just that the plaintiff should have time to investigate the new evidence (*a*).

Objections on the ground of **prior publication** stand very much upon the same footing as those on the ground of prior user.

If the prior publication is alleged to be in books or newspapers, the plaintiff is entitled to be told the name of the book or newspaper, and to give such details of the books or newspapers as will enable them to be found and identified by the plaintiff (*b*).

In *Fowler* v. *Gaul* (*c*), the defendants, by their particulars of objections, alleged (inter alia), "5. That the alleged invention was published prior to the patent by certain patents and the specifications thereof (naming them); 8. The plaintiff's specification claims some of the matters specified or patented in certain specifications (naming them)." The District Registrar, affirmed subsequently by

(*z*) Page 298.

(*a*) *Daw* v. *Eley*, L. R., 1 Eq. 38.

(*b*) *Jones* v. *Berger*, 5 M. & G. 208; *Palmer* v. *Cooper*, 9 Ex. 231.

(*c*) Griffin, P. C. 99. See also *Harris* v. *Rothwell*, Griffin, P. C. 109.

the Judge in Chambers and Divisional Court, ordered "better particulars, showing in detail what part or parts of the patents or specifications respectively referred to in the 5th and 8th objections showed prior publication, and what parts were relied on as being claimed by the plaintiff's specification. In default of delivery, objections 5 and 8 to be struck out."

In *Plimpton* v. *Spiller* (*d*), the particulars were—"before the date of the alleged letters patent the alleged invention had been published in England in the 'Commissioners of Patents Journal,' of the 6th February, 1863, and in the 'Scientific American,' of the 24th January, 1863, and in drawings and sketches deposited in the Patent Office library, in July, 1865." Mr. Justice Field directed that the defendant should amend his particulars by stating the **date of the American patent**, and in whose name it had been granted. And also by giving the **pages of the publications** mentioned, but not the lines. And also by giving such written details as would enable the drawings mentioned to be identified, and to state whether the drawings were or were not contained in books, and what books. Notice of objections, on the ground that the grantee of the letters patent was not the first and true inventor, does not stand upon the same footing as objections on the ground of prior user or publication. Sect. 29, sub-sect. 3, does not require the defendant to state more than generally on what grounds he objects, and a statement that his objection is that the **plaintiff was not the true inventor**, that is, that the consideration did not move from him, will be sufficient, care being taken to distinguish this objection from that of prior user or publication.

When the objection is, that the grantee was not the true inventor, the Court will not require the defendant to

(*d*) 20 Solicitors' Journal, 1876, p. 860. See also *Flower* v. *Lloyd*, same reference.

say who was the true inventor (*e*). The fact upon which the objection is based, is the want of consideration, not the fact of some one having performed the invention before. The performance of the invention by some one else before the patent would not, of necessity, invalidate the patent. As, for instance, if it were done in secret; but if the invention was communicated to the grantee, the patent would be void for want of consideration. Now the foundation of the objection is, the fact of that communication, and the knowledge of this, and the time and place of it, might be within the patentee's knowledge only, and might not be extracted from him until in the witness box.

The objection that the specification is insufficient is enough without explaining in what way it is insufficient (*f*). A litigant could scarcely be required to argue his case on paper before he went into Court, and the sufficiency or insufficiency of a specification is to a great extent a matter of mere argument.

In *Jones* v. *Berger* (*g*), it was held that objections that the specification "did not sufficiently distinguish between what was old and what was new," and that the inventor "did not disclose the most beneficial method with which he was then acquainted of practising his said invention," were sufficient.

We have seen that Ord. XIX. rule 6, requires **particulars in case of fraud** to be delivered with the statement of defence.

Fraud is a valid objection to a patent. The practice of the Court is to require accurate and detailed particulars of any fraudulent acts alleged. The species of "fraud, covin, or misrepresentation" should be given (*h*).

When the objection is on the ground of **want of con-**

(*e*) *Russell* v. *Ledsam*, 11 M. & W. 647. But see *Jones* v. *Berger*, 5 M. & G. 208; 1 Web. P. C. 544.

(*f*) *Heath* v. *Unwin*, 10 M. & W. 687.

(*g*) 5 M. & G. 208.

(*h*) *Russell* v. *Ledsam*, 11 M. & W. 647.

formity between the provisional and complete specification, "the defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of this objection of nonconformity. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them. Each case must depend on its own circumstances." Per Cotton, L. J. (*i*), C. A. And when the objection is the insufficiency of the specification, the defendant must condescend to particulars of insufficiency (*k*).

(*i*) *Anglo-American Brush Light Corporation* v. *Crompton*, 34 Ch. D. 152; 56 L. J. Ch. 167; Griffin, P. C. 34.

(*k*) *Crompton* v. *Anglo-American Brush Light Corporation*, 35 Ch. D. 283; 56 L. J. Ch. 802; 57 L. T. 291.

CHAPTER VIII.

INTERROGATORIES.

ORD. XXXI. rule 1, of the Rules of the Supreme Court, 1883, provides that either party to an action, with leave of the Court or a judge, may interrogate the other party.

Interrogatories must be relevant to the issue, and will not be allowed to be used for the purpose of cross-examination. Since it is not possible to say precisely what the issues between the parties are before the statement of defence is delivered, neither party, except under special circumstances, will be allowed to interrogate until that stage of the action has been reached (*a*).

Rule 26 provides that 5*l*., or some further sum, should be brought into Court by the party desiring to interrogate before he shall be at liberty to do so.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

The plaintiff may interrogate the defendant, and the defendant must **answer as to what infringement** he has been guilty of; and he must disclose, if asked, the names and addresses of all persons, whether in England or abroad, from whom he may have received money for the use of articles alleged to be made in infringement of the patent (*b*).

In *Lister* v. *Norton* (*c*), the defendants put in a defence

(*a*) *Mercier* v. *Cotton*, L. R., 1 Q. B. D. 442.

(*b*) *Crossley* v. *Stewart*, 1 N. R. 426; *How* v. *McKernan*, 30 Beav. 547.

(*c*) Griffin, P. C. at p. 119.

denying infringement, and the plaintiff interrogated the defendants, and asked in one interrogatory whether the defendant's firm had not sold imitation sealskins (the patent being for "Improvements in the manufacture of velvets and of pile fabrics in imitation of sealskin and other similar materials") to certain firms, naming sixteen firms. This interrogatory the defendants declined to answer, on the ground that the information was not *bonâ fide* sought for the purposes of the action. Chitty, J., ordered an answer to the interrogatory, unless within fourteen days the defendant admitted infringement.

In a petition for revocation under sect. 26, interrogatories will be allowed to be administered by the petitioner to the respondent, inquiring into the manufacture, use, and sale of the patented article prior to the date of the patent (*d*).

Where a defendant alleged that his process was secret, he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but not to disclose the proportions in which he used the specified materials, or what the additional materials were (*e*).

When there is nothing to show that the defendant has infringed the patent, and he has denied on oath having infringed the patent, the plaintiff will not be permitted to interrogate as to the articles made and sold by the defendant, there being nothing to show that the articles sold infringe the patent. If *Lea* v. *Saxby* (*f*) be read, this proposition will be seen to follow.

Crossly v. *Tomey* (*g*) was an action to restrain infringement. The defendant in interrogatories was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed, and by what process they were made.

(*d*) Haddan's Patent, 54 L. J. Ch. 126.

(*e*) *Renard* v. *Levinstein*, 3 N. R. 665.

(*f*) 32 L. T., N. S. 731.

(*g*) L. R., 2 Ch. D. 533.

It was held that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles he now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration. It was also held in this case, that when the defendant alleged prior user by other persons, he was bound to set forth the names of some of those persons. In the argument of this case, it appears that some confusion existed as to the necessary requirements of particulars of objections and answers to interrogatories. It must be remembered that the answers to interrogatories are on oath, and it can never have been intended by the legislature, when the stringent requirements of particular objections were created, that the defendants should be to swear to these particulars; the penalty upon giving particulars, which at the trial he is not prepared to prove, is that he is mulcted in costs. But it was never intended that he should be prohibited from giving particulars, which, although based upon mere suspicion, he may hope to prove at the trial, perhaps out of the plaintiff's own mouth (*i*).

It appears that Chitty, J., has ordered a plaintiff (patentee) to answer interrogatories with reference to documents which passed between himself and his patent agent at the time the specification was prepared, notwithstanding that the patent agent was also acting in the matter as plaintiff's solicitor and that privilege was claimed (*k*). In the same case interrogatories which sought to compel the plaintiff to particularize the alleged breaches by stating what parts of the plaintiff's specification were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done)

(*i*) See, however, *Finnegan* v. *James*, as to *answers to interrogatories*, L. R., 19 Eq. 72.

(*k*) *Mosely* v. *The Victoria Rubber Co.*, Griffin P. C. 163.

were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

In *Bovill* v. *Smith* (*l*), the following interrogatory was disallowed, "Does not the defendant allege that the plaintiff's invention was publicly used within this realm before the date of the plaintiff's patent? Set forth particularly when, and in what place or places, and in what manner, does the defendant allege that the plaintiff's invention, or any or what part thereof, was publicly used within this realm before the date of the plaintiff's patent." Sir W. Page-Wood, V.-C., said that the plaintiff was not entitled to enquire generally into the way in which the defendant shaped his case in order to find out whether some of the persons alleged by him to have used the process before the date of the patent, were the persons against whom the plaintiff had succeeded in other suits, though he might have asked if the process was the same as that used by A. B., or any one person specifically named, who had been a defendant in some former suit.

A defendant who submits to answer must answer fully: he cannot, by denying the plaintiff's title, escape answering. Discovery of title deeds and of professional communications form an exception. The plaintiff and defendant had both patents for making gelatine; the plaintiff interrogated as to the article manufactured by the defendant, and as to the names and addresses of the customers, and as to prices and profits. The defendant denied all infringement. He said he had made his article according to his own, and not according to the plaintiff's, patent, and he declined to give an account of such article. Held, that notwithstanding his denial, he was bound to do so (*m*). It is doubtful whether this case would be followed

(*l*) L. R., 2 Eq. 459. See also *Daw* v. *Eley*, 2 H. & M. 725.

(*m*) *Swinborne* v. *Nelson*, 16 Beav. 416.

now, for it is difficult to understand how the question could be relevant to the issue. It might be relevant after judgment, but before judgment the issue is, infringement or no infringement. The names of the customers could not bear upon this question.

After trial, and in pursuance of the terms of the judgment, if the plaintiff has been successful he is entitled to interrogate the defendant, or to require that the defendant "should make and file an affidavit stating what machines of the same construction as that supplied by him to A. or B., including such machines as are in his possession or power," see *Seton, 4th ed., p.* 352. The answer or affidavit of the defendant must be complete. In *Murray* v. *Clayton* (*n*), a patentee of improvements in brick-cutting machines, who was a manufacturer of the machines by an agent at the agent's works and not a licensor, having obtained a perpetual injunction against the defendants, (who were also manufacturers of brick-cutting machines), from infringement, the defendants were ordered to file an affidavit stating the number of machines made by them since the date of the patent, and the names and addresses of the persons to whom the same had been sold, and of the agents concerned in the transactions. Upon motion to vary the order, it was held, that the plaintiff was entitled to have discovery of the names and addresses of the purchasers but not of the agents concerned, there being nothing to show that any agents had been employed.

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies that he who is bound to answer must answer fully (*o*).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to

(*n*) L. R., 15 Eq. 115.
(*o*) *Hoffman* v. *Posthill*, L. R., 4 Ch. App. 673.

discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim (*p*).

In determining whether a question is one of fact, and, therefore, to be answered, it makes no difference that it is asked with reference to a written document (*p*).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in the specifications of various patents, and asked him to show in what respects they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were **not questions of fact, and that they related to the plaintiff's case**; the defendant excepted to the answer, and the exceptions were allowed (*p*).

A plaintiff in a patent suit was required by interogatories to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect the correspondence: and that he had sufficiently set out the particulars of the infringement in his bill. These answers were held to be sufficient (*p*).

We have set out the effect of this case at length, because it is founded upon and exemplifies in many ways the principle upon which a defendant may examine a plaintiff. Lord Justice Giffard, in giving judgment, said, "As regards the case of *Daw* v. *Eley* (*q*), it must be always remembered that that was the case of a plaintiff exhibiting interrogatories to a defendant, and it was there held that the plaintiff could not call on the defendant to set forth the particulars of his defence. But when you come to the case of a

(*p*) *Hoffman* v. *Posthill*, L. R., 4 Ch. App. 673.

(*q*) 2 H. & M. 725.

defendant asking questions of a plaintiff, it is a very different thing. It is the defendant's business to destroy the plaintiff's case, and there the defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent, or that what he alleges to be an infringement is not an infringement." Lord Justice Selwyn had said, "Our decision in this case will leave it entirely within the power of the learned Vice-Chancellor to order that all the costs occasioned by the interrogatories, the answer, the exceptions, the hearing the exceptions before him, and the hearing of this appeal, shall be dealt with as he, in his discretion, shall think fit; and if it shall appear that the power which the Court, for the purpose of justice and discovery, gives to the parties to administer interrogatories to each other has been abused, I have no doubt the learned Vice-Chancellor will take care that justice shall be done, and will make the party who is to blame pay all the costs of the improper exercise of this power."

CHAPTER IX.

INSPECTION.

SECT. 30 of the Patents, &c. Act of 1883, provides: "*In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction,* **inspection**, *or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit.*"

The power to order an inspection was always assumed by the Courts; in *Bovill* v. *Moore* (*a*), Lord Eldon said: "There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article; and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by the plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine

(*a*) 2 Coop. Ch. Ca. 56 (n.); Dav. P. C. 361.

similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

The object which the Court has in view in all cases where an inspection is permitted, is to ensure that **the true facts of the case shall be carefully sifted**; but at the same time the Court will take care that the process of the law is not abused, and that an action for infringement shall not be made a means and lever for the discovery of other persons' secrets.

The Court requires before granting an order for inspection that a strong *primâ facie* case shall be made out of infringement (*b*). And when the interests of justice require, the inspection will be granted to scientific witnesses, who will be required to keep any secrets which they may have discovered, and which do not affect the question of infringement (*c*). And in *Flower* v. *Lloyd* (*d*) the Court of Appeal strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott* v. *The Anglo-American Telegraph Co.* (*e*), it was alleged that an inspection would disclose important secrets. Giffard, V.-C., in refusing an order to inspect, said: "Of late years greater readiness has been shown by the Equity Courts to allow inspection in patent cases than by the Courts of Common Law. But it has never been

(*b*) *Morgan* v. *Seaward*, 1 Web. P. C. 169; *Russell* v. *Cowley*, 1 Web. P. C. 458; *Bovill* v. *Moore*, *supra*; *Kynaston* v. *East India Co.*, 3 Swan. 248; *East India Co.* v. *Kynaston*, 3 Bl. Ap. Cas. 153; *The Germ Milling Co.* v. *Robinson*, 55 L. J. Ch. 287; 1 Griffin P. C. 103.

(*c*) See *Russell* v. *Crichton*, 1 Web. P. C. 667 (n.); 15 Dec. Ct. of Sess. 1270.

(*d*) W. N. 1876, 169, 230.

(*e*) 19 L. T., N. S. 46.

considered as a matter of right, nor have the Equity Courts considered themselves as precluded from exercising a proper discretion in applications of this description. The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause, and that the inspection asked for is of material importance to the plaintiff's case *as made out by his evidence.*"

In *Batley* v. *Kynock* (*f*), Sir James Bacon, V.-C., said: "Upon the single point which is raised before me, there can be no doubt that the plaintiff in such a suit as this is entitled to an inspection of the means which the defendants employ in the manufacture of the articles alleged to be violations of the plaintiff's patent, when such **inspection is essential for the purpose of enabling the plaintiff to prove his case**; upon the materials before me that is not made out. There is no allegation by the plaintiff that he cannot make out his case without inspection. But there is on the part of the defendants a plain allegation that inspection is not necessary for the purposes of the suit; upon that only I must decide this question. I would rather not go into the other matters which have been referred to. The description in the specification and the allegation in the bill—but as I read both the description in the specification and the allegation in the bill—I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendant, and if that fact can be made out the plaintiff's case can be clearly established. The mode of making that out is by examination of the cartridges, the means by which they have been made, whether by a machine or hammer or a screw cannot signify in the least if the cartridges of the defendant when made are made upon the principle of the patent claimed by the plaintiff."

(*f*) L. R., 19 Eq. 91.

In *Drake* v. *Muntz Metal Co.* (*g*), before statement of claim application was made to Bacon, V.-C., that the defendants by their proper officer should make an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since date of plaintiff's patent and for inspection. The Vice-Chancellor said that sect. 30 (*supra*) did not give him power to direct an affidavit to be made, but ordered inspection of the machines.

The Court, in the case of *The Patent Type Founding Co.* v. *Walter* (*h*), assumed the jurisdiction to order the defendant to deliver to the plaintiff a **sample of the type made by him so that the plaintiff might have the same analysed,** for the purpose of ascertaining whether the composition was similar to the plaintiff's patented composition.

In some cases where it is necessary, the Court will order the defendant and the plaintiff to give **mutual inspection**, and to show both the patented machine and the alleged infringement at work, and to permit either party to take away any of the work or samples of the work which has been done in their presence (*i*).

The application may be made on motion to the Court or by summons; it is usually made upon the application for an interim injunction, but it is immaterial at what stage of the proceedings the application is made. The evidence in support must be on affidavit, and a *primâ facie* case of infringement must be made out, and that the inspection is material to the plaintiff's case.

Order L. of the Rules of the Supreme Court, 1883, contains some provisions as to inspection which must be noticed.

Rule 3 provides for the inspection of property and the

(*g*) 3 P. O. R. 43.

(*h*) 8 W. R. 353.

(*i*) *Davenport* v. *Jepson*, 1 N. R. 307. See also *The Singer Sewing Machine Co.* v. *Wilson*, 5 N. R. 505, and *The Germ Milling Co.* v. *Robinson*, 55 L. J. Ch. 288.

taking of samples, or for "any observations to be made or experiment to be tried which may be necessary or expedient for the purpose of obtaining full information or evidence." Rule 4: "It shall be lawful for any judge, by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, to inspect any property *or thing* concerning which any question may arise therein."

This last mentioned rule was introduced by the Rules 1883. Before, the parties must have consented to a view being had. In *Jackson* v. *The Duke of Newcastle* (*k*), Lord Westbury said: "A judge is bound to pronounce his decision according to the evidence before him, but his inspection of the premises may bring him to a conclusion directly opposite to that which is established by the evidence."

(*k*) 33 L. J., Ch. 698.

CHAPTER X.

THE TRIAL.

The constitution of the Court which is to hear and determine patent actions is provided for by sect. 28, sub-sect. 1, of the Act of 1883. "*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 hear and try the case wholly or partially, with his assistance; the action shall be tried without a jury, unless the Court shall otherwise direct.*"

Under the old statute, either party had an absolute right to have the questions of fact decided by a jury, and the Court had no power to deprive them of this right (*a*).

Under the 57th sect. of the Judicature Act, 1873, the Court had power, without the consent of the parties, "in any such cause or matter requiring any prolonged examination of documents or accounts, or *any scientific* or local *investigation* which cannot, in the opinion of the Court, or a judge, conveniently be made before a jury, or conducted by the Court through its other ordinary officers, the Court or a judge may at any time, on such terms as may be thought proper, order any question or issue of fact, or

(*a*) *Sugg* v. *Silber*, L. R., 1 Q. B. D. 362.

any question of account arising therein, to be tried either before an official referee, to be appointed as hereinafter provided, or before a special referee to be agreed on between the parties; and any such special referee so agreed on, shall have the same powers and duties, and proceed in the same manner as an official referee. All such trials before referees shall be conducted in such manner as may be prescribed by rules of court, and subject thereto in such manner as the Court or judge ordering the same shall direct."

In the case of *Saxby* v. *The Gloucester Wagon Co.* (*b*), Mr. Justice Hawkins was of opinion that a patent case was a case which required a "prolonged scientific examination," and consequently he remitted the action to that which he considered the most proper tribunal for difficult scientific questions, "*the official referee.*" We are inclined to think that sect. 28 of the Patent &c., Act, does away with this option. The words appear to read, "*The Court may employ an assessor, and shall do so on the application of either party, and* shall *try the case; and the action* shall *be tried without a jury, &c.*"

Ord. XXXVI. rule 5 of the Rules of the Supreme Court, provides, "The Court or a judge may direct the trial, without a jury, of any cause, matter, or issue, requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in their or his opinion, conveniently be made with a jury;" and rule 6: "In any other cause or matter, upon the application of any party thereto, for a trial with a jury of the cause or matter, or any issue of fact, an order shall be made for a trial with a jury." These rules, together with the provisions of sect. 28 of the Patent Act, would show that the better opinion probably is that, unless a judge or the Court otherwise orders, the constitution of the Court

(*b*) W. N. 1880, p. 28.

shall be a judge sitting without a jury, and with or without an assessor.

The grounds of application for a trial by jury would be that the evidence shows a **conflict of testimony** in material parts, or that **grave questions of credibility** are likely to arise, or that a **charge of fraud** is made against either party.

Mr. Hindmarch, at p. 291 of his celebrated work, says: "Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law and difficult questions of fact must often be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions and prepare the necessary proofs, a competent knowledge not only of law, but also of science in general and the useful arts, is essentially requisite."

It is no ground for **postponing the trial of an action for infringement** that a petition has been presented by the defendant or any other person under sect. 26 to revoke the patent.

We have seen that proceedings for revocation are similar to, and for the same purpose as, *scire facias* prior to the Act of 1883. In *Muntz* v. *Foster* (*c*) it had been held that the fact of a writ of *scire facias* being pending was no ground for staying the action for infringement. Tindal, C. J., said: "As a general rule, a plaintiff has a right to have his cause go on for trial according to the ordinary course of business. Special circumstances may exist upon which the Court may see fit to interfere; but the present does not appear to us to be a case in which we ought to interfere by staying the proceedings in the action."

(*c*) 2 Web. P. C. 93 (n.), 1 Dowl. & Low. 942.

The ground of this decision was that the plaintiff in the action for infringement, being defendant in the proceedings by *scire facias*, had not the conduct of those proceedings, and that the defendant in the action for infringement might delay them; but where in *Patteson* v. *Holland* (*d*), an action for infringement had been tried, and a rule nisi for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And where a verdict had already gone for the Crown on *scire facias*, but a new trial was pending, the plaintiff was not permitted to proceed to trial with his action for infringement until the rule for the new trial in *scire facias* had been disposed of (*e*).

In an action for infringement the plaintiff has the **right of beginning and of replying**, notwithstanding that the burden of proof may really be on the defendant, as, for instance, where the case principally turns upon questions of prior user or prior publication, which are introduced by the defendant. It sometimes happened that this privilege, particularly in cases of conflicting evidence, was of great value, and for the purpose of snatching it from the plaintiff the defendant did not wait for the plaintiff to commence his action, but commenced proceedings himself by *scire facias* to repeal the patent, so as to place himself in the position of plaintiff. But, by sect. 26, sub-sect. 7, of the Act of 1883, it is provided that in cases where it is sought to **revoke a patent**, "*The defendant shall be entitled to begin and give evidence in support of the patent,*

(*d*) Hindmarch, 293.

(*e*) *Smith* v. *Upton*, 6 M. & G. 251.

and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply."

The plaintiff must give evidence of the issues, which he is bound to prove. It is for him to support his patent and to establish its validity. He must prove his patent if the grant be denied. This is done by producing the patent itself, with the great seal—or, under the Act of 1883, the seal of the Patent Office—attached to it; sect. 12, sub-sect. 2, provides that, "*A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom*"; or under sect. 89, if it be not convenient or possible to produce the original, "*Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.*"

If the plaintiff sues as assignee, or under any derivative title, and his title is denied, the entry from the register of patents may be proved in the manner suggested by the 89th section.

Under the 96th section "*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.*"

For instance, if an entry in the register is denied by the defendant, he may prove its omission by a certificate under the 96th section.

If the fact of infringement is denied, the plaintiff must

be ready with evidence that the defendant has made, used or sold the article or process, and any one of these acts will satisfy the allegation of infringement, whether the infringement was **intentional or not** (*f*). **Mere possession** unaccompanied by user, does not amount to infringement (*g*). Evidence that the **defendant has sold** articles made by a patented process, or by a patented machine, will be sufficient (*h*). If the defendant has **imitated the plaintiff's process**, or substituted chemical or mechanical equivalents, he will have infringed the patent (*i*), and the plaintiff must be ready with expert and other evidence to satisfy the Court that the defendant has substantially imitated his process or article. It is an infringement to import and use or sell a patented article; although it is **no infringement to merely import** and no more (*k*). If an article, by its appearance or properties, can be distinguished as having been made by a patented process, and the defendant will not permit the plaintiff to see how it is made, Lord Ellenborough held, that a *primâ facie* case had been made out, which it was for the defendant to rebut (*l*). But the mere fact that there is a **similarity of appearance** between an article made by the patented process and the alleged infringement, is not sufficient: there must be reasonably satisfactory evidence that a similar article could not be produced in any other manner; that, in fact, it carries the footprint of the invention with it (*m*). It will be observed, that when **expert witnesses** are called for the purpose of proving infringement in this manner, they must be asked whether there is a similarity between the patented article

(*f*) *Stead* v. *Anderson*, 4 C. B. 806, and ante, p. 168.

(*g*) Ante, p. 189.

(*h*) *Wright* v. *Hitchcock*, L. R., 5 Ex. 37.

(*i*) Ante, p. 179.

(*k*) Ante, p. 189.

(*l*) *Huddart* v. *Grimshaw*, Davis, P. C. 288. See also *Betts* v. *Neilson*, L. R., 5 H. L. 11 and 12.

(*m*) See *Palmer* v. *Wagstaff*, 9 Ex. 494; 23 L. J., Ex. 217; 2 C. L. R. 1052; and *Davenport* v. *Richards*, 3 L. T., N. S. 504.

and the alleged infringement, and also whether there is any other process, except the patented process, which will produce that similarity; but they cannot be asked their opinion as to whether or not there has been infringement. That is a question for the jury, or the Court in the absence of a jury (*n*).

The Court will consider the circumstances of the case, the behaviour of the witnesses and their credibility, when considering the question of infringement or no infringement.

In *Clark* v. *Adie* (*o*), Lord Blackburn said:—"Whenever a man knowing for the first time of an invention, either by seeing a machine at work or by reading a specification, proceeds to do what he never did before, and takes a part of the invention, it is always a very strong *argumentum ad hominem* to say: You are, by the very fact of taking this, making evidence against yourself that it was a new invention; otherwise, why did you take it? You are making evidence against yourself that at all events the part you took was new, or why did you take it? and whenever there is a case of theft or stealing knowingly, that observation ought to have some weight, although I think in practice it has more weight given to it than it ought to have. But where there is a case of an innocent infringement of property, by an unwitting use of this sort, that observation can have no weight against the party in the slightest degree, and I think it ought not to have any."

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no necessity of entering upon the defendant's case on other matters. The plaintiff must always give evidence

(*n*) Per Lord Wensleydale in *Seed* v. *Higgins*, 8 H. L. Cas. 550.

(*o*) L. R., 2 App. Cas. 337.

when the alleged infringement is the sale or use of an article, **that it was not made by himself or his agents** (*p*).

When the defendant alleges that there is a **defect or insufficiency in the specification**, the burden of proving that there is no such defect is on the plaintiff.

We have seen (*q*) that it is for the jury to say whether a specification is **sufficient** or **intelligible** or not: it is for the Court to place a **construction** upon the language used in the specification. The plaintiff must therefore be prepared with evidence of an expert character as to the sufficiency of the specification; and in selecting this evidence the plaintiff cannot be better guided than by the judgment of Sir George Jessel in *Plimpton* v. *Malcolmson* (*r*): he must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose "ordinary workmen" in the particular branch of trade to which the invention refers—"not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description." He may, of course, call eminent engineers, but their evidence can only be, "placing myself in the position of an ordinary workman I think it would or would not be intelligible or sufficient to me." If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentees, and the plaintiffs will be nonsuited (*s*).

Experiments conducted for the express purpose of manu-

(*p*) *Betts* v. *Wilmott*, L. R., 6 Ch. 239.

(*q*) Ante, pp. 72 and 73.

(*r*) L. R., 3 Ch. D. 531.

(*s*) *Brooks* v. *Ripley*, 2 Lond. Jour. C. S. 35.

facturing evidence, with a view to litigation, are to be looked at with distrust (*t*).

The plaintiff must, if the matter be put in issue, prove that the title, provisional specification and complete specification, correspond and substantially describe the same invention (*u*).

If it is alleged by the defendant that the invention is illegal or useless, the burden of proof is on the plaintiff (*x*).

So the plaintiff must be prepared, if he intends to claim damages, and not on account, to prove the damage which he has sustained. If he has been in the habit of granting royalties, the amount of royalties to which he would have become entitled is the proper measure of his damages; as to the measure of damages in other cases, see *ante*, *p.* 203 *et seq.*

When the **defendant pleads** that the grantee of the letters patent was **not the true and first inventor,** or **that the invention was not new,** it will be sufficient if the plaintiff gives some *primâ facie* evidence of novelty (*y*). It will be sufficient to call one or two persons acquainted practically with the trade to which the invention refers, to say that they never heard of it, or saw or heard of its having been put in practice or published before the date of the patent. Gibbs, C.J., said: "The first witness, a man of considerable experience, had never seen locks with the lips so perforated; *primâ facie* that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before would be of no avail if one was called who had seen it and practised it" (*z*).

The plaintiff having given this *primâ facie* evidence, **the burden of proof** as to prior user or prior publication **is**

(*t*) *Young* v. *Fernie*, 4 Giff. 609.
(*u*) Ante, p. 60 et seq.
(*x*) Ante, p. 255.
(*y*) *Turner* v. *Winter*, 1 T. R. 606.
(*z*) *Manton* v. *Manton*, Dav. P. C. 350.

shifted to the defendant, and if he would invalidate the patent he must prove his case.

We have previously discussed what amounts to prior user and prior publication (*a*). The evidence which the defendant brings must be complete and satisfactory, and the question is one of fact.

If the defendant has succeeded in establishing a case against the plaintiff, the latter will be permitted before the defendant sums up, **to adduce rebutting evidence.** In *Penn* v. *Jack and Others* (*b*), Sir W. Page-Wood, V.-C., said: "I think the plaintiff is entitled to adduce evidence, in reply, for the purpose of rebutting the case set up by the defendants; and for this reason, that it is quite impossible for him to know what is the nature of the evidence which is to be produced. The defendants, who contest the validity of the invention, have in effect put in a plea denying the novelty of the plaintiff's patent; and the affirmative of the issue thus raised in reality rests with the defendants, who are not obliged to give the names of their witnesses. How can the plaintiff possibly meet such a case until he hears the evidence for the defence, and knows what their witnesses will prove? I should be very sorry to have to put the parties to all the expense and delay of a new trial, which I should have to direct, if this evidence were excluded. Besides which, the witnesses are at hand and ready, and the sensible and obvious course is to examine them now. The practice at common law is stated in Taylor on Evidence; and it appears that where, as here, several issues are joined, the plaintiff may content himself with adducing evidence in support of those issues which he is bound to prove, reserving the right of rebutting his adversary's proofs, in the event of the defendant establishing a *primâ facie* case with respect to the issues which lie upon him. In support of this proposition, *Shaw* v. *Beck* (*c*) is

(*a*) Ante, pp. 35 and 41. (*b*) L. R., 2 Eq. at p. 317
(*c*) 8 Ex. 392.

cited, where Parke, B., used the following expression: 'But Abbott, C.J., laid down what appears to me to be a more reasonable rule, by holding that the defendant was bound to prove his plea, and that the plaintiff might answer it by additional evidence.' Other instances are also mentioned, all showing the wide discretion given to the judge in allowing evidence to be given by the plaintiff in reply. The plaintiff has put in his letters patent as formal evidence of his title. The defendants then plead want of novelty, and give, in proof of the issues thus raised by them, special evidence, which the plaintiff is entitled to rebut, by evidence, in reply. Regarding this case as one of an affirmative plea, the burden of proving which rests on the defendants, I feel bound to admit the evidence proposed to be given by the plaintiff in reply."

Although the plaintiff may, as of right, rebut the case made by the defendant, upon any issue which rests with the defendant, where the plaintiff has given such rebutting evidence, **the defendant will not be allowed to strengthen the case which he had made by adducing further evidence**; and this will apply with greater force when the defendant's counsel has summed up the evidence which has been offered (*d*).

At the hearing of the action, **no objection will be allowed, either to the particulars of objections, or to the particulars of breaches,** and any evidence will be received which they are wide enough to admit of. If there is any vagueness or insufficiency in the particulars, the party requiring further information must apply for it to a judge in chambers, within reasonable time before the trial of the action; but they will not be allowed to permit the opposite side to go to trial, and then to submit that, for want of sufficient particularity in the objection, the evidence is not admissible (*e*).

(*d*) *Penn* v. *Jack*, L. R., 2 Eq. at p. 318.

(*e*) *Neilson* v. *Harford*, 8 M. & W. 806; *Hull* v. *Bolland*, 1 H. & N. 134.

In *Sykes* v. *Howarth* (*f*), the plaintiff delivered particulars of breaches in May, 1878, which stated that the defendant had at divers times between the 29th of May, 1879, and the commencement of the action, infringed the plaintiff's patent by the manufacture, or sale, or use of fancy rollers, and in particular by fancy rollers manufactured and sold by or covered with cards, by the defendant, for Messrs. Shaw and Mr. Smith. In July, 1878, the statement of defence was delivered. It stated, "The defendant has made and sold to Messrs. Samuel Shaw and Co. and Mr. Charles Smith, in the particulars of breaches in this action respectively mentioned, and to other persons, certain cards (in all six sets), which were all $2\frac{1}{2}$ inches in width;" and the defendant, in answer to interrogatories, disclosed the name of Hirst as one of the persons supplied with such sets of cards. Mr. Justice Fry admitted evidence in Hirst's case. He said: "The defendant did not apply for amended particulars, according to the case of *Hull* v. *Bolland* (*supra*). It appears to me I have to inquire what is the meaning of the particulars. I find that the case of Hirst is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised in Smith's or Shaw's case, I should probably have given an opportunity to the defendant to bring any fresh evidence." The learned judge would not have ruled that the plaintiff was prevented from giving the evidence in Hirst's case, but he would have allowed the defendant to rebut it.

These decisions must not be confused with a case where, for example, the particulars alleged infringement or prior user at London and Liverpool. In such a case no act of infringement or prior user would be admitted in evidence which did not occur at London or Liverpool, but if the words were London, Liverpool, or elsewhere, then the

(*f*) L. R., 12 Ch. D. 826.

evidence might extend to any part of the country, because any evidence would come within the strict meaning of the objections.

Upon the trial no evidence will be received in support of any issue which is not raised in the pleadings. In *Bovill* v. *Goodier* (*g*) it was held that an objection to the validity of a patent on the ground of the expiration of a foreign patent for the same invention, cannot be taken at the hearing of a suit to restrain the infringement of a patent unless it has been raised by the answer.

(*g*) L. R., 2 Eq. 195.

CHAPTER XI.

QUESTIONS FOR COURT AND JURY.

We have seen that as a rule actions for the infringement of letters patent are directed to be tried before the Court without a jury. Still, under special circumstances, the parties, or either of them, may obtain an order to try before a jury. Under these circumstances it will still be material to consider what are the questions which the Court should leave to the jury, and which are left to the decision of the Court.

As to the specification. **The construction is for the Court** (*a*); and the rules of construction are similar to those which govern the construction of other documents(*b*). In *Hills* v. *Evans* (*c*), Lord Westbury said: "It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents), that all these are matters of fact upon which

(*a*) *Hills* v. *Evans*, 31 L. J., Ch. 457; *Seed* v. *Higgins*, 8 H. L. Cas. 561; *Bovill* v. *Pimm*, 11 Ex. 740.

(*b*) *Simpson* v. *Holliday*, 20 Newton's Lon. Jour. N. S. 105.

(*c*) 31 L. J., Ch. 457.

evidence may be given, contradictory testimony may be adduced, and upon which undoubtedly it is the province and the right of a jury to decide. But when these portions of a specification are abstracted and made the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction given only conditionally, that is to say, a direction as to the meaning of the patent upon the hypothesis or the basis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. And so the rule is given by Parke, B., in delivering the judgment of the Court of Exchequer in the case, I think, of *Neilson* v. *Harford* (*d*). The language of the learned judge, which I adopt, is in these words: 'The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments as soon as the true meaning of the words in which they are couched and the surrounding circumstances, if any, have been ascertained as facts by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained, or conditionally, when those words or circumstances are necessarily referred to them.' Now, adopting that as the rule in the comparison of two specifications, each of which is filled with terms of art and with the description of technical processes, the duty of the Court would be confined to this—to give the legal construction of such documents taken independently. But, after that duty is discharged, there would remain a most important function to be still performed,

(*d*) 8 M. & W. 806.

which is the comparison of the two instruments when they have received their legal exposition and interpretation; and as it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of comparing the two, and ascertaining whether the words, as interpreted by the Court, contained in specification A, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in specification B, is a matter of fact, and is, I conceive, a matter within the province of the jury, and not within the function of the Court."

Epitomising this elaborate judgment. When the language used is that which has an ordinary and legal meaning the question is, what has the man said? not what did he intend to say? and, therefore, the Court will place the legal meaning on his words. When the language used is that which has no ordinary legal meaning, or which under different circumstances may have two or more ordinary legal meanings, the question is, as a fact, with what meaning did the writer use the words or expressions which he has used? and that is a question which the Court should require the jury to solve. The matter could not be placed more lucidly than it is by Lord Westbury in the last dozen lines of the judgment which we have quoted.

It is for the jury to say whether the specification is **intelligible** (*e*) or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible (*f*).

It is for the jury to say whether the specification is **sufficient** or not, that is, whether it contains a sufficient description of the invention; but it is for the Court to

(*e*) *Neilson* v. *Harford*, 1 Web. P. C. 295.

(*f*) See cases cited at p. 80 et seq.

inform the jury the degree of sufficiency which the law requires in specifications (*g*).

The novelty of the invention is a question for the jury. Questions of prior user or prior publication are always questions of fact, and it is for the jury to compare what has been done before and what is set up as being new, and to say whether or not they are identical. And so any document which is said to amount to prior publication must be construed by the Court, but it is for the jury to **compare it with the specification** and to say whether the described matter is the same or not (*h*).

The **utility of the invention is also for the jury,** subject to the directions of the Court as to the degree of utility which the law requires for the purpose of supporting the validity of a patent (*i*).

The question of infringement is for the jury. In *De la Rue* v. *Dickinson* (*k*), Campbell, C. J., said :—"There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But, if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the

(*g*) *Hill* v. *Thompson*, 1 Web. P. C. 235 ; *Bickford* v. *Skewes*, 1 Q. B. 938 ; *Neilson* v. *Harford*, 1 Web. P. C. 295 ; *Walton* v. *Bateman*, 1 Web. P. C. 621 ; *Beard* v. *Egerton*, 19 L. J., C. P. 38 ; *Wallington* v. *Dale*, 7 Ex. 888 ; *Parkes* v. *Stevens*, L. R., 8 Eq. 358, and L. R., 5 Ch. Ap. Cas. 36.

(*h*) *Cornish* v. *Keene*, 1 Web. P. C. 519 ; *Elliott* v. *Aston*, 1 Web. P. C. 222 ; *Muntz* v. *Foster*, 2 Web. P. C. 107 ; *Spencer* v. *Jack*, 11 L. T., N. S. 242.

(*i*) *Hill* v. *Thompson*, 1 Web. P. C. 237 ; *Bloxam* v. *Elsee*, 1 C. & P. 565 ; *Cornish* v. *Keene*, 1 Web. P. C. 506 ; *Morgan* v. *Seaward*, 1 Web. P. C. 186 ; *Macnamara* v. *Hulse*, C. & M. 471.

(*k*) 7 E. & B. at p. 755.

defendant actually has used such means, the question becomes one of fact, mixed with law, which the judge is bound to submit to the jury."

In *Seed* v. *Higgins* (*l*), Lord Chelmsford in the House of Lords said :—" What the defendant had done in any case was of course a question of fact, but whether, on proof of certain acts having been done by a defendant, the plaintiff had any case to go to a jury, was a question for the judge " (*m*).

(*l*) 30 L. J., Q. B. at p. 317.

(*m*) See also *Walton* v. *Potter*, 1 Web. P. C. 586 ; *Macnamara* v. *Hulse*, Car. & M. 471 ; *Newton* v. *Grand Junction Rail. Co.*, 5 Ex. 331 ; *Stevens* v. *Keating*, 2 Web. P. C. 191 ; *Sellers* v. *Dickinson*, 5 Ex. 323 ; *Curtis* v. *Platt*, 35 L. J. Ch. 852.

CHAPTER XII.

CERTIFICATES.

SECT. 31 of the Patents, &c., Act, 1883, is as follows :—"*In an action for infringement of a patent, the Court or a judge may* **certify that the validity of the patent came in question**, *and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.*"

Similar provisions were contained in 5 & 6 Will. IV. c. 83, and also in the 43rd section of the Patent Law Amendment Act, 1883.

The object of these sections is to prevent patentees of important inventions being ruined by successive actions, which they are bound to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

The Act of William IV. cited above gave the patentee a right to treble costs, but this was taken away by 5 & 6 Vict. c. 97, which gave him full costs; and now, as we have seen, costs as between solicitor and client are substituted for full costs.

In *Otto* v. *Steel* (*a*), Pearson, J., refused costs as between

(*a*) Griffin P. C. 182.

solicitor and client in a second action, after a certificate had been obtained in a first action, on the ground that the patent was **impeached on grounds substantially different** from those relied on in the first action.

To acquire the protection of the 31st section a certificate is requisite, and this should be applied for at the trial of the action, and the application must be made to the Court or judge who have tried the cause (*b*).

The Court have no power to order full costs upon the first trial in which the validity of the patent came in question, the words of the statute being "in any subsequent action for infringement" (*c*).

Where several simultaneous actions have been brought, and one of them has been made a test action and proceeded with to trial, upon a certificate being given in that action it will not operate upon the others (*d*).

An action was compromised at the trial by a verdict being entered for the plaintiff in the action for 40*s.* damages and costs, with all usual certificates. Subsequently, upon an ex parte application, the judge endorsed on the record a certificate that the record in a certain action, wherein Bovill was plaintiff and Keyworth was defendant, and the certificate thereon endorsed was given in evidence at the trial of this action (*Bovill* v. *Hadley*), it was held that this certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being under the circumstances a "usual certificate" within the contemplation of the parties (*e*). Upon the trial of the second action the record of the first action with the endorsement must be produced, but not before the verdict, in such a manner as to prejudice the second trial (*f*).

(*b*) *Gillet* v. *Green*, 7 M. & W. 347.

(*c*) *Penn* v. *Bibby*, L. R., 3 Eq. 308.

(*d*) *Penn* v. *Fernie*, L. R., 3 Eq. 308.

(*e*) *Bovill* v. *Hadley*, 17 C. B., N. S. 435.

(*f*) *Newall* v. *Wilkins*, 17 L. T. 20.

The certificate of the judge, which is granted for the purpose of affecting the costs in future cases, is one which cannot be given by consent. In obtaining this certificate **the plaintiff and the country are the parties, not the defendant,** and the judge is bound to protect the interests of the country and to see that the certificate is not given when the validity of the patent has not, in fact, been proved to the satisfaction of the Court; otherwise, there is nothing to prevent collusive actions being merely brought for the purpose of obtaining this valuable privilege—a privilege which can be used as an enormous lever, preventing persons from incurring the risk of a conflict with the patentee (*g*).

No appeal will lie from a granting or refusing to grant a certificate that the validity of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (*h*).

We have seen that the object of this section is to prevent the patentee from being repeatedly harassed by the validity of his patent being called in question in succession of actions. It does not appear ever to have been decided whether, when in a second action the validity of the patent is not called in question, but there is a mere denial of infringement, the section applies. It is submitted that such a case was not within the contemplation of the legislature, and that the judge should direct only party and party costs whenever the validity of the patent is not called in question.

Sect. 29 of the Act of 1883, after providing for the delivery of particulars of breaches and objections, enacts: "(6) **On taxation of costs** *regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively* **shall not be allowed any**

(*g*) *Stocker* v. *Rodgers*, 1 C. & K. 99.

(*h*) *Haslam Foundry and Engineering Co.* v. *Hall*, 20 Q. B. D. 491.

costs *in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper without regard to the general costs of the case.*"

Where the plaintiff is successful on some issues and the defendant on some the costs should be apportioned (*i*). In *Simmonds* v. *Hitchman*, noticed L. R. 29 Ch. D. at p. 417, costs were apportioned by Bacon, V.-C. In *Badische Anilin Fabrik* v. *Levinstein* (*k*), in the Court of Appeal, Bowen, L.J., said: "I am of opinion in this case that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result and be awarded to the successful party. It seems to me that without laying down any hard and fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that the parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable with regard to their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated, but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense. The order, therefore, I think ought to be as I have stated."

The certificates granted under this section must not be confused with the certificate under sect. 31. The object of sect. 29 is to provide what costs shall be payable in the action itself, and the object of sect. 31 is to provide for the costs of future actions.

Care must be taken at the trial to ask the judge to

(*i*) *Wegmann* v. *Corcoran*, L. R. 13 Ch. D. 65; 27 W. R. 357; *Young* v. *Rosenthal*, 2 P. O. R. 41.

(*k*) L. R., 29 Ch. D. at p. 418. See also *Pooley* v. *Pointon*, Griffin, P. C. at p. 200.

certify as to each particular breach mentioned in the particulars of breaches, and as to each particular objection, and no costs of witnesses, or of, and incidental to, such breach or objection, as is not specially certified for, will be allowed (*l*). The Court of the County Palatine cannot grant a certificate, not being a "Court" within the meaning of the Patent, &c., Act, 1883 (*m*), and this appears to be confirmed by sect. 26 of the Patents, &c., Act, 1888. The certificate is not a judgment or order under sect. 19 of Judicature Act, 1873, and therefore there is no appeal from the judge who grants or refuses it (*n*).

If an action is not tried out, it is obvious that a difficulty may arise as to costs, since the parties have had no opportunity to prove or disprove their particulars. In *Greaves* v. *The Eastern Counties Railway Co.* (*o*), it was held that where the defendant had delivered particulars of objections, and just before trial the plaintiff had abandoned his action, thus giving the defendant no opportunity of proving or disproving his objections, the defendant was entitled to the costs of the objections and of the witnesses, for the act did not apply, except where the cause came on for trial. It will be observed, however, that there is a difference between the language of the 43rd sect. of the Patent Law Amendment Act, 1852, and the language of the 29th sect. sub-sect. (6) of the Patents, &c. Act, 1883. In the former case the words were: "Shall not be allowed any costs in respect of any particular unless certified by the *judge before whom the trial was had to have been proved.*" Under the latter statute: "*Shall not be allowed any costs in respect of any particular delivered*

(*l*) *Honiball* v. *Bloomer*, 10 Exch. 538. See also *Losh* v. *Hague*, 5 M. & W. 387, and *Parnell* v. *Mort Leddell & Co.*, 29 Ch. D. 325.

(*m*) *Proctor* v. *Sutton Lodge Chemical Co.*, 5 P. O. R. 184.

(*n*) *Haslam* v. *Hall*, 5 P. O. R. 144.

(*o*) 1 E. & E. 961.

by them, unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper." It is submitted that the practice under the new act when the action has not been tried is to take out a summons before a judge at chambers for a certificate, on the ground that the particulars were reasonable and proper; such summons should be supported by an affidavit, alleging that the plaintiff or defendant had reasonable grounds for believing that he would at the trial have been able to prove the particulars in respect of which application is made; but a certificate so granted will not operate in a manner to entitle the plaintiff to costs as between solicitor and client in any subsequent action.

Since the above was written the point in question has arisen in *Peroni* v. *Hudson* (*p*), where the defendant did not appear on the trial. Kay, J., gave a certificate that the plaintiff had proved his particulars, but refused to certify that the validity of the patent came in question, holding that sect. 31 only applied where the patent was established in a case contested in Court.

We have seen that since the Judicature Acts, the Common Law Division and the Chancery Division can either of them grant full relief in an action for the infringement of a patent, **granting both an injunction and damages, or an account.** In olden times the Common Law Courts merely inquired into damages, and if less than 40*s.* was recovered a question arose as to whether or not County Court costs should not alone be allowed; but now in every patent case an injunction may be granted, and this removes the case from the operation of 30 & 31 Vict. c. 142, s. 5.

The Rules of the Supreme Court, 1883, provide for cases where the **higher scale and lower scale of costs** are to be allowed; and in future, notwithstanding that an injunction

(*p*) Griffin, P. C. 183.

is granted, it will be necessary to ask the judge at the trial to certify for costs on the higher scale.

Order LXV. r. 8, provides: "In causes and matters commenced after these rules come into operation, solicitors shall be entitled to charge and be allowed the fees set forth in the column headed 'lower scale,' in Appendix N. in all causes and matters, and no higher fees shall be allowed in any case, except such as are by this order otherwise provided for; and in causes and matters pending at the time when these rules come into operation, to which the higher scale of costs previously in force was applicable, the same scale shall continue to be applied."

Rule 9.—"The fees set forth in the column headed 'higher scale' in Appendix N. may be allowed, either generally in any cause or matter, or as to the costs of any particular application made, or business done, in any cause or matter, if, on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or a judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of every application therein, whether the cause or matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be) so order; or if the taxing officer, under directions given to him for that purpose by the Court or a judge, shall think that such allowance ought to be made upon such special grounds as aforesaid."

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs; but this was held not to apply where the costs were a matter of right, and not discretionary (*q*). Under the Rules of Court, which were in operation prior to the 24th October, 1883, the question of higher or lower scale was a matter of right (*r*). Hence,

(*q*) *Turner* v. *Hancock*, C. A., 20 Ch. D. 303.

(*r*) Rules of S. C. Dec. 1875

in *Re Terrell* (*s*), the Court of Appeal held that there was an appeal, but now it will be observed that the order is in the absolute discretion of the judge, and, therefore, it is submitted there is no appeal.

The **directors of a limited company,** whose servants have infringed a patent, **may be ordered to pay costs personally.** Sir W. Page-Wood, in *Betts* v. *De Vitre* (*t*), said: "Where there is a wilful act against the rights of a patentee, after he has obtained a verdict, and the certificate of a judge, that his title came in question, all the world must be taken to know that that was fairly and completely tried and disposed of, and, if they infringe the patent, they infringe it with a liability for costs." The reasoning of this decision is not quite clear, and it is submitted that, should the question arise again, the opinion of the Court of Appeal might be taken on the subject, regard being had to the case of *Denley* v. *Blore* (*u*).

Judgment having been recovered, minutes of judgment should be prepared. The minutes will be in accordance with one or other of the precedents given hereafter. We have drawn attention in previous pages to those points which should be attended to in preparing these minutes. Care should be exercised when an account is directed to be taken that provision be made for the **payment of costs to the plaintiff up to and including the hearing,** otherwise the payment of all costs will be delayed until the final account has been taken, which in some cases has been known to amount to a delay of years.

(*s*) L. R., 22 Ch. D. 473.
(*t*) 11 Jur., N. S. 11.
(*u*) 38 Lond. Jour. 224.

CHAPTER XIII.

PRACTICE ON PETITION FOR REVOCATION.

THE Rules of the Supreme Court apply to a petition for revocation and the word plaintiff in Ord. XXXI. r. 1, includes petitioner (*a*).

All persons are not empowered to petition for revocation of a patent.

The parties who may petition are specified in sect. 26, sub-sect. 4, of the Patents Act, 1883.

The petition must be presented to the High Court of Justice.

A form of petition, applicable to such a case is given hereafter (*b*).

Sub-sect. (5). "*The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.*"

The practice as to particulars is precisely similar to that in an action for infringement. It will, however, be observed that the judge has no power of certifying under sect. 31 that the validity of the patent came in question, nor will a certificate granted in a previous action for infringement affect the question of costs in proceedings for revocation, the words of sect. 31 being "*in any subsequent action for infringement.*"

(*a*) *Haddan's Patent*, 54 L. J. Ch. 126. (*b*) Page 288.

Sect. 100 of the Judicature Act, defines "Pleading" as including any *petition* or summons, and also as including the statements, in writing, of the claims or demand of any plaintiff, and of the defence of any defendant thereto, and of the reply of the plaintiff to any counter-claim of a defendant.

Ord. XXXI. r. 1, of the Rules of the Supreme Court, gives power to the Court, or a judge, to permit interrogatories "*in any other cause or matter*," to be delivered by either party to the other. It is presumed that leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner, and circumstances may arise when it would be just to permit the petitioner to examine the respondent. The rules as to interrogatories will be similar to those in an action for infringement.

The respondent having entered an appearance to the petition, the same will be set down for trial.

There does not appear to be any provision that the petition should be verified by affidavit, or that the respondent should deliver an answer.

The respondent should be careful that the **particulars of objections are sufficiently precise and accurate**, otherwise he may be taken by surprise at the hearing (*c*). He may apply for further and better particulars in the same manner as in an action for infringement; and under sect. 26, sub-sect. (6), "*Particulars delivered may be, from time to time, amended by leave of the Court or a judge.*"

Sect. 28, sub-sect. (1), provides that the mode of trial of a petition for revocation shall be similar to that of an action for infringement.

And the parties are entitled to have the petition heard as *viva voce* evidence (*d*).

(*c*) Ante, p. 228 et seq.

(*d*) *Goulard and Gibbs' Patent*, 34 Ch. D. 396; 56 L. J. Ch. 606; 56 L. T. 284.

Sect. 26, sub-sect. 7. "*The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.*"

The evidence which will be required of the respondent (defendant), in the first instance, will be very slight, and will be similar to that which he would give as to the validity of the patent were he plaintiff in an action for infringement. The petitioner will then have to prove the case he alleges in his petition and particulars, and the respondent has the right of reply. It is merely to preserve this right to reply, that the respondent is made practically plaintiff at the trial.

It is very doubtful whether sect. 29, sub-sect. (6), will be held to apply to petitions for revocation. Sub-sect. (1) of the same section, limiting, apparently, the operation of that section to actions for infringement, as distinguished from sect. 28, which deals with both actions for infringement and petitions for revocation.

CHAPTER XIV.

PRACTICE ON APPEAL.

UNDER Order LVIII. rule 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court together with full discretionary power to receive further evidence upon questions of fact, such evidence to be either by oral examination in Court, by affidavit, or by deposition taken before an examiner or commissioner. Such further evidence may be given without special leave upon interlocutory application or in any case as to matters which have occurred after the date of the decision from which the appeal is brought. Upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence (same as to matters subsequent as aforesaid) shall be admitted on special grounds only, and not without special leave of the Court.

Leave to *amend particulars* of objections to letters patent was refused where the case had been argued throughout on the footing that no such amendment was necessary (*a*).

As to *further evidence* in *Hinde* v. *Osborne* (*b*), Lindley, L.J., said: "The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by Order LVIII. r. 4. I cannot understand that as meaning that the Court of Appeal ought to grant leave to

(*a*) *Cropper* v. *Smith*, 26 C. D. 700; but see remarks of Bowen, L. J., at pp. 710, 711.

(*b*) Griffin, P. C. at p. 127.

adduce fresh evidence, simply because a man has failed at the trial and he thinks he can get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shown to satisfy the Court that there is some evidence now forthcoming, which, with due diligence, he could not have got, and it must, therefore, in accordance with the usual practice, be evidence, not merely swearing by affidavits or anything of that kind, but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and defects which have been disclosed upon the first trial."

Pending an appeal an *injunction* will under some circumstances be *suspended* (*c*).

On appeal to the House of Lords it was held in a case where the Court of Appeal had held the specification bad and for the defendant on the infringement issue, but the House had reversed the decision on the specification and upheld it on the infringement issue, that each party must pay their own costs of the appeal (*d*).

(*c*) *Hocking* v. *Frazer*, Griffin, P. C. 129.

(*d*) *Moore* v. *Bennett*, Griffin, P. C. at p. 161.

CHAPTER XV.

ACTION FOR INJUNCTION TO RESTRAIN THREATS.

SECT. 32 of the Patents Act, 1883, provides, "*Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise,* **threatens any other person** *with any legal proceedings, or liability in respect of any alleged manufacture in sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase, to which the threats related,* was not, in fact an infringement of any legal rights of the person making such threats: *Provided that this section shall not apply if the person making such threats, with due diligence, commences and prosecutes an action for infringement of his patent.*"

The action mentioned in the proviso as taking a case out of the section need not be an action against the person who is suing to restrain the threats, but that an action for infringement honestly brought with reasonable diligence against any of the persons who have been threatened will if duly prosecuted satisfy the proviso (*a*).

Pending the trial of an action for the infringement of certain patents, the plaintiffs in the action issued advertisements stating that in consequence of the continued infringement of their patents by the defendants, they had commenced an action against them to restrain them from infringing such patents; and that actions would be commenced against all persons employing or using apparatus

(*a*) *Challender* v. *Royle*, 36 Ch. D. 425.

which was in accordance with the letters patent without the leave of the patentees. Held that the plaintiffs were not justified in issuing such advertisements notwithstanding sect. 32, *supra* (*b*).

Before this Act an injunction under some circumstances might have been granted (*c*).

This section would appear to give the threatened party the power of testing the validity of the patent.

But in an action commenced under this sect. 32 of the Act for an injunction to restrain a patentee from issuing threats of legal proceedings, Chitty, J., held that the validity of the patent could not be tried, the only issue in such an action being infringement or no infringement. The plaintiffs in their statement of claim alleged that the defendant's patent was invalid, and such allegation was ordered to be struck out (*d*).

No appeal was lodged from this decision until it was too late, subsequently upon application to amend by reinserting the allegations that the patent was invalid, the Court of Appeal expressed the opinion that the validity of the patent could be questioned under this section, and allowed the amendment upon terms that particulars of objection were delivered, and that the defendant, as to the validity of the patent, be at liberty to begin and reply (*e*), and the decision of Chitty, J., (*supra*) has since been directly overruled by the Court of Appeal (*f*).

In *Driffield &c., Pure Linseed Cake Co.* v. *Waterloo Mills, &c., Co.*, (*g*), such a course was evidently contemplated but was abandoned. Bacon, V.-C., held that the words "by circulars, advertisements, or otherwise," did not

(*b*) *Goulard* v. *Lindsay*, 56 L. T. 579.

(*c*) *Société, &c., des Glaces* v. *Tilghman's, &c., Co.* 25 Ch. D. 1, and *Halsey* v. *Brotherhood*, 15 Ch. D. 514.

(*d*) *Kurtz* v. *Spence*, 33 Ch. D. 506.

(*e*) *Kurtz* v. *Spence*, 36 Ch. D. 770. See also *Walker* v. *Clarke*, 56 L. J. Ch. 239.

(*f*) *Challender* v. *Royle*, 36 Ch. D. 425.

(*g*) 31 Ch. D. 638.

mean otherwise *ejusdem generis* with circulars or advertisements, and that a solicitor's letter was a sufficient threat, a perpetual injunction was granted, but a claim for damages disallowed.

This is neither an action for infringement under sect. 29 nor a petition for revocation under sect. 26, and therefore the provisions as to particulars of objections do not apply. The provisions of the Rules of the Supreme Court, 1883, as to particulars do not appear to be available for the obtaining of particulars of objections in such a case, it being remembered that the patentee is defendant; that the cause of action is not to establish the patent but to restrain threats, and that the patentee himself has to set up his valid patent by way of substantive defence. The patentee is at such disadvantage in such form of action that it is to his interest forthwith to commence an action for infringement, and to apply for a stay of the action brought against him (*h*).

Forms of indorsement to writ, &c., under this section, are given hereafter.

In *Barrett* v. *Barrett's Screw Stopper Co., Limited* (*i*), an action had been brought to restrain the issue of certain circulars containing threats against persons infringing defendant's alleged patent. The inventor had brought an action for infringement. Upon motion for interlocutory injunction to restrain the issue of the circulars, Pearson, J., adjourned the motion until the hearing of the action for infringement with liberty to apply and costs reserved.

If an action to restrain threats has been commenced and stayed pending an action for infringement, and the action for infringement is not prosecuted with due diligence, an injunction will be granted upon the first action and the stay removed (*j*). And in considering whether such an

(*h*) See *Kurtz* v. *Spence*, 36 Ch. D. 770.

(*i*) 1 Patent Office Reports, 9.

(*j*) *Household* v. *Fairburn*, Griffin, P. C. 131.

action is brought with due diligence, the time of issuing the threats, and not the time when the party bringing the action first knew of the acts which he alleges to be infringements, is the period to be looked at (*k*).

In *Burney* v. *United Telephone Co.*, (*l*), upon an interlocutory motion to restrain threats, the defendants declined to bring an action for infringement on the ground that the plaintiff was a man of straw, Chitty, J., said: "Sect. 32 of the Act of 1883, under which this motion is made contains this condition, '*If the alleged manufacture . . . . to which the threats related was not in fact an infringement of any legal rights of the person making the threats.*' In this case there appears to be a serious question between the parties whether the instrument sold by the plaintiff is an infringement or not of the defendant company's patent rights. There is a conflict of affidavits upon the point, and therefore the question is one which the Court cannot decide on this motion. As the plaintiff is not able to prove that there is not in fact any infringement of the defendant company's rights, which is a condition precedent to his obtaining an injunction, the motion must be refused." Costs were ordered to be costs in the cause.

In *Sharp* v. *Brauer* (*m*), which was an action to restrain threats and for damages, Bacon, V.-C., said: "Upon the question of damages, the case is covered over and over again by decisions. Unless there is plain evidence of malice, in the plain common vernacular meaning of the word malice, there is no cause of action."

In *Challender* v. *Royle* (*n*), upon the subject of an *Interlocutory Injunction* in an action to restrain threats, Cotton, L. J., said: "I think, however, that before going to the

(*k*) *Challender* v. *Royle*, 36 Ch. D. 423.

(*l*) L. R. 28 Ch. D. 394.

(*m*) Griffin, P. C. 205. See also *Sugg* v. *Bray*, Griffin, P. C. 210, and *Halsey* v. *Brotherhood*, 15 Ch. D. 514, and 19 Ch. D. 386; *Wren* v. *Weild*, 4 Q. B. L. R. 730.

(*n*) 36 Ch. D. at p. 435.

proviso, I ought, having regard to the judgment of the Vice-Chancellor, to state my opinion as to how the matter ought to be dealt with in an interlocutory application. As far as I understand the Vice-Chancellor, he seems to have considered that he could not enter, or that he need not enter, at this stage of the cause into the question, whether the sale of the plaintiff's tap-unions was an infringement of the defendant's patent, or whether that patent was a valid patent, and that all he need consider was the balance of convenience and inconvenience as between these parties in granting or refusing the interlocutory injunction. I must express my dissent from that view. It is very true that in all cases of interlocutory injunction the Court does consider and ought to consider the balance of convenience and inconvenience in granting or refusing the injunction. But there is another and very material question to be considered, has the plaintiff made out a *primâ facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, though I quite agree that the Court ought not on an interlocutory injunction to attempt finally to decide the question, whether the act complained of is an infringement, or (if the question of the validity of the patent is raised), whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of these two points, the plaintiff in the action has made out a *primâ facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction merely on the ground that it cannot do the defendant any harm."

It has been deemed advisable to limit the remarks in this work to such points of practice as pertain particularly to the law of patents. The general practice of the Courts has not been dealt with, and the practitioner is referred to the ordinary books of practice for such general information as he may require.

FORMS

FOR PROCEEDINGS IN THE HIGH COURT OF JUSTICE.

Indorsement on Writ.

1. *Action for Infringement.*

The plaintiff's claim is:—

1. For an injunction to restrain the defendant from infringing the plaintiff's patent, No. ——, and dated ———. Injunction.

2. For damages for the infringement of the said patent, or alternatively that an account may be taken of all the machines made in infringement of the said patent which have been manufactured, or sold, or let for hire, or used by or by the order, or for the use and profit, of the defendant, and also of the gains and profits made by the defendant by reason of such manufacture, sale, or letting for hire or use, and that the defendant may by a day to be appointed by the Court be ordered to pay to the plaintiff the amount of such gains and profits. Damages. Account.

3. That the defendant may be ordered upon oath to deliver up to the plaintiff, or break up, or otherwise render unfit for use, all machines or parts of machines made in infringement of the plaintiff's said patent, which are in the custody or power of the defendant, his servants, or agents. Order for destruction.

2. *Action to restrain Threats.*

The plaintiff's claim is:—

1. For an injunction restraining the defendant from, by circulars, advertisements, or otherwise, threatening to take legal or other proceedings against persons manufacturing, using, or selling an alleged invention of the defendants, to wit, ———. The said threats being to the prejudice of the plaintiff. Injunction.

2. For damages in respect of the injury sustained by the plaintiff by reason of the circulars, advertisements, or other threats of the defendant to take legal or other proceedings against persons manufacturing, using, or selling the said alleged invention.

3. Petition for the Revocation of a Patent.

In the High Court of Justice,
Chancery [*or* Queen's Bench] Division.

In the matter of Letters Patent granted to ——, of ——, dated ——, and numbered ——, and in the matter of the Patents, Designs, and Trade Marks Act, 1883, sect. 26.

To Her Majesty's High Court of Justice.

The humble petition of Sir ——, Her Majesty's Attorney-General in England (*or* Ireland, *or* Lord Advocate in Scotland) (or other person authorized to petition by sect. 26, sub-sect. 4 of the Patents, &c. Act, 1883) (*a*),

Sheweth as follows :—

Grant. 1. Letters patent, dated the ——, 18—, have been granted to ——, for [*title of invention*]. The said letters patent were sealed on the ——.

Not first inventor. 2. On the said [*date of letters patent*], the said [*name of grantee*], was not the true and first inventor of the said invention.

Obtained in fraud of petitioner. 3. The said letters patent were obtained by the said [*name of grantee*], in fraud of the rights of your petitioner, who was the true and first inventor of such invention, [*or*, in fraud of the rights of J—— S——, who was the true and first inventor of the said invention. The said J—— S—— died on the —— day of ——, intestate, and letters of administration of his estate were granted to your petitioner out of the Probate Division of this Honourable Court, on the —— day of ——].

Invention not new. 4. The said invention was not at the time of the date of the said letters patent a new invention as to the public use and exercise thereof within this realm.

Had been used by petitioner. 5. Your petitioner (*or person under or through whom he claims an interest in any trade, business, or manufacture*) had prior to the date of the said letters patent publicly manufactured, used, or sold within this realm the alleged invention (or a part of the alleged invention, to wit, such part as relates to, &c., &c.), in respect of which such letters patent were granted as aforesaid.

Not subject matter for patent. 6. The said alleged invention was not any manner of new manufacture, the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies.

(*a*) If the petition be presented by any person under sect. 26, sub-sect. 4 (*c*), (d), or (e), the name and address, and description of petitioner must appear; if under (b), the fact of the authority of the Attorney-General must be stated. *Glazbrook* v. *Gillatt*, 9 Beav. 492.

Your petitioner humbly prays that the said letters patent may be revoked, or that such other order may be made in the premises as to this Honourable Court shall seem meet.

And your petitioner will ever pray.

It is intended to serve this petition on (*b*) ———, ———.

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4. NOTICE OF MOTION FOR INTERLOCUTORY INJUNCTION.

In the High Court of Justice.

Chancery [*or* Queen's Bench] Division.

Between A. B. . . . . Plaintiff,

and

C. D. . . . . Defendant.

Take notice that this Honourable Court will be moved [*if short notice of motion*, by leave granted] on the ——— day of ———, or so soon thereafter as counsel can be heard by Mr. ———, of counsel for the above-named plaintiff, that an injunction may be awarded against the defendant to restrain the said defendant, his servants or agents until the trial of this action or further order from either directly or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent granted to the plaintiff [*or* assignor, *or* other predecessor in title of plaintiff], and numbered ———, or that such further order may be made in the premises as to the Court may seem meet.

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5. AFFIDAVIT IN SUPPORT OF NOTICE OF MOTION.

[*Title as above.*]

I, ——— of ———, the above-named plaintiff, make oath and say,

1. Letters patent dated [———] were granted to me under the seal of the Patent Office for an invention entitled "improvements, &c., &c.," for a period of fourteen years from the ——— day of ———. Grant.

2. At the time when the said letters patent were granted to me the said invention was new as to the public use and exercise thereof within this realm. Novelty.

(*b*) Here insert the names and addresses of all persons who, either as original grantees or by assignment, are registered under sect. 23 of the Patent, &c. Act, 1883, as interested in the patent.

A copy of the petition must be served personally, unless an order has been obtained for substituted service. The original must be shown if demanded. An order may be obtained for service out of the jurisdiction; see Daniell's Chancery Practice.

First inventor.

3. I am the true and first inventor of the said invention [or John Smith or other predecessor in title of the plaintiff, was the true and first inventor of the said invention].

Utility.

4. The said invention is of great public utility.

5. [*State any particular facts, such as a previous action or long user, which have a tendency to cause a presumption of the validity of the patent.*]

Infringement.

6. On the ——— day of ——— the defendant infringed the plaintiff's said patent by manufacturing [selling *or* using], etc. (*c*).

7. [The articles sold by the defendant were not manufactured by me or by my licensees or agents.]

8. I believe that the defendant means to continue the infringement of the said letters patent, whereby my trade is greatly injured; persons refusing to purchase the patented articles from me [*or* I am unable to grant licences, *or state any other grounds of special damage arising by reason of the continued infringement*].

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6. Interlocutory Order to Restrain Infringement of Patent.

Form 1.

Upon motion, &c. by counsel for the plaintiff, and upon hearing counsel for the defendant [*or* reading an affidavit of service of notice of this motion on the defendant; *or*, *if moved ex parte before the defendant has appeared*, the writ of summons issued in this action on the ——— day of ———] [*enter affidavits in support and in opposition, if any*], and the plaintiff, by his counsel, undertaking to abide by any order this Court may make as to damages, in case this Court should hereafter be of opinion that the defendant shall have sustained any, by reason of this order, which the plaintiff ought to pay [*if so*, and also undertaking to accept short notice of motion to dissolve the injunction hereby awarded], let an injunction be awarded to restrain the defendant T., until further order, from manufacturing any tube expanders similar to the tube expander which has been purchased by the defendant B., as in the plaintiff's writ mentioned, or otherwise constructed so as to imitate or resemble the roller expanding tool described in the specification in the plaintiff's letters patent in the said writ mentioned, and

Interlocutory injunction.

(*c*) Evidence should be adduced by supporting affidavits in case it is deemed that the defendant has infringed the patent. In *Moore* v. *Bennett*, 1880, M., No. 94, the evidence adduced was that of several persons who had purchased brushes, which, from their appearance, showed they had been made by the patented machine, from the defendant.

to restrain the defendants T. and B., their agents, &c., from selling or offering for sale, or otherwise parting with the custody of any tube expanders, or parts of any tube expanders, which have been so manufactured by the said defendant T. Liberty to either party to apply to expedite the hearing (*d*).

Form 2.

On usual undertaking as to damages, let an injunction be awarded against the defendants S. and C., to restrain the said defendants, their servants, &c., until the trial of this action or further order, from either directly or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent, granted to N., dated the, &c., and numbered 2190, and now vested by assignment in the plaintiff, or any part thereof, except as to any skates made by the plaintiff, or his agents or agent (*e*).

The same on terms.

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7. Interlocutory Injunction for Infringement refused on Terms.

Upon motion, &c., for injunction to restrain, &c., and the defendant, by his counsel, undertaking to keep an account of all moneys received or to be received by him, by reason of the sale or use of the parlour or roller skates in the writ mentioned, this Court does not think fit to make any order upon the said motion, but does order that the costs of the said motion be costs in the cause (*f*).

Refusal on terms.

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8. Inspection, Notice of Motion for.

[*Title as before.*]

Take notice, that this Honourable Court will be moved [*if in the Chancery Division*, before his lordship, Mr. Justice ——], on the part of the plaintiff, that the plaintiff, his solicitors and agents, and or two scientific witnesses, to be named in the notice hereinafter mentioned, may be at liberty at all seasonable times, and as often as may be requisite, upon giving three days' previous notice in writing to the defendants' solicitors, to enter into and upon the business premises of the defendants, where the process of decorating or printing tin or metal plates is carried on by the defendants, as stated in the plaintiff's statement of claim in this action, and to inspect and examine there the whole of the process by which such printed and decorated tin and metal plates are manufactured by the defendants; and to take, on pay-

Scientific witnesses.

(*d*) *Dudgeon* v. *Thompson*, M. R., 24th March, 1874, A. 723.

(*e*) *Plimpton* v. *Spiller*, M. R., 16th March, 1876, B. 424.

(*f*) *Plimpton* v. *Malcolmson*, M. R., 4th March, 1875, B. 421.

ing the reasonable charges of the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants; and that the defendants may be ordered to permit the plaintiff, his solicitors and agents, and two persons to be named as aforesaid, to enter into and upon their said premises for the purposes aforesaid, and that the costs of this application may be costs in the action (*g*).

Take samples.

Costs.

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9. INSPECTION, WHERE FOR A PROCESS AND TO TAKE SAMPLES.

[*Title as above.*]

[*Formal parts as above*] to enter in and upon the business premises of the defendants, where the manufacture of ——— is carried on by the defendants, as mentioned in the statement of claim in this action, and to inspect and examine there the machines used by the said defendants in the manufacture of ———, and the process by which ——— is manufactured by the said defendants, and that the said machines $\frac{\text{or}}{\text{and}}$ process may be put to work upon such inspection, and that the plaintiff, his servants or agents, may be at liberty to take samples of the ——— made or to be made by the said machines or process, upon paying to the defendants their reasonable charges for the same.

Machines to be worked.

Samples.

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10. INSPECTION OF PLAINTIFF'S PATENTED PROCESS BY DEFENDANT.

[*Form of Order given in Griffin, P. C., at p.* 106.]

"That A. B. and one other indifferent person appointed by him and C. D., one of the defendant's solicitors, be at liberty at all such times and as often as in the opinion of the said A. B. be requisite, on giving 3 days' notice to the plaintiffs to enter into some business premises to be selected by the plaintiffs, where the process or mode of working referred to in the specification mentioned in the Statement of Claim can be seen at work, and to inspect and examine there the whole of the machinery fitted in such mill, and to take such samples of the finished and unfinished products of the working of such machinery as in the opinion of the said A. B. may be necessary for the purposes of this action, And it is ordered that such machinery be put to regular work upon such inspection. The costs of this application are to be costs in the action" (*h*).

(*g*) *Flower* v. *Lloyd*, 1876, A. 1254.

(*h*) *The Germ Milling Co.* v. *Robinson*, 55 L. J. Ch. 287.

11. Inspection, and Order for Delivery by Defendant Samples for Analysis.

[*Title as above.*]

[*Formal parts as above*] may be at liberty, upon giving three days' previous notice in writing to the defendants' solicitors, to enter upon the defendants' premises, and to inspect the type there used by the said defendants in their printing processes, as mentioned in the statement of claim in this action; and that the defendant may be ordered to permit the plaintiff, his solicitors and agents, and one person to be named as aforesaid, to enter upon his premises for the purpose aforesaid, and that said defendant may be further ordered to deliver to the plaintiff a competent part of the said type so used, on payment of a fair price for the same, and that the costs of this application may be costs in the action (*i*).

Samples for analysis.

12. Order for Inspection of Defendants' process by Experts.

Let I. and C., of, &c. be at liberty at all seasonable times, and as often as requisite, on giving three days' notice to the defendants, to enter into the business premises of the defendants where the process of decorating or printing tin and metal plates is carried on by the defendants, as stated in the plaintiff's statement of claim, and mentioned in the said affidavits, or some of them, and to inspect and examine there the whole of the purpose of the action. *Shaw* v. *Bank of England*, 22 L. J., Ex. 26. It should also show what the patent is for, so that the Court or judge may see that there is necessity for the inspection. The order will not be granted on the plaintiff's application, unless the Court is satisfied that it is essential to enable him to prove his case. *Batley* v. *Kynock*, L. R., 19 Eq. 90; *Meadows* v. *Kirkmann*, 29 L. J., Ex. 205. In *The Singer Manufacturing Company* v. *Wilson*, 13 W. R. 560, the Court refused to give the plaintiff inspection of the defendant's stock before judgment, but ordered the defendant to verify by affidavit all the different kinds of sewing machines which he had sold since the last disclaimer entered by the plaintiff, and to produce one of each sort for inspection.

Order for experts.

(*i*) This was the notice of motion in *The Patent Type Founding Co.* v. *Walter*, reported at 5 H. & N. 192; 29 L. J., Ex. 207; 6 Jur. N. S. 103; 1 L. T. Rep., N. S. 382. The samples of type in this case were required for the purpose of analysis.

Notice of motion for inspection must be supported by affidavit; a fair *primâ facie* case of validity and infringement must be made out. The order for inspection is frequently made upon the application for interlocutory injunction, and is sometimes made to include a cross order that the plaintiff shall permit the defendant to see and inspect the patented machine at work, and also to take samples. *Ames* v. *Kelsey*, 22 L. J., Q. B. 84. The affidavit should show that there is such property or machinery as is required to be inspected, that the inspection is necessary for the pur-

cess by which such printed and decorated tin (*j*) and metal plates are manufactured by the defendants, and to take, on paying the reasonable charges of the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants (*k*).

Full information.

13. Statement of Claim.

In the High Court of Justice.
Chancery [*or* Queen's Bench] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Statement of Claim.

Infringement. 1. The defendant has infringed the plaintiff's patent, numbered —, granted for the term of fourteen years from the ——— day of ———, for an invention entitled improvements in the manufacture of iron and steel.

First inventor. 2. The plaintiff was the first and true inventor of the said invention.

Injunction, damages, account. 3. The plaintiff claims an injunction to restrain the defendant from further infringement, and that accounts may be taken of the sales and profits made by the defendant by infringing the said letters patent [*or* in the alternative, £100 damages].

Particulars of breaches are delivered herewith.

[*Place of trial.*]

Signed.
Delivered the ——— day of ———, 18—

14. Particulars of Breaches.

In the High Court of Justice.
Chancery [*or* Queen's Bench] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

The following are the particulars of the breaches of the letters patent complained of in the statement of claim herein :—

Using. 1. The defendant on or about the ——— day of ——— at

(*j*) No order will be made on this application for the inspection of books, for which a separate order must be obtained. *Vidi* v. *Smith*, 3 E. & B. 969.

(*k*) *Flower* v. *Lloyd*, C. A., 5th July, 1876, A. 1254.

his factory at ———, in the county of ——— manufactured acetate of soda by the process and with the use of the machinery and appliances which form the subject-matter of the plaintiff's patent.

2. On the ——— day of ——— the defendant sold to John Selling. Smith of ———, one parcel containing ——— tons of acetate of soda manufactured by the defendant by the process and with the use of the machinery and appliances which form the subject-matter of the plaintiff's patent.

3. On the ——— day of ——— the defendant sold, &c.

Yours, &c.
X. Y.,
Plaintiff's solicitor.

To Mr. E. F.,
Defendant's solicitor.

[*Formal parts as above.*]

1. The defendant, on or about the ——— day of ———, Making. manufactured at his factory at ———, in the county of ———, sewing machines, which sewing machines were infringements of the plaintiff's patent.

2. The defendant, on or about the ——— day of ——— at Selling. his shop at ———, in the county of ———, sold a sewing machine to ———, which sewing machine was an infringement of the plaintiff's patent.

3. The defendant, on or about the ——— day of ———, in Using. his workshop at ———, in the county of ———, by himself, his servants or agents, used a sewing machine, which sewing machine was an infringement of the plaintiff's patent (*m*).

(*Further and better particulars of breaches or objections obtained by summons, common form.*)

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15. Order for Delivery of further Particulars of Breaches.

It is ordered that the plaintiffs within ——— days from the date of this order deliver to Messrs. ———, solicitors for the defendants, further and better particulars in writing of the breaches alleged to have been committed by the defendant, upon which the defendants intend to rely on the trial of the questions directed to be tried by the said order dated, &c., specifying by reference to the pages and lines the part of the plaintiffs' speci- Pages and

(*m*) In the case of a patent for a combination, or where there are several distinct claims, the particulars of breaches should specify what portion of the combination has been infringed, or as to which of the claims infringement is alleged.

lines of specification.

fication in respect of which such alleged breaches have been committed; and let the time within which the defendants are to deliver to the plaintiffs' solicitors particulars in writing of the objections to the letters patent in the plaintiffs' writ mentioned, be enlarged until the twenty-first day after the delivery of such further and better particulars, costs of application to be costs in the cause (*n*).

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16. STATEMENT OF DEFENCE.

In the High Court of Justice.
Chancery [*Queen's Bench*] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Statement of Defence.

1. The defendant did not infringe the patent.
2. The invention was not new.
3. The plaintiff was not the first and true inventor.
4. The invention was not useful.
5. [*The denial of any other matter of fact affecting the validity of the patent.*]
6. The patent was not assigned to the plaintiff.

Particulars of objections are delivered herewith.

Signed.
Delivered the ——— day of ———, 18—.

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17. PARTICULARS OF OBJECTIONS IN ACTIONS FOR INFRINGEMENT, AND ON PETITION FOR REVOCATION.

In the High Court of Justice.
Chancery [*Queen's Bench*] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Take notice, that the defendant [*or petitioner*], will, on the trial of this cause, rely on the following objections to impeach the letters patent in the statement of claim [*or petition*] herein mentioned.

(*n*) *Lamb* v. *The Nottingham Manufacturers' Company (Limited)*, M. R., 14th March, 1874, B. 776.

1. That the plaintiff [*or alleged inventor*] was not the first and true inventor of the said invention within this realm. First inventor.

2. That the alleged invention was not subject-matter of a grant of letters patent, within the meaning of the 6th section of the Statute of Monopolies (that is, the act of the 21st year of King James I. ch. 3). Subject-matter.

3. That the alleged invention was not useful to the public. Utility.

4. That the specification of the said invention was not sufficient, and was unintelligible. Insufficiency of specification.

5. That the alleged invention was not a new invention as to the public use and exercise thereof within this realm. Novelty.

6. That the alleged invention was published in a specification, dated the ——— day of ———, and numbered ———, and issued by Her Majesty's Commissioners of Patents prior to the date of the said letters patent. Prior publication in specification.

7. That the alleged invention was, prior to the date of the said letters patent, published in a book, which on the ——— day of ———, was in the British Museum Library and open for public inspection; the title of the said book was ———, and the pages of the said book particularly referred to are numbered ——— and ———. Prior publication in book.

8. That the alleged invention was used prior to the date of the said letters patent in the following manner, that is to say, by ———, at ———, on the ——— day of ———. Prior user.

9. That a material part of the alleged invention, namely, that part which refers to ———, was not new at the date of the said letters patent, having been used by ———, at ———, on the ——— day of ———. Part old.

10. That the plaintiff does not sufficiently distinguish and point out in his specification which of the matters and things therein mentioned he claims to have invented, and which he does not claim to have invented, or admits to be old. Combination not distinguished.

11. The defendant will also rely, as examples of prior publication, upon the following specifications, filed with the Commissioners of Patents, and will object that the specification of the plaintiff's patent claims some of the matters thereby patented or specified, that is to say [*enumerate specifications*].

Yours, &c.,

L.

Defendant's Solicitor or Agent.

To Mr. A. B.,

Plaintiff's Solicitor.

18. Order for Delivery of further Particulars of Objections.

Let the order dated 6th July, 1876, whereby it was ordered that the defendants shoul' on or before the 20th July, 1876, deliver to the plaintiffs further and better particulars of objections, stating therein the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which the process of, &c., was known and publicly practised in England before the 8th March, 1864 [*date of letters patent*], and that in default thereof the words from, and after the words "in a dry state," in the 6th paragraph of the statement of defence, which had been delivered in this action, to the end of the said 6th paragraph, should be struck out; and in that case no evidence should be given by the defendants on the trial of this action of such prior publication, and that defendants should pay to the plaintiffs their costs of the application, to be taxed, &c., BE VARIED, and as varied be as follows:—Let the defendants on or before the ——— deliver to the plaintiffs further and better particulars of objections under the ——— paragraph of the statement of defence on which they mean to rely at the trial, stating therein the place or places at or in which, and in what manner, the process of printing upon tin or metal surfaces by direct impression by means of damp stones is alleged to have been used or published prior to the ——— day of ———, 1864 (*o*).

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19. Order for liberty to amend Particulars of Objections by adding Fresh Objections upon terms.

Let the plaintiff, within six weeks from the date of this order elect whether he will discontinue this suit, and if the plaintiff shall elect to discontinue this suit, and shall give notice thereof to the defendants within six weeks from the date of this order, refer it to the taxing master to tax the defendants their costs up to and including the 23rd Feb., 1875 (*delivery of the original particulars of objection*), and to tax the plaintiff's costs of this suit subsequently to the said 23rd Feb., 1875, to the date of this order, and the taxing master is to set off the costs of the plaintiff and of the defendants to be so respectively taxed, and certify to which of them the balance after such set off is due, and let such balance be paid by the party from whom, to the party to whom the same shall be certified to be due. And if the plaintiff shall not give notice to the defendants of his discontinuance of this suit within the time aforesaid let the defendants be at liberty to add to the particulars of objections to the

(*o*) *Flower* v. *Lloyd* (C. A.), 2nd August, 1876, A. 1523; 25 W. R. 17. Varying order of V.-C. B., 6th July, 1876, A. 1252.

validity of the plaintiff's letters patent, &c., which have been already delivered by the defendants, the following further objections to be relied on by the defendants at the hearing of this cause, viz. (*particulars of new objections proposed to be introduced by amendment*). And let defendants, Moules, &c., Co. pay to the plaintiff, A. F. Baird, his costs of this application to be taxed, &c., liberty to apply (*p*).

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20. Interrogatories.

Interrogatories may be delivered in the common form, subject to the Rules of 1883, by either party, notwithstanding the delivery of particulars. Enquiry may be made by the plaintiff as to the names and addresses of the persons by whom prior user is alleged to have been made as well as the places where the prior user has taken place (*q*).

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21. Order for Reference under Sect. 57 of the Judicature Act, 1873.

[*Formal parts.*]

Upon hearing counsel for the plaintiff, and for the defendant [*or* This cause coming on for trial], It is ordered that the following questions

1. As to whether the invention, the subject of his letters patent of the ——— day of ———, was or was not, at the date of the said letters patent, new as to the public use and exercise thereof within this realm; — Novelty.

2. Whether the plaintiff was the true and first inventor of the said invention; — First inventor.

3. Whether the specification of the said letters patent in the pleadings mentioned does or does not particularly describe the nature of the said invention, and in what manner the same is to be performed pursuant to the proviso in that behalf contained in the said letters patent; — Sufficiency of specification.

4. Whether the defendant has, or has not, infringed the said letters patent, in or by any or either, and which of the apparatus manufactured by him, as in his statement of defence delivered in this action mentioned, or in any other manner; — Infringement.

5. Whether the undisclaimed portions of the said alleged invention were used in the United Kingdom at the date of the said letters patent; — Disclaimer.

(*p*) See *Baird* v. *Moules, &c., Co.*, L. R., 17 Ch. D. 139 (n.).

(*q*) *Birch* v. *Mather*, 22 Ch. 629.

be referred, to be tried before one of the official referees [or a special referee], who shall have all the powers as to certifying and amending of a judge at nisi prius, and shall make his report of and concering the matters ordered to be tried as aforesaid, pursuant to the statute; and it is further ordered that the said referee shall be at liberty, if he shall think fit, to examine the said parties to this action, and their respective witnesses upon oath or affirmation, and that the said parties do and shall produce before the said referee all books, deeds, papers, and writings in their or either of their custody or power relating to the matters ordered to be tried as aforesaid. And it is further ordered, that neither the plaintiff nor the defendant shall bring or prosecute any action against the said referee, or against each other of and concerning the matters ordered to be tried as aforesaid. And that if either party shall by affected delay, or otherwise, wilfully prevent the said referee from making his report, he or they shall pay such costs to the other as the said Court, or any judge thereof, shall think reasonable and just. And it is further ordered, that in the event of the said referee declining to act, or dying before he shall have made his report, the said parties may, or if they cannot agree, one of the judges of the said High Court may, upon application of either side, appoint a new referee.

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22. ORDER FOR TRIAL OF A REPRESENTATIVE CASE, FOR THE PURPOSE OF DETERMINING THE QUESTION OF VALIDITY.

Undertaking to be bound.

And the plaintiff, F., by his counsel, undertaking to be bound by the result of the trial hereinafter directed, and the said above-mentioned defendants, by their respective counsel, admitting that the letters patent in the pleadings mentioned are duly vested in the plaintiff, and consenting to be bound by the result of the trial hereinafter directed, and that the said trial shall be conducted by B., G., B. and W., four of the above-named defendants, on behalf of and as representing all the defendants in the said suit; let, by consent of all the said several defendants in the above-mentioned suits, the said defendants, B., G., B. and W., be the defendants in the said trial, and let the said defendants, B., G., B. and W., on or before the ——— day of ———, pursuant to the statute, deliver to the plaintiff their objections to the validity of the said patents; and let, by the consent of the plaintiff and the said defendants, the following question be tried before his lordship without a jury, that is to say, whether the patent in the pleadings mentioned, dated, &c., is a valid patent; and the plaintiff is to proceed to such trial on such day, &c. Adjourn the consideration of the costs on the several applications to the judge and to his lordship until after the said trial; and let

Delivery of objections.

all further proceedings in the above-mentioned causes be stayed until after the said trial, and any of the defendants in any suits commenced by the plaintiff with respect to infringement of the said patent are to be at liberty to apply to be made parties to this order (*r*). Liberty to apply.

23. FINAL JUDGMENT—RECITAL OF EVIDENCE—INJUNCTION—INQUIRY AS TO DAMAGES—ORDER FOR DESTRUCTION—COSTS AS BETWEEN SOLICITOR AND CLIENT—LIBERTY TO APPLY.

The following Order was settled by the late Master of the Rolls, Sir George Jessel, personally, in the case of Plimpton v. *Spiller, reported L. R., 6 Ch. D.* 412.

In the High Court of Justice. 1876. P. 69.
Chancery Division.

Thursday the 19th day of April, 1877.

Master of the Rolls.

Mr. Clowes, Reg.

Between J. L. P. . . . . Plaintiff,
and
A. F. S., and T. C. . . Defendants.

This action, coming on for trial the 11th and 12th days of April, 1877, and this day before this Court, in the presence of counsel for the plaintiff and the defendants, upon hearing an order, dated the 4th August, 1876, an affidavit of A. F. S., filed the 15th March, 1876; an affidavit of J. I., filed the 16th February, 1877, the bill, answers, orders, record for trial, and the certificate of the Master of the Rolls, the judge before whom the questions of fact were tried, that the validity of the letters patent of the 25th day of August, 1865, granted to A. V. N., and numbered 2190, hereinafter mentioned, came in question in the cause of P. *v.* M., 1875, P. 39, and upon hearing the said letters patent, and a certified printed copy of the specifications and drawings, filed under the said letters patent, and the indenture of assignment, dated the 10th day of January, 1866, and made between the said A. V. N., therein described, of the one part, and the plaintiff, J. L. P., of the other part, and registered in the Great Seal Patent Office on the day of the date thereof, the printed shorthand note of the evidence taken orally before this Court, on the trial of the said action of P. *v.* M., 1875, P. 39; of A. V. N., F. J. B., J. I., J. L. P., E. A. C., R. C. M., W. W. H. and E. J. C. W. and the exhibits marked 1, 2, and 4, then produced; the examination Evidence. Certificate.

(*r*) *Foxwell* v. *Bradbury, &c.*, 80 other titles, L. C., 7th December, 1863, A. 2391

of H. J. A., W. B. P., W. G. A., A. F. S., J. I., T. M. W., G. B., C. P. B. S., E. E., W. S. M. and H. L., taken orally before this Court, on the 11th, 12th, and 19th days of April, 1877, and the exhibits marked: 1. 2. 4. A. B. C. D. E. F. G. H. I. L. M. N. O. P. E. E. 2. S. 1. S. 2. E. E. 1. E. E. 3. W. S. M. 1. W. 1. and W. 2. and the two catalogues and donation book produced to W. G. A., and the volume of the year 1863, of Jowitt's Book of Illustrations to the Report of the American Commissioners of Patent, and the "Scientific American" for the years 1863 and 1865; the records from the Court of Bankruptcy of an assignment, dated the 11th August, 1865, by W. S. M., for the benefit of his creditors, and of a composition deed by the said W. S. M., in the year 1869, and what was alleged by counsel on both sides, and this Court being of opinion that the plaintiff has proved the breaches complained of, in the particulars of breaches delivered by him in this action,

Proof of breaches.

Injunction.

doth order that an injunction be awarded to restrain the defendants, their servants, agents, and workmen during the continuance of the letters patent, granted to A. V. N., dated the 25th day of August, 1865, and numbered 2190, and any extension of the term thereof, from using, or exercising, or causing or permitting to be used or exercised, the invention described in the hereinbefore mentioned specification and drawings, filed under the said letters patent, and from selling, letting for hire, or making any profitable use, or permitting the sale, letting for hire, or profitable use of any roller or runner skates not made by the plaintiff, or his licensees, and having applied thereto rollers or runners in manner described, and for the purposes mentioned in the said specification, or fitted with any apparatus for causing the skate to run in curved line, in the manner described in the said specifications and drawings, or differing therefrom only colourably, and by the substitution of

Mechanical equivalents.

mere mechanical equivalents, and it is ordered that it be referred to the official referee in rotation, to inquire what sum of money

Enquiry as to damages.

is fit to be awarded to the plaintiff, to be paid by the defendants in respect of any damage sustained by the plaintiff up to the day of the date of this order, from the manufacture, sale, or letting for hire, of skates, being the same as the "Spiller" Skates, and "Wilson" Skates, in the pleadings in this action, and in the said order dated the 4th August, 1876, mentioned, or of any other skates made in infringement of the said letters patent, or otherwise from the sale, or use by the defendants of the said invention, or any apparatus in imitation of, or being only a colourable deviation from the said invention. And it is

Payment of amount.

ordered, that the defendants, A. F. S. and T. C., do pay to the plaintiff, J. L. P., such sum of money as upon such inquiry shall be found fit, to be awarded to the plaintiff for such compensation as aforesaid, within twenty-one days after service of the official referee's report of the result of the said inquiry.

And it is ordered, that the defendants, A. F. S. and T. C., do deliver up on oath to the plaintiff, or break up, or otherwise render unfit for use, all roller skates, or parts of roller skates so manufactured, or let for hire by, or by the order, or for the use of the defendants in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendants, or either of them, or their, or either of their, servants or agents. And it is ordered, that the said defendants, A. F. S. and T. C., do pay to the plaintiff, J. L. P., his full costs, to be taxed by the taxing master as between solicitor and client, including all costs, charges, and expenses. And any of the parties are to be at liberty to apply, as they may be advised.

Destruction.

Full costs.

Liberty to apply.

W. C.

Entered.
G. L.

Registrar's Office, Entering Lib. B. Seal.

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24. Judgment for Perpetual Injunction, under the Patent Law Amendment Act, 1852, restraining Infringement of Patented Skates after Trial without Jury, with account of Sales and Profits, Discovery, Delivery up, or Destruction.

Let an injunction be awarded to restrain the defendant, his servants, &c., during the continuance of the said letters patent granted to N., dated, &c., from using or exercising, or causing, or permitting to be used and exercised the invention described in the hereinbefore-mentioned specification and drawings of the said N., and from selling, letting for hire, or making any profitable use, or permitting the sale, letting for hire, or profitable use, of any roller or runner skates not made by the plaintiff or his licensees, and having applied thereto rollers or runners in manner described and for the purposes mentioned in the said specification, or fitted with any apparatus for causing the skate to run in a curved line in the manner described in the said specification and drawings, or differing therefrom only colorably and by the substitution of mere mechanical equivalents; and let an account be taken of all roller skates being the same as the skates sold by the defendant to G., as in the pleadings mentioned, or otherwise made in infringement of the said letters patent, which have been manufactured, or sold, or let for hire, by or by the order, or for the use or profit of the defendant, and also of the gains and profits made by the defendant by reason of such manufacture, sale, or letting for hire; and let the defendant within [seven] days after the service upon him of the chief clerk's certificate of the result of such account pay to the plaintiff the amount of such gains and profits, and let the defendant forth-

Injunction.

Account of profits.

Destruction. with upon oath deliver to the plaintiff, or break up, or otherwise render unfit for use, all roller skates or parts of the roller skates so manufactured or let for hire, by or by the order or for the use of the defendants in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendant or his servants or agents. Defendant to pay to plaintiff costs of suit (*s*).

Ordinary costs.

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25. JUDGMENT FOR PERPETUAL INJUNCTION UNDER THE PATENT LAW AMENDMENT ACT, 1852, RESTRAINING INFRINGEMENT AS TO PATENTED ARTICLES (PULLEYS) AFTER REFUSAL OF MOTION FOR NEW TRIAL AND FOR DELIVERY UP OF THE ARTICLES MADE BY DEFENDANT TO BE SPECIFIED BY AFFIDAVIT.

Injunction. Let an injunction be awarded to restrain the defendant, S., during the continuance of the letters patent, and any extension of the term thereof, from using or exercising, &c., and from in any manner infringing the rights and privileges granted by the said letters patent; defendant within seven days to specify by affidavit what apparatus constructed or arranged according to the said invention and improvements, or only colourably differing from those described in the said specification and drawing, have been manufactured by or by the order or for the use of the said defendant as in the writ mentioned, and are in the possession, custody or power of the said defendant or his servants or agents; defendant within [seven] days after filing such affidavit to deliver up to the plaintiffs all such pulleys or apparatus (*t*).

Delivery up of articles.

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26. JUDGMENT FOR PERPETUAL INJUNCTION UNDER THE PATENT LAW AMENDMENT ACT, 1852, RESTRAINING INFRINGEMENT OF PATENT FOR MACHINERY AFTER TRIAL OF ISSUES BY A JURY—DISCOVERY—ACCOUNT OF PROFITS—CERTIFICATE FOR FULL COSTS.

And the parties having, on the ——— day of ———, proceeded to a trial of the questions of fact directed to be tried by the order dated, &c., before this court by a jury, when the jury

Findings of jury. found that [*finding for the plaintiff upon all the issues*]. And upon reading the letters patent, dated, &c., and the complete specification, dated, &c., in the writ respectively mentioned, an

Evidence. affidavit of the plaintiff's, &c. [*enter evidence*], this court doth order [*and*] decree [*and adjudge*] that an injunction be awarded

(*s*) *Plimpton* v. *Malcolmson*, M. R., 28th January, 1876, B. 381.

(*t*) *Tangye* v. *Scott*, V.-C. W., 12th February, 1866, B. 461.

to restrain the defendant, O., his agents, servants, &c., during the subsistence [*continuance*] of the plaintiff's letters patent in the writ mentioned, or any extension thereof, from manufacturing, or selling, or disposing of, or using any machine of the same construction as that supplied to him by the W. B. Co., in the said writ mentioned, or only colourably differing therefrom, or being an infringement of the plaintiff's said patent, and from in any way infringing the plaintiff's said patent; and it is ordered that the defendant, O., do, within [*seven*] days after service of this decree, make and file an affidavit stating what machines of the same construction as that supplied by him to the said W. B. Co., including such machines, are in his possession or power; and the plaintiffs are to be at liberty to inspect and mark the same for the purpose of identification. And it is ordered that an account be taken of the profits made by the defendant by making, using, selling, or disposing of the machines supplied by him to the said W. B. Co., or any other machine of the same construction therewith, or otherwise by an infringement of the plaintiff's patent. And it is ordered that the defendant, O., do, within one month after the date of the chief clerk's certificate, pay unto the plaintiffs, N. and C., what shall be certified to be the amount of such profits. Direction for certificate that the validity of the plaintiff's patent came in question. And it is ordered that the defendant, O., pay to the plaintiffs their costs of this cause up to and including this hearing, and their costs of the trial by jury of the questions of fact directed to be tried by the said order, dated, &c., including the costs of a special jury; such costs to be taxed, &c. Liberty to apply in chambers touching subsequent costs, and otherwise to apply as advised (*u*).

Injunction.

Order to inspect and mark.

Account.

Costs.

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27. Judgment for the Defendant.

[*Formal parts as above.*]

The action having on the ——— day of ——— been tried before Mr. Justice ——— [and a common or special jury of the county of ———, and the jury having found a verdict for the defendant on the issues] and the said Mr. Justice ——— having ordered that judgment be entered for the defendant on the issues [*certificate as to particulars of objections as in form*]: therefore it is adjudged that the plaintiff recover nothing against the defendant, and that the defendant recover against the plaintiff £———, for his costs of defence.

(*u*) *Needham* v. *Oxley*, V.-C. W., 24th June, 1863, B. 1395.

28. CERTIFICATES NECESSARY UNDER SECT. 29, SUB-SECT. 6, OF THE PATENTS, &C., ACT, 1883.

[*Form of judgment for perpetual injunction, accounts of profits and damages as above.*]

It is certified that the plaintiff has proved to the satisfaction of the Court the breaches mentioned in the particulars of breaches delivered by him, and numbered respectively, 1, 2, 3, 4, and 5, and that the particulars numbered 6 and 7, were, under the circumstances of the case, reasonable and proper.

[*Form of judgment for defendant as above.*]

It is certified that the defendant has proved to the satisfaction of the Court the objections mentioned in the particulars of objections delivered by him, and numbered respectively 1, 2, 3, 4 and 5, and that the objections numbered 6 and 7 were, under the circumstances, reasonable and proper.

EXAMPLES OF SPECIFICATIONS AND CLAIMS.

PROVISIONAL AND COMPLETE SPECIFICATION TO A PATENT FOR A NEW MECHANICAL APPLIANCE AND MODE OF OPERATING—A VERY GENERAL CLAIM. 1885. No. 6205.

NOTE.—*These were the specifications contested in Siddell* v. *Vickers, L. R.* 39 *Ch. D.* 92, *decision of Kekewich, J., affirmed by the Court of Appeal, Cotton, Fry and Lopes, L.JJ., holding that the provisional specification was sufficient and that the claim was sufficient having regard to the body of the complete specification and to the particular subject-matter of the invention.—Two sheets of drawings which accompany the specification are not given here.**

Title.

PROVISIONAL SPECIFICATION. AN IMPROVED MECHANICAL APPLIANCE FOR WORKING OR OPERATING ON LARGE FORGINGS IN IRON OR STEEL.—This Invention relates to the construction and application of an improved and more simple and effective mechanical appliance or means, for working or operating on large forgings in iron or steel, being such forgings as are usually made under a hydraulic forging press or machine.

Provisional specification.

My improved appliance consists of a horizontal bar or bars made of suitable metal and fitted with suitable pulleys and hooks, which bar or bars can be placed or fitted on either side of the crosshead of the forging press, or through the "pellet" or key way.

Clips or grips or ratchets are conveniently arranged so as to fix on or hold the ingot or forging and hooked on the ratchet or clip or grip; and in operating, when the press lifts up or is

* It would not be wise to treat this as a model in preparing specifications, it is given here as showing probably the extreme limits to which the courts will go in supporting a patent.

raised, the ingot or forging will be turned as much as required at every stroke or operation of the press.

The crank bar of the press in connection with the wheel and endless chain thereof will raise the forging from the anvil at the same time that the clip or grip or the ratchet is turning the forging, the ratchet being suitably fixed for turning the crane wheel over which the endless chain passes.

The ratchet has a chain attached to the crane girder which will travel along a horizontal bar suitably fixed for the purpose and will turn over the ingot or forging in the furnace.

Dated this 20th day of May, 1885.

Complete specification.

COMPLETE SPECIFICATION. — This invention relates to the construction adaptation and application of an improved more simple and effective mechanical appliance or means for working or operating on large forgings in iron or steel, which forgings are such as are usually made under a hydraulic forging press or machine or a steam hammer; and in order that the carrying out of my invention in practice may be fully understood, I have illustrated it on the accompanying two sheets of explanatory drawings, and have marked the same with letters of reference corresponding with those in the following description thereof, that is to say:—

Description of drawings.

Figure 1, on Sheet 1, is an end elevation or view, and Figure 2, is a front or face view of one arrangement of my mechanical appliance for working large forgings.

A, is the hydraulic forging press or machine. G, is the endless chain which is attached to the crank bar of the press, and which passes over the wheel W, and under the ingot or forging or mandril F, which is being operated upon by the press A.

The wheel W, is held in position by means of the crane block hook *b*, and shackle or bridle *a*; the crane with the horizontal bar and carriage are not shown on the drawings.

On or to the centre pin of the wheel W, is attached a double or single lever L, having pawls or ratchets R (one only being shown on the drawings) working on pins. The ratchets engage in teeth provided for them on the wheel W.—When the endless chain G, is slack the ratchet lever L, falls or is forced in towards the centre so as to crank or bend the chain to any required extent, and when the weight of the forging comes on the chain it tends to straighten it, and the pressure on the end of the

lever L, is transferred to the pawl or ratchet R, and thence to the teeth of the wheel, which will cause it to rotate on its axis to the desired extent. An eye or other convenient appliance E, is attached to the end of the ratchet lever L, in order to work the ratchet and rotate or turn the wheel independently of the endless chain G.

Figure 8, on Sheet 1, shows the appliance arranged and applied in another manner; the centre pin of the wheel is connected with a cranked bar K, or by other convenient means to the pellet or crosshead of the press, whereby the wheel W, and endless chain G, are simultaneously raised when the pellet is lifted. The chain when slack is cranked or bent as before mentioned, and when the pellet rises the ingot or forging rises with it, and the consequent straightening of the chain forces round the wheel W, by means of the ratchet lever (not shown in this Figure) and so turns over the forging at the same time that it rises from the anvil; or it can be made to turn the forging by means of the eye provided at the end of the ratchet lever L, and thus this arrangement of the appliance can be made either automatic or self-acting, or it can be worked by steam or other power independently of the appliances shown at Figures 1, 6, and 7; for the working of the forging under the steam hammer.

This appliance can likewise be used to turn over the ingot or forging when in the furnace, and it is operated by the crane as an automatic appliance, or when suspended the forging can be turned by working the ratchet lever L, by any convenient means, such as by steam or other power.

In the combination and arrangement of the appliance, as shown at Figures 4 and 5 on Sheet 2, a horizontal bar B, is provided and fixed on or through the crosshead or pellet of the press, this bar carries one or more bridles *c*, and rollers *d*, with one or more hooks or shackles H attached to them. An adjustable clip or ratchet grip X, is put on to the ingot or forging or mandril F, and an eye *e*, on the end of the screw or lever *f*, is attached to the hook or shackle H. When the pellet or crosshead of the press rises, the clips or ratchet grips X, engage with or grip the ingot or forging or mandril, and the leverage so obtained will turn over the forging, and when the pellet descends the appliance will release itself and will slip round to obtain a fresh hold for the next lift.

The wheels and endless chains shown at Figures 6, and 7, on Sheet 2, which are similar to those described as shown at

Figure 3, on Sheet 1, can also be used in combination with the appliances represented at Figures 4, and 5, on Sheet 2, and the forging will be lifted up from the anvil and turned over to the required extent, at the same time that the press rises.

The appliance as shown at Figures 1, and 2, on Sheet 1, can also be used in combination; in fact each arrangement of appliance can be used either separately or combined, for the purposes of lifting slinging or turning over the ingot or forging when in the furnace, under the press or hammer, or when being otherwise operated on.

The ratchet appliance has a chain attached to the crane girder, which will travel along a horizontal bar provided and fixed for that purpose, or with the crane carriage and will turn over the ingot or forging in the furnace.

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be and can be performed, I here declare that I do not limit myself to the precise details of my invention as hereinbefore specified and as illustrated on the accompanying drawings, because equivalent modifications or variations can be made in such details, and quite consistent with the principles or characteristic features of my invention; and in conclusion I declare that what I claim is

Claim. The general construction, adaptation or application, and the combination and use of the several parts, in the whole, constituting improved, more simple, and efficient appliances or means for working or operating on iron or steel forgings, substantially as hereinbefore set forth, and as illustrated on the accompanying drawings.

Dated this 19th day of September, 1885.

COMPLETE SPECIFICATION.—APPLICATION OF AN OLD ARTICLE IN A NEW MANNER. 1876. No. 4216.

NOTE.—*This was the specification contested in Morgan & Co. v. Windover & Co., 5 P. O. R. 295, held by the Court of Appeal, Lord Coleridge, L.C.J., and Cotton and Bowen, L.JJ., amongst other findings to be sufficient in all respects and to disclose good subject-matter for a patent. Decision of Kekewich, J., affirmed. (One sheet of drawings not inserted here.)*

GEORGE HENRY MORGAN of Long Acre in the County of Middlesex. "IMPROVEMENTS IN CARRIAGES." Title.

The invention has for its object improvements in carriages and relates to that description of carriage in which the body is supported by C springs at both the front and back thereof. Heretofore in such description of carriage the lower parts of the front C springs have been fixed to the top "beds" of the "under carriage" and elliptic springs have been fixed to the axle to support the "under carriage" whilst a "perch" was necessary to hold the front under carriage and the hind under carriage together. This arrangement of parts was expensive, cumbrous and inconvenient. Description.

Now according to my invention I am enabled to dispense with the "perch" and with the front elliptic springs whilst I obtain a "full lock" to the under carriage and produce a cheaper, more elegant, more compact and otherwise convenient form of carriage. For this purpose I fix the lower parts of the front C springs to the axle and I give support to the tails of such springs by connecting them to a cross spring fixed at its centre to a stay or stays fixed to the "framing pieces" of the "bottom bed" or I connect the tails of such C springs to "half springs" fixed to the "bottom bed."

The bows of the C springs are connected by links or loops to bearings fixed to the "bottom bed" of the "under carriage" and the body of the carriage is bolted to the "top beds" of the under carriage as has been the usual practice when common elliptic springs have been used to carry the body.

And in order that my said invention may be more clearly

understood and readily carried into effect I will proceed aided by the accompanying drawings more fully to describe the same.

Description of drawings.

DESCRIPTION OF THE DRAWINGS.—Figure 1 is an elevation and Figure 2 is a plan of parts of a carriage with my invention applied thereto and showing the tails of the front C springs supported by a cross spring and Figures 3 and 4 are respectively an elevation and plan of parts of a carriage having my invention applied thereto but showing the tails of the C springs at both the front and back supported by "half springs."

Like parts are marked with similar letters of reference in all the Figures.

a is the body of the carriage. *b* are the front C springs and *c* are the back C springs.

According to my invention I dispense with the "perch" heretofore employed in carriages having the body supported by C springs at both the front and back thereof and I fix the lower parts of the C front springs *b* to the axle *d* and according to the arrangement shown at Figures 1 and 2 I support the tails b^1 of such springs *b* by connecting them to a cross spring *e* which is fixed at its centre to a stay or stays f^1 fixed to the framing pieces f^2 of the bottom bed *f* or according to the modification shown at Figures 3 and 4 I support the tails b^1 of the front C springs *b* by connecting them to half springs *g* fixed to the "bottom bed" and in this last arrangement I have shown the tails c^1 of the back C springs *c* supported by half springs *h* fixed to the "pump handles" *i*.

The bows of the front C springs are according to my invention connected by links or loops *j* to bearings f^3 fixed to the "bottom bed" *f* of the under carriage and the body of the carriage is bolted to the "top beds" *k* of the under carriage as has been the usual practice when common elliptic springs have been used to support the carriage body.

The links or loops *j* I also form of leather as has heretofore been the case but I prevent the stretching thereof by connecting thereto or covering the same on one side and the two ends with a plate j^1 as shown more clearly at Figure 5.

According to my invention in "locking," the front C springs pass under the "boot" of the carriage and in addition to the advantages before mentioned I obviate the lateral motion of the carriage body which is inseparable from the former mode of using C springs for both the front and back thereof.

Having thus described the nature of my said invention and

the mode in which I carry the same into effect I would have it understood that what I claim is :—

First. The mode herein described of supporting the front of a carriage by C springs having their lower parts fixed to the axle and their bows connected by links or hoops to bearings fixed to the bottom bed of the under carriage substantially as and for the purposes herein shown and described. Claims.

And Secondly. I claim giving support to the tails of the front C springs by connecting them to a cross spring fixed at its centre to a stay or stays fixed to the framing pieces of the bottom bed in manner and for the purpose substantially as herein shown and described.

In witness whereof, &c.

COMPLETE SPECIFICATION FOR A CHEMICAL INVENTION.—FOUR PROCESSES.—TWO CLAIMS. 1878. No. 786.

NOTE.—*This is the specification to the Patent in The Badische Anilin, &c., Co.* v. *Levinstein and others, tried before Mr. Justice Pearson, reported L. R. 24 Ch. D. 156, and held good subject-matter, sufficient and workable. In the Court of Appeal, by Bowen and Fry, L.JJ., Baggallay dissenting, L. R. 29 Ch. D. 366, to be bad for ambiguity. In the House of Lords, by Lord Halsbury, L.C., Lords Herschell and Macnaughten, L. R. 12 App. Cases, 710, the judgment of Pearson, J., upheld on all grounds. The particulars of objections in this action, after dealing with alleged instances of anticipation, were in these terms :—5. "That the specification purporting to be filed "in pursuance of the condition in that behalf in the said letters "patent does not sufficiently describe and ascertain the nature "of the said alleged invention, or in what manner the same is "to be performed, and does not sufficiently distinguish which "of the matters and things therein described the said John "Henry Johnson claims to be new or as being comprised in "the said letters patent, and which of the same he does not so "claim and admits to be old, the said specification is in other "respects vague and insufficient, and framed so as to mislead.*

"6. *That the alleged invention claimed in the said specifica-*
"*tion is not the alleged invention for which the said letters*
"*patent were granted.* 7. *That the said alleged invention is*
"*not useful.* 8 (*added at trial*). *The said invention is not*
"*proper subject-matter for which letters patent can be validly*
"*granted.*"

Communication from abroad and title.

JOHN HENRY JOHNSON, of 47, Lincoln's Inn Fields, in the county of Middlesex, Gentleman. "IMPROVEMENTS IN THE PRODUCTION OF COLOURING MATTERS SUITABLE FOR DYEING AND PRINTING." A communication to me from abroad by Heinrich Caro, chemist to the Badische Aniline and Soda Works of Mannheim in the Empire of Germany.

This invention consists in the production of red and brown colouring matters which in chemical language may be termed the "Sulphoacids of Oxyazonapthaline" and the following processes may be employed for their preparation.

First process.

FIRST PROCESS.—Napthylamine is converted into its diazo compound by the action of nitrous acid and in a manner well known to chemists and equal molecules of the diazo compound thus obtained and of napthol or napthylic alcohol are allowed to react upon one another by preference in an alkaline solution.

According to the employment of either of the two isomeric modifications of napthylic alcohol known as alpha-napthol and beta-napthol the result of this operation is a precipitate containing either of the two corresponding and isomeric modifications of oxyazonapthaline and which may be termed "Alpha and Beta-Oxyazonapthaline" respectively.—These azo compounds are further converted into their sulpho-acids by any method now in use for the preparation of organic sulpho-acids such as for instance by heating them with fuming sulphuric acid. The excess of sulphuric acid may then be removed by any of the known means for effecting this purpose and the colouring matter may be obtained in a solid state by precipitation or evaporation.

In this manner brown colouring matters are obtained from alpha oxyazonapthaline and red colouring matters from beta-oxyazo-napthaline.

Example.

As an example of the manner in which this first process may be carried out I proceed as follows:—About ten pounds of napthylamine are mixed with or dissolved in about two gallons

of concentrated or strong muriatic acid and about 100 gallons of cold water and thereto an aqueous solution of nitrite of sodium is added containing about 4·8 (four and eight-tenths) pounds of pure nitrite of sodium or as much as will be found necessary to convert the napthylamine into its diazo compound or into hydrochlorate of diazonapthaline. The solution thus obtained is added to an aqueous and strongly alkaline solution of about ten pounds of either of the two isomeric napthols or of mixtures of the same when a dark red or brown precipitate will be produced consisting of oxyazonapthaline, which is to be filtered washed and dried. In order to obtain the sulpho-acids of oxyazonapthaline I dissolve about ten pounds of the oxyazo-napthaline in about 20 lbs. of fuming sulphuric acid containing about 80 per cent. of anhydrous sulphuric acid and the mixture is heated at a temperature of about 100° Centigrade for about two hours or until a sample of the mixture will be found to produce a solution with water.—The further treatment consists in removing the free sulphuric acid contained in the mixture by any of the known means for effecting this purpose such as for instance by neutralization with caustic lime and the colouring matter may be obtained in a solid state by preference in the state of a sodium salt in a manner well understood by chemists.

Second process.

SECOND PROCESS.—Napthylamine is converted into its diazo compound as before stated and equal molecules of the diazo compound thus obtained and of the sulpho-acids of either alpha-napthol or beta-napthol are allowed to react upon each other by preference in an alkaline solution. In this instance red colouring matters are the result of the operation and may be obtained in a solid state by precipitation or evaporation.

The above said sulpho-acids of either alpha-napthol or beta-napthol are produced as is well known by heating napthol with excess of sulphuric acid at a temperature of about 100° Centigrade.—The resulting product is a mixture of several napthol sulpho-acids and as my process may be applied not only to the mono-sulpho-acids of napthol contained in that mixture but also to the other sulpho-acids which result from the treatment of napthol with sulphuric acid I wish it to be understood that what I consider as my invention under this second process for preparing the sulpho-acids of oxy-azo-napthaline is the action of diazonapthaline upon all sulpho-acids of either alpha or beta-napthol and substantially in the manner aforesaid. And as an example of the manner in which I prefer to carry out this

Example.

second process I take a solution of hydrochlorate of diazonaphthaline prepared from about ten pounds of napthylamine substantially in the manner described in the first process and the solution of the diazo compound is added to a cold and strongly alkaline solution of the sodium salts of the napthol sulpho acids such as result from the treatment of about ten pounds of napthol with about twenty or thirty pounds of sulphuric acid.—This mixture which throughout this operation is to be kept alkaline is precipitated with chloride of sodium and the precipitate of the colouring matter thus obtained is filtered washed pressed and dried.

Third process. THIRD PROCESS.—The sulpho acids of napthylamine are converted into their respective diazo compounds and equal molecules of the diazo compounds thus obtained and of either alpha-napthol or beta-napthol are allowed to react upon each other by preference in an alkaline solution and substantially in the manner above described in the first and second processes. In this instance alpha-napthol produces brown colouring matters while red colouring matters result from the employment of beta-napthol.

As is well known the said sulpho acids of napthylamine may be produced in various ways such as for instance by the direct action of sulphuric acid upon napthylamine or in a less direct manner by treating nitro-napthaline with sulphite of ammonium or by submitting the sulpho acids of nitro napthaline to the action of reducing agents. By the said methods as is well known several modifications of the sulpho acids of napthylamine are obtained chiefly differing from each other by their various degrees of solubility in water some of them being nearly insoluble such as the so-called napthionic acid.

Example. As an example of the manner in which the sulpho acids of napthylamine may be prepared from the sulpho acids of nitronapthaline I proceed as follows :—One part by weight of nitronapthaline is mixed with about two parts by weight of rectified sulphuric acid and with about one part by weight of fuming sulphuric acid containing about 80 per cent. of anhydrous sulphuric acid and the mixture is treated at a temperature of about 100° Centigrade until the conversion into the sulphoacids of nitronapthaline is perfect or until a sample of the mixture produces a clear solution with an excess of caustic alkali. The result of this operation is then mixed with about ten parts of water and treated with reducing agents such as

metallic iron and in a manner well known in order to obtain the sulpho acids of napthylamine which may be further purified in the following manner :—

The reduction of the nitronapthaline compounds being complete the mixture is treated with an excess of milk of lime filtered and the filtered solution of the lime salts is strongly concentrated and decomposed by an excess of muriatic acid when the difficultly soluble sulpho acids will become precipitated and may be separated from the more soluble modifications by filtration or otherwise.

Example of subordinate process.

As an example of the manner in which the sulpho acids of napthylamine may be prepared by the direct action of sulphuric acid upon napthylamine I proceed as follows :—

One part by weight of napthylamine is mixed with about three parts by weight of fuming sulphuric acid containing about 80 per cent. of anhydrous sulphuric acid and the mixture is heated at a temperature of about 70° to 80° Centigrade until a sample of the mixture produces a clear solution with an excess of caustic alkali. The result of this operation is then mixed with about twenty parts of water when the difficultly soluble sulpho acids will become precipitated and may be separated from the easily soluble modifications by filtration or otherwise. All these modifications of the sulpho acids of napthylamine may be converted into the corresponding sulpho acids of oxyazonapthaline in the manner above described and thus colours obtained differing in a similar ratio in their various degrees of solubility.

Fourth process.

Fourth Process.—The sulpho acids of napthylamine are converted into their respective diazo compounds and equal molecules of the diazo compounds thus obtained and of any of the various sulpho acids of either alpha-napthol or of beta-napthol are allowed to react upon each other by preference in an alkaline solution and substantially in the manner described in the foregoing processes. In this instance the sulpho acids of oxyazonapthaline thus produced are red colouring matters.

Alternative process.

This invention further consists in the production of similar colouring matters and which may be termed "The Sulpho acids of Dioxyazonapthaline" by substituting dioxynapthaline or the diatomic napthylic alcohol for either of the two isomeric napthols in any of the before-mentioned processes.

Having now described and particularly ascertained the nature of the said invention and the manner in which the same is or may be used or carried into effect I would observe in conclusion

that what I consider to be novel and original and therefore claim as the invention secured to me by the hereinbefore in part recited letters patent is :—

Claims. First. The production of red and brown colouring matters which in chemical language may be termed the sulpho acids of oxyazonapthaline by the action of the diazo compounds which may be prepared from napthylamine or from the sulpho acids of napthylamine upon any of the isomeric napthols or of mixtures of the same or upon any of the sulpho acids which may be prepared from either alpha-napthol or from beta-napthol or from mixtures of the same substantially by the processes above described.

Secondly. The production of similar colouring matters and which in chemical language may be termed the sulpho acids of dioxyazonapthaline by substituting dioxynapthaline for either of the two isomeric napthols in any of the processes above described for the preparation of the sulpho acids of oxyazonapthaline substantially as hereinbefore described.

In witness whereof I the said John Henry Johnson have to this my specification set my hand and seal this ninth day of August one thousand eight hundred and seventy-eight.

J. HENRY JOHNSON (L.S.).

COMPLETE SPECIFICATION.—A NEW PRINCIPLE, COUPLED WITH THE METHOD OF CARRYING THE PRINCIPLE INTO EFFECT—SUPPORTED BY A COMBINATION CLAIM. 1882, No. 3660.

NOTE.—*This Specification was attacked as disclosing no subject-matter and want of utility. Held by the Court of Appeal, Cotton, Bowen, and Fry, L.JJ., affirming Kekewich, J., to be good subject-matter: that the claims were sufficient and the patent valid.* 5 P. O. R. 437.

PAUL EHRLICH, resident at Gohlis near Leipsic, Saxony, German Empire, "IMPROVEMENTS IN MECHANICAL MUSICAL INSTRUMENTS." Title.

This invention relates to that class of mechanical musical instruments in which the notes or sounds are produced by the passage of a perforated sheet or surface across the levers operating the valves of reeds or pipes, and it consists substantially in the employment of a perforated disk of circular form or of a number of like semi-circular disks, instead of the ordinary strip or band hitherto used in such instruments. Complete specification.

The invention is represented on the annexed sheet of drawings. Fig. 1 is a sectional elevation, and Fig. 2 a sectional plan of the instrument. Fig. 3, *x*, *y* *z* are three diagrams showing the relative position and arrangement of the air-holes in the reeds or pipes. Fig. 4 is a plan of a perforated circular disk; Fig. 5 a top view of a part of the instrument; Fig. 6 a top view of the instrument with semi-circular disks, one of which only is shown, and Fig. 7 a like view with both semi-circular disks in their place. Description and reference to drawings.

The disk *a* is made of thin sheet metal, card-board, paper or other suitable material, and perforated in the manner required for producing a given melody. The same is carried by a plate *b* forming the head of the vertical shaft *c*, and provided with a driving-pin or pins engaging with holes in the disk. The shaft *c* is slowly rotated from the main-shaft c^1 by worm-wheel gearing or otherwise. The main-shaft also operates the bellows *k* and k^1 by means of a crank and connecting rods. *h* are the pipes or reeds.

The valve-levers *d*, which have their fulcrum at *s*, are provided

each with a projecting stud or finger, which bears by virtue of a spring n against the under side of the disk a, so that when, during the rotation of the disk, a perforation thereof comes opposite to one of the said fingers, this finger enters into the perforation, thus permitting the valve to which it belongs, to open, and the note to sound.

Description and reference to drawings.

In order to prevent the fingers of the valve-levers from lifting the disk and from coming out of line with the perforations with which they are to register, the grates or combs e and e^1 are arranged, the former being fixed to a bar f Figs. 1 and 5, the latter to the top of the chest p. The disk a rotates between these grates, while the fingers of the valve-levers are guided in the slits between the bars thereof, the said slits registering with the perforations of the disk when these are in a line with the fingers. The latter are thus always guided accurately into the corresponding perforations. The bar f is hinged at one end to the chest p, while at the other end it is secured in such a manner that it may with facility be released and lifted, in order to allow the disk a to be exchanged. It may, when hinged at one end, also be kept in its place by a spring in the manner of a clasp-knife.

The valves r and their levers are arranged in a compartment q hermetically separated from the rest of the inside space of the instrument, and communicating with the outer air by the holes g, g^1, g^2, g^3, &c.

In case a piece of music be too long for one disk, a number of semi-circular disks A, B, C, &c., Figs. 6 and 7, may be used, each of which contains a part of the notes, and which may be inserted into the instrument one after the other without interrupting the playing. The bar f with the grate e is in this case by preference made of a length as not to reach to the centre of the plate b, as otherwise it would prevent, or at least render difficult the exchange of the disk-parts.

In perforated music sheets of all kinds it is desirable that the perforations for the lower notes have a comparatively greater length than those for the higher ones. Considering that in the circular disk the length of the perforations for notes of the same duration must be in proportion to the distance of these perforations from their centre of rotation, the disk presents the advantage that the aforesaid condition will be naturally fulfilled simply by the arrangement of the reeds and the valves in such a manner that the outer perforations will correspond to the lower notes, the inner ones to those of higher pitch.

In order to reduce as much as possible the diameter of the disk, the valve-levers *d* must be brought together as close as possible. To this effect the reeds or pipes *h* are placed in vertical ranges, but each reed or pipe is shifted laterally by so much in respect to the one which is below or above it, as is required for allowing the valve-levers to pass freely by the side of each other.

For the purpose of reducing the requisite lift of the valves, I prefer to provide each pipe or reed with two air-holes as shown in section by Fig. 1, and in front view by Fig. 8 *x*, or with three holes as in Fig. 8 *y*, and to form the valve of as many separate bars, each of which is adapted to cover one of the said holes. The valves may also be arranged in the manner of slide-valves, and in some cases two valves may be connected together in order to produce double notes; see Fig. 8 *z*. In Figs. 8 *x* and 8 *y* is also shown the relative position of the air-holes of the different reeds; I, II, III being the first range, IV, V, VI the second, &c.

The reeds *h* communicate with the main chamber T of the instrument. This chamber is hermetically closed and contains the bellows *k*, k^1 and the driving mechanism. The air sucked in by the said bellows is delivered into the chamber T with which is combined the regulating bellows *l*. The bellows *k*, k^1 may, however, also operate in the contrary manner by sucking the air from the chamber T; the pipes or reeds and the regulating bellows *l* having, in this case, of course to be arranged accordingly.

Having thus described the nature and object of my invention, and the manner in which it is to be carried out in practice, I hereby claim as new and important features of the same:

Claims perforated disk.

1. In a mechanical musical instrument, the rotative music sheet *a*, consisting of a disk perforated in accordance with the notes to be produced and co-operating with the valve-levers *d*, substantially as and for the purpose described.

Combination.

2. The combination with the valve-levers *d* of a perforated disk consisting of two parts A and B, either of which may be exchanged, as and for the purpose specified.

In witness whereof, I, &c.

A FEW PRECEDENTS FOR THE TRANSFER OF INTERESTS IN LETTERS PATENT.

SALE OF PATENT RIGHTS TO A PROPOSED COMPANY.

1. *Preliminary Agreement with Promoter.*

An Agreement made this ——— day of ——— ——— 188,— Between A. B. of ———, C. D. of ———, and E. F. of ———, hereinafter called the vendors of the first part, and X. Y. of ——— hereinafter called the promoter of the other part. **Whereas** the vendors are the owners of certain letters patent dated —— and numbered ——, for an invention entitled ——.

Agreement to assign to company.

And whereas it is intended that the promoter shall procure forthwith the incorporation by registration under the Companies Acts, 1862 to 1883, of a company to be called ——— Limited, and that the vendors shall for the considerations hereinafter mentioned sell and assign the said letters patent to the said ——— Limited. **And whereas** a print of the memorandum and articles of association of the ——— Limited has been approved by the parties hereto and is annexed to this agreement. Now it is agreed as follows:

Promoter to procure incorporation.

1. The promoter shall and will forthwith procure the incorporation under the above-mentioned acts of the said ——— Limited, and shall and will duly register as the memorandum and articles of association of the said company the memorandum and articles of association hereinbefore referred to and which are set forth in the *schedule* hereto.

Assignment to be executed by company.

2. With as little delay as possible after incorporation the vendors shall execute and the said promoter shall procure the execution by the said ——— Limited of a contract similar to that set forth in the schedule hereto or such other contract as the parties hereto and the ——— Limited shall agree upon.

Notice of determination.

3. If the promoter shall not before the ——— day of ——— 188—, perform his part of this agreement, then it shall be lawful for the vendors or either of them to determine the same

by giving notice in writing of such determination to the promoter, and if the said ——— Limited shall at that time have been incorporated also to the said ——— Limited.

SCHEDULE.

2. *Agreement to Assign to the Company.*

An Agreement made this ——— day of ——— 1888, Between A. B. of ———, C. D. of ———, and E. F. of ———, hereinafter called the vendors of the one part, and the ——— Limited hereinafter called the purchasers of the other part. **Whereas** the vendors are the owners of certain letters patent dated ——— and numbered ——— and entitled ———. **And whereas** by agreement dated ——— and made between the vendors of the one part and ——— therein called the promoter of the other, it was agreed that for certain considerations therein and herein mentioned the vendors should sell the said letters patent to the purchasers. Now it is agreed as follows :

Recital of above agreement.

1. The vendors shall upon the completion of the purchase as hereinafter provided for, assign unto the purchasers the said letters patent and all the right, title and interest of the vendors therein, free from all incumbrances save as regards assignments for districts and licences already granted as hereinafter mentioned, and the vendors shall do all things necessary and execute all documents necessary for rendering the said assignment valid and effectual.

Agreement to assign.

2. The purchasers shall pay to the vendors on or before the ——— day of ——— the sum of £——— in cash, and shall allot to the vendors or to such other person or persons as the vendors shall nominate ——— fully paid up shares in the vendors' company, and immediately upon such payment being made and the said shares being allotted the vendors shall assign the said letters patent as in the first clause hereof provided.

Payment of cash and allotment of shares.

3. The said assignment shall be subject to assignments for districts and licences in the schedule hereof mentioned, but such assignment shall include all the rights and benefits from time to time hereafter accruing to the vendors under or by virtue of such assignments for districts or licences.

Assignment subject to licenses, &c.

4. The vendors do not warrant or represent the validity of the said letters patent.

No warranty of validity.

5. Should the said purchase price not be paid or the shares not be allotted on or before the said ——— day of ——— the

Determination upon default.

vendors shall be entitled to interest upon the said purchase price and upon the nominal value of the said shares after the rate of 5 per cent. per annum until payment and allotment, or at their option to determine this contract by notice under their hands delivered at the registered office of the company. **Provided always** that the vendors shall not be entitled to sue for or recover damages against the purchasers in respect of the breach of the said agreement.

6. The said A. B. shall be deemed the agent of the said C. D. and E. F. for the purpose of receiving the said purchase money and shares and giving an effectual discharge for the same.

SCHEDULE.

AGREEMENT TO OBTAIN AND ASSIGN LETTERS PATENT FOR AN INVENTION IN CONSIDERATION OF A SUM OF MONEY AND DELIVERY OF CERTAIN NUMBER OF THE PATENT ARTICLES (*a*).

Parties.

An Agreement made the ——— day of ———, Between (*inventor*) of, &c., of the one part and (*purchaser*) of, &c., of the other part. **Whereas** the said (*inventor*) claims to have invented a new and improved kind of ———, a plan or drawing of which is hereunto annexed. **And whereas** the said (*purchaser*) has arranged with the said (*inventor*) for the sale to him of the benefit of the said invention in the manner and upon the terms hereinafter expressed. **Now Witness** that in consideration of the sum of £——— to the said (*inventor*) now paid by the said (*purchaser*) the receipt whereof is hereby acknowledged and also in consideration of the agreements hereinafter contained on the part of the said (*purchaser*) he the said (*inventor*) hereby agrees with the said (*purchaser*) in manner following (that is to say) that he the said (*inventor*) will at any time or times hereafter within the term of fourteen years to be computed from the day of the date of these presents upon the request and at the cost of the said (*purchaser*), his

Agreement to obtain and assign patent.

Recital of invention.

Testatum.

In consideration of a sum and of the purchaser's covenants, inventor covenants with purchaser, to solicit grant of letters patent

(*a*) Extracted by permission of the publishers from Bythewood and Jarman's Conveyancing.

executors, administrators, or assigns, take and use all such steps, means, and proceedings as shall be requisite or proper for obtaining, and use his the said (*inventor*)'s utmost endeavours to obtain, in the name of him the said (*inventor*), a patent for the sole and exclusive making, using, exercising, and vending of the said invention within the United Kingdom of Great Britain and Ireland, and the Isle of Man, as the said (*purchaser*), his executors, administrators, and assigns, may desire, during the term or terms for which patents for inventions are usually granted. **And further**, that the said (*inventor*), his executors, or administrators, will at any time or times after obtaining any such patent upon the request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, make, do, and execute all such assignments, deeds, matters, and things, as the said (*purchaser*), his executors, administrators, and assigns, shall reasonably require for assigning, and transferring unto the said (*purchaser*), his executors, administrators, and assigns, for his or their absolute benefit, the said patent, and the full benefit and advantage thereof; **And further**, that he the said (*inventor*) will, at any time or times hereafter, upon every reasonable request of the said (*purchaser*), his executors, administrators, or assigns, more particularly and sufficiently describe to him or them, or his or their agents or workmen, either in writing or by personal explanation and instruction, or otherwise, the nature of the said invention, and in what manner the same, and every part thereof, and every process relating thereto, are to be performed or carried into effect and used; **And further**, that he the said (*inventor*), his executors or administrators, will not, nor shall any person or persons claiming by, from, through, or under him or them, at any time or times hereafter, during the term of fourteen years to be computed from the day of the date of these presents, without the consent or licence of the said (*purchaser*), his executors, administrators, and assigns, either alone or in copartnership, or in any other manner, howsoever, directly or indirectly, make or assist in the making of any ——— of the new and improved kind hereinbefore mentioned, or in the construction of which the aforesaid invention shall be used; or (except by any specification or specifications which may have to be executed and enrolled for the purposes of the application for the said patent) described, either in writing or otherwise, to any person or persons other than the said (*purchaser*), his

and to assign letters patent;

to instruct purchaser in the invention

Not to use invention without purchaser's licence;

nor, except by specification, to disclose invention;

executors, administrators, or assigns, the nature of the said invention, or in what manner the same is to be performed or carried into effect, or give any information, or do or permit or be party or privy to, any act, matter, or thing whereby or by means whereof the same respectively may be known by any person or persons other than as aforesaid, or whereby or by means whereof the said (*inventor*) may be prevented or hindered, from obtaining the said patent for the purposes hereinbefore mentioned. **And further**, that he the said (*inventor*) has not at any time or times heretofore described, either in writing, or otherwise, to any person or persons other than the said (*purchaser*), the nature of the said invention, or in what manner the same is to be performed or carried into effect, or given any information, or done or permitted, or been party or privy to, any act, matter, or thing, whereby or by means whereof the same respectively may have been or may be known by any person or persons other than as aforesaid, or whereby or by means whereof he may be prevented or hindered from obtaining the said patent for the purposes hereinbefore mentioned; **And further**, that he the said (*inventor*) will, at any time or times hereinafter, upon every request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, make, do, execute, and perfect all such lawful acts, deeds, disclaimers, amendments, and other matters and things, for the better or more satisfactorily or effectually sustaining or maintaining such patent as aforesaid, and assuring the same, and the full benefit thereof, and of the said invention unto the said (*purchaser*), his executors, administrators, and assigns, as by him or them shall be reasonably required. **And** in consideration of the agreements hereinbefore contained on the part of the said (*inventor*), he the said (*purchaser*) hereby agrees with the said (*inventor*), his executors and administrators, that he the said (*purchaser*), his executors or administrators, will, within the space of one year, to be computed from the day of the date of the patent to be so obtained as aforesaid, at his or their cost, make and deliver, for and to the said (*inventor*), his executors and administrators,—complete, perfect, and well made and finished,—of the new and improved kind hereinbefore mentioned. **And will**, from time to time and at all times hereafter, save, defend, and keep harmless and indemnified the said (*inventor*), his heirs, executors, and administrators, and his and their estates and effects whatsoever and wheresoever, of, from,

that inventor hath not disclosed invention, and is not prevented from obtaining patent :

for further assurance,

purchaser agrees to make a certain number of articles, and deliver them to the inventor ;

to indemnity inventor from costs of obtaining letters patent.

and against all costs and charges to be incurred or sustained in, about, or in anywise relating to the obtaining of the said patent, and the preparing any specifications which may be necessary for the purposes of the application for the same, and of, from, and against all claims and demands on account thereof. **Provided always,** and it is hereby agreed and declared, that the solicitor or agent to be employed in obtaining the said patent, and in preparing any such specification or specifications as aforesaid, shall be appointed by the said (*purchaser*), his executors, administrators, or assigns; **And that** the said (*inventor*), his heirs, executors, or administrators, shall not be answerable or accountable for any neglect or default of such solicitor or agent anything hereinbefore contained to the contrary thereof in anywise notwithstanding.

Proviso that purchaser is to appoint solicitor, or agent, and that inventor shall not be responsible for his default.

As witness, &c.

AGREEMENT BETWEEN JOINT OWNERS OF A PATENT FOR PARTITION.

An Agreement made the ——— day of ——— 188—, Between A. B. of ——— of the one part, and C. D. of ——— of the other part. **Whereas** the said A. B. and C. D. are joint owners of certain letters patent dated ——— and numbered ——— and entitled ———. **And whereas** they have agreed to divide the special licence, full power, sole privilege, and authority by the said letters patent granted in the manner and upon the terms hereinafter appearing. Now it is agreed as follows:

Agreement to divide.

1. The said A. B. shall be solely entitled henceforth to use, work and vend the invention forming the subject matter of the said letters patent in the following counties ——— and shall be solely entitled within the said counties to grant assignments for districts or special or general licences upon any terms which the said A. B. shall see fit, and the said C. D. shall whenever required to do so by the said A. B., execute a valid assignment of all his interest in the said letters patent within the said counties to the said A. B.

Assignment of district to A. B.

2. The said C. D. shall be solely entitled henceforth to use, work, and vend the said invention in the following counties ———, and shall be solely entitled within the said counties to grant assignments for districts or special or general licences

Assignment of district to C. D.

upon any terms which the said C. D. shall see fit, and the said A. B. *shall, whenever required to do so by* the said C. D., execute a valid assignment of all his interest in the said letters patent within the said counties to the said C. D.

Neither party to account.

2. Neither party shall be bound to account to the other for any profits, royalties, or payments received by him with respect to the *using*, vending, or working the said invention within the counties or districts assigned to him hereby.

Payment of fees, &c.

3. The said C. D. shall from time to time and as they become due pay the fees for the continuance and renewal of the said letters patent, and shall be entitled to recover one moiety of the sums of money so paid from the said A. B.

4. This agreement and all the provisions thereof shall apply to any letters patent obtained or acquired by either party hereto for any improvements upon the said patented invention, and

Future patents elective.

neither party shall be bound to make any payments in respect of any such improvements to the other. **Provided always**, that immediately after applying for any such letters patent the party seeking to obtain the same shall give notice in writing to the other of the said improvement and full particulars respecting the same, together with a copy of the specification filed, and thereupon the other party shall elect whether he shall take the benefit of the said invention or not, and if he elects to take the benefit thereof shall from time to time pay to the party applying for such letters patent one moiety of all the costs, fees, and charges incurred in obtaining or seeking to obtain such letters patent, and then the said letters patent and the said invention shall be deemed to be within this agreement, but should he elect not to pay the said moiety of costs, fees, and charges, then he shall be deemed to have abandoned all claim to the said letters patent and invention, and the party applying for such letters patent shall thenceforth be the sole owner thereof.

No amendment without consent.

5. Neither party shall apply for leave to amend the specifications to any letters patent within this agreement without the consent of the other first had and obtained.

6. So far as practicable this agreement shall apply to and be binding on the executors, administrators, or assigns of the parties hereto.

AGREEMENT FOR WORKING AND SELLING AN INVENTION, IN RESPECT OF WHICH AN APPLICATION FOR A PATENT HAS BEEN MADE, FOR THE JOINT BENEFIT OF THE INVENTOR AND ANOTHER PERSON (*a*).

An Agreement made the ——— day of ———, 18—, Between Parties. (*inventor*), of, &c., of the one part; and (*capitalist*), of, &c., of the other part. Recitals of application for patent; **Whereas** the said (*inventor*) has, under the Patents, Designs, and Trade Marks Act, 1883, made an application, dated the ——— day of ——— 18—, number ———, for a patent for an invention of (*title of invention*), which application was accompanied by a complete specification: of acceptance of specification; **And whereas** the said complete specification has been accepted: of agreement for arrangement as to working, &c., the invention. **And whereas** the parties thereto have agreed to enter into the arrangements hereinafter mentioned in respect of the said invention and application, and the patent to be obtained thereupon. *Testatum.* **Now these Presents witness** that it is hereby agreed as follows, that is to say:—

Agreement.

1. The said (*capitalist*) shall immediately upon the execution of these presents, pay to the said (*inventor*) a sum of £———, to be applied by him towards the expenses of working and developing the said invention. Capitalist to contribute sum for expenses.

2. In consideration of the payment so agreed to be made as aforesaid, and of the agreements on the part of the said (*capitalist*) hereinafter contained, the said (*inventor*) shall use his best endeavours to perfect the said invention, and to obtain the grant of the said patent in his own name, and shall, whenever required by the said (*capitalist*) after the granting of such patent, assign the same, so that the same premises may be legally and beneficially vested in the said parties hereto as tenants in common in equal shares, and the said parties hereto shall as well before as after such assignment, be entitled to the said patent in the shares aforesaid. Inventor to endeavour to obtain patent, and assign the same when required.

3. The said (*inventor*), without any further remuneration than the monies hereinafter agreed to be paid by the said (*capitalist*), will communicate to the said (*capitalist*) all improvements which the said (*inventor*) has already invented, discovered, or made, or may during the continuance of the said patent, or of any other Inventor to communicate improvements.

(*a*) Extracted by permission of the publishers from Bythewood and Jarman's Conveyancing.

patent which may become subject to the provisions of these presents, invent, discover, or make in, or in connection with the said invention; and also all improvements whether patented or not in or in connection with the said invention, of which the said (*inventor*) shall become the owner, or have the control.

Inventor to apply for foreign and colonial patents

4. The said (*inventor*) will also, at the expense in the first instance of the said (*capitalist*), such expense to be considered as an advance, and to be reimbursed as hereinafter mentioned, apply for and endeavour to obtain in such foreign countries, or British Colonies, or dependencies, as the said (*capitalist*) shall think proper, and shall require, the like privilege for the invention comprised in the application, and for any such improvements as aforesaid; and will, as far as practicable, at the request and expense, in the first instance, of the said (*capitalist*), such expense to be considered as an advance, and to be reimbursed as hereinafter mentioned, render all such foreign and colonial patents, and the said improvements available for the exclusive use of the said parties hereto in equal shares; and execute and do every act, deed, and thing which may be necessary or expedient for effectually vesting the same in the said parties hereto in the shares aforesaid.

Capitalist to make advances for working and developing invention.

5. The said (*capitalist*) shall advance from time to time such monies as he shall think fit for working and developing the patent to be obtained on the aforesaid application numbered ——, or the said foreign and colonial patents or like privileges, or any such patents for improvements as aforesaid (all which patents and privileges are collectively referred to as the "said patents"), and for defraying the costs and expenses of obtaining and completing the said patents respectively, and keeping the same on foot, and for protecting or defending the same from, or obtaining damages or other compensation for infringements or otherwise defending the said patents, or of obtaining renewals and extension of the term of the said patents, or amending the specification thereof, or working or developing the working comprised in the said patents (hereinafter referred to as the said patented inventions), or introducing the same to the public, or exercising or using the said patented inventions, or any of them, or any parts thereof respectively, or for any purpose whatever in connection with the said patents, or any of them; and the said advances, and also the aforesaid sum of £—— shall be repaid to the said (*capitalist*) as hereinafter mentioned; and if there shall at any one time during the continuance of this

agreement be owing to the said (*capitalist*) in respect of such advances in the aggregate, the sum of £———, or upwards, then any excess of such advances over the sum of £———, shall carry interest at the rate of £5 per cent. per annum, from the date when such excess shall have become due to the said (*capitalist*) until the same shall be paid.

Charge of advances on patents.

6. All advances made by the said (*capitalist*) as aforesaid, and all interest shall be, and the same are hereby charged upon the said patents as a first charge upon the same.

Application of royalties, proceeds of sale of patent rights, &c.

7. All monies which shall be received by way of royalties, or otherwise, as the consideration for any licence granted for the use of the said patented inventions, or any of them, or any part thereof respectively, or which shall be received as the proceeds of the sale, or other disposition of the said patents, or any share or interest therein, or which shall be received in respect of any working, using, or exercising by or on behalf of the said parties hereto, or either of them, of the said patented inventions, or any of them, or any part thereof respectively, or which shall in any manner whatever arise, or be received out of, or in respect of the said patents, or any of them, all which monies are hereinafter referred to as "the proceeds of all the said patents," shall be applied as follows:—that is to say, in the first place, in payment of the costs and charges incurred with the consent of the said (*capitalist*) attending the licence, sale, disposition, or working in respect of which the same respectively shall be received; and in the next place, and as a charge upon the said proceeds of the said patents, and in priority to any other payments hereinafter mentioned, in payment to the said (*capitalist*) of all advances made by the said (*capitalist*) as aforesaid with the interest thereon, in the events, and at the rate, and in manner aforesaid; and in the next place, in payment of all expenses of working the said patents (hereinafter referred to as the patent expenses, and defined as hereinafter mentioned); and the balances which shall remain of the proceeds of the said patents, after making the same payments aforesaid, shall be divided between the parties hereto in equal shares.

Definition of "patent expenses."

8. For the purposes of this agreement the expression "patent expenses" shall mean and include all monies which, with the consent of the said (*capitalist*), shall be expended for any of the purposes mentioned in the 5th clause of these presents, which shall not have been defrayed by monies advanced by the said (*capitalist*).

Reserve fund.

9. There shall be set aside yearly out of the aforesaid proceeds of the said patents and premises, after payment of the said costs, charges, and interest (if any), and of the said patent expenses, such a sum not exceeding £——— in any one year, as the said (*capitalist*) shall think proper, as a reserve fund for meeting contingencies, and providing monies for working and developing the patents, or for any of the purposes mentioned in the 5th clause of these presents, and such reserve fund may from time to time be drawn upon and applied for any of the purposes aforesaid, as and whenever the said (*capitalist*) shall think fit.

Inventor to devote attention to working patent.

10. The said (*inventor*) shall give as much time and attention as may be necessary for working and developing the said patented inventions, and shall use his best endeavours to promote the success thereof, but the said (*capitalist*) shall not be bound to give more time or attention thereto than he shall think proper.

Neither party to grant licences, &c., without consent of the other.

11. During the continuance of the arrangement hereby made neither of the said parties hereto shall, without the consent of the other of them, grant or agree to grant any licence for working the patented inventions, or any of them, or any part thereof, or sell or dispose of his share or interest in the said patents or any of them, or any part thereof, or use or exercise the said invention, or make any payment, or incur any expenses, debts, or liabilities in respect of the said patents or patented inventions, and in case any payment, debt, or liability shall be so made or incurred without such consent, the same shall be made or incurred on the separate and individual account of the party making or incurring the same, and shall be borne by him exclusively, without any right to resort to the proceeds aforesaid of the said patents, and the other of the said parties hereto shall be indemnified by him in respect of the same.

Inventor alone to work the patent; rendering accounts to capitalist.

12. The said patents, patented inventions, and premises shall be worked, and the business thereof shall be carried on in the name of the said (*inventor*) alone as patentee; and proper accounts shall be kept by him of all payments made, and monies received, and liabilities incurred in respect thereof, and of all transactions relating thereto, and all monies received in respect of licences, sales, and dispositions or otherwise, in respect of the said patents, shall be paid into a bank to an account to be kept in the joint names of the said parties hereto, and shall not be paid out except upon the joint cheque of both parties. The books of account and other documents shall be kept in the

custody of the said (*inventor*) at his office or such other place in London as the said parties hereto may agree upon, but so as that the said (*capitalist*) may at any time have access thereto. The accounts relating to the said patents, patented inventions, and premises shall be made up and balanced half-yearly on the ——— day of ———, and the ——— day of ———, or oftener if the said parties hereto shall so agree.

Inventor to take all proceedings necessary for protecting patents.

13. The said (*inventor*) shall, during the continuance of the arrangements hereby made, take all such proceedings as the said (*capitalist*) shall require for keeping up the said patents and protecting and defending the same from and obtaining damages or other compensation for infringement or otherwise defending the said patents or any of them, obtaining renewals or extensions of the term of the said patents or any of them, or amending the specifications thereof, and the costs and expenses of all such proceedings as last aforesaid shall be defrayed in the first instance by the said (*capitalist*), and shall be considered as advances by him within the meaning of the 5th clause of these presents, and so far as not defrayed by the said (*capitalist*) shall be considered as part of the patent expenses as hereinbefore defined.

Clause negativing partnership.

14. Nothing herein contained shall be construed as constituting a partnership between the said parties hereto.

Duration of arrangement.

15. The arrangement hereby entered into shall remain in force until the expiration of the term of the patent to be granted in respect of the said application numbered ——— aforesaid, and of any renewal or extension thereof, and during any further patents, whether British, colonial, or foreign, to be obtained for the said invention, or any such improvements as aforesaid in case both the said parties hereto shall so long live.

Proviso for determining arrangement by notice.

Provided always that it shall be lawful for the said (*capitalist*) at any time hereafter to determine the said arrangement upon giving to the said (*inventor*), or leaving for him at his last known place of business or abode in England, ——— calendar months previous notice in writing of an intention so to do; And in the event of the said arrangement being determined by the death of either party, or by notice as aforesaid, the said patents and any extension or renewal thereof, and the proceeds of the said patents to be received in respect of any licences, sales, working, or using of the patented inventions which have been granted, effected, or taken place previously to such determination as aforesaid shall, subject to the payment thereout of the costs, charges, advances, interest, and patent expenses as aforesaid (subject to any charge

thereon under the provisions hereinbefore contained in favour of the said (*capitalist*) for unpaid advances and interest) belong to the said parties hereto in equal shares, and each of the parties hereto, or their respective executors, administrators, or assigns, shall thenceforward be at liberty and entitled to work, use, and exercise the said patented inventions, and to grant licences (not being exclusive licences) for working and using the same, or to sell, assign, or otherwise dispose of his share and interest in the said patents without being liable to account to the other of such parties, his executors, administrators, or assigns, for the profits, royalties, or monies to be derived from the same.

As witness, &c.

ASSIGNMENT OF A PATENT.

This Indenture made the ——— day of ——— 18—, Between A. B. of ——— of the one part, and C. D. of ——— of the other part.

Whereas by letters patent under the seal of the Patent Office, numbered ——— and dated ——— day of ———, 18—, and entitled, "Improvements, &c. ———," Her Majesty the Queen gave and granted unto the said A. B., his executors, administrators, and assigns, Her Majesty's especial license, full power, sole privilege and authority, that he the said A. B., his executors, administrators, and assigns, and every of them during the term therein expressed should and lawfully might make, use, exercise, and vend his said invention within the United Kingdom of Great Britain and Ireland and the Isle of Man, and the whole profit and advantage from time to time accruing by reason of the said invention during the term of years therein mentioned to have, hold, exercise and enjoy the said licence, power, privileges and advantages thereinbefore granted unto the said A. B., his executors, administrators and assigns, for and during and unto the full end and term of fourteen years from the date of the now reciting letters patent next ensuing subject to the conditions and provisoes therein contained. **And whereas** the said A. B. has agreed for the sum of £——— to assign unto the said C. D. the said invention and the said letters patent and all the licence, power, privilege and advantage thereby granted, and any extension of the same, together with all improvements and additions useful to the

General recitals.

manufacture, the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the said A. B.

Now this Indenture witnesseth that in pursuance of the said agreement and in consideration of the sum of £———, this day paid by the said C. D. to the said A. B. (the receipt whereof is hereby acknowledged) he the said A. B. *as beneficial owner* (*a*), doth hereby assign unto the said C. D., his executors, administrators and assigns, all that the said special licence, full power, sole privilege and authority, and the said invention and all and every of the rights, privileges, profits, benefits, commodities and advantages in and by the said hereinbefore recited letters patent granted, together with the said hereinbefore recited letters Testatum.

(*a*) By the Conveyancing Act, 1881, s. 7 (*a*), it is provided "In a conveyance for valuable consideration, other than a mortgage, the following covenant by a person who conveys and is expressed to convey as beneficial owner (namely) :—'That, notwithstanding anything by the person who so conveys, or any one through whom he derives title, otherwise than by purchase for value, made, done, executed, or omitted, or knowingly suffered, the person who so conveys, has, with the concurrence of every other person, if any, conveying by his direction, full power to convey the subject-matter expressed to be conveyed, subject as, if so expressed, and in the manner in which it is expressed to be conveyed, and that notwithstanding anything as aforesaid that subject matter shall remain to and be quietly entered upon, received and held, occupied, engaged and taken by the person to whom the conveyance is expressed to be made and any person deriving title under him, and the benefit thereof shall be received and taken accordingly without any lawful interruption or disturbance by the person who so conveys or any person conveying by his direction or rightfully claiming, or to claim by, through, under, or in trust for the person who so conveys or any person conveying by his direction or by, through, or under anyone, not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made through whom the person who so conveys derives title otherwise than by purchase for value ; and that freed and discharged from or otherwise by the person who so conveys sufficiently indemnified against all such estates, incumbrances, claims and demands other than those subject to which the conveyance is expressly made as either before or after the date of the conveyance, have been or shall be made, occasioned or suffered by that person or by any person conveying by his direction or by any person rightfully claiming by, through, under, or in trust for the person who so conveys or by, through, or under any person conveying by his direction or by, through, or under any one through whom the person who so conveys derives title otherwise than by purchase for value, and further that the person who so conveys and any person conveying by his direction and every other person having or rightfully claiming any estate or interest in the subject matter of conveyance other than an estate or interest subject whereto the conveyance is expressly made by, through, under, or in trust for the person who so conveys or by, through, or under, any person conveying by his direction or by, through, or under any one through whom the person who so conveys derives title otherwise than by purchase for value will from time to time, and at all times after the date of the conveyance on the request and at the cost of any person to whom the conveyance is expressed to be made or of any person deriving title under him execute and do all such lawful assurances and things for further or more perfectly assuring the subject matter of the conveyance to the person to whom the conveyance is made and to those deriving title under him subject as if so expressed and in the manner in which the conveyance is expressed to be made as by him or them or any of them shall be reasonably required : (in which covenant a purchase for value shall not be deemed to include a conveyance in consideration of marriage).' "

patent, and also all the right, title, interest, claim and demand whatsoever of him the said A. B., his executors, administrators and assigns, or any of them, to apply and petition for, obtain and procure a prolongation, or extension of the said licence, privilege and authority, and of the said term of fourteen years granted by the said hereinbefore recited letters patent, and to apply and petition for, obtain and procure any new or other letters patent to be granted for any new or additional term or terms of years.

Habendum. **To have, hold, and receive**, take, exercise and enjoy the said especial licence, sole privilege and authority, invention, letters patent, rights, privileges, and all and singular the premises hereby assigned or intended so to be unto and by the said C. D., his executors, administrators, and assigns for and during all the rest, residue and remainder which is now to come and unexpired of the said term of fourteen years granted and created by the said hereinbefore recited letters patent, and for and during all other the term right and interest of him the said A. B. under or by virtue of the said hereinbefore recited letters patent or otherwise howsoever to and for the sole use, benefit and advantage of the said C. D., his executors, administrators and assigns.

And the said A. B. for himself, his heirs, executors and administrators doth covenant with the said C. D., his executors, administrators and assigns, by these presents in manner following, (that is to say) that notwithstanding any act, deed, matter or thing by the said A. B. done, executed or permitted, the said hereinbefore recited letters patent are at the time of the sealing and delivery of these presents, good, valid and sufficient in the law for all and every of the purposes therein mentioned and expressed, and that the same letters patent or the grant therein expressed or contained have not been and are not surrendered, forfeited or become void or voidable in anywise whatsoever (*b*).

Covenant as to validity

and as to specification being sufficient, &c.

And that the specification filed by the said A. B. at the Patent Office pursuant to the conditions upon which the hereinbefore recited letters patent were granted, well and sufficiently describes and ascertains the nature of the invention mentioned in the said letters patent, and in what manner the same is to be performed, and that the same specification was truly and duly made and filed according to and well, truly, fully and sufficiently performed

(*b*) It is obvious that this is a stringent covenant on the part of the patentee, inasmuch as it renders him responsible should it hereafter appear that for any reason such as anticipation, &c., the letters patent were invalid, this covenant and the next should be carefully considered before they or either of them are inserted.

and complied with the conditions in that behalf in the same hereinbefore recited letters patent expressed and contained.

In witness.

Additional Recitals.

And whereas the said A. B. has agreed for the sum of £——, and for other sums by way of percentage as hereinafter mentioned, and subject to the contracts on the part of the said C. D., hereinafter contained to assign (&c., as before).

Substituted recital of agreement for a sum down and future payments. *See* Covenant and Conditions in such a case.

And whereas the said A. B. has applied for and obtained letters patent or a Brevet d'Invention, for the said invention in the following foreign states and countries . . . . . and in the following British Colonies . . . . . whereby the said A. B., his executors, administrators and assigns, have acquired the sole right privilege and authority to work, use, or vend the said invention in the said Foreign States and British Colonies for the terms of years limited respectively by the said letters patent and Brevet d'Invention, and whereas in consideration of the sum of money hereinbefore expressed, the said A. B. has agreed to assign the said letters patent and Brevets d'Invention to the said C. D.

Foreign and colonial patents recital.

And whereas the said A. B. has represented himself to the said C. D. to be to the best of his knowledge, information and belief, the true and first inventor of the said invention within this realm.

True and first inventor.

And whereas the said A. B. has assigned the said letters patent and all the rights, powers, privileges and advantages of he the said A. B. in the said letters patent, and the said invention for the counties of ——— to G. H. his executors, administrators or assigns, and for the counties of ——— to J. K. his executors, administrators or assigns, &c., &c.

Previous assignments for districts (c),

(c) See special covenant necessary in such cases as to applications to amend, &c., &c.

and of intention to assign for other district.

And whereas the said A. B. contemplates and intends to assign the said letters patent and all the rights, powers, privileges and advantages of he the said A. B. in the said letters patent and the said invention for other districts so soon as a purchaser shall be found therefor.

Recital of licence granted.

And whereas the said A. B., by indenture dated ——, has granted a license unto E. F. of ——, his executors, administrators and assigns, to manufacture, use and vend the said invention during the continuance of the said letters patent or any extension or renewal thereof, upon certain terms and conditions as to the payment of royalties and otherwise in the said indenture made and provided (*d*).

Substituted recital of agreement to assign for a district.

And whereas the said A. B. has agreed in consideration of the sum of £ ——to assign unto the said C. D., benefit of the said letters patent so far as the same relates to the counties of ——, but not elsewhere, and so far as the same relates to the said counties, all the licence, power, privilege and advantage thereby granted, and any extension of the said letters patent together with all improvements and additions useful to the manufacture the subject matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the said A. B.

Assignment for a county(*e*).

Now this Indenture witnesseth that in pursuance of the said agreement, and in consideration of the sum of £—— this day paid by the said C. D. to the said A. B. (the receipt whereof is hereby acknowledged) the said A. B., *as beneficial owner*, doth hereby assign unto the said C. D., his executors, administrators and assigns, all that the said especial license, full power, sole privilege and authority, and the said invention, and all and every the rights, privileges, profits, benefits, commodities and advantages in and by the said hereinbefore recited letters patent granted so far as the same relate to the counties of ——, and not elsewhere.

(*d*) This may be varied by reciting "an exclusive licence" or "an exclusive licence for the county of ——"

(*e*) See proviso restricting actions for infringement.

Together with all license, powers, privileges and advantages granted to the said A. B., his executors, administrators and assigns: by virtue of the said recited Letters Patent and Brevets d'Invention for Foreign States and British Colonies. Foreign and colonial patents (*f*).

Together with all the rights, royalties, benefits and advantages of the said A. B., under and by virtue of the said recited licence granted by the said A. B. unto E. F., his executors, administrators and assigns. Assignment of benefit of licences.

Additional Covenants. (*See* Recitals.)

And the said C. D. hereby covenants with the said A. B. that if and so soon as the said C. D., his executors, administrators, or assigns, shall have received out of the net profits (to be calculated as hereinafter mentioned) arising from or by means of the said invention, or such improvements as aforesaid (patents for which improvements shall have been assigned to or become vested in the said C. D., his executors, administrators, or assigns, or from or by means of any sales, or licences, or dispositions of, or dealings with the same invention, or patented improvements, or otherwise, from, or by means of the using, exercising, vending, or making the said invention or any such patented improvement as aforesaid, or the said patent, the sum of £——, he, the said C. D., his executors, administrators, or assigns, shall pay to the said A. B., his executors, administrators, or assigns, at the times and in the manner hereinafter mentioned, such a sum or sums of money as shall be equal to a percentage of £—— per cent. upon the net profits (to be calculated as hereinafter mentioned), arising as aforesaid, from the time when the said C. D., his executors, administrators, or assigns, shall have received the aforesaid sum of £——, and thenceforth during the remainder of the period in which the said patent hereby assigned, or any such patent for improvements as aforesaid as shall be assigned to or become vested in the said C. D., his executors, administrators, or assigns, shall continue in force. **And further**, that the said C. D., his executors, administrators, Covenant as to percentage when such is stipulated for by vendor.

(*f*) See covenants as to maintaining such foreign patents.

or assigns, will, so soon as he or they shall have received from the net profits arising as aforesaid the sum of £—— thenceforth twice in every year on the —— day of ——, and the —— day of ——, or within 14 days thereafter respectively, furnish to the said A. B. an account showing the amount for the half year in respect of which the account is furnished, of the net profits arising as aforesaid; and shall within one calendar month after the date up to which such half-yearly account is furnished, pay to the said A. B., his executors, administrators, or assigns, the percentage by the said account appearing to be due.

Covenant not to apply for leave to amend applicable to assignments for a district (*h*).

And the said C. D. covenants with the said A. B. that he the said C. D., his executors, administrators and assigns, will not apply for leave to amend, or amend, or cause to be amended, the said specification or the drawings thereof, in any way whatsoever without the consent of the said A. B., his executors, administrators or assigns, in writing, first had and obtained—such consent not to be unreasonably withheld (*g*).

Covenants by assignor as to taking future patents in assignment for a district only.

And that in case he, the said A. B., shall obtain letters patent in respect of any improvements, additions to, or discovery useful to the manufacture the subject-matter of the said recited letters patent, he shall, at the expense of the said C. D., his executors, administrators or assigns (if and when required him to do so), execute and do all such assurances and things as shall be necessary or convenient for vesting the same letters patent, and the exclusive benefit thereof, *for the said counties* in the said C. D., his executors, administrators or assigns.

(*g*) In some cases where the district assigned is large a converse covenant on the part of the assignor should be inserted.

(*h*) A great difficulty is introduced by section 36 of the Act of 1883: "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." It will be observed that under this section a patentee can create innumerable patentees all with coequal rights, not only amongst themselves but with the original patentee, but still all possessing only one original patent and one specification. It was clearly not the intention of the legislature that the specification might be split up and amended in one county and not in another and so on; but on the other hand the whole validity and value of a patent may very often depend upon the question of amendment or non-amendment—if one assignee amends he might by doing so ruin all the others, on the other hand by refusing to consent to an amendment he might do the same thing. The author has drafted a precedent clause which might do for some instances, but it is chiefly introduced to call the attention of conveyancers to the difficulty of the position.

Covenant to pay fees on renewal when patent assigned for a district only.

And also that he the said A. B., his executors, administrators or assigns, will pay all fees necessary for the renewal of the said letters patent respectively during the respective terms comprised therein one calendar month at least before the times provided by the Patents, &c., Act, 1883, or the Rules made in pursuance thereof in that behalf, but in case of non-payment thereof as aforesaid, will, if required by the said C. D., his executors, administrators or assigns, permit him or them to pay the same, and any sum if so paid by him or them shall be repayable on demand, together with interest thereon at the rate of 5 per cent. per annum from the time of payment thereof and until repayment, and shall together with the interest aforesaid, be a charge upon the interest of the said A. B. and his executors, administrators or assigns, in the said letters patent respectively.

Covenant to communicate and assign future improvements.

And the said A. B. hereby covenants with the said C. D. that the said A. B. will without any further remuneration or royalties communicate to the said C. D. all improvements which the said A. B. may during the continuance of the said patent invent, discover, or make for or in connection with the said invention, and also all improvements, whether patented or not, of which the said A. B. shall have the control, and will, so far as practicable, at the request and expense of the said C. D., render the same available for the exclusive use of the said C. D., and do every act, deed, and thing which may be necessary or expedient for obtaining and perfecting patents for all or any such improvements, and for assigning or vesting the same to or in the said C. D.

Conditions to be inserted when a percentage is to be paid as well as a sum down.

And it is hereby further agreed and declared between and by the said parties hereto as follows:

1. For the purpose of calculating the moneys to be derived as aforesaid, there shall be deducted from the gross moneys received from or by means of the said inventions, or such patented improvements as aforesaid, or any sales, or licences, or other dispositions and dealings with the same, or otherwise, from, or by means of the using, exercising, vending, or working the invention, or patented improvements, or patent, which moneys are hereinafter called the gross receipts, all costs, charges, losses, damages, and expenses whatsoever, which the said C. D., his executors, administrators, or assigns, may have already paid or

incurred, or may hereafter pay or incur, in or about the obtaining, or endeavouring to obtain, or the keeping in force any such patent for improvements as aforesaid, or the assigning the same to the said C. D., his executors, administrators, or assigns, or in or about the introducing to the public the said patents, inventions, and patented improvements, or any of them, or in or about any such sales, licences, or other dispositions, or dealings as aforesaid, or in or about any legal, or other proceedings, which may be taken for the purpose of restraining infringement of the said patents, or any of them, or for recovering damages for infringements, or which may be taken in respect of any sale, or proposed sale of the said patents, or any interest therein, or any licence or proposed licence for working the said invention and patented improvements, or any of them, or any part thereof; or generally in any manner in or about the said patents, or any of them, or the using, exercising, vending, or working the said invention, or patented improvements, or any of them, or patents, all which costs, charges, losses, damages, and expenses are hereinafter referred to as patent expenses, together with interest at the rate of £—— per cent. per annum, upon such patent expenses respectively from the time of the payment thereof, and the difference between the gross receipts for any half year and the patent expenses for the same half year, shall be the net profits arising as aforesaid, upon which the percentage aforesaid is to be paid.

Keeping accounts.

2. Proper books of account shall be kept by the said C. D., his executors, administrators, and assigns, in which true, plain and perfect entries shall be made of all the payments, expenses, and gross receipts aforesaid, and such books of account shall at all reasonable times be open to the inspection of the said A. B., his executors, administrators, or assigns, or any agent duly appointed by him or them in writing.

Assignee not to be bound to apply for patent for improvements.

3. Nothing herein contained shall be construed as obliging the said C. D., his executors, administrators, or assigns to obtain, or endeavour to obtain, any patent for any such improvements as aforesaid, or to accept any assignment of any patent for such improvements, or to pay the stamp duty upon, or to defend, or maintain the said patent hereby assigned, or any such patent for improvements as aforesaid, which may be assigned to, or become vested in him or them, in performance of the covenants in that behalf hereinbefore contained, or to take any steps for restraining infringements of the same patents, or any of

thom, or recovering damages for any infringement, or to make any sale or sales of the said patents, or any interest therein, or to grant any licence, or licences for the use of the said invention, or any such patented improvements as aforesaid, or any part thereof respectively, or in any manner to use, exercise, vend, or work the said invention, improvements or patents, or any of them; it being hereby expressly agreed and declared that the said C. D., his executors, administrators or assigns, is and are and shall be the absolute owners of the said patent hereby assigned and of any patent or patents for improvements which may be assigned to or vested in him or them as aforesaid, or which he or they may under the covenants aforesaid, require to be assigned to him or them; and that the said C. D., his executors, administrators, or assigns, shall not in regard to the said patents, or any of them, be subject to any control or interference whatsoever of the said A. B., his executors, administrators or assigns.

Assignor not to assign interest without consent

4. During the continuance of the said patent hereby assigned, and during the continuance of any patent or patents for improvements which may be assigned to or become vested in the said C. D., his executors, administrators, or assigns as aforesaid, the said A. B., his executors, administrators, or assigns, shall not sell or dispose of the percentage payable to him or them as aforesaid without the consent in writing of the said C. D., his executors, administrators, or assigns; nor shall the said C. D., his executors, administrators, or assigns, sell, or dispose of the said patents, or any of them, without the consent in writing of the said A. B., his executors, administrators, or assigns.

Assignor not to reassign without consent.

No partnership.

5. Nothing herein contained shall be considered as constituting a partnership between the said parties hereto.

No warranty, of validity.

6. Nothing herein contained shall be construed as a warranty by the said A. B., of the novelty or utility of the said invention, or of the validity of the said patent hereby assigned.

Proviso to be inserted in assignment for a district of certain inventions(*i*).

Provided always, and it is hereby further agreed and declared, that no action at law or equity shall be brought by the said

(*i*) It is evident that some such proviso as this is of the utmost importa n , when the patent is for an article of common use. The words of sect. 36 are :—"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." It would create great confusion and injury to all parties if a man travelling from London to York were liable to actions by different assignees of the districts through which he trav lled on account of wearing a particular collar stud.

C. D. against any person or persons to restrain infringements or to recover damages in respect of the mere user of (*collar studs made in pursuance of the said patented invention*) within the said county of —— provided that such user be not for profit or for sale, or in the way of trade.

NON-EXCLUSIVE LICENCE TO USE PATENTED INVENTION IN CONSIDERATION OF AN ANNUAL PAYMENT AND THE PURCHASE OF THE PATENTED ARTICLES FROM THE INVENTOR.

Parties. **This Indenture** made the —— day of —— 18—, Between A. B. of ——, hereinafter called the patentee of the one part, and C. D. of ——, hereinafter called the licensee of the other part.

Recitals. **Whereas** the patentee is in possession of and entitled to the full benefit of certain letters patent dated —— and numbered —— for an invention entitled ——, **And whereas** the patentee has agreed to grant to the licensee a licence to use the said invention at ——, in the course of his trade and business as a —— upon the terms and conditions hereinafter set forth. **Now this Indenture witnesseth** that in pursuance of the said agreement and in consideration of the payments and covenants hereinafter reserved, contained, and on the part of the licensee to be paid and performed, he the patentee grants to the licensee full and free licence and authority during all the residue now to come and unexpired of the term of fourteen years by the said patent to use the said invention in the course of his trade and business as a ——, upon the terms and conditions following, that is to say:

Payments by licensee. 1. The licensee shall pay to the patentee upon the execution of this indenture the sum of £——, and further shall once in every year during the continuance of the said letters patent, including any extended term thereof, pay the sum of £——, the first of such payments to be made on or before the —— *day of* ——, 18—.

Covenant to purchase patented articles. 2. The licensee shall purchase of the patentee and the patentee shall sell and deliver to the licensee all the (*here insert name and description of patented articles*) which the licensee shall from

time to time require, paying for the same after the rate of ——— per (*dozen or gross*) with nett cash within one month after delivery.

3. The licensee shall not manufacture or vend any of the said ———, but shall only be entitled to use the same in the course of his trade or business, and the licensee shall not purchase or otherwise acquire any of the said ——— other than of the patentee. Covenant not to manufacture or sell.

4. The licensee shall be at liberty upon giving ——— months' notice in writing to the patentee to determine the licence and all the terms and conditions thereof, provided always that upon any such determination the licensee shall deliver to the patentee free of charge all the ——— which at that time shall be in his possession, or in the possession of any of his servants, agents, or customers. Power to licensee to determine licence.

5. In the event of the infringement of the said patent by any person or persons the licensee shall at the cost of the patentee render to him all the information and assistance in his power to enable the patentee to restrain further infringements of the said patent, and to recover damages for any past infringements thereof: Provided always that nothing herein contained shall be construed as placing the patentee under any obligation to take proceedings for the purpose of restraining or recovering damages for infringements, or as in any manner exonerating the licensee from payment of the amounts and observance of the covenants herein reserved and contained by reason that the profits of the licensee from the use of the said invention may be diminished on account of such infringements being permitted. Covenant by licensee to render assistance to patentee in actions. Proviso patentee not to be bound to take action.

6. Should the licensee make default in the payment of the annual sum hereinbefore provided for, within twenty-one days after the same shall have become due, or commit any breach of the covenants herein contained as on his part to be observed, it shall be lawful for the patentee by writing under his hand to give to the licensee, or leave at his usual or last known place of business in England notice of the patentee to determine this present licence, and thereupon this licence shall be deemed to be determined, and the licensee shall deliver to the patentee as soon as practicable, free of charge, all the ——— which at that time shall be in his possession or in the possession of any of his servants, agents, or customers. Determination of licence on default by licensee.

7. If during the continuance of the licence hereby granted the said patent shall be pronounced to be invalid by a decision of Determination on patent being

declared invalid.

the House of Lords, these presents shall be void as to the future operation thereof, but without prejudice to any rights or liabilities which shall be then subsisting on either side with respect to any prior breach of any of the covenants and agreements herein contained.

Reduction of payments to level of other licences.

8. If whilst this licence is in force the patentee shall at any time grant any licence or premium to any other person or persons for the use of the said invention in the United Kingdom, and shall reserve any annual payment or charge any price for the said ——— lower than the annual payments and price reserved under and by virtue of this indenture, then that the annual payments and price thenceforward payable to the patentee shall be reduced to an amount equal to the lowest price reserved and payable for the use of the said invention by such other person.

Power of patentee to amend specification.

9. The patentee shall be at liberty from time to time, and at all times hereafter, without the consent or concurrence of the licensee to apply for and procure the amendment of the specification or specifications of the said invention, whether by way of disclaimer, amendment or alteration.

Transmission clause and cost as "beneficial owner."

10. The word patentee herein shall include the patentee, his executors, administrators, or assigns, and he shall be deemed to covenant as beneficial owner with like effect as if this indenture were a conveyance within the meaning of the Conveyancing and Law of Property Act, 1881. The word licensee shall include the licensee, his executors, administrators, and assigns.

Licence not to be estopped after determination of licence.

11. Nothing in this indenture contained shall preclude or estop the licensee from disputing the validity of the said patent after the determination of the licence by notice or otherwise.

Arbitration clause.

12. If any dispute, question, or difference shall arise between the parties to these presents touching these presents or any clause or thing herein contained, or the construction hereof, or any matter in any way connected with these presents, or the operation hereof, or the rights, duties, or liabilities of either of the said parties hereto in connection with the premises then and in every or any such case the matters in difference shall be referred to two arbitrators or the umpire, pursuant to and so as with regard to the mode and consequences of the reference, and in other respects to conform to the provisions in that behalf contained in the Common Law Procedure Act, 1854, or any other subsisting statutory modification thereof, and upon every or any such reference the arbitrators and umpire shall respectively have power to examine the parties and witnesses upon oath or affirma-

tion, and either to fix, settle, and determine the amount of cost of the reference and award respectively or incidental thereto to be paid by both parties or either party, or to direct the same to be taxed either as between solicitor and client, or otherwise to direct and award when, by, and to whom such costs shall be paid.

As witness.

EXCLUSIVE LICENCE FOR A DISTRICT.

This Indenture made the ——— day of ——— 188—, Between A. B. of ———, hereinafter called the grantor of the one part and C. D. of ——— hereinafter called the grantee of the other part. **Whereas** the grantor is the registered legal owner of certain letters patent dated ——— and numbered ——— granted for an invention entitled ———. **And whereas** the grantor has agreed to grant to the grantee the sole and exclusive licence to make, use, exercise, or vend the said invention within the counties of ——— upon the terms and conditions hereinafter appearing. **Now this Indenture witnesseth** and it is agreed as follows:— Recitals.

1. The grantor *as beneficial owner* and with like effect as if these presents were a conveyance, doth hereby grant unto the grantee, his executors, administrators and assigns, the sole and exclusive licence to make, use, exercise or vend the said invention within the counties of ——— and ——— during the continuance of the said letters patent or any extended time thereof, together with all improvements and additions useful to the manufacture the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the grantor. Grant.

2. The grantee shall upon the execution of these presents pay to the grantor the sum of £———, and shall further pay to the grantor during the continuance of the licence once in every year on the ——— day of ——— or within twenty-one days thereafter the sum of £——— by way of annual royalty. **Provided always** that in the event of the said letters patent being adjudged invalid by any court of competent jurisdiction and within ——— months of the said judgment the grantor, his executors, administrators, or assigns, shall not have done all things necessary for Consideration and royalty reserved.

the purpose of appealing from the said judgment, or in the event of the said letters patent having been adjudged invalid by the House of Lords, then that these presents shall be deemed to be cancelled, and all payments accruing thereafter from the grantee to the grantor shall cease, but without prejudice to the recovery by the grantor of any monies then already due.

Grantor not to amend.

3. The grantor shall not without the consent of the grantee, his executors, administrators, or assigns, in writing first had and obtained apply for leave to amend the specification to the said letters patent in any way whatsoever (*a*).

Grantee to be at liberty to determine.

4. The grantee shall be at liberty upon giving ——— months' notice in writing to the grantor to determine this licence and all the terms and conditions thereof, and thereupon the said letters patent for the district hereinbefore defined, and all the rights and privileges thereby granted shall revert in the grantor absolutely, and the annual payments hereinbefore provided for shall cease.

As to actions.

5. The grantee shall be at liberty either in his own name or in the name of the grantor, or both, as he may be advised, to bring any action or proceeding for the purpose of restraining the infringement of the said letters patent within the district herein-before defined. **Provided always** that before in any way making use of the name of the grantor in any such action or proceeding the grantee shall give security to the satisfaction of the grantor to indemnify him in respect of any costs or damages which he may become liable for by reason of any such action or proceeding.

Payment of fees, &c.

6. The grantor shall pay all fees necessary for the renewal and maintenance of the said letters patent during the term comprised therein one calendar month at least before the times provided by the Patents &c. Act, 1883, or the rules made in pursuance in that behalf thereof and in case of non-payment thereof as aforesaid, the grantee shall be at liberty to pay the same and to deduct any monies so paid by him from the annual payments hereinbefore provided for, or to recover the same from the grantor at the grantee's option.

Improvements.

7. Should the grantor during the continuance of this licence obtain letters patent in respect of any improvements, additions to, or discovery useful to the manufacture the subject-matter of

(*a*) See last preceding precedent for the converse—in a general licence the patentee should reserve power to amend, but in an exclusive licence it is obviously otherwise.

the said letters patent, he shall at the expense of the grantee grant to him an exclusive licence to make exercise use or vend the invention the subject-matter of the said further letters patent within the said district without any extra or additional payment on the part of the grantee. **Provided always** that the grantor shall not be bound to maintain or keep in force the said further letters patent by payment of the prescribed fees or otherwise.

8. Should the grantee make default in the payment of the annual royalty reserved by the second clause hereof as therein provided, it shall be lawful for the grantor to serve upon the grantee by leaving the same at his last known place of business or abode notice in writing determining these presents, and thereupon the licence hereby granted shall cease but without prejudice to the right of the grantor to sue for and recover any arrears of the said annual royalty which may then be due. Default in payment of royalty.

9. The licensor notwithstanding anything herein to the contrary shall not be deemed in any way to warrant or represent the validity of the said letters patent. No warranty of validity.

In witness, &c.

MORTGAGE OF A PATENT.

This Indenture made the ——— day of ——— 188—, Between A. B. of ———, hereinafter called the mortgagor of the one part, and C. D. of ———, hereinafter called the mortgagee of the other part. Parties.

Whereas the mortgagor is the registered owner of certain letters patent dated ——— 18— and numbered ——— for an invention entitled Improvements, &c. ———. **And whereas** the mortgagee has agreed to lend to the mortgagor the sum of £——— to be secured together with interest thereon by mortgage of the said letters patent as hereinafter expressed. Recitals.

Now this Indenture witnesseth that in consideration of the sum of £——— this day paid by the mortgagee to the mortgagor (the receipt whereof is hereby acknowledged) the mortgagor doth covenant with the mortgagee that he the mortgagor will pay to the mortgagee on the ——— day of ——— 188—, the sum of £——— together with interest thereon at the rate of £——— per cent. per annum. Testatum.

And this Indenture also witnesseth that for the consideration

Assignment.

aforesaid the mortgagor *as beneficial owner* doth hereby assign to the mortgagee the said letters patent and the sole and exclusive benefit thereof and all extensions thereof and all the rights, privileges, profits, benefits, commodities and advantages by the said letters patent granted to have and to hold the same to the mortgagee subject to the proviso for redemption hereinafter contained. **Provided always** that if the mortgagor shall pay to the mortgagee the sum of £——— with interest for the same at the rate aforesaid then that the mortgagee will at any time thereafter at the request and cost of the mortgagor re-assign to him the said letters patent and the sole and exclusive benefit thereof. And the mortgagor doth hereby covenant with the mortgagee that if the said sum of £——— or any part thereof shall remain unpaid after the said ——— day of ——— 18—, he the mortgagor will pay to the mortgagee so long as the said sum of £——— or any part thereof shall remain unpaid interest upon such sum as shall from time to time remain unpaid after the rate of £——— per cent. per annum by equal half-yearly payments on the ——— day of ——— and the ——— day of ——— in every year. **Provided also** that if the mortgagor shall on every ——— day of ——— and ——— day of ——— until the ——— day of ——— 18—, or within ——— days after the said days respectively pay to the mortgagee all interest then due and shall perform and observe all the covenants on his part to be performed or observed then the mortgagee will not before the ——— day of ——— 18— call in the principal sum aforesaid or any part thereof. **Provided also** that the mortgagor shall not before the ——— day of ——— 18— compel the mortgagee to receive the said principal sum or any part thereof. And that the mortgagor during the continuance of the security will take all steps necessary for the protection of the said letters patent and maintaining the same in full force and effect and for the prevention of any infringement thereof and will pay all fees necessary for the continuance of the said letters patent one calendar month at least before the same shall become due and payable and will whenever required to do so produce to the mortgagee or his agent the receipts for the said fees and in default of the mortgagor taking any such steps as aforesaid or protecting the said letters patent from infringement or making payment of the said fees it shall be lawful for the mortgagee to do or pay the same either in his own name or in the name of the mortgagor as he the mortgagee shall elect and to sue for and

Proviso for redemption.

recover from the mortgagor any costs, charges or expenses which he may incur in so doing or at his option to allow the same to remain on the security hereof as monies advanced as aforesaid. **Provided always** that until the mortgagee shall become entitled to exercise the power of sale to be implied herein the mortgagor shall be at liberty to use and work the said invention without interruption from the mortgagee and also may (but so that he shall in each case give to the mortgagee ——— days at least notice in writing of his intention so to do and of the particulars thereof) with the consent of the mortgagee in writing but not otherwise grant licences to use and work the said invention as from the dates thereof respectively for the whole or any part of the term comprised in the said letters patent. **And further** the mortgagor shall within fourteen days after the execution of every such licence furnish the mortgagee with a copy of the same. **Provided also that** *from and after* the time when the mortgagee shall first become entitled to exercise the statutory power of sale to be implied herein but subject to any licences which may have been granted as hereinbefore authorised it shall be lawful for him alone to work the said invention and to grant licences in respect thereof or to assign the said letters patent and invention for districts or otherwise to deal with the same in any manner that he shall think fit. And the mortgagor **doth hereby further covenant** with the mortgagee that he will communicate to the mortgagee during the continuance of this security all improvements which he may discover or make in connection with the said invention and also all improvements which during the said time he shall have control of or acquire by purchase or otherwise and whether patented or not and such improvements and letters patent if any shall be deemed to be comprised within this security and the mortgagor will execute all documents and do all things necessary to extend the operation of this security to all such improvements or letters patent. **And that** during the continuance of this security the mortgagor will not without the consent of the mortgagee first had and obtained amend or apply for leave to amend the specifications to the said letters patent or either of them in any way whatsoever. **And lastly** that it shall be lawful for the mortgagee if the monies secured hereby shall not have been repaid within one year from the expiration of the term of fourteen years for which the said letters patent were originally granted to apply for an extension of such term in his own name or in the name

Mortgagee to be at liberty to use and work invention,

and grant licences,

to supply copy to mortgagee.

Proviso for foreclosure.

Communication of improvements.

As to amendments.

As to application for extension.

of the mortgagor or of both of them as he shall think fit and the mortgagee shall do all acts and things and execute all documents and prepare all accounts necessary for such application.

Transmission clause.

And it is hereby declared that except where the context requires a different interpretation, each of the expressions "the mortgagor" and "the mortgagee" shall wherever used herein be also applicable as far as possible to the executors administrators and assigns of the person designated thereby.

In witness, &c.

APPENDIX.

PATENTS, DESIGNS AND TRADE MARKS ACT, 1883.

(SO FAR AS THE SAME RELATES TO LETTERS PATENT.)

46 & 47 VICT. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[25th August, 1883.]

BE IT ENACTED by the Queen's most excellent Majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present Parliament assembled, and by the authority of the same, as follows :

PART I.—PRELIMINARY.

1. This act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

2. This act is divided into parts, as follows :— Division of act into parts.

PART I.—*Preliminary.*
PART II.—Patents.
PART III.—Designs.
PART IV.—Trade Marks.
PART V.—General.

3. This act, except where it is otherwise expressed, shall commence from and immediately after the 31st day of December, 1883. Commencement of act.

PART II.—PATENTS.

Application for and Grant of Patent.

4. (1) Any person, whether a British subject or not, may make an application for a patent. [*page* 5] Persons entitled to apply for patent.

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly. [*page* 5] Joint application.

5. (1) An application for a patent must be made in the form set forth in the first schedule to this act, or in such other form as may be from time to time prescribed ; and must be left at, or sent by post to, the patent office in the prescribed manner. [*pages* 5, 56] Application and specification.

(2) An application must contain a declaration to the effect that Declaration.

the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification. [*pages* 5, 56] (*a*)

Provisional specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required. [*pages* 57, 64]

Complete specification.

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required. [*pages* 57, 69 *et seq.*] (*b*)

Necessary contents of specification.

(5) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed. [*pages* 57, 74]

Reference of application to examiner.

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject matter of the invention. [*pages* 57, 64]

Power for comptroller to refuse application or require amendment.

(*c*) **7.** (1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application. [*pages* 57, 102]

Appeal from comptroller.

(2) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.

Law officer may make order.

(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.

Notice to be given to applicant.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

Where subsequent application before first sealed bears similar title, examiner to report to comptroller and give notice to applicants.

(5) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

Comptroller determines whether applications are similar, and may refuse to seal second patent.

(6) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.

(*a*) Amended and altered by sect. 2 of the Patents, &c., Act, 1885, *infra*.

(*b*) Explained by sect. 2 of Patents, &c., Act, 1886.

(*c*) This is printed as the section originally stood. It is now amended and altered by sect. 2 of the Patents, &c., Act, 1888, see *infra*.

Time for leaving complete specification.

8. (1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application. [*pages* 57, 64] (*d*)

When specification deemed abandoned.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned (*d*).

Comparison of provisional and complete specification.

9. (1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification. [*pages* 58, 102, 104] (*d*)

Power of comptroller to refuse until amended.

(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer. [*page* 58]

Power of law officer.

(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted. [*pages* 58, 102]

When specification void.

(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

Reports of examiners to be private.

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, *other than an appeal to the law officer under this act* (*e*), unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection. [*pages* 58, 116]

Opposition to grant of patent.

Time and grounds for.

11. (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the patent office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground. [*page* 116] (*f*)

(*d*) The times mentioned in these sections are altered by sect. 3 of the Patents, &c., Act, 1885, *infra*.

(*e*) These words are struck out by sect. 3 of the Patents, &c., Act, 1888.

(*f*) This section is materially altered by sect. 4 of the Patents, &c., Act, 1888, see *infra*.

After notice comptroller to decide.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer. [*page* 120]

Or on appeal, law officer.

(3) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made. [*page* 121]

Who may obtain expert's assistance.

(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the treasury, shall appoint. [*page* 121]

Sealing of patent.

When sealed.

12. (1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the patent office. [*pages* 121, 123]

Great seal abolished for patents.

(2) A patent so sealed shall have the same effect as if it were sealed with the great seal of the united kingdom. [*pages* 123, 255]

Time for sealing.

(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of the application, except in the cases hereinafter mentioned, that is to say—

Exceptions to limit.

(a) For legal proceedings.

(a) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b) When applicant dead.

(b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

Date of patent.

13. Every patent shall be dated and sealed as of the day of the application : provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification : provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

Provisional Protection.

Provisional protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same ; and such protection from the consequences of use and publication is in this act referred to as provisional protection. [*page* 17]

Protection by Complete Specification.

Effect of acceptance of complete specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification : provided that an appli-

cant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him. [*pages* 69 *et seq.*]

Patent.

16. Every patent when sealed shall have effect throughout the united kingdom and the Isle of Man. [*pages* 123 *et seq.*] Extent of patent.

17. (1) The term limited in every patent for the duration thereof shall be fourteen years from its date. Term of patent.

(2) But every patent shall, notwithstanding anything therein or in this act, cease if the patentee fails to make the prescribed payments within the prescribed times. Ceases on failure of payments.

(3) If, nevertheless, in any case, by accident, mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment. Exception by application to comptroller.

(4) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions: Extension of time for payment upon terms.

(a) The time for making any payment shall not in any case be enlarged for more than three months. (a) Period of extension.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement. (b) Damages for infringement in the interval.

Amendment of Specification.

18. (1) An applicant or a patentee may, from time to time, by request in writing left at the patent office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same. [*pages* 58, 102 to 115] Amendment of specification.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the patent office of opposition to the amendment. Advertisement of amendment and notice of opposition to be given.

(3) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer. Where notice given comptroller decides.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed. Appeal to law officer.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed. Where no notice comptroller determines conditions of amendment.

(6) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

Appeal to law officer.

(7) The law officer shall, if required, hear the person making the request, and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

No amendment allowed so as to enlarge or alter materially specification.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

Leave conclusive except in case of fraud; amendment forms part of specification.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending. [*page* 109] (*g*)

Power to disclaim part of invention during action, &c.

19.—(1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the court or a judge may impose, be at liberty to apply at the patent office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed. [*pages* 110 *et seq.*]

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfaction of the court, that his original claim was framed in good faith and with reasonable skill and knowledge. [*pages* 111 *et seq.*]

Advertisement of amendment.

21. Every amendment of a specification shall be advertised in the prescribed manner.

Compulsory Licenses.

Power for board of trade to order grant of licenses.

22. If on the petition of any person interested it is proved to the board of trade that by reason of the default of a patentee to grant licenses on reasonable terms— [*page* 141]

(a) The patent is not being worked in the united kingdom; or

(b) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

(*g*) This subsection is altered and limited in its operation by sect. 5 of the Patents, &c., Act, 1888, *infra*.

Register of Patents.

Register of patents. Where to be kept and contents.

23.—(1) There shall be kept at the patent office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. [*pages* 20, 143]

Is evidence.

(2) The register of patents shall be primâ facie evidence of any matters by this act directed or authorized to be inserted therein.

Copies for filing.

(3) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the patent office.

Fees.

Fees payable.

24.—(1) There shall be paid in respect of the several instruments described in the second schedule to this act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the act, such fees as may be from time to time, with the sanction of the treasury, prescribed by the board of trade; and such fees shall be levied and paid to the account of her majesty's exchequer in such manner as the treasury may from time to time direct.

Power to reduce fees.

(2) The board of trade may from time to time, if they think fit, with the consent of the treasury, reduce any of those fees.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in council. When applied for.

25.—(1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her majesty in council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent. [*pages* 145 *et seq.*]

Entry of caveat.

(2) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

Privy Council jurisdiction.

(3) If her majesty shall be pleased to refer any such petition to the judicial committee of the privy council, the said committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

Powers of judicial committee.

(4) The judicial committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case. [*page* 155]

On their report extension granted on conditions.

(5) If the judicial committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her majesty in council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the judicial committee may think fit.

Power to make rules for such proceedings.

(6) It shall be lawful for her majesty in council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the judicial committee. [*page* 154.]

Costs.

(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the judicial committee; and the orders of the committee respecting costs shall be enforceable as if they were orders of a division of the high court of justice.

Revocation.

Abolition of scire facias.

26. (1) The proceeding by scire facias to repeal a patent is hereby abolished. [*pages* 114, 116, 208, 253, 277]

Revocation of patent.

(2) Revocation of a patent may be obtained on petition to the court.

How revocation obtained. Grounds of revocation.

(3) Every ground on which a patent might, at the commencement of this act, be repealed by scire facias shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

Petition for revocation, who may present.

(4) A petition for revocation of a patent may be presented by—

(a) The attorney-general in England or Ireland, or the lord advocate in Scotland: [*pages* 208 *et seq.*]

(b) Any person authorized by the attorney-general in England or Ireland, or the lord advocate in Scotland:

(c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims:

(d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

(e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

Plaintiff must deliver and be bound by particulars.

(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the court or a judge, be admitted in proof of any objection of which particulars are not so delivered. [*page* 277]

Amendment of particulars.

(6) Particulars delivered may be from time to time amended by leave of the court or a judge. [*page* 278]

Patentee though defendant has privileges of plaintiff at trial.

(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply. [*pages* 254, 279]

Where patent revoked for fraud, first true inventor may obtain patent.

(8) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor, made in accordance with the provisions of this act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Crown.

Patent to bind crown.

27.—(1) A patent shall have to all intents the like effect as against her majesty the queen, her heirs and successors, as it has against a subject. [*pages* 128, 185]

Exceptions.

(2) But the officers or authorities administering any department of the service of the crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the crown on terms to be before or after the use thereof agreed on, with the approval of the treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the treasury after hearing all parties interested.

Legal Proceedings.

Hearing with assessor.

By court.

28.—(1) In an action or proceeding for infringement or revocation of a patent, the court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the court shall otherwise direct. [*pages* 251, 277, 278]

Court of appeal or privy council may sit with assessors.

(2) The court of appeal or the judicial committee of the privy council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

Assessors' fees.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the court of appeal or judicial committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this act.

Delivery of particulars of breaches; of objections.

29.—(1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the court or the judge, at any subsequent time, particulars of the breaches complained of. [*pages* 222 *et seq.*, 270, 279]

(2) The defendant must deliver, with his statement of defence, or, by order of the court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof. [*pages* 229 *et seq.*]

Grounds must be stated.

(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him. [*page* 296]

Evidence must not go beyond particulars.

(4) At the hearing no evidence shall, except by leave of the court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered. [*page* 222]

Amendment.

(5) Particulars delivered may be, from time to time, amended, by leave of the court or a judge. [*page* 222]

Costs.

(6) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them, unless the same is certified by the court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case. [*pages* 271 *et seq.*]

Order for inspection, &c., in action.

30.—In an action for infringement of a patent, the court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms, and give such directions respecting the same and the proceedings thereon as the court or a judge may see fit. [*page* 246]

Certificate that validity questioned.

31.—In an action for infringement of a patent, the court or a judge may certify that the validity of the patent came in question; and if the court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client, unless the court or judge trying the action certifies that he ought not to have the same. [*pages* 269, 272, 277]

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not, in fact, an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent. [*page* 281]

Miscellaneous.

Patent for one invention only.

33. Every patent may be in the form in the first schedule to this act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding, to take any objection to a patent on the ground that it comprises more than one invention. [*page* 164]

Patent on application of representative of deceased inventor.

Time and contents of application.

34.—(1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative. [*pages* 8, 134]

(2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. [*page* 16]

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the united kingdom, or Isle of Man, as effectually as if the patent

were originally granted to extend to that place, or part only. [*pages* 135, 160, 163, 216]

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may, at any time, cause a duplicate thereof to be sealed.

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath, and administer oaths for that purpose under this part of this act, and may, from time to time, make, alter, and rescind rules regulating references and appeals to the law officers, and the practice and procedure before them under this part of this act; and in any proceeding before either of the law officers under this part of this act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court. [*pages* 103, 121]

Exhibition at industrial or international exhibition not to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the board of trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

Conditions:

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and (a) Notice;

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition. (b) Patent must be applied for.

See Patents, &c., Act, 1886, sect. 3.

Publication of illustrated journal, indexes, &c.

40.—(1) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

Copies to be on sale.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

Continuation of publication

(3) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues and other works relating to inventions, as he may see fit.

Patent museum.

41. The control and management of the existing patent museum and its contents shall, from and after the commencement of this act, be transferred to and vested in the department of science and art, subject to such directions as her majesty in council may see fit to give.

Power to require models on payment.

42. The department of science and art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the board of trade.

Foreign vessels in British waters.

43.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her majesty's courts in the united kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the united kingdom or Isle of Man. [*page* 187]

Exception.

(1) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.

Assignment to secretary for war of certain inventions.

44.—(1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor), may (either for or without valuable consideration) assign to her majesty's principal secretary of state for the war department (hereinafter referred to as the secretary of state), on behalf of her majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the secretary of state may be a party to the assignment. [*page* 133]

Extent of assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the secretary of state for the time being on behalf of her majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the secretary of state for the time being.

Power of secretary of state for war to keep invention secret on certifying that it is in public interest to do so.

(3) Where any such assignment has been made to the secretary of state, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

In which case specifications and documents are sealed up.

(4) If the secretary of state so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the patent office, be delivered to the comptroller in a packet sealed by authority of the secretary of state.

For term of patent.

(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the secretary of state, or of the law officers.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the secretary of state to receive the same, and shall if returned to the comptroller be again kept sealed by him. Delivery of packet under secretary of state's authority during term.

(7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the secretary of state to receive it. At expiration.

(8) Where the secretary of state certifies as aforesaid, after an application for a patent has been left at the patent office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the secretary of state. Foregoing sub-sections to apply where patent applied for but specifications not published.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the secretary of state has certified as aforesaid. Where certified by secretary of state no petition for revocation.

(10) No copy of any specification or other document or drawing by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this act shall apply in respect of any such invention and patent as aforesaid. No copy of any secret specifications to be made public.

(11) The secretary of state may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way. Power of secretary of state to waive benefit of section.

(12) The communication of any invention for any improvement in instruments or munitions of war to the secretary of state, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same. Communication to secretary of state for war not to be deemed publication.

Existing Patents.

45.—(1) The provisions of this act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this act. Provisions respecting existing patents.

(2) Every patent granted before the commencement of this act, or on an application then pending, shall remain unaffected by the provisions of this act relating to patents binding the crown, and to compulsory licenses. [*page* 158]

(3) In all other respects (including the amount and time of payment of fees) this act shall extend to all patents granted before the commencement of this act, or on applications then pending, in substitution for such enactments as would have applied thereto if this act had not been passed. [*page* 158]

(4) All instruments relating to patents granted before the commencement of this act required to be left or filed in the great seal patent office shall be deemed to be so left or filed if left or filed before or after the commencement of this act in the patent office. Documents left at great seal patent office deemed left at patent office on commencement of this act.

Definitions.

Definitions of "Patent;"

"Patentee;"

"Invention;"

46. In and for the purposes of this act—

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent: [*page* 5]

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies (that is, the act of the twenty-first year of the reign of King James the First, chapter 3, intituled, "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention. [*page* 22]

"Injunction" in Scotland.

In Scotland "injunction" means "interdict."

PART V.—General.

Patent Office and Proceedings thereat.

Patent office.

82.—(1) The treasury may provide for the purposes of this act an office with all requisite buildings and conveniences, which shall be called, and is in this act referred to as, the patent office.

(2) Until a new patent office is provided, the offices of the commissioners of patents for inventions and for the registration of designs and trade marks existing at the commencement of this act shall be the patent office within the meaning of this act.

Control.

(3) The patent office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks, who shall act under the superintendence and direction of the board of trade.

(4) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the board of trade.

Officers and clerks.

83.—(1) The board of trade may at any time after the passing of this act, and from time to time, subject to the approval of the treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the board of trade think fit, and may from time to time remove any of those officers and clerks.

Salaries.

(2) The salaries of those officers and clerks shall be appointed by the board of trade, with the concurrence of the treasury, and the same and the other expenses of the execution of this act shall be paid out of money provided by parliament.

Seal of patent office.

84. There shall be a seal for the patent office, and impressions hereof shall be judicially noticed and admitted in evidence. [*page* 123]

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive. [*pages* 20, 143]

Refusal to grant patent, &c., in certain cases.

86. The comptroller may refuse to grant a patent for an invention or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality. [*page* 127]

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject (*h*) to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property. [*page* 143]

Inspection of and extracts from registers.

88. Every register kept under this act shall at all convenient times be open to the inspection of the public, subject (*h*) 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. [*page* 143]

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents, specifications, disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her majesty's dominions, and in all proceedings, without further proof or production of the originals. [*pages* 143, 255]

Rectification of registers by court.

90.—(1) The court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person (*i*) from any register kept under this act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the court thinks fit; or the court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the court thinks fit. [*page* 143]

Powers of court to decide all necessary questions.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

Notice.

(3) Any order of the court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee,— [*page* 144]

(*h*) The words "to the provisions of this act and to," are here inserted by sects. 21 & 22 of the Patents, &c., Act, 1885, *infra*.

(*i*) The words "or of any other particulars," are here inserted by sect. 23 of the Patents, &c., Act, 1888, *infra*.

(a) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark ; or

(b) Correct any clerical error in the name, style or address of the registered proprietor of a patent, design, or trade mark ;

(c) Cancel the entry or part of the entry of a trade mark on the register : Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

Alteration of registered mark.

92.—(1) The registered proprietor of any registered trade mark may apply to the court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this act, and the court may refuse or grant leave on such terms as it may think fit.

Notice to be given.

(2) Notice of any intended application to the court under this section shall be given to the comptroller by the applicant ; and the comptroller shall be entitled to be heard on the application.

Comptroller to alter in accordance with order.

(3) If the court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent. [*page* 103]

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized 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. [*page* 255]

Applications and notices by post.

97.—(1) Any application, notice, or other document authorized or required to be left, made, or given at the patent office, or to the comptroller, or to any other person under this act, may be sent by a prepaid letter through the post ; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post. Proof.

98. Whenever the last day fixed by this act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document, or to pay such fee, on the day next following such excluded day, or days if two or more of them occur consecutively. Provision as to days for leaving documents at office.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this act or by any rules made under the authority of this act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this act be as effectual as if done by the person for whom he is substituted. [*page* 6] Declaration by infant, lunatic, &c.

100. Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh museum of science and art, and to the enrolments office of the chancery division in Ireland, and to the rolls office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals. Transmission of certified printed copies of specifications, &c.

101.—(1) The board of trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this act— [*page* 141] Power for board of trade to make general rules for classifying goods and regulating business of patent office.

(a) For regulating the practice of registration under this act:

(b) For classifying goods for the purposes of designs and trade marks:

(c) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the board of trade think fit, of specifications, drawings, amendments, and other documents:

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications

and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(g) Generally for regulating the business of the patent office, and all things by this act placed under the direction or control of the comptroller, or of the board of trade.

Alteration of forms. (2) Any of the forms in the first schedule to this act may be altered or amended by rules made by the board aforesaid.

General rules; (3) General rules may be made under this section at any time after the passing of this act, but not so as to take effect before the commencement of this act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this act, and shall be judicially noticed.

to be laid before parliament and advertised. (4) Any rules made in pursuance of this section shall be laid before both houses of parliament, if parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either house of parliament, within the next forty days after any rules have been so laid before such house, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual reports of comptroller. **102.** The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this act to be laid before both houses of parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this act, and an account of all fees, salaries, and allowances, and other money received and paid under this act.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks. **103.**—(1) If her majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this act, in priority to other applicants; and such patent or registration shall have the same date as *the date of the protection obtained* in such foreign state. [*pages* 213, 214]

Read "Date of Application" in substitution for "Date of the Protection obtained." Patents, &c., Act, 1885, sect. 6.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force

Time.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

No protection prior to specification or registration.

(2) The publication in the united kingdom or the Isle of Man, during the respective periods aforesaid, of any description of the invention or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark :

Publication at or use in exhibition not to invalidate patent or trade mark.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this act : Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this act :

Application under this section to be made in same manner as ordinary application.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which her majesty shall from time to time by order in council declare them to be applicable, and so long only in the case of each state as the order in council shall continue in force with respect to that state.

Application of this section.

104.—(1) Where it is made to appear to her majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her majesty, from time to time, by order in council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her majesty in council may seem fit, to such British possession. [*pages* 213, 214]

Provision for colonies and India.

(2) An order in council under this act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this act ; but it shall be lawful for her majesty in council to revoke any order in council made under this act.

Effect of order in council.

Offences.

105.—(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Penalty on falsely representing articles to be patented.

(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is

Definition of false repre-

sentation under this section.

registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.

Penalty on unauthorized assumption of royal arms.

106. Any person who, without the authority of her majesty, or any of the royal family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland; Ireland; &c.

Saving for courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

Definition of "court of appeal."

For the purposes of this section "court of appeal" shall mean any court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109.—(1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the lord advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only. [*page* 210]

Service in Scotland.

(2) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this act,

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only. [*page* 211]

General saving for jurisdiction of courts.

111.—(1) The provisions of this act conferring a special jurisdiction on the court as defined by this act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the court" shall mean any lord ordinary of the court of session, and the term "court of appeal" shall mean either division of the said court; and with reference to any such proceedings in Ireland, the terms "the court" and "the court of appeal" respectively mean the high court of justice in Ireland and her majesty's court of appeal in Ireland.

(2) If any rectification of a register under this act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly. Rectification of register.

112. This act shall extend to the Isle of Man, and— Isle of Man.

(1) Nothing in this act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts: Jurisdiction of courts.

(2) The punishment for a misdemeanor under this act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court: Punishments.

(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. Offences and penalties treated as in England under this act.

See sect. 112A added here by sect. 26 of the Patents, &c., Act, 1888, printed *infra*.

Repeal; Transitional Provisions; Savings.

113. The enactments described in the third schedule to this act are hereby repealed. But this repeal of enactments shall not— Repeal and saving for past operation of repealed enactments, &c. Exceptions.

(a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this act; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

114.—(1) The registers of patents and of proprietors kept under any enactment repealed by this act shall respectively be deemed parts of the same book as the register of patents kept under this act. Former registers to be deemed continued.

(2) The registers of designs and of trade marks kept under any enactment repealed by this act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this act.

115. All general rules made by the lord chancellor or by any other authority under any enactment repealed by this act, and in force at the commencement of this act, may at any time after the passing of this act be repealed, altered, or amended by the board of trade, as if Saving for existing rules.

they had been made by the board under this act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this act, continue in force as if they had been made by the board of trade under this act.

Saving for prerogative.

116. Nothing in this act shall take away, abridge, or prejudicially affect the prerogative of the crown in relation to the granting of any letters patent, or to the withholding of a grant thereof.

General Definitions.

General definitions.

117.—(1) In and for the purposes of this act, unless the context otherwise requires,—

"Person."

"Person" includes a body corporate:

"Court."

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her majesty's high court of justice in England:

"Law officer."

"Law officer" means her majesty's attorney-general or solicitor-general for England:

"Treasury."

"The Treasury" means the commissioners of her majesty's treasury.

"Comptroller."

"Comptroller" means the comptroller general of patents, designs, and trade marks:

"Prescribed."

"Prescribed" means prescribed by any of the schedules to this act, or by general rules under or within the meaning of this act:

"British possession."

"British possession" means any territory or place situate within her majesty's dominions, and not being or forming part of the united kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this act:

Legislature.

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature *only*.

"Summary conviction" as applied to Ireland.

In the application of this act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin metropolitan police district the acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Forms A, B and C of this first schedule are altered by the substitution of those given in the second schedule to the Patent Rules, 1885.

FORM D. Section 33.

FORM OF PATENT.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, queen, defender of the faith: To all to whom these presents shall come greeting: The address.

Whereas *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief: First recital.

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent for the sole use and advantage of his said invention: Second recital.

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention: Third recital.

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request: Fourth recital.

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: The grant.

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: The prohibition.

Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our privy council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our united kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: The conditions.

Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also, that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors,

The construction.

grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this 18 and to be sealed as of the 18 .

[Seal of Patent Office.]

Section 24.

The Second Schedule.

Fees on Instruments for obtaining Patents and Renewal.

	£	s.	d.	£	s.	d.
(a.) *Up to sealing.*						
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
(b.) *Further before end of four years from date of patent.*						
On certificate of renewal				50	0	0
(c.) *Further before end of seven years, or in the case of patents granted after the commencement of this act, before the 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:—

	£	s.	d.
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

Section 113.

The Third Schedule.

Enactments Repealed.

21 James 1, c. 3 (1623).—The Statute of Monopolies. In part; namely, sections 10, 11 and 12.

5 & 6 Will. 4, c. 62 (1835) [In part].—The Statutory Declarations Act, 1835. In part; namely, section 11.

5 & 6 Will. 4, c. 83 (1835).—An act to amend the law touching letters patent for inventions.

2 & 3 Vict. c. 67 (1839).—An act to amend an act of the fifth and sixth years of the reign of king William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."

5 & 6 Vict. c. 100 (1842).—An act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.

6 & 7 Vict. c. 65 (1843).—An act to amend the laws relating to the copyright of designs.

7 & 8 Vict. c. 69* (1844) [In part].—An act for amending an act passed in

* *Note.*—Sects. 6 and 7 of this act are repealed by the Statute Law Revision (No. 2) Act, 1874.

the fourth year of the reign of his late majesty, intituled "An act for the better administration of justice in his majesty's privy council, and to extend its jurisdiction and powers." In part; namely, sections 2 to 5, both included.

13 & 14 Vict. c. 104 (1850).—An act to extend and amend the acts relating to the copyright of designs.

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

16 & 17 Vict. c. 5 (1853).—An act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.

16 & 17 Vict. c. 115 (1853).—An act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said act.

21 & 22 Vict. c. 70 (1858).—An act to amend the act of the fifth and sixth years of her present majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.

22 Vict. c. 13 (1859).—An act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.

24 & 25 Vict. c. 73 (1861).—An act to amend the law relating to the copyright of designs.

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

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

33 & 34 Vict. c. 97 (1870).—The Stamp Act, 1870. In part; namely, sections 65, and in the schedule the words and figures, "Certificate of the registration of a design . . £5 0 0. And see section 65."

38 & 39 Vict. c. 91 (1875).—The Trade Marks Registration Act, 1875.

38 & 39 Vict. c. 93 (1875).—The Copyright of Designs Act, 1875.

39 & 40 Vict. c. 33 (1876).—The Trade Marks Registration Amendment Act, 1876.

40 & 41 Vict. c. 37 (1877).—The Trade Marks Registration Extension Act, 1877.

43 & 44 Vict. c. 10 (1880).—The Great Seal Act, 1880. In part; namely, section 5.

45 & 46 Vict. c. 72 (1882).—The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely, section 16.

PATENTS, ETC., ACT, 1885.

48 & 49 VICT. c. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

BE IT ENACTED by the queen's most excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, as follows :

1. This act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this act referred to as the principal act).

This act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this act and the principal act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of sect. 5, subsect. 2.

2. Whereas subsection two of section five of the principal act requires a declaration to be made by an applicant for a patent to the effect in that subsection mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts : Be it therefore enacted that :

The declaration mentioned in subsection two of section five of the principal act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

Amendment of sects. 8 and 9.

3. Whereas under the principal act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times : Be it therefore enacted as follows :

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on the payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent ; and the principal act shall have effect as if any time so allowed were added to the said periods specified in the principal act.

Abandoned application.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any)

accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

5. Whereas doubts have arisen whether under the principal act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal act to grant such a patent. Joint patent.

6. In subsection one of section one hundred and three of the principal act, the words "date of the application" shall be substituted for the words "date of the protection obtained." Amendment of sect. 103, subsect. 1.

PATENTS, ETC., ACT, 1886.

49 & 50 VICT. c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

WHEREAS by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it therefore enacted by the queen's most excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, as follows:

1. This act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886. Title.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification. Explanation of sect. 5, subsect. 4 of principal act.

3. Whereas by section thirty-nine of the Patents, Designs, and Extension of sect. 39 of principal act.

Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the board of trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the controller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the united kingdom, be it therefore enacted as follows:

It shall be lawful for her majesty, by order in council, from time to time to declare that sections thirty-nine and fifty-seven of the *Patents, Designs, and Trade Marks Act, 1883*, or either of those sections, shall apply to any exhibition mentioned in the order in like manner as if it were an industrial or international exhibition certified by the board of trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her majesty in council may seem fit.

PATENTS, ETC., ACT, 1888.

(SO FAR AS THE SAME RELATES TO LETTERS PATENT.)

51 & 52 VICT. c. 50.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, herein-after referred to as the principal act:

46 & 47 Vict. c. 57.

Be it therefore enacted by the queen's most excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, as follows:

Register of patent agents.

1.—(1.) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this act.

(2.) The board of trade shall, as soon as may be after the passing of this act, and may from time to time, make such general rules as are in the opinion of the board required for giving effect to this section, and the provisions of section one hundred and one of the principal act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the board of trade that prior to the passing of this act he had been *bonâ fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this act.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the united kingdom.

Amendments of 46 & 47 Vict. c. 57.

s. 7, as to applications.

2. For section seven of the principal act the following section shall be substituted, namely :— [*pages* 57 *and* 102]

"**7.** (1.)—If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application ; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

"(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

s. 9, as to disclosure of reports of examiners.

3. In sub-section five of section nine of the principal act the words "other than an appeal to the law officer under this act" shall be omitted.

s. 11, as to opposition to grant of patent.

4. In sub-section one of section eleven of the principal act the words from "or on the ground of an examiner" to "a previous application," both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, "or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification." [*page* 119]

s. 18, as to amended specifications.

5. For sub-section ten of section eighteen of the principal act the following sub-section shall be substituted, namely :— [*page* 109]

"(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending."

s. 87, as to entry of assignments, &c.

21. In section eighty-seven of the principal act, after the words "subject to," shall be added the words "the provisions of this act and to." [*page* 143]

s. 88, as to inspection.

22. In section eighty-eight of the principal act, after the words "subject to," shall be added the words "the provisions of this act and to." [*page* 143]

s. 90, as to rectification of register.

23. In section ninety of the principal act, after the words "of the name of any person," shall be added the words "or of any other particulars." [*page* 143]

Proceedings of board of trade.

25. After section one hundred and two of the principal act the following section shall be added and numbered 102A; namely,

"(1.) All things required or authorised under this act to be done by, to, or before the board of trade, may be done by, to, or before the president or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the board of trade and to be sealed with the seal of the board, or to be signed by a secretary or assistant secretary of the board, or by any person authorised in that behalf by the president of the board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

"(3.) A certificate, signed by the president of the board of trade, that any order made or act done is the order or act of the board, shall be conclusive evidence of the fact so certified."

Jurisdiction of Lancashire palatine court.

26. After section one hundred and twelve of the principal act the following section shall be added and numbered 112A; namely,

"The court of chancery of the county palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester office, have the like jurisdiction under this act as her majesty's high court of justice in England, and the expression 'the court' in this act shall be construed and have effect accordingly. [*page* 273]

"Provided that every decision of the court of chancery of the county palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that court in other cases."

Construction of principal act.

27. The principal act shall, as from the commencement of this act, take effect subject to the additions, omissions, and substitutions required by this act, but nothing in this act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this act.

Commencement of act.

28. This act shall, except so far as is by this act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

RULES AND PRACTICE OF THE PATENT OFFICE AND BEFORE THE LAW OFFICERS AND COMPTROLLER GENERAL.

PATENTS RULES, 1883.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the board of trade do hereby make the following rules :—

Short Title.

1. These rules may be cited as the Patents Rules, 1883. Short title.

Commencement.

2. These rules shall come into operation from and immediately after the 31st day of December, 1883. Commencement.

Interpretation.

3. In the construction of these rules, any words herein used defined by the said act shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned act, in addition to the fees mentioned in the second schedule thereto, so far as it relates to patents, shall be those specified in the list of fees in the first schedule to these rules. Fees.

Forms.

5 and 6. Repealed by Patent Rules, 1885, *infra*.

GENERAL.

Hours of business.

7. The patent office shall be open to the public every weekday during the hours of ten and four, except on the days and times following :—

Christmas Day.
Good Friday.
The day observed as her majesty's birthday.
The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency.

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller and all attendances by the applicant upon the comptroller may be made by or through an agent duly authorised to the satisfaction of the comptroller, and if he so require resident in the united kingdom.

Statement of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the comptroller or by the board of trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the comptroller. He may in any particular case require that the address mentioned in this rule be in the united kingdom.

Size, &c. of documents.

10. All documents and copies of documents sent to or left at the patent office or otherwise furnished to the comptroller or to the board of trade shall be written or printed in large and legible characters in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller.

Exercise of discretionary power by comptroller.

Notice of hearing.

11. Before exercising any discretionary power given to the comptroller by the said act adversely to the applicant for a patent or for amendment of a specification, the comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the comptroller.

Notice by applicant.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the comptroller may appoint in such notice, the applicant shall notify to the comptroller whether or not he intends to be heard upon the matter.

Comptroller may require statement, &c.

13. Whether the applicant desires to be heard or not, the comptroller may at any time require him to submit a statement in writing within a time to be notified by the comptroller, or to attend before him and make oral explanations with respect to such matters as the comptroller may require.

14. The decision or determination of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby. Decision to be notified to parties.

15. The term "applicant" in Rules 11, 12, and 13, shall include an applicant whose specification bears a title the same as or similar to that of the specification of a prior applicant, and has been reported on by the examiner. Definition of "applicant."

16. Such prior and second applicant respectively may attend the hearing of the question whether the invention comprised in both applications is the same, but neither party shall be at liberty to inspect the specification of the other. Prior and second applicant may attend hearing.

17. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the comptroller seven days' notice of his intention to exhibit, publish, or use the invention, as the case may be. Industrial or international exhibitions.

For the purpose of identifying the invention, in the event of an application for a patent being subsequently made, the applicant shall furnish to the comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the comptroller may in each case require.

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

19. Any application, notice, or other document authorised or required to be left, made, or given at the patent office or to the comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Documents by post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

20. Affidavits may, except where otherwise prescribed by these rules, be used as evidence in any proceedings thereunder when sworn to in any of the following ways, viz. :— Affidavits.

(1.) In the United Kingdom before any person authorised to administer oaths in the Supreme Court of Judicature or before a justice of the peace for the county or place where it is sworn or made.

(2.) In any place in the British dominions out of the United Kingdom before any court, judge, or justice of the peace or any person authorised to administer oaths there in any court.

(3.) In any place out of the British dominions before a British minister, or person exercising the functions of a British minister, or a British consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

Statutory declarations.

21. Where any statutory declaration prescribed by these Rules, or used in any proceedings thereunder, is made out of the United Kingdom, the words, "and by virtue of the Statutory Declarations Act, 1835," must be omitted, and the declaration shall (unless the context otherwise requires) be made in the manner prescribed in Rule 20, sub-section (3).

Application with Provisional or Complete Specification.

Order of recording applications.

22. Applications for a patent sent by prepaid letter through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the patent office otherwise than through the post shall be in like manner numbered in the order of their receipt at the patent office.

Application for separate patents by way of amendment.

23. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said act and by these rules, as if every such application had been originally made on that date for one invention only.

Application by representative of deceased inventor.

24. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative.

Notice and advertisement of acceptance.

25. On the acceptance of an application with a provisional or complete specification the comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the patent office.

Inspection on acceptance of complete specification.

26. Upon the publication of such advertisement of acceptance in the case of an application with a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the patent office upon payment of the prescribed fee.

APPLICATION ON COMMUNICATION FROM ABROAD.

27. An application for a patent for an invention communicated from abroad shall be made in the form A 1 set forth in the Second Schedule hereto. Communication from abroad.

(Rules 28, 29, 30, and 31 repealed, and other rules substituted by Patent Rules, 1886, *infra*.)

OPPOSITION TO GRANTS OF PATENTS.

32. A notice of opposition to the grant of a patent shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the united kingdom. Notice of opposition.

33. On receipt of such notice a copy thereof shall be furnished by the comptroller to the applicant. Copy for applicant.

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

35. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent shall leave at the patent office statutory declarations in support of his opposition, and deliver to the applicant a list thereof. Opponent's evidence.

36. Within 14 days from the delivery of such list the applicant shall leave at the patent office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent shall leave at the patent office his statutory declarations in reply, and deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply. Applicant's evidence. Evidence in reply.

Copies of the declarations mentioned in this and the last preceding rule may be obtained either from the patent office or from the opposite party.

37. No further evidence shall be left on either side except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller on application made to him for that purpose. Closing of evidence.

38. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

39. On the completion of the evidence the comptroller shall appoint a time for the hearing of the case, and shall give to the parties seven days' notice at the least of such appointment. Notice of hearing.

Disallowance of opposition in certain cases.

40. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition.

If it appears to the Comptroller-General that the specification of the applicant should be amended, he may make such amendment a condition of the patent being sealed, such amendment will be made so as to limit the claim, and to make it clear that that which is sought to be claimed is not the same invention as that referred to in the specification which forms the ground of opposition (*a*); and when the opposition is on the ground that the invention was obtained from the opponent by the applicant, the Comptroller-General or Law Officer will sometimes order the patent to be sealed in both names (*b*), or one party to execute an assignment of a share to the other as a condition of sealing (*c*).

When it appears that the applicant's invention contains really an improvement upon the opponent's invention, the Law Officer as a condition of sealing the applicant's patent, will require a distinct statement to be inserted in the specification that it is only for an improvement upon the opponent's patent, giving the date and number of such patent (*d*).

Decision to be notified to parties.

41. The decision of the comptroller in the case shall be notified by him to the parties.

When the Comptroller-General requires an amendment as a condition of sealing, the time for appealing will run from the date when the amendment is accepted, and not from the date of the notification that such amendment will be required (*e*).

Certificates of Payment or Renewal.

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

42. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to make the prescribed payment for keeping the same in force, he shall seven days at least before such expiration give notice to the comptroller of such intention, and shall before the expiration of such fourth or eighth year, as the case may be, leave at the patent office a form of certificate of payment, duly stamped, subject as hereinafter provided, with the prescribed fee of 50*l.* or 100*l.*, as the case may be.

As to patents granted before commencement of act.

43. In the case of patents granted before the commencement of the said act, the above rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

Payment of annual fees in lieu of 50*l.* and 100*l.*

44. If the patentee intends to pay annual fees in lieu of the above

(*a*) *Chandler's Patent*, Griffin P. C. 270; *Cooper and Ford's Patent*, Griffin P. C. 275.
(*b*) *Eadie's Patent*, Griffin P. C. 279.
(*c*) *Evans and Otway's Patent*, Griffin P. C. 279; and *Garthwaite's Patent*, Griffin P. C. 284.
(*d*) *Hoskins Patent*, Griffin P. C. 291.
(*e*) *Chandler's Patent*, Griffin P. C. 270; *Cooper and Ford's Patent*, Griffin P. C. at p. 276.

mentioned fees of 50*l.* and 100*l.*, he shall seven days at least before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 18th year thereof, give notice to the comptroller of such intention, and shall, before the expiration of such respective periods as aforesaid, leave at the patent office a form of certificate of payment, duly stamped with the fee prescribed to be paid at such periods respectively.

Certificate of payment.

45. On due compliance with these rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the comptroller shall give to the patentee a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

46. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake or inadvertence has failed to make such payment, and the comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

In other cases.

47. The time prescribed by these rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Amendment of Specification.

Request for leave to amend.

48. A request for leave to amend a specification shall be signed by the applicant or patentee and accompanied by a copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the patent office, and in such other manner (if any) as the comptroller may in each case direct.

Advertisement.

Notice of opposition.

49. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and shall be signed by him. Such notice shall state his address for service in the united kingdom.

Copy for the applicant.

50. On receipt of such notice a copy thereof shall be furnished by the comptroller to the applicant or patentee, as the case may be (hereinafter called the applicant).

Opponent's evidence.

51. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent shall leave at the patent office statutory declarations in support of his opposition and deliver to the applicant a list thereof

Further proceedings.

52. Upon such declarations being left, and such list being delivered,

the provisions of Rules 36, 37, 38, and 39 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Decision to be notified to parties.

53. The decision of the comptroller in the case shall be notified by him to the parties.

Requirements thereon.

54. Where leave to amend is given the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the patent office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 28, and 29.

Leave by order of court.

55. Where a request for leave to amend is made by or in pursuance of an order of the court or a judge, an official or verified copy of the order shall be left with the request at the patent office.

In *Codd's Patent* (*f*) the Comptroller-General held proceedings irregular *ab initio*, because the order of the court had not been filed pursuant to this rule (there was another objection); the application to amend was dismissed.

Advertisement of amendment.

56. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the patent office, and in such other manner (if any) as the comptroller may direct.

Compulsory Licenses.

Petition for compulsory grant of licenses.

57. A petition to the board of trade for an order upon a patentee to grant a license shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

To be left with evidence at patent office.

58. The petition and an examined copy thereof shall be left at the patent office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

Directions as to further proceedings unless petition refused.

59. Upon perusing the petition and evidence, unless the board of trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

60. If and when a primâ facie case for relief has been made out to the satisfaction of the board of trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver

Petitioner's evidence.

to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Patentee's evidence.

61. Within fourteen days after the day of such delivery the patentee shall leave at the patent office his affidavits or statutory

(*f*) Griffin P. C. 306.

declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in reply.

62. The petitioner within fourteen days from such delivery shall leave at the patent office his affidavits, or statutory declarations in reply, and deliver copies thereof to the petitioner; such last mentioned affidavits or declarations shall be confined to matters strictly in reply.

Further proceedings.

63. Subject to any further directions which the board of trade may give, the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the board of trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

Register of Patents.

Entry of grant.

64. Upon the sealing of a patent the comptroller shall cause to be entered in the register of patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

65. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the united kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the patent office.

Signature of request.

66. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Particulars to be stated in request.

67. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

68. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller.

Copies for patent office.

69. There shall also be left with the request an examined copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an examined copy.

Body corporate.

70. A body corporate may be registered as proprietor by its corporate name.

Entry of orders of the privy council or of the court.

71. Where an order has been made by her majesty in council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the court for the revocation of a patent or the rectification of the register under section 90 of the said act or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the patent office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Entry of payment of fees on issue of certificate.

72. Upon the issue of a certificate of payment under rule 45, the comptroller shall cause to be entered in the register of patents a record of the amount and date of payment of the fee on such certificate.

Entry of failure to pay fees.

73. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licenses.

74. An examined copy of every license granted under a patent shall be left at the patent office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original license shall at the same time be produced and left at the patent office if required for further verification.

Hours of inspection of register.

75. The register of patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following :—

(*a*) Christmas Day, Good Friday, the day observed as her majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England ; or

(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the patent office ;

(*c*) Times when the register is required for any purpose of official use.

Certified copies of documents.

76. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the patent office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee.

Power to Dispense with Evidence, &c.

77. Where, under these rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the patent office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the board of trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Repeal.

78. All general rules made by the lord chancellor, or by any other authority, under the Patent Law Amendment Acts, and in force on the 31st day of December, 1883, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to any application then pending. Repeal.

Dated the 21st day of December, 1883.

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the act, he shall within 14 days from the date of the decision appealed against file in the patent office a notice of such his intention.

> When an amendment has been ordered by the comptroller-general as a condition of sealing, the time for appeal will run from the date when the amendment has been accepted, and not from the date of the decision requiring amendment to be made (*a*).

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

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

IV. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

(*a*) *Chandler's Patent*, Griffin P. C. 270; *Cooper and Ford's Patent*, Griffin P. C. at p. 276.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

Where upon the hearing application before the law officer application was made by the opponent to amend by putting in another specification which it was alleged anticipated the application, leave refused upon the ground that the application was to oppose upon new grounds, and not merely to adduce further evidence (*b*).

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless, in the opinion of the law officer, there is good ground for not making such order.

Summonses under this rule are issued by the law officer's clerk.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

As a general rule costs will follow the event, even though it appears doubtful whether there is really any material difference between the invention sought to be patented and that upon which the opposition is based (*c*). The law officer in a simple case will generally fix the costs at 5 guineas (*d*), in other cases at 10 guineas; but when witnesses have been brought from a distance the costs will be ordered to be taxed. This was done in McIlwain's application by Clark, S.-G., on Nov. 19, 1887 (not reported). And where the appeal is against a decision of the comptroller-general, and there is no opposition, Sir R. Webster laid it down that the comptroller-general should, except under very special circumstances, neither give nor receive costs (*e*).

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the patent office, unless the law officer shall order to the contrary.

(*b*) *In re Bailey's Patent*, Griffin P. C. at p. 270.

(*c*) *Cochrane's Patent*, Griffin P. C. 304.

(*d*) *Cumming's Patent*, Griffin P. C. 277; *Chandler's Patent*, Griffin P. C. at p. 274; *Stubbs' Patent*, rule laid down by Webster, A.-G., Griffin P. C. 298; *Anderton's Patent*, 2 Griffin P. C. 25.

(*e*) *Lake's Patent*, 2 Griffin P. C. 16.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.-G.
FARRER HERSCHELL, S.-G.

REVOCATION.—When it is desired to obtain the attorney-general's authority under sect. 26, it is necessary to send the following papers to the patent clerk to the law officers:—(1) Memorial to the attorney-general asking for his authority, and stating all the circumstances; (2) Statutory declaration verifying the statements in the memorial; (3) Two copies of the proposed petition and of the particulars proposed to be delivered with it, under sect. 26 (5); (4) Certificate of a barrister that the petition is proper to be authorized by the attorney-general; (5) Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

The attorney-general sometimes gives or refuses his authority ex parte. In some cases he directs notice to be given to the patentee, and directs the parties to be heard before him.

FIRST SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNEXION WITH LETTERS PATENT.

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection .	1	0	0			
2. On filing complete specification . . .	3	0	0			
				4	0	0
or						
3. On filing complete specification with first application				4	0	0
4. On appeal from comptroller to law officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent				0	10	0
6. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
7. On application to amend specification :—						
Up to sealing. By applicant				1	10	0
8. After sealing. By patentee				3	0	0
9. On notice of opposition to amendment. By opponent				0	10	0
10. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
11. On application to amend specification during action or proceeding. By patentee				3	0	0
12. On application to the board of trade for a compulsory license. By person applying				5	0	0
13. On opposition to grant of compulsory license. By patentee				5	0	0

		£	s.	d.
14.	On certificate of renewal :—			
	Before end of four years from date of patent .	50	0	0
15.	Before end of seven years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of eight years from date of patent	100	0	0
	or in lieu of the fees of 50*l.* and 100*l.*, the following annual fees :—			
16.	Before the expiration of the 4th year from the date of the patent	10	0	0
17.	,, ,, 5th ,, ,, .	10	0	0
18.	,, ,, 6th ,, ,, .	10	0	0
19.	,, ,, 7th ,, ,, .	10	0	0
20.	,, ,, 8th ,, ,, .	15	0	0
21.	,, ,, 9th ,, ,, .	15	0	0
22.	,, ,, 10th ,, ,, .	20	0	0
23.	,, ,, 11th ,, ,, .	20	0	0
24.	,, ,, 12th ,, ,, .	20	0	0
25.	,, ,, 13th ,, ,, .	20	0	0
	On enlargement of time for payment of renewal fees :—			
26.	Not exceeding 1 month	3	0	0
27.	,, 2 months	7	0	0
28.	,, 3 months	10	0	0
29.	For every entry of an assignment, transmission, agreement, license, or extension of patent . .	0	10	0
30.	For duplicate of letters patent . . . each	2	0	0
31.	On notice to comptroller of intended exhibition of a patent under sect. 39	0	10	0
32.	Search or inspection fee . . . . . each	0	1	0
33.	For office copies . . . every 100 words (but never less than one shilling)	0	0	4
34.	,, of drawings, cost according to agreement.			
35.	For certifying office copies MSS. or printed . each	0	1	0
36.	On request to comptroller to correct a clerical error .	0	5	0
37.	For certificate of comptroller under sect. 96 . .	0	5	0
38.	For altering address in register	0	5	0

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

21st December, 1883.

Approved :

(Signed) CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of
Her Majesty's Treasury.

4th December, 1883.

THE SECOND SCHEDULE.

Forms.

		PAGE
A.—	Form of Application for Patent . . .	See Second Schedule to Patent Rules, 1885.
A1.— „	„ „ communicated from abroad	
B.— „	Provisional Specification . . .	
C.— „	Complete „ . . .	
D.— „	Opposition to Grant of Patent	399
E.— „	Application for Hearing by Comptroller . . .	399
F.— „	„ to amend Specification or Drawings .	399
G.— „	Opposition to Amendment of Specification or Drawings	400
H.— „	Application for Compulsory Grant of License .	400
H1.— „	Petition for Compulsory Grant of Licenses . .	400
I.— „	Opposition to Compulsory Grant of License . .	401
J.— „	Application for Certificate of Payment or Renewal	402
K.— „	Application for Enlargement of Time for Payment of Renewal Fee	402
L.— „	Request to enter Name upon the Register of Patents	403
M.— „	Request to enter Notification of License in Register	403
N.— „	Application for Duplicate of Letters Patent . .	404
O.— „	Notice of Intended Exhibition of Unpatented Invention	404
P.— „	Request for Correction of Clerical Error . . .	404
Q.— „	Certificate of Comptroller	405
R.— „	Notice for Alteration of an Address in Register .	405
S.— „	Application for Entry of Order of Privy Council in Register	405
T.— „	Appeal to Law Officer	406
U.—	See Second Schedule to Patent Rules, 1885.	

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM D.

Form of Opposition to grant of Patent.

[*To be accompanied by an unstamped copy.*]

*I —— hereby give notice of my intention to oppose the grant of letters patent upon application No. —— of —— applied for by —— upon the ground † ——.

(Signed) ‡ ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address.
† Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed.
‡ Here insert signature of opponent or agent.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT]. FORM E.

Form of Application for Hearing by the Comptroller.

IN CASES OF REFUSAL TO ACCEPT, OPPOSITION, OR APPLICATIONS FOR AMENDMENTS, &C.

Sir,

—— of (*a*) —— hereby apply to be heard in reference to —— and request that I may receive due notice of the day fixed for the hearing.

Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) Here insert address.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] Form F.

Form of Application for Amendment of Specification or Drawings.

* —— seek leave to amend the specification of letters patent No. —— of 188—, as shown in red ink in the copy of the original specification hereunto annexed ——.

My reasons for making this amendment are as follows † ——.

(Signed) ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant or patentee.
† Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the letters patent.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM G.

Form of Opposition to Amendment of Specification or Drawings.

[*To be accompanied by an unstamped copy.*]

* —— hereby give notice of objection to the proposed amendment of the specification or drawings of letters patent No. —— of 188— for the following reason : † ——.

(Signed) ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of opponent.
† Here state reason of opposition.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM H.

Form of Application for Compulsory Grant of License.

[*To be accompanied by an unstamped copy.*]

* —— hereby request you to bring to the notice of the board of trade the accompanying petition for the grant of a license to me by † ——.

(Signed) ——.

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* form below.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant.
† Here state name and address of patentee, and number and date of his patent.

Patents, Designs, and Trade Marks Act, 1883.

FORM H1.

Form of Petition for Compulsory Grant of Licenses.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

THE PETITION of (*a*) —— of —— in the county of ——, being a person interested in the matter of this petition as hereinafter described :—

(*a*) Here insert name, full address, and description.

SHEWETH as follows :—

1. A patent dated —— No. —— was duly granted to —— for an invention of (*b*) ——.

2. The nature of my interest in the matter of this petition is as follows :—(*c*)

3. (*d*)

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licenses on reasonable terms (*e*)

Your petitioner therefore prays that an order may be made by the board of trade (*f*)
or that the petitioner may have such other relief in the premises as the board of trade may deem just.

(*b*) Here insert title of invention.
(*c*) Here state fully the nature of petitioner's interest.
(*d*) Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licenses on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.
(*e*) Here state the ground or grounds on which relief is claimed in the language of section 22 subsection (*a*), (*b*), or (*c*), as the case may be.
(*f*) Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment or otherwise, upon which the petitioner claims to be entitled to the relief in question.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM I.

Form of Opposition to Compulsory Grant of License.

* —— hereby give notice of objection to the application of —— for the compulsory grant of a license under patent No. —— of 188—.

(Signed) ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address.

Patents, Designs, and Trade Marks Act, 1883.

FORM J.

Application for Certificate of Payment or Renewal.

—— hereby transmit the fee prescribed for the continuation in force of —— patent No. ——, of 18—, for a further period of ——.

Name * ——.

Address ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert name and full address of patentee or his agent.

[PATENT.]

Certificate of Payment or Renewal.

Letters patent No. —— of 188—.

—— 18—.

This is to certify that —— did this —— day of —— 18—, make the prescribed payment of £—— in respect of a period of —— from —— and that by virtue of such payment the rights of —— remain in force.*

(Seal.)

Payment Office, London.

* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM K.

Form of Application for Enlargement of Time for Payment of Renewal Fee.

Sir,

I HEREBY apply for an enlargement of time for —— month — in which to make the —— payment of £—— upon my patent, No. ——, of 188—.

I am,
Sir,
Your obedient Servant,

(*a*) ——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) Here insert full address to which receipt is to be sent.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM L.

Form of Request to enter Name upon the Register of Patents, and of Declarations in support thereof.

I (*a*), —— hereby request that you will enter (*b*) —— me —— (*c*) in the register of patents :—

(*d*) —— claim to be entitled (*e*) —— of the patent No. —— of 188—, granted to (*f*) —— for (*g*) —— by virtue of (*h*) ——.

And in proof whereof I transmit the accompanying (*i*) —— with an examined copy thereof (*j*).

I am,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) *Or* We. Here insert name, full address, and description.
(*b*) My *or* our.
(*c*) *Or* names.
(*d*) I *or* We.
(*e*) Here insert the nature of the claim.
(*f*) Here give name and address, &c., of Patentee or Patentees.
(*g*) Here insert title of the invention.
(*h*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.
(*i*) Here insert the nature of the document.
(*j*) Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an examined copy must be left.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM M.

Form of Request to Enter Notification of License in the Register of Patents.

Sir,

I hereby transmit an examined copy of a license granted to me by ——, under patent No. —— of 188—, as well as the original license for verification, and I have to request that a notification thereof may be entered in the register.

I am,
Sir,
(*a*) ———. Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) Here insert full address.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM N.

Application for Duplicate of Patent.

Date.

Sir,

I regret to have to inform you that the letters patent, dated * ——, No. ——, granted to ——, for an invention of † ——, have been ‡ ——.

I beg therefore to apply for the issue of a duplicate of such letters patent.§

[Signature of Applicant.]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert date, No., name, and full address of Patentee.
† Here insert title of invention.
‡ Here insert the word "destroyed" or "lost," as the case may be.
§ Here state interest possessed by applicant in the letters patent.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM O.

Notice of Intended Exhibition of an Unpatented Invention.

* —— hereby give notice of my intention to exhibit a —— of —— at the —— Exhibition, which † —— of —— 18—, under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

‡ —— herewith enclose ——. (Signed) ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant.
† State "opened" or "is to open."
‡ Insert brief description of invention, with drawings if necessary.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM P.

Form of Request for Correction of Clerical Error.

Sir,

I hereby request that the following clerical error (*a*) may be corrected in (*b*)

Signature ——
Full address ——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) *Or* errors.
(*b*) Here state whether in application, specification, or register.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM Q.

Certificate of Comptroller-General.

Patent Office,
London,
—— 188 —.

I, ——, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

---

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM R.

Form of Notice for Alteration of an Address in Register.

Sir,

(*a*) ——hereby request that —— address now upon the register may be altered as follows :—

(*b*) ————

——,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Here state name or names and full address of applicant or applicants.
(*b*) Here insert full address.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM S.

Form of Application for Entry of Order of Privy Council in Register.

(*a*) —— hereby transmit an office copy of an Order in Council with reference to (*b*).

——,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Here state name and full address of applicant.
(*b*) Here state the purport of the order.

Patents, Designs, and Trade Marks Act, 1883.

[PATENT.] FORM T.

Form of Appeal to Law Officer.

I, (*a*) —— of (*a*) —— hereby give notice of my intention to appeal to the law officer from (*b*) —— of the comptroller of the —— day of —— 188—, whereby he (*c*) —— No. (*d*) —— of the year 188—(*d*).

Signature ——
Date ——.

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

21st December, 1883.

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

(*a*) Here insert name and full address of appellant.
(*b*) Here insert "the decision" or "that part of the decision," as the case may be.
(*c*) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.
(*d*) Insert number and year.

PATENTS RULES, 1885.

By virtue of the provisions of the Patents Designs and Trade Marks Act, 1883 (herein-after referred to as the principal act,) the board of trade do hereby make the following rules :—

Short Title.

1. These rules may be cited as the Patents Rules, 1885. Short title.

Commencement.

2. These rules shall come into operation from and immediately after the 14th day of August, 1885. Commencement.

Fees.

3. In addition to the fees mentioned in the second schedule to the principal act so far as it relates to patents, and in the list of fees contained in the first schedule to the Patents Rules, 1883, there shall be paid under the said act and the Patents, Designs and Trade Marks (Amendment) Act, 1885, the fees specified in the first schedule to these rules. Fees.

Forms.

4. The Forms A, B, and C in the first schedule to the principal act shall be altered or amended by the substitution therefor respectively of the Forms A, A1, B, and C in the second schedule hereto. Forms. Alterations.

5. (1.) An application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the principal act shall be made either in the Form A or the Form A1, set forth in the second schedule hereto, as the case may be. Application.

(2.) The Form B in such schedule of provisional specification and the Form C of complete specification shall respectively be used. Specification.

(3.) The remaining Forms other than A, A1, B, and C, set forth in the second schedule to the Patents Rules, 1883, and in the second schedule hereto respectively, may, as far as they are applicable, be used in any proceedings under these rules. Other forms.

Extension of Time.

6. An application for extension of time for leaving or accepting a complete specification shall be in writing and shall state in detail in what circumstances and upon what grounds such extension is applied Extension of time for leaving and accepting

complete specification. for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary.

REPEAL.

Repeal. 7. Rules 5 and 6 of the Patents Rules, 1883, shall be and they are hereby repealed as from the 14th day of August, 1885, without prejudice, nevertheless, to any application then pending.

(Signed) RICHMOND AND GORDON,
President of the Board of Trade.

15th August, 1885.

FIRST SCHEDULE.

	£	s.	d.
No. 39.—For enlargement of time for filing complete specification not exceeding one month .	2	0	0
No. 40.—For enlargement of time for acceptance of complete specification—			
Not exceeding one month . . .	2	0	0
,, two months . . .	4	0	0
,, three months . . .	6	0	0

(Signed) RICHMOND AND GORDON,
President of the Board of Trade.

15th August, 1885.

Approved
(Signed) SIDNEY HERBERT,
W. H. WALROND,
Lords Commissioners of Her Majesty's Treasury.

15th August, 1885.

SECOND SCHEDULE.

Patents, Designs, and Trade Marks Acts, 1883 and 1885.

[PATENT.] FORM A.

Application for Patent.

(*a*) ——, do hereby declare that —— in possession of an invention for (*b*) ——, that (*c*) —— the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of —— knowledge and belief; and —— humbly pray that a patent may be granted to —— for the said invention.

Dated —— day of —— 188—.

(*d*) ————.

NOTE.—Where application is made through an agent (Rules 8 and 9 of Patents Rules, 1883), the authorization on the back (if used) should be signed by the applicant or applicants.

For the convenience of applicants, suggested forms of authorization to an agent and statement of address respectively are printed below. *They are not, however, to be deemed to be binding upon applicants, no particular form of these documents having been prescribed by the act or rules.*

(*a*) Here insert name and full address and calling of applicant or applicants.
(*b*) Here insert title of invention.
(*c*) In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.
(*d*) To be signed by applicant or applicants.

(1.) WHERE APPLICATION IS MADE THROUGH AN AGENT (RULES 8 AND 9 OF PATENTS RULES, 1883.)

—— hereby appoint —— of —— to act as —— agent in respect of the within application for a patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

—— day of ——, 188—.

* ————.

* To be signed by applicant or applicants.

(2.) WHERE APPLICATION IS MADE WITHOUT AN AGENT (RULE 9 OF PATENTS RULES, 1883.)

—— hereby request that all notices, requisitions, and communications in respect of the within application may be sent to —— at ——.

—— day of —— 188—.

† ————

† To be signed by applicant or applicants.

Patents, Designs, and Trade Marks Acts, 1883 and 1885.

[PATENT.] FORM A1.

Application for Patent for Inventions communicated from Abroad.

I (*a*) —— of —— in the county of —— do hereby declare that I am in possession of an invention for (*b*) —— which invention has been communicated to me from abroad by (*c*) —— that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

Dated —— day of —— 188—.

(*d*) ——

NOTE.—Where application is made through an agent (Rules 8 and 9 of Patents Rules, 1883) the authorization on the back (if used) should be signed by the applicant or applicants.

For the convenience of applicants, suggested forms of authorization to an agent and statement of address respectively are printed below. *They are not, however, to be deemed to be binding upon applicants, no particular form of these documents having been prescribed by the act or rules.*

(*a*) Here insert name, and full address and calling of applicant.
(*b*) Here insert title of invention.
(*c*) Here insert name, address, and calling of communicant.
(*d*) To be signed by applicant or applicants.

(1.) WHERE APPLICATION IS MADE THROUGH AN AGENT (RULES 8 AND 9 OF PATENTS RULES, 1883).

—— hereby appoint of —— to act as —— agent in respect of the within application for a patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

—— day of —— 188—.

* ——

* To be signed by applicant or applicants.

(2.) WHEREBY APPLICATION IS MADE WITHOUT AN AGENT (RULE 9 OF PATENTS RULES, 1883).

—— hereby request that all notices, requisitions, and communications in respect of the within application may be sent to —— at ——.

—— day of —— 188—.

† ——

† To be signed by applicant or applicants.

To be issued with Form A. or A1.

Patents, Designs, and Trade Marks Acts, 1883 and 1885.

FORM B.

Provisional Specification.

(To be furnished in Duplicate.)

(*a*) ——, (*b*) ——, do hereby declare the nature of this invention to be as follows :—

(*c*) ————

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification ; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows :—

"Dated this —— day of —— 18—."

(*a*) Here insert title as in declaration.
(*b*) Here insert name and full address and calling of applicant or applicants as in declaration.
(*c*) Here insert short description of invention.

Patents, Designs, and Trade Marks Acts, 1883 and 1885.

[PATENT.] FORM C.

*

Complete Specification.

(To be furnished in Duplicate—one unstamped.)

(*a*) ——, (*b*) ——, do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :

(*c*) ————

NOTE.—This document must form the commencement of the Complete Specification ; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on

(*a*) Here insert title as in declaration.
(*b*) Here insert name, and full address and calling of applicant or applicants as in declaration.
(*c*) Here insert full description of invention, *which must end with a distinct statement of claim or claims, in the following form* :—

"Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is—

"(1)
"(2)
"(3) ."

Here state distinctly the features of novelty claimed.

* Where provisional specification has been left, quote No. and date.

No.
Date

left hand of paper. The Complete Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows :

"Dated this —— day of ——, 18—."

Patents, Designs, and Trade Marks Acts, 1883 and 1885.

[PATENT.] FORM U.

Form of Application for Extension of Time for Leaving a Complete Specification.

SIR,

—— hereby apply for extension of time for one month in which to leave a Complete Specification upon application.

dated ——.

The circumstances in and grounds upon which this extension is applied for are as follows (*a*) : —

——

Sir,

Your obedient Servant.

(*b*) ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) See Rule 6 of Patents Rules, 1885.
(*b*) To be signed by applicant or applicants or his or their agent.

Patents, Designs, and Trade Marks Acts, 1883 and 1885.

[PATENT.] FORM V.

Form of Application for Extension of Time for Acceptance of a Complete Specification.

Sir,

—— hereby apply for extension of time for —— months —— for the acceptance of the Complete Specification upon application No. —— dated ——.

The circumstances in and grounds upon which this extension is applied for are as follows (*a*) :—

——

Sir,

Your obedient Servant,

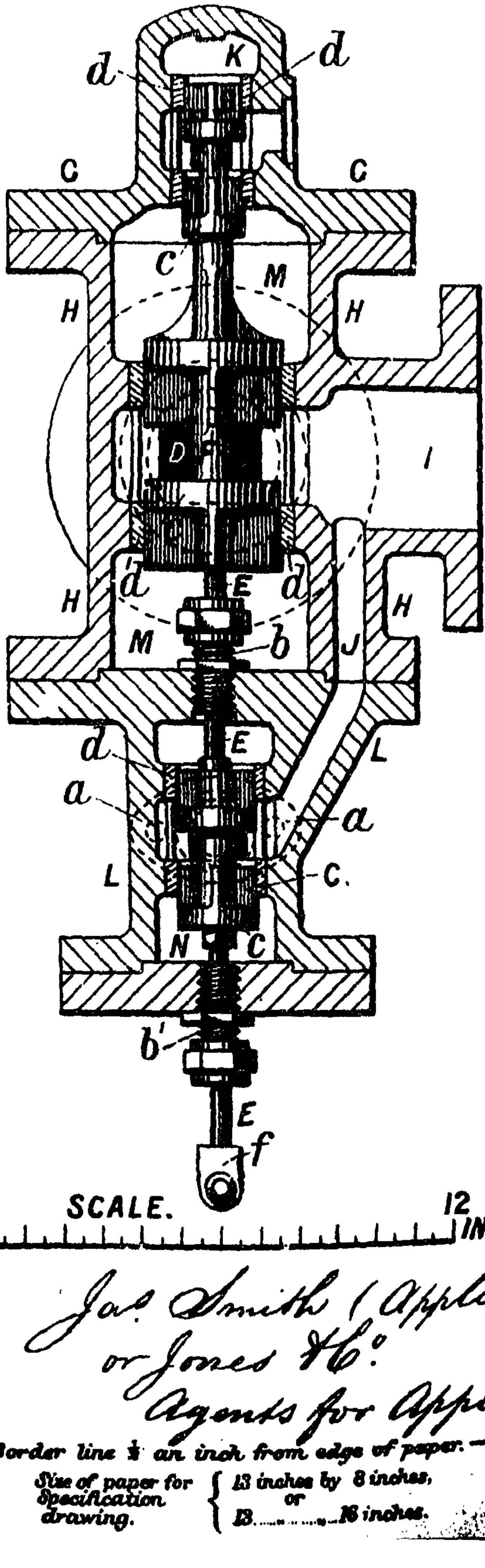
(*b*) ——.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) See Rule 6 of Patents Rules, 1885.
(*b*) To be signed by applicant or applicants or his or their agent.

A. D. 1885. No. 1974. 1 Sheet
Smith's Specification. Sheet

FIG. 1.



SCALE.
0 INS. 12 INS.

Jas. Smith (Applicant)
or Jones & Co.
Agents for Applicant

Border line ½ an inch from edge of paper.

Size of paper for Specification drawing. { 13 inches by 8 inches, or 13 ..... 16 inches.

PATENT RULES, 1886.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, *the Board of Trade do hereby make the following Rules in lieu of and substitution for Rules* 28, 29, 30, *and* 31, *of the Patents Rules*, 1883.

Sizes and methods of preparing Drawings accompanying Provisional or Complete Specifications.

Drawings for specifications.

Rule 28. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 31. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself.

Rule 29. Where drawings accompany the specifications, they must be delivered at the patent office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

Requirements as to paper, &c.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality (*a*), and where possible without colour or Indian-ink washes.

Size of drawings.

They must be on sheets of one of the two following sizes (the smaller being preferable), 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be $\frac{1}{2}$ an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Quality of ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is annexed in illustration of this requirement. Reference figures and letters must be bold, distinct, not less than $\frac{1}{8}$ of an inch in height, and of the character shown in the specimen; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference

(*a*) As the drawings are copied at the Patent Office for publication by the process of photo-lithography, this rule must be *strictly* observed in order that correct copies may be made.

letters must be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings. The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c. need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings to bear name of applicant, &c. Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

No written description of the invention should appear on the drawings.

Restrictions as to wood engravings. Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings. Rule 30. A *facsimile* of the original drawings but *without* colour or Indian ink washes, and prepared strictly in accordance with the regulations prescribed in rule 29, must accompany the originals, and be marked "true copy."

Provisional drawings used for complete specification. Rule 31. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

Repeal. Rule 31*a*. The above rules shall be in force as from the day of the date hereof and Rules 28, 29, 30, and 31 of the Patents Rules, 1883, shall be and they are hereby repealed without prejudice, nevertheless, to any application now pending. Notwithstanding such repeal the comptroller shall be at liberty during a period of three months from the date hereof (or in special cases during such further time as the comptroller may think fit) to accept drawings prepared in accordance with such repealed rules.

Dated the 16th day of September, 1886.

STANLEY OF PRESTON,
President of the Board of Trade.

RULES

TO BE OBSERVED IN PROCEEDINGS BEFORE THE

JUDICIAL COMMITTEE OF THE PRIVY COUNCIL

Under the Act of the 5th and 6th Will. IV., intituled "An Act to amend the Law touching LETTERS PATENT FOR INVENTIONS" (*cap.* 83).

RULE I.—A party intending to apply by petition, under section 2 of the said act, shall give public notice by advertising in the London Gazette three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition his majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the London Gazette), and that on or before such day, notice must be given of any opposition intended to be made to the petition ; and any person intending to oppose the said application, shall lodge notice to that effect at the council office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

RULE II.—A party intending to apply by petition, under section 4 of the said act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the London Gazette), and that on or before such day caveats must be entered ; and any person intending to enter a caveat shall enter the same at the council office, on or before such day so named in the said advertisements ; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

RULE III.—Petitions under sections 2 and 4 of the said act must be presented within one week from the insertion of the last of the advertisements required to be published in the London Gazette.

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of sect. 4 of the said act, and the 1st and 2nd of these rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

RULE V.—All persons entering caveats under sect. 4 of the said act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect. 2 of the said act, and all persons lodging notices of opposition under the 1st of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

RULE VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said act, at their own expense.

RULE VIII.—The registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

RULE IX.—A party applying for an extension of a patent, under sect. 4 of the said act, must lodge at the Council Office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the lords of the committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said act, in case it shall be thought fit to oppose the same on such behalf.

INDEX.

ABANDONED, application for patent, 58, 355, 378.

ACCEPTANCE,
of complete specification, 116.
of application, 354.

ACCIDENTAL discovery sufficient to support patent, 54.

ACCOUNTS,
filing of, on application for extension of patent, 152.
must be reasonable and precise, 152—154.
when dispensed with, 154.
of sales and profits, when allowed, 206.
not allowed when no profit made, 207.
injunction granted on terms of keeping, 196.
plaintiff must elect between damages and, 203.
of profits lost by competition, not allowed when licence has been granted, 205.

ACTION,
for infringement, 214. See *Infringement*.
for injunction to restrain threats. See *Threats*.
for revocation. See *Revocation*.

ADDITION to known machine producing new result may be patented, 27.

ADDRESS,
of letters patent, 124.
form of notice for alteration of, in register, 405.
statement of, of applicant, 384.

ADMINISTRATORS. See *Executors*.

ADVANTAGES, claiming, 54.

ADVERTISEMENT,
of amended specification, 106, 357, 358.
of acceptance of specification, 58, 116, 355.
rules relating to, 386.

AFFIDAVIT,
on motion for injunction, 220.
what it must state, *ib*.
after trial, 243.
rules as to, 385.

AGENT,
patent, to be registered, 380.
duties of, 384.
infringement by, 182.
to sell, cannot maintain action for infringement, 217.
discovery of name of, infringing after judgment, 243.
application for patent by, 384.

AGREEMENT, fraudulent, will be set aside, 140.

ALIEN,
may obtain patent, 6.
liable for infringement, 166.

AMBIGUITY,
in specification, whether a question for jury, query, 80.
latent, in licence, how explained, 142.

AMENDMENT. See *Specification*.
of specification, 58, 102, 357.
compulsory or voluntary, 102.
compulsory limited to matters of form, 103.
rules as to by comptroller, 385, 389, 399.
which appear on the face of it, 104.
comptroller may require, 102, 354, 381.
appeal to law officer, 102, 354, 381.
duties of examiner as to, 103.
by applicant or patentee, 104.
disclaimer, correction or alteration, 105, 112.
assignees might amend by disclaimer or alteration, 105.
now made at peril of inventor, 105.
statutory provisions respecting, 106.
must not enlarge the claim, 106.
prohibition to law officer does not lie, 106.
comptroller may impose conditions, 107.
conditions imposed by law officer, 107.
must not extend exclusive right, 112.
once made, cannot afterwards be objected to, 113.
discretion as to costs on application, 115.
opposition to, 357.
proceedings before law officer and comptroller in case of, 357, 358.
conditions may be imposed, *ib.*
pending action for infringement, 109, 358, 381.
in case of fraud, 113.
when allowed after action brought, 109.
of particulars. See *Particulars*.

ANTICIPATION. See *Prior User* and *Prior Publication*.

APPARENT possession, doctrine of, does not affect patent right, 135.

APPEALS,
in action, practice on, 280.
further evidence, when allowed, 281.
injunction suspended pending, 281.
to law officers, rules regulating, 394.
form of notice of, 406.

APPLICATION,
for patent, 5, 56, 353.
reference of, to examiner, 57, 64, 354.
comptroller may refuse or require amendment, 57, 102, 364.
order of recording, 380.
amendment of, 380.
considered abandoned if specification not left within specified time, 355.
what it must contain, 5
by infants and married women, 6.
by first importer, 7.
in fraud of inventor, 16. See *Opposition*.
for separate patents by way of amendment, 386.
by representative of deceased inventor, *ib.*
on communication from abroad, 387.
form of, 409.
when communicated from abroad, 410.
for hearing by comptroller, 390.
for compulsory grant of licence, 400.

ARCHITECT, when not liable for infringement, 166.

ASSESSORS,
at trial, 251, 277, 278, 361.
remuneration of, 361.

ASSIGNEE,
suing, 163.
extension of patent to, 158.
on what grounds, 159.
as to action by assignee for district, 170.
can restrain infringement within assigned area, 216.
may sue in his own name, 216.
amendment of specification by, 340, note.

ASSIGNMENT OF PATENT. See *Devolution*.
precedent for, 334.
for a place or district, 135, 160, 163, 216, 363.

BALANCE SHEET must be lodged on application for extension, 154.

BANKRUPTCY of patentee, effect of, 134.

BOARD OF TRADE,
may grant compulsory licences, 141.
powers of to make rules, 369, 380, 382.

BONA FIDES necessary in specification. See *Specification*.

BREACHES, particulars of, 222 *et seq.*

CAPITALIST may join inventor to obtain grant, 8.

CAVEAT, entry of, 145, 160.

CERTIFICATE,
of comptroller. See *Comptroller.*
of Court that validity of patent questioned, 269, 362
in simultaneous actions, 270.
when action compromised, 273.
cannot be given by consent, 271.
of proof of particulars of breaches, 273 *et seq.*
no costs without, 362.
form of, 306.

CERTIFIED COPIES, 255, 392.

CLAIM,
if too large, vitiates patent, 52.
if advantages claimed are not now, does not vitiate patent, 54.
must be distinct, 101.
sect. 5 of Patents Act, 1883, directory only, 96.

CLERICAL ERRORS, 385, 404. See *Amendments.*

COLONIAL, arrangements as to patents, 214.

COLOURABLE IMITATION, 175.

COMBINATION,
as subject-matter, 33.
infringement of patent for a, 172, 177. See *Infringement.*
elements of, may be used, 177.
use of, patented in improved, *ib.*
subject-matter of patent, 33, 98.
though every part old, 34.
must be claimed as such, 98.

COMMUNICATION,
from abroad, 20. See *Importer.*
in England, 20.
patent granted as for such communication, *ib.*
rule relating to, 387.

COMPANY, directors of, 144, 244.

COMPOUND SUBSTANCE, discovery of, good ground for patent, 28.

COMPTROLLER,
may refuse to accept unamended specification, 102.
determines when amendment allowable, 104 *et seq.* See also 385.
may refuse illegal patent, 127.
no appeal from this decision, *ib.*
exercise of discretionary power by, 384.
notice of hearing by, *ib.*
may require statement, *ib.*
decision of, to be notified, 385.
prior and second applicants may attend before, *ib.*
may make clerical amendments, 385.
rules relating to opposition before, 387.
cases and penalties, 388.
relating to amendment by, 389.
relating to duties of with respect to register, 391.
power of, to dispense with evidence, 393.
form of certificate of, 405.

CONCEALMENT, in specification by patentee, 88 *et seq.*

CONDITIONS of grant, 130. See *Grant.*

CONDONATION of infringement, 206.

CONFIRMATION abolished, 162.

CONSIDERATION,
for grant, 8.
merit, a part of, 11–21.
mental labour is the, 12—14.

CONSTRUCTION,
of specification, when object old and means new, 32.
of specification will be liberal, 74.
as with other documents, 78.
dictum of Lord Westbury, *ib.*
of claims, 79.
of grant most beneficial, 133, 140.

CONTRACTOR,
liable for infringement, 165, 217.
with Crown, 217.

CO-OWNERS, action by, 216.

CORPORATION, may be registered as proprietor of patent, 392.

CORRECTION of specification. See *Amendment.*

COSTS,
of disclaimer, when allowed, 115.
on application for leave to amend specification, *ib.*
of extension of term, 146, 161.
of entry of caveat, 160, 161.
on abandonment of petition for extension, *ib.*
fixed sum in lieu of, *ib.*
security for, by licensee using patentee's name, 165.
discretion of court as to, 207.
of abandoned defences, 227.
of particulars allowed on certificate only, 271, 361.
when particulars are amended, 234.
between solicitor and client, when ordered, 269 *et seq.*
particulars considered on taxation of, 271.
of abandoned action, 273.
on higher or lower scale, 274.
appeal as to, 275.
when payable by directors personally, 276.
up to hearing, 276.
fees payable in connection with patents. See *Fees.*

CROWN,
patent to bind, 128, 185, 361.
use of invention by servants of, 132, 184, 361.
by contractor with, 185.
liable for infringement, 132, 185.
power of purchase by, 132, 361.

CROWN—*continued.*
right of user without payment abolished, 132, 133.
terms of user by, *ib.*
arrangements with other governments by, 213.
assignment to Secretary of War of certain inventions, 133, 364.
invention to be kept secret, 364.
conditions of assignment, *ib.*
Royal prerogative preserved, 374.

DAMAGES. See *Injunction* and *Account of Sales and Profits, Amendment.*
when allowed after amendment, 114.
when plaintiff entitled to, 203.
measure of, in action for infringement, 203.
commercial competition an element in, 204.
extent of infringement considered, *ib.*
where licence granted, 205.
against whom recoverable, *ib.*
discovery in aid of, 205.
for infringement before amendment, 111, 358.
do not depend on right to injunction, 207.
plaintiff cannot claim account and, 215.
must be proved when claimed, 259.

DATE of patent, 356.

DEATH of applicant, 356, 362.

DECLARATION,
must accompany application, 5, 56, 353, 378.
what it must contain, 8.
must distinguish inventor and importer, 8.
must be made by one of the applicants, 9.
by infant, lunatic, &c., how to be made, 369.
statutory, 386.

DEFINITIONS of patent, patentee, invention, &c., 366. See *sub titulis*

DELAY,
in practising invention, 156.
in applying for injunction, 201.

DELIVERY up of infringing articles, 202.

DESCRIPTION,
court will distinguish between claim and, 95.
insufficient, in specification not fatal, 126.

DESTRUCTION,
of infringing articles, 202.
when ordered, *ib.*
of patent, 363.

DETERMINATION, of patent for non-payment of fees, 132.

DEVOLUTION. See *Assignment, Licence*.
by bankruptcy, 134, 135, 136.
of patent by assignment, 135.
absolute or limited assignment, *ib.*
assignment must be by deed, *ib.*
may be for a district only, 136.
operates by way of estoppel, 136.
no estoppel in case of fraud, 137, 138.
executors may assign before probate, 140.
specific performance of agreement to assign, 140.
licence need not be stamped as a deed, 136.
need not be delivered, *ib.*
may be verbal, 139, 142.
does not operate by way of estoppel, 138–142.
except where licensee has received the benefit, 139.
does not imply any warranty, 139.
distinction between licence and assignment, 140.
compulsory licence, 141.
licence not assignable, 142.
licence by parol is a licence at will, 142.
register of assignments, &c., 143.

DISCLAIMER. See *Amendment*.

DOCUMENTS,
Patent Office rules relating to, 384, 392.
to be sent by post, 385.
certified copies of, 392.

DRAWINGS,
do not limit claim as against specification, 80.
rules relating to, 415, 416.

DUPLICATE form of application for patent, 404.

DURATION of patent, 128, 357.

ENLARGEMENT OF TIME,
for payments, 389.
in other cases, *ib.*
form of application for, 402.

ENTRY of grant on register, 391.

EQUIVALENTS,
mechanical or chemical, 85, 179.
description of, when necessary, 85.

ESTOPPEL,
patentee estopped from questioning validity of patent assigned, 136, 138.
except in case of fraud, *ib.*
law as to, 136.
by licence not under seal, 138.
of licensee, *ib.*
as between partners, *ib. et seq.*

EVASION of patent, 177.

EVIDENCE, must not go beyond particulars. See *Particulars*.

EXAMINER,
reference of specification to, 57, 64, 254.
duty of to compare a subsequent application and give notice of similarity, 354.
reports of private, 355.
may require amendment of specification, 102.
duties of, 103.

EXCLUSIVE,
right not extended by amendment, 112.
licence. See *Licence*.

EXECUTORS AND ADMINISTRATORS,
may sue, 165.
property in patent passes to, 134.
powers of, *ib.*
may petition for extension, 158.
patent may be granted to, 362.
when assign patent, before probate, 140.
rules relating to application by, 386.

EXHIBITION,
of patent, when allowable, 363, 379.
rules as to, 385.
form of notice of intended, 404.

EXPERIMENTS,
cost of, allowed in application for extension, 153.
with a view to discovery, 50.
no infringement, 183.

EXPERT,
may be called in by law officer, 121, 356.
form of order for inspection by, 293.

EXPLANATION of specification. See *Amendment*.

EXPOSURE for sale, no infringement, 189.

EXTENSION,
of term of patent, 145, 359.
petition for, *ib.*
opposition to by caveat, 145, 359.
when granted, and for how long, 146.
former practice as to, 146, 147.
evidence necessary to obtain, 148.
in the case of communicated inventions, 149.
granted to assignee, *ib.*
limit of the enquiry as to novelty and utility, 150.
accounts on application for, 151 *et seq.*
profits derived from patent and as a manufacturer, 152.
costs of experiments, 153.
costs of litigation, *ib.*
costs of bringing invention into use, *ib.*

EXTENSION *continued*.
accounts must be clear and precise, 155.
must contain balance sheets, *ib.*
profits from foreign patents must be stated, *ib.*
grounds of opposition, 156.
invention not brought into use, *ib.*
negligence in restraining infringement, *ib.*
invention useless, *ib.*
intentional delay, *ib.*
patent obviously invalid, *ib.*
executors and assignees may apply for extension, 158.
and executors of assignees, *ib.*
effect of Act of 1883: 159, 160.
costs of abandoned petition, 161.
costs, *ib.*
further prolongation not allowed, *ib.*
after expiry of foreign patent, 161.

EXTENT of patent, 123, 367.

EXTRANEOUS matter, when fatal in specification, 94.

FALSE suggestion avoids patent, 7, 125.

FEES,
determination of patent for non-payment of, 357.
extension of time for payment, *ib.*
rules relating to payment of, 389, 407.
scale of, 396, 397.
forms relating to, 402.

FOREIGN,
patents should be stated in petition for prolongation, 155.
country, protection of patent in, 213.
ship, use of patented invention by, 187, 364.

FRAUD,
no amendment allowed in case of, 113.
no estoppel in case of, 137.
entry in register by, 144.
particulars of, 237.
must be accurately stated, *ib.*
application in fraud of true inventor, 16, 362.

GRANT,
of letters patent, 123.
of letters patent for one invention only, 123, 124.
royal prerogative saved in, 128.
distinction between patent and trade mark, 128.
creates property in invention, 128.
form of prohibition in, 130.
conditions of, 130.
novelty of invention, 131.
rights of crown limited in, 132.
construction of, beneficial, 133.

IGNORANCE of patent, no excuse for infringement, 169.

IMITATION,
colourable, 178.
of invention forbidden, 130, 178 *et seq.*

IMMORAL subject, refusal of patent for, 127, 366.

IMPORTATION,
mere, no infringement, 189.
of invention sufficient to support grant, 7.
as an invention, 19.

IMPORTED INVENTION, 17.
patent for, at common law, 18.
statutory provisions as to, *ib.*
merit of, 149.

IMPORTER,
has the merit of invention, 20.
but less than true inventor, 21, 149.

IMPROVEMENT,
of manufacture, 25.
by new process, *ib.*
by alteration of known machine, 27.
by new application of old invention, 28.
by new combination, 33.
on existing patent, 28.

INDORSEMENT on writ, 215. See "*Writ*," "*Infringement.*"

INFANT may obtain patent, 6.

INFRINGEMENT,
action for, 163, 215.
statement of claim in, 221.
form of, 294.
particulars of breaches in, 222 *et seq.* See *Particulars.*
form of particulars, 294.
further and better particulars. See *Particulars.*
form of order for, 295.
statement of defence in, 227, 296.
particulars of objections, 228. See *Particulars.*
form of, 296.
parties to, 163.
as plaintiffs, *ib.*, 216.
grantee or assignee, 163, 216.
of a portion or for a district, 163, 216.
joint owners, 164, 216.
trustee in bankruptcy, 165.
executors and administrators, *ib.*
licensee cannot maintain, 165, 216.
where agent for sale cannot maintain, 217.
as defendants, 165.
person physically using, *ib.*, 217.
person threatening to infringe, 217.
contractors, 165, 217.
servants and agents, 165.
directors, 166—217.
architect, 166, 217.
alien infringing in United Kingdom, 165

INFRINGEMENT—*continued.*
definition of, 167.
prohibited by royal command, *ib.*
a question for jury, *ib.*
of invalid patent, no, 168.
ignorance of patent immaterial, 168, 169.
what amounts to, 170, 203.
where patent locally assigned, 170.
of part of invention, 170.
by alteration or subtraction, 174.
of patent for combination, 172.
by other combination of same parts, 173.
of substance of invention, 174, 176, 177.
by colourable imitation, 175.
by application for a different object, 175, 177.
other combination of same materials, 177.
the essence of the invention, 179.
chemical and mechanical equivalents, 179.
colourable imitation, 178.
by evasion, 177.
sale of elements of combination, no, 183.
experiments, no, *ib.*
by crown and its servants, and contractors, 132, 184.
by using, definition of, 185
what amounts to use in action for, 185, 186.
mere possession, no, 187, 189.
by foreign or British ships, 187, 188, 200.
constructive, will not support action, 189.
by selling, definition of, 189.
mere purchases, exposure for sale, or importation, no, 189.
actual sale, an, 190.
sale of patented article made abroad, an, 190.
re-sale of article sold by patentee, no, 191
neglect to restrain, reason for not granting extension, 156.
injunction, remedy by, 193. See *Injunction.*
damages for, 203. See *Damages*
damages, indorsement account, 215.
account of sales and profits. See *Account*, 215.
by tacit permission, 206.
defences to action for, 226 *et seq.*
costs of abandoned defences, 227.
defendant's particulars of objections, 228. See *Particulars.*
form of, 296.
trial of action for, 251 *et seq.* See *Trial.*

INJUNCTION.
remedy for infringement by, 193.
interlocutory or perpetual, *ib.*
perpetual, when granted, 194—195.
interlocutory, when granted, 195, 219.
sometimes *ex parte*, 218.
granted or refused on terms, 196, 220.
refused where patentee not proceeded with reasonable speed, 201.
primâ facie case of validity, 219.
requisites of affidavits in support, 220.
in action to restrain threats, 285.
notice of motion for, form, 289.
affidavit in support of notice, *ib.*
forms of interlocutory injunction, 290.
ditto, 291.
order refusing form of, *ib.*

INJUNCTION—*continued.*
in cases of possession under colour of title, 194.
threatening to infringe patent, 198.
revoking a threat to infringe, 199.
suspended pending appeal, 281
in action to restrain threats, 282 *et seq.* See *Threats.*
against threats of action for infringement, 282.
alleged infringement to be strictly proved, 196.
evidence of intention to infringe will support, 193.
must be no delay in moving for, 201.
falls with expiry of patent, 202.
but not as to previously made articles, *ib.*
mandatory, when granted, 203, 215.
dissolved if claim disagree with affidavits, 220.
affidavits on motion for. See *Affidavits*, 220.
form of notice of motion for interlocutory, 289.
of affidavit in support, *ib.*
of refusal on terms, 291.

INSPECTION,
power of Court to grant, 246, 362.
object of Court in granting, 247.
strong *primâ facie* necessary for, *ib.*
granted if essential, 248.
samples may be ordered for, 249.
mutual, when ordered, *ib.*
application for, on motion or by summons, *ib.*, 250.
form of notice of motion for, 291.
affidavit in support of, requirements of, 293, note.
of inspection of process, and to take samples, 292.
of order for inspection of process by experts, 293.
by defendants, 292.
and for delivery of samples, 293.
on acceptance of complete specification, 386.
of register, 143.
at what hours, 392.

INTELLIGIBILITY. See *Specification.*
of specification, 74.
to skilled person, 80.

INTENTION of party infringing immaterial, 169.

INTERLOCUTORY INJUNCTION. See *Injunction.*

INTERNATIONAL arrangements as to patents, 213, 370.

INTERROGATORIES,
may be administered, 239.
must be relevant, *ib.*
how far defendant must disclose secret process in, 240.
some evidence of infringement necessary for delivery of, 241.
differ from particulars, *ib.*
fishing disallowed, 242.
must be answered fully, *ib.*
when permitted after trial, 243.
by plaintiff and defendant differ, 243, 244.
costs of, 245.
form of, 299.

INTRODUCER, first, 19.

INVALID, patent, no infringement of, 168.

INVENTION,
defined by Act, 3.
what is an, 9.
when already public property, 15.
a new and useful, 22.
of new article, *ib.*
of new process, *ib.*
novelty of, 34.
a question of fact, 30.
secret prior user of an, 40.
public prior user of an, *ib. et seq.*
experiment, whether, 38.
prior publication of an, 41.
the whole must be new, 51.
utility of, 52.
distinct statement of, necessary, 101.
must not be enlarged by amendment of specification, 112.
property in, created by grant, 128.
infringement of part of, 172, 177.
of substance of, 174. See *Infringement.*
importance of, how estimated, 140.

INVENTOR,
definition of term, 10.
employment of workman to carry out ideas, 11.
importer of invention, 19.

IRELAND, proceedings in, 372.

ISLE OF MAN, 373.

JOINT APPLICANTS for patent, 5, 353.

JOINT OWNERS,
one of, may sue, 164.
partition between, precedent for, 327.

JOURNAL,
official advertisements, 389. See *Advertisement.*
illustrated, of inventions, 363.
copies to be on sale, *ib.*
abridgments of specifications to be published, *ib.*

JUDGMENT,
final, for plaintiff, forms of order of, 301—305.
for defendant, 305.

JURY,
questions for, 264 *et seq.*
infringement, 167.
intelligibility of specification, 266.
sufficiency of, *ib.*
novelty, 39, 267.
utility, 52, 267.
grounds of application for, 253.

KNOWN,
material, application of, to new purpose, 28.
instrument to ditto, *ib.*, 30, 31.

LAW OFFICER,
proceedings before, 103, 121, 363. See *Amendment, Opposition.*
rules and canon relating to practice before, 394, 395.

LEGAL personal representative, grant of patent to, 8. See *Executors.*

LETTERS PATENT,
origin and history of, 1.
persons entitled to apply for, 5, 353.
joint applicants for, 5, 353.
form of application, &c., 5, 56, 353.
declaration, 5, 56, 353, 378.
provisional specification, requirements of, 57, 64, 354. See *Specification.*
complete specification, requirements of, 57, 69 *et seq.*, 94, 354.
duties of examiner and comptroller on application for, 57, 102, 354, 381.
when deemed abandoned, 355, 378.
comptroller may refuse until specification amended, 58, 355.
granted for one invention only, 124.
subject to appeal to law officer, 58, 102, 355.
void unless complete specification accepted within twelve months, 355.
opposition to, 116, 120, 121, 355, 356.
sealing of, 121, 123, 356.
provisional protection, 17, 356.
protection by complete specification, 69, 356.
extent of, 123, 357.
term of, 357.
fees payable to maintain, 357.
compulsory licences, 358.
register of, 359.
extension of term of, 359.
revocation of, 114, 116, 208, 253, 277, 360.
rights of crown, 128, 132, 185, 361.
for one invention only, 164, 362.
loss or destruction of, 363.
illustrated journal of, *ib.*
museum, *ib.*
rights of secretary of war, 364.
form of, 375.

LICENCE,
to use patent, should be under seal, 135.
how far valid if not, *ib.*, 136.
is not a deed, 138.
a verbal, 139.
exclusive licensee may sue, 216.
differs from assignment, 140.
compulsory, *ib.*, 141, 358.
rules relating to, 390.
by whom granted, 141.
must be registered, 143.
not assignable, 142.
measure of damages after grant of, 205.
an exclusive, 165, 347.

LICENCE—*continued.*
entry of, on register of patents, 143, 359.
forms of application for compulsory grant of, 400.
of opposition thereto, 401.
of request to enter notification of licence on register, 403.
precedent for non-exclusive, 344.
exclusive, 347.

LICENSEE,
profits of, when considered, on question of extension, 153.
whether extension granted to, query, 159.
action for infringement not maintainable by ordinary, 165, 210.
exclusive, may use patentee's name in action, *ib.*
not exclusive user of patent in more, *ib.*
security for costs by exclusive, *ib.*

LOST patent, how supplied, 363.

MAKING,
infringement by, 182.
secret, by inventor before patent, 49.

MALA FIDES in specification, 88. See *Specification.*

MANDATORY orders only granted after trial, 203.

MANUFACTURE,
what is a new, 22, 34.
a new article, 22.
a new process, *ib.*
a principle not a, *ib.*
construction of term a question of law, 38.

MANUFACTURER,
distinguished from inventor, 9.
profits of, distinguished from patentee's, 152.
when considered in action for infringement, 203.

MARRIED women may obtain patent, 6.

MASTER liable for infringement by servant, 165.

MERIT,
not necessary in importer, 20.
part of consideration, 53.

MISREPRESENTATION,
in specification fatal, 88.
particulars of, 230.

MISTAKE,
in specification, 102.
by including several inventions, 386. See *Amendment.*

MONOPOLIES, STATUTE OF, 2.
provisions of, 3.

MOTION for inspection, 249.

MUSEUM, PATENT, 393.
models to be supplied to, 394.

NON-USER,
of patent, 150.
ground for refusing extension, *ib.*

NOVELTY,
a question of fact, 39.
everything claimed must be new, 51.
claiming what is old vitiates patent, 52.
want of, vitiates patent, 126. See *Letters Patent*, *Invention*, *Subject-matter*, *Manufacture*.

OBJECTIONS, particulars of. See *Particulars*.

OFFENCES,
falsely representing article to be patented, 371.
unauthorised use of royal arms, 372.

OFFICIAL journal, advertisement. See *Advertisement*.

OLD. See *Known*.

OPPOSITION,
to grant of patent, 116, 355, 384.
rules relating to, 387.
grounds of, now available, *ib.*
available prior to act, *ib.*
where applicant has obtained invention from opponent, 117
in cases of doubt patent should be sealed, *ib.*
where both parties contributed to the invention, *ib.*
cases of workman and master, 118.
on ground of previous patent, *ib.*
costs of opposition before law officer to follow event, 120.
opposition to amendment of specification, 357.
notice of, by Comptroller, 120, 356.
who is entitled to be heard, 121, 122, 356.
patent sealed in absence of, 121.
to amendment of specification, *ib.*
notice of, 387.
form of, to grant of patent, 399.
of opposition to grant of compulsory licence, 400.

PART OF INVENTION. See *Subordinate Integer* and *Combination*.
infringement of, 174, 176 *et seq.*
when old, 43, 44.

PARTICULARS,
of breaches, 222, 361.
must disclose case to be made, *ib.*
instances of sufficient and insufficient particulars, 223 *et seq.*
must state what part of invention has been infringed, 224, 295, n.
ordinary jurisdiction of Court as to, 225.
particulars postponed to discovery, *ib.*
form of order for further and better, 295.
of objections,
provisions of statute, 228, 361.
rules of Court, 229.
where several defendants, *ib.*
distinguished from particulars of breaches, *ib.*
prior user, time, place and persons, 230.
prior publication, 235.
present addresses, *ib.*
evidence admitted of particulars sufficiently wide, 233.
instances of sufficient and insufficient particulars, 233 *et seq.*
pages of publication to be given, 236.
amendment of particulars (terms on which allowed), 234, 361.
when grantee not true inventor, 236.
in cases of fraud, 237.
in cases of non-conformity in specifications, 237, 238.
form of, 296.
form of order for further particulars, 298.
liberty to amend particulars, *ib.*

PARTIES to action for infringement. See *Infringement.*

PARTNERS,
estoppel of retiring, 140.
plea of invalidity, when allowed, *ib.*

PATENT,
letters, to and by whom granted, 1, 6. See *Letters Patent.*
conditions of grant, 3.
form of application for, 5.
what it must disclose, *ib.*
whether granted to an importer doubtful, voided by false suggestion, 8.
grant to joint applicants, *ib.*
or to legal personal representative, *ib.*
consideration for grant of, 8. See *Consideration.*
determines on non-payment of fees, 357.
office, 366.

PATENTEE,
construction of, 5.
alien may be, *ib.*

PENALTIES. See *Offences.*

PERPETUAL injunction. See *Injunction.*

PETITION,
to Court substituted for *scire facias*, 208.
to extend term of patent, 145. See *Extension.*
by whom presented, 209 *et seq.*
for revocation, by whom presented, 277. See *Revocation.*
form, 288.

PETITIONER,
for extension, 145, 359.
may give evidence of profits, 152.

PHYSICAL user of invention, 165. See *Infringement.*

PORTION,
action by assignee of, 163.

POSSESSION, mere, no infringement, 189.

POST, documents may be sent by, 368.

POSTPONEMENT of trial, 253.

PRACTICE. See *sub titulis Infringement; Injunction; Trial, &c.*

PRECEDENTS for transfer of interests in patents,
sale to a company, 322—323.
agreement to obtain and assign, 324—327.
between co-owners for partition, 327.
for working and selling invention, &c., 329—334.
assignment of a patent, 334—344.
non-exclusive licence, 344—347.
exclusive licence for a district, 347—349.
mortgage of a patent, 349—352.

PREJUDICIAL concealment by patentee, 92.

PREROGATIVE. See *Crown.*

PRESUMPTION in favour of patent with fair disclosure, 72.

PRINCIPLE,
no invention can be claimed in a, 23.
discovery of a principle with the method of applying, 78, 93.

PRIOR PUBLICATION. See *Publication.*

PRIOR USER. See *Infringement; Particulars; Letters Patent.*
must be public user, 37.
secret use does not amount to, *ib.*
no longer ground of opposition, 116.
confirmation of patent notwithstanding, 162.
what amount of, invalidates patent, 169 *et seq.*
objection on ground of, 231.
evidence of, not disclosed in particulars of objection, 233.

PRIVY COUNCIL. See *Extension.*
power of, to avoid grant, 131.
application for extension to, 145, 359.
will not inquire into novelty, 150. See *Extension.*
may sit with assessors, 361.
rules of, 415.

PROCESS. See *Subject-matter.*
distinction between process and new substance, 23.
infringement of patent for, 176.
selling article made abroad by patented, 190.
subject-matter of patent, 24.

PROFITS. See *Invention.*
of patentee and manufacturer, 152.
how estimated, *ib.*
by licences must be added, 153.

PROLONGATION of patent. See *Extension.*

PROPERTY, right of, in infringing articles, 202.

PROTECTION,
by complete specification, 356.
provisional, 17, 356.

PROVISIONAL
protection, 16.
provisions of Act as to, 17, 356.
specification, 59, 64, 354. See *Specification.*

PUBLIC use, what amounts to, 37—39.
experiment does not, 38.

PUBLICATION,
prior, 41.
in a speculative specification, 43.
to anticipate patent must be sufficient, 45.
in specification, book or newspaper, 44.
book need not be sold, if exhibited for sale or open to inspection, 46.
British Museum Library, *ib.*
Patent Office Library, *ib.*
objections on ground of prior, 235.

PURCHASE, mere, of patented article no infringement, 189.

REBUTTING evidence by plaintiff, 260.

RECITALS,
must be four in number, 125.
false suggestion in, *ib.*

REFERENCE, *form* of order for, 299.

REGISTER,
of patent agents, 380.
of patents, 20, 143, 359, 367, 391.
inspection of, 367.
rectification of by Court, 143, 367, 373.
clerical error in, 367.
primâ facie evidence of matters therein, 359, *ib.*
no notice of trust receivable on, *ib.*
inspection of, 359.

REGISTER—*continued*.
comptroller may correct errors of, 144, 367.
fraudulent entry on, 144.
entries of grant on, 359.
orders affecting patents, to be entered, *ib.*
copies of necessary documents to be supplied to comptroller, *ib.*
former registers to be deemed continued, 373.
forms of application relating to, 403.

RENEWAL of English after expiry of foreign patent, 151.

REPEAL of statutes, 376.

REPRESENTATIVE case, *form* of order for trial of, 300.

RESTRAINT of trade, covenant not to manufacture without patented invention not in, 142.

REVOCATION,
scire facias abolished, 114, 116, 208, 253, 277, 360.
on petition to Court, 114, 210, 360.
who may petition, 208, 360.
provisions of the Act of 1883, 208, 209, 360.
grounds for revocation, 209.
practice on petition for, 277.
parties, *ib.*
particulars of objections, *ib.* See *Particulars*, 360.
amendment of, 278, 360.
right to begin and reply at trial, 279.
where patent revoked on the ground of fraud, patent to true inventor, 360.

RIVAL applicants, 16.

RULES, 383 *et seq.*
under 5 & 6 Will. 4, c. 83...415 *et seq.*

SALE,
infringement by, 189. See *Infringement*.
by patentee carries right of free disposition, 191.

SAMPLES,
of infringing article, when ordered to be delivered, 249.
form of notice of motion to take, 291.
of order for delivery of, 292.

SCIRE FACIAS, proceedings by, abolished, 114, 116, 202, 253, 277, 360.

SCOTLAND, proceedings in, 372.

SEAL,
when affixed to patent, 121, 356.
of Patent Office, 123, 366.

SECRET,
use of invention prior to patenting, 40, 50.
of trade, 120.
no means of enforcing agreement to keep a trade, *ib.*
if subject of intended patent, *secus*, *ib.*
use, anticipation by, 40.

SERVANT, infringing, 165.

SHIPS,
use of invention by foreign, 187, 364.
by British, abroad, 187.

SPECIFIC performance of agreement to assign, 140.

SPECIFICATION,
provisions of Act of 1883, as to, 56 *et seq.*, 354.
rules relating to, 386.
title of, 60, 354.
requisites for, *ib.*
claims limited by title, *ib.*
must not be too general, *ib.*
must correspond with invention, 61.
must be consistent with invention, 63.
vagueness fatal, *ib.*
specification must not be at variance with, *ib.*
Provisional, 64.
not now published, 48.
must describe nature of invention, 64, 354.
and agree with complete, 65, 354, 378.
must identify invention, 66, 364.
distinguished from final, 67, 354.
must conform with provisional, 58, 102, 104, 354, 378.
rule laid down in *Siddell* v. *Vickers*, 69.
form of, 411.
Complete,
what it is, 69.
must be sufficient, 70, 86, 88.
degree of sufficiency, 87.
must be precise, 71.
should make fair disclosure, 72.
must be intelligible and sufficient, 73, 74.
construction of, 74 *et seq.*
benignant construction, 75.
"as herein described," 77, 78.
to whom intelligible, 80, 81.
will be fairly construed, *ib.*, 228.
use of general words in claim of, 79.
must distinguish new from old, *ib.*
must be intelligible, 80.
to whom intelligible, 81, 86.
concealment in, 88.
misleading, *ib.*
in case of, of communication from abroad, 91.
drawings in, how used, 80.
error curable in, 85.
sufficiency, a question for jury, 73, 266.

SPECIFICATION—*continued.*
Complete—continued.
what constitutes sufficiency, 88—92.
intelligibility, novelty, and utility, 264 *et seq.*
degrees of sufficiency required, 91—92.
suppression or false suggestion fatal in, 88—92.
must be read in relation to existing knowledge, 89.
general rule as to sufficiency, 89.
unnecessary and misleading details fatal, 94.
must contain a distinct claim, 94.
and not too large, 95.
distinction between describing too much and claiming too much, 95,
disclaimer of what is old, 96, 97.
Sect. 5 of Patents Act, 1883, directory (*Siddell* v. *Vickers*), 96.
improvements in old processes must be so claimed, 96.
combination of old parts, ditto, 98.
examples of, 307- -321.
amendment of. See *Amendment.*
extension of time for accepting, 407, 412.
form of, 411.

STATEMENT
of claim, 221.
form of, 294.
of defence, 226. See *Infringement, action for.*

STATUTE,
of Monopolies, its origin, 2.
declares common law, *ib.*
creates no right, 3.
of 1883, 353 *et seq.*
of 1885, 378.
of 1886, 379.
of 1888, 380.

SUBJECT-MATTER. See *Infringement, Letters Patent, Invention, &c., &c., &c.*
of patent must not be illegal or immoral, 127.
process may be, 24 *et seq.*
principle, when may be, 23, 25.
combination, 33, 98.
subordinate combination, 172, 177.
subordinate integer, infringement of, when, 172, 177.
combination, ditto, *ib. et seq.*

SUBSTANCE,
new, subject-matter of patent, 23.
of invention, infringement of, 174 *et seq.*

SUBTRACTION from known machine, 27.

SUFFICIENCY,
of specification, 73.
question for jury, 74.
what is, 87.

SUGGESTIONS,
by one person to another, 11.
in book or publication, 43.
in recitals must not be false, 125 *et seq.*

SUPPRESSION of information by patentee, 88.

TAXATION of costs. See *Costs.*

THREATS,
action for injunction to restrain, 282 *et seq.*
statutory provisions, 282, 362.
old practice, 283.
validity of patent can be questioned in action for, 283.
"by circulars, advertisements or otherwise," *meaning of, ib.*
provisions as to particulars do not apply to this action, 284.
must be brought with due diligence, 285.
interlocutory injunction, when granted, *ib.*
damages in, *ib.*

TITLE of specification, 60 *et seq.* See *Specification.*

TRIAL,
of action for infringement, 251, 277, 278, 361.
constitution of Court, *ib.*, 252.
when by jury, 253.
postponing, *ib.*
right of opening and replying at, 254.
issues on plaintiff at, 255, 257, 258.
expert witnesses, 256.
primâ facie evidence by plaintiff, 259.
when plaintiff may produce rebutting evidence, 260, 261.
defendant cannot produce further evidence, 261.
no objection to particulars allowed at, *ib.*
no evidence admitted not raised by pleadings, 263.

TRUST,
not receivable on register, 20, 143.
particulars of breach of, 229.

TRUSTEE in bankruptcy may sue, 165. See *Practice; Parties.*

UNDUE INFLUENCE, particulars of, 229.

USE,
what constitutes infringement by, 185 *et seq.* See *Infringement.*
objection on ground of prior, 229 *et seq.*

UTILITY,
of invention, 53.
substantial improvement constitutes, *ib.*
not necessary in every part, 54,
Privy Council will not inquire into, 149. See *Extension.*
presumption by non-user against, *ib.*

VERBAL licence by patentee, 139, 142.

War, patents for munitions of, 364.

Workman,
assisting master, 10, 13.
invention by, 10.
in cases of opposition, 118.

Writ,
form of indorsement on, 287.
in action for infringement, 215.
to restrain threatened infringement, *ib.* See *Infringement Action.*
no action to restrain threats, *form* of, 287.

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