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THE LAW AND PRACTICE RELATING TO
LETTERS PATENT FOR
INVENTIONS.

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THE
LAW AND PRACTICE
RELATING TO
LETTERS PATENT FOR INVENTIONS.

TOGETHER WITH NOTICES OF THE PATENT LAWS IN
FORCE IN THE PRINCIPAL FOREIGN STATES
AND IN THE COLONIES.

WITH AN APPENDIX CONTAINING THE STATUTES,
RULES, ETC.

BY ^{Y^{er}} WILLIAM FISCHER AGNEW,
OF LINCOLN'S INN, BARRISTER-AT-LAW.

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3 & 4 Will. IV. c. 41	182	— s. 9	150, 154
5 & 6 Will. IV. c. 83, s. 1		— s. 10	154, 162
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THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

OF THE GRANT OF LETTERS PATENT.

THE right to grant monopolies to inventors of new manufactures has always been considered as part of the prerogative of the Crown. Sir Edward Coke defines monopolies as follows: "A monopoly is an institution or allowance by the king; by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of any thing whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade."^(a)

CHAP. I.

Monopoly.

The grant is by "letters patent," that is, open letters, *litteræ patentæ*: so called because they are not sealed up but exposed to open view, with the great seal pendent at the bottom; and are usually directed or addressed by the sovereign to all her subjects at large, in this respect differing from other letters of the sovereign which are closed up and sealed on the outside, and are therefore called writs *close*, *litteræ clausæ*.^(b)

(a) 3 Inst. 181.

(b) 2 Bl. Com. 349 (Kerr).

CHAP. I.

Before the statute of monopolies (21 Jac. I. c. 3) was passed, it was decided that a monopoly might be granted to any person who "by his own charge and industry or by his own wit or invention doth bring any new trade into the realm," (a) and in the *Oloth-workers of Ipswich case*, (b) it was said that "if a man hath brought in a new invention and a new trade within the kingdom in peril of his life and consumption of his estate or stock, or if a man hath made a new discovery of anything, in such cases the king of his grace and favour, in recompence 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."

Term of patents.

These principles were followed in the statute, which, after declaring monopolies to be void, enacts 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 manufacture, within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so that they be not contrary to law or mischievous to trade, by raising the prices of commodities at home or hurt of trade or generally inconvenient." This statute does not introduce a new law, but is simply declaratory of the common law and simply exempts patents which were good at common law from the penalty which the statute

(a) *Darcy v. Allin*, Noy. 182; Shepp. Abr. part III. tit. Prerog. p. 61.

(b) Godb. 254.

imposes upon such patents as were thereby prohibited. (a)

The object of granting patents is that the person, who has benefited the public by bringing some new and useful manufacture into the country, may be rewarded for his ingenuity and trouble, and for the expense to which he has been put.

Object of
granting
patents.

A patent is not a grant of a monopoly in the sense of the old definition, but is a grant by the Crown to an inventor, of the right of practising a new and useful invention for a limited time. The patentee may be looked upon as a purchaser from the public; for an inventor has not an exclusive property in an invention, he has only the right to exercise his own invention freely for a limited period; and the consideration for which this grant is made, is the benefit to the public resulting from the invention by the use of it; first, under the patent, and secondly, after the term has expired. On the other hand the patentee is not obliged to make his invention known, he may keep it a secret; it is therefore only reasonable that if he makes it known he should receive some compensation from the public, who are to have the ultimate benefit of the invention.

The mode of securing such compensation to the patentee, adopted in this and in almost every other country, namely, of granting to him the sole right of using his invention for a limited time, seems to be the best that can be devised. In certain cases where the merit of the invention has been very great, or where the inventor could not be rewarded in any other way, grants of public money have been made, but it is evident that this course could not be adopted in every case, not only from

(a) 3 Co. Inst. c. 85, pp. 181—184.

CHAP. I.

the expenditure of money that would be required, but also from the impossibility of ascertaining what the proper remuneration should be; whereas by granting a monopoly, the gain made by the inventor when his invention is known will be proportionate to the amount of benefit which the public derive from the use of it.

Utility.

There must be a certain amount of utility in the invention, otherwise a patent will not be granted (see *post*, Ch. III.) (a)

(a) See as to the history of letters patent for inventions, Hindmarch on Patents; Webster on

the Law of Patents; Curtis on Patents (America).

CHAPTER II.

OF THE PERSONS TO WHOM LETTERS PATENT MAY BE GRANTED.

THE Statute of Monopolies (21 Jac. I. c. 3) provides that letters patent may be granted to the "true and first inventor." If the invention, for which a patent has been taken out, is borrowed from a previous specification, (a) or has been communicated by other persons in the kingdom, (b) or has been previously described in a book published in the kingdom, (c) even if it has not been reduced into practice, (d) and is in fact practically a new discovery to the world, (e) or if there has been any public user of a similar invention, (f) the patentee cannot be the "true and first inventor." (g)

CHAP. II.
True and first
inventor.

In order that a patent may be valid the subject matter
Invention
must be that

(a) *Walton v. Potter*, 1 Webs. P. R. 592; *Lewis v. Marling*, 4 C. & P. 52; 10 B. & C. 27; 1 Webs. P. R. 495.

Foster, 2 Webs. P. R. 102; *Jones v. Pearce*, 1 Webs. P. R. 122.

(d) *Walton v. Potter*, 1 Webs. P. R. 592.

(b) *Cornish v. Keene*, 1 Webs. P. R. 507; *Tennant's Case*, Dav. P. C. 29; 1 Webs. P. R. 125, n.

(e) *Cornish v. Keene*, 1 Webs. P. R. 507; *Muntz v. Foster*, 2 Webs. P. R. 102.

(c) *Walton v. Potter*, 1 Webs. P. R. 592; *Cornish v. Keene*, 1 Webs. P. R. 507; *Muntz v.*

(f) *Carpenter v. Smith*, 9 M. & W. 300; 1 Webs. P. R. 543.

(g) See also *post*, Ch. III., publication and user.

CHAP. II.

of patentee
himself.

must have been invented by the patentee himself, (a) and he must have invented every part of what he claims to have invented. (b) In *Losh v. Hague*, (c) Lord Abinger, C. B., said: "If a man claims by his patent a number of things, as being the inventor of them, whether they consist of improvements or original inventions, and it turns out that some of them be not original and not improvements, his patent is void."

If not, the
Crown is de-
ceived

If it can be shown that the patentee is not the inventor of the patented article, the crown is deceived in the suggestion on which the patent is granted, and the patent is therefore void. (d)

and the in-
terests of the
public affected.

It is against the interests of the public also that they should be prevented from using the invention. The object of the grant is to reward the inventor for the future benefit to be received by the public, and this reason cannot apply to a person who has not invented the machine, for the public are already entitled to use it.

"A patent," said Lord Ellenborough, "is a species of property highly important, as it respects the interests of the individual, and with him also the interests of the public; on the one hand, persons who are really the means of promoting any beneficial object should be protected for the period the law allows, and should have the benefit of the article so invented; and on the other hand, in case they are not the inventors they should not lock up from the public for that limited period of

(a) *R. v. Arkwright*, Dav. P. C. 68; *R. v. Wheeler*, 2 B. & Ald. 349; *Jones v. Pearce*, 1 Webs. P. R. 124.

(b) *Tennant's Case*, 1 Webs. P. R. 125, n.

(c) 1 Webs. P. R. 208.

(d) *Minter v. Wells*, 1 Webs. P. R. 129; *R. v. Wheeler*, 2 B. & Ald. 349.

time that invention, which, if they are not the inventors, they have no priority to, and which ought to be open to the public." (a)

If several persons simultaneously discover the same thing, the one who first communicates it to the public under the protection of a patent becomes the legal inventor, and is entitled to the benefit of it. (b) If a servant while in the employment of his master invents a machine, the invention belongs to him and not to the master. (c) But if an inventor employs mechanics to work out the details of his invention and to carry his idea into execution, any thing suggested or invented by any person so employed and subsidiary to such idea is the invention of the patentee. (d) In *Minter v. Wells*, (e) it was suggested that the invention was that of a mechanic named Sutton. Alderson, B., said: "Minter and Sutton were together about the time the invention took place; which of the two suggested the invention and which carried it into effect is a question for you to decide. If Sutton suggested the principle to Mr. Minter, then he would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. Minter used for the purpose of enabling him to carry his original conception into effect." (f)

Simultaneous discoverers, first patentee is inventor.

Invention by servant.

Patentee may have assistance.

(a) *Huddart v. Grimshaw*, 1 Webs. P. R. 86; Dav. P. C. 265.

(b) *Forsyth v. Rivière*, 1 Webs. P. R. 97; *Cornish v. Keene*, 1 Webs. P. R. 508.

(c) *Bloxam v. Elsee*, 1 C. & P. 558; 6 B. & C. 169; *R. v. Ark-*

wright, Dav. P. C. 61; 1 Webs. P. R. 64.

(d) *Barker v. Shaw*, 1 Webs. P. R. 126; *Barber v. Walduck*, 1 C. & P. 567.

(e) 1 Webs. P. R. 129.

(f) And see *Bloxam v. Elsee*, 1 C. & P. 558; 6 B. & C. 169.

The rule appears to be that where the principle and object of the invention are complete without the suggestions of the servant, and his suggestions merely carry out the intention of the inventor more easily, the validity of the patent will not be affected. "It would be difficult," said Sir N. C. Tindal, C. J., "to define how far the suggestions of a workman are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and the object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." (a) See as to the terms on which letters patent were granted, in the case of dispute between master and servant, *Re Russell's Patent*. (b)

Importer of an invention is true and first inventor.

The importer of an invention which has never before been used in this country has from a very early period been considered to be an inventor and entitled to letters patent. (c)

Invention must be new in England.

The earliest case reported on this point since the statute of monopolies (21 Jac. I. c. 3) is the case of *Edgeberry v. Stephens*, (d) where it was held that "if the invention be new in England a patent may be granted, though the thing was practised beyond the sea before ;

(a) *Allen v. Rawson*, 1 C. B. 575; *Hatton v. Kean*, 7 C. B. (N. S.) 275.

(b) 2 D. G. & J. 130; noted *post* under the head of sealing, tit. "Terms."

(c) *Darcy v. Allin*, Noy. 182; Sheph. Abr. part. III. tit. Prerog. p. 5; *Clothworkers of Ipswich Case*, Godb. 254.

(d) 2 Salk. 447; 1 Webs. P. R. 35.

for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute; for the act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing." (a)

In *Walton v. Bateman*, (b) Cresswell, J., said: "The party obtaining the patent must be the true and first inventor in this country. If he import from a foreign country that 'which others at the time of the making of such letters patent and grants did not use,' it will suffice." (c)

If a patent is taken out as for an original invention when it is in fact communicated from abroad by a British subject it is void. (d)

If an invention has been known in Scotland, a person importing it into England cannot be considered the first and true inventor. (e)

When a patent was taken out in this country by a British subject and held by him as trustee for the inventor, a foreigner, it was contended, that in order to come within the statute the person taking out the patent in this country should be the meritorious importer, and not merely servant or agent for the purpose of taking out the patent for the benefit of the foreign inventor. Sir N. C. Tindal said: "No authority is cited for such dis-

Patent may be taken out by trustee for foreign inventor.

(a) See also *Boulton v. Bull*, 2 H. Bl. 491.

(b) 1 Webs. P. R. 615.

(c) And see *Carpenter v. Smith*, 1 Webs. P. R. 535; *Stead v. Anderson*, 2 Webs. P. R. 149; *Crane v. Price*, 4 M. & Gr. 580; 5 Scott, N. R. 338; 1 Webs.

P. R. 411; *Nickels v. Ross*, 8 C. B. 723.

(d) *Milligan v. Marsh*, 2 Jur. (N. S.) 1083.

(e) *Brown v. Annandale*, 8 C. & F. 437; *Robinson's Patent*, 5 Moo. P. C. C. 65; *S. C. nom. Pow's Patent*, 2 Webs. P. R. 2.

10 TO WHOM LETTERS PATENT MAY BE GRANTED.

CHAP. II.

inction, and so far as the public are concerned in interest no such distinction is necessary." It was also contended that the patent was invalid, as being taken out in trust for aliens residing abroad, and this objection was also overruled. (a)

Alien enemy.

In another case the point was raised whether a patent could be taken out in trust for an alien enemy, but was not decided. (b)

Foreign inventor parted with interest abroad.

If the original inventor abroad has parted with his discovery abroad, he may nevertheless take out a patent here, as his right to an English patent is not affected by the foreign transaction. (c)

Communication from abroad, not confidential, entitles recipient to patent.

Any person receiving a communication from abroad may take out a patent if the communication is not confidential. "I apprehend," said Sir W. P. Wood, V.C., "that any person not being in a confidential position towards the first inventor, receiving from a person abroad an invention, is entitled, perhaps not in a strictly moral view, but at all events according to law, to take out a patent on his own account for an invention so communicated." (d)

And he may improve on a confidential communication.

And it appears that a person who receives a confidential communication from abroad which is useless in itself and incapable of application may take out a patent for his own benefit, if the effect of the communication is to set him thinking, and leads to a discovery of a practical mode of carrying out the idea. (e)

(a) *Beard v. Egerton*, 3 C. B. 129.

(b) *Bloxam v. Elsee*, 1 C. & P. 558; 6 B. & C. 169; and see *Beard v. Egerton*, 3 C. B. 129.

(c) *Beard v. Egerton*, 3 C. B. 131.

(d) *Steedman v. Marsh*, 2 Jur. (N. S.) 392.

(e) *Milligan v. Marsh*, 2 Jur. (N. S.) 1083.

CHAPTER III.

OF THE SUBJECT MATTER OF LETTERS PATENT.

THE sixth section of the Statute of Monopolies (21 Jac. I. c. 3) provides "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 such letters patent and grants shall not use, so as they be not contrary to the law nor mischievous to the State by raising prices of commodities at home, or hurt of trade or generally inconvenient."

CHAP. III.

Novelty.

In *Liardet v. Johnson*, (a) Lord Mansfield said that it was always a question whether the invention was publicly known and in use before the patent was taken out. It will be convenient to consider first, what amount of publication and user will invalidate a patent: secondly what constitutes a "new manufacture" within the meaning of the statute, and thirdly whether the invention is useful, which is a condition imposed by the common law and not by the statute.

If the invention has been previously described in a Publication in a book, which

(a) Bull (N. P.) 76; 1 Webs. P. R. 53.

CHAP. III.

has been circulated, invalidates subsequent patent.

book published in this country, the patent will be void. In *R. v. Arkwright*, (a) Buller, J., said: "It is admitted that this is not a new discovery, for Emmerson's book was produced, which was printed a third time in 1773, and that is precisely the same as this;" and in the course of the argument of *Morgan v. Seaward*, (b) Alderson, B., referring to the case of Dollond's patent cited in *Boulton v. Bull*, (c) said: "If Dr. Hall had published his discoveries in a book, I apprehend that would have put an end to Dollond's patent." (d) In *Cornish v. Keene*, (e) the same learned judge said; "Although it is proved that this is a new discovery so far as the world is concerned, yet if anybody is able to show, that although that was new, that the party who got the patent was not the man whose ingenuity first discovered it, that he got it from A. or B., or took it from a book that was printed in England, and which was open to all the world then, although the public had the benefit of it, it would become an important question whether he was the first and true inventor." And in *Walton v. Potter*, (f) Sir N. C. Tindal, C. J., said: "Though the matter may not have been used, the party is not entitled to his patent unless he is the first and true inventor; therefore, if the subject matter of the patent has been discovered, has been published in a dictionary, for example, though it has not been reduced into practice, if a man merely adopts it, the merit is so small, that his patent for it would be worth nothing."

In the course of the argument in the case of *The*

(a) 1 Webs. P. R. 72.

M. & W. 300; 1 Webs. P. R.

(b) 2 M. & W. 554; 1 Webs.

543.

P. R. 190.

(e) 1 Webs. P. R. 507.

(c) 2 H. Bl. 470.

(f) 1 Webs. P. R. 592.

(d) See *Carpenter v. Smith*, 9

Househill Co. v. Neilson, (a) Lord Lyndhurst observed: "If the machine is published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed works, without reference to what has been done." And Lord Brougham added: "It negatives being the true and first inventor, which is as good as negating the non-user. The book that is generally referred to is the 'Repertory of Arts and Sciences.' It must not be a foreign book, but published in England."

In a case before Lord Romilly, M. R., his lordship said that it would make no difference that the book was in a foreign language, if it was exposed for sale. It does not appear, however, from the report, that the case of *The Househill Co. v. Neilson* was cited in argument. (b)

Where the book has never been circulated, and has been lost sight of, it becomes a question whether there has been such a publication as to invalidate a patent. "If the invention," said Sir N. C. Tindal, C. J., "has already been made public in England, by a description contained in a book, whether written or printed, which has been publicly circulated, in such a case the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances

Secus, if book has not been circulated.

(a) 1 Webs. P. R. 718 n.

(b) *Lang v. Gisborne*, 31 Beav. 133.

CHAP. III.

which are brought to bear upon each particular case. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia, or other work in general circulation. The question will be, whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information?" (a)

Publication in a book is an objection, not merely evidence of objection.

Publication in a book which has been exposed for sale is an objection to the validity of the patent, not merely evidence of an objection. "I think," said Maule, J., "it is an objection, to the patent, and not evidence simply of an objection that there has been a previous patent and a specification enrolled, and therefore published being enrolled, containing the invention. In the same way, I think it is an objection to a patent that it has been published in such a book." (b)

Sale of book not necessary.

It is not necessary to establish the fact that a single copy of the book has been sold—the publication is complete as soon as the book is exposed for sale in the bookseller's shop. (c)

Publication in a specification vitiates subsequent patent,

If an invention has been described in a specification, a subsequent patent for a similar invention will be void; but in certain cases when the invention has been abandoned it has been held that a subsequent patent was not void, (d) and by 5 & 6 Will. IV. c. 83, s. 2, provision is made for confirming letters patent granted to a *bonâ fide* inventor who

(a) *Stead v. Williams*, 8 Scott (N. R.) 219; 1 Webs. P. R. (N. R.) 472; 2 Webs. P. R. 142; 550.

Stead v. Anderson, 2 Webs. P. R. 150.

(c) *Lang v. Gisborne*, 31 Beav. 133.

(b) *Jones v. Berger*, 6 Scott

(d) See *post*, tit. Experiments.

discovers that his invention has already been described. (a) The general rule is, however, that if prior to the time of obtaining a patent any part of the substance of the invention has been communicated to the public by a specification of any other patent, or is known, the benefit of a patent cannot be claimed; (b) and the latter patent will be void even if there is some difference in the mode of working, if the invention is substantially the same. Thus where a patent was granted for "improvements in the construction of racks and pulleys for window blinds and other useful purposes," which, besides claiming a mode of making the frames by constructing them in a particular manner of drawn open metal tubes, claimed a mode of fixing the pulley in the frame, by turning the knob of the spindle upon which the pulley revolved, and thereby of screwing a piece of metal made to slide within the frame, tight to the edge of the frame, so as to fix the pulley spindle firmly to the frame; and it appeared that by a previous patent the same object had been effected by a similar method, with the addition merely of a thin piece of metal called an escutcheon which worked outside the frame, but the specification stated that the pulleys might be made without the escutcheon, it was held that the two patents were substantially the same as to one of the things claimed, and that the one first described was void. (c)

even if some difference in mode of working.

The fact that another specification for a similar invention has been filed since the date of the plaintiff's patent, but

(a) See *post*, chapter on Confirmation of Letters Patent.

Ald. 542; *Forsyth v. Rivière*, 1 Webs. P. R. 97; *Muntz v. Foster*, 2 Webs. P. R. 107.

(b) *Huddart v. Grimshaw*, 1 Webs. P. R. 86; *Hill v. Thompson*, 8 Taunt. 375; 1 Webs. P. R. 244; *Brunton v. Hawkes*, 4 B. &

(c) *Dobbs v. Penn*, 3 Exch. 427; *Bush v. Fox*, 5 H. & C. 707; *McCormick v. Gray*, 7 H. & N. 26.

CHAP. III.

before the latter was filed, is not of itself any proof of want of novelty in the plaintiff's invention. (a)

In *Booth v. Kennard* (b) the plaintiff's patent, obtained in 1852, for improvements in the manufacture of gas, was described in the specification to "consist in the direct use of seeds, leaves, flowers, branches, nuts, fruit, and other substances and matters containing oil or oily or resinous matter," and the mode of using the materials, it was stated, might be the same as the apparatus used in the ordinary mode of making gas from coal. The claim was in these words: "I claim for making gas direct from seeds and matters herein named for practical illumination or useful purposes, instead of making it from the oils, resins, or gums previously extracted from such substances." A patent obtained in 1829 was given in evidence by the defendant, in which the inventor proposed to use fatty substances such as greases or grains; also the residuum after the oil had been expressed from seeds such as oil cake; also beech nuts, mast, cocoa nuts, and other matters abounding in oil, and it was held that the latter specification showed that the making gas direct from seeds and other oily matters was not new at the date of the plaintiff's patent and that it was therefore void. (c)

Specification
not different
from any other
publication.

A specification of a patent does not differ from any other publication of an invention for the purpose of invalidating a subsequent patent for want of novelty; (d) it may describe the process to be adopted so insufficiently as to invalidate the patent and yet disclose enough to

(a) *Cornish v. Keene*, 1 Webs. P. R. 519.

(b) 2 H. & N. 84.

(c) See also *Hullett v. Hague*, 3 B. & Ad. 370; *Muntz v. Fos-*

ter, 2 Webs. P. R. 92; *Allen v. Rawson*, 1 C. B. 551.

(d) *Hills v. Evans*, 4 D. G. F. & J. 288; 8 Jur. (N. S.) 529.

show that what is claimed by a subsequent patent is not new. (a) CHAP. III.

If a patentee files a provisional specification which he abandons, and afterwards files another provisional specification before the time for provisional protection has expired, the abandonment itself will not be a publication. (b) Publication in provisional specification.

The amount of information given by a prior publication in order to avoid a subsequent patent, must be equal to that required to be given by a specification and must be enough to enable the public to carry the invention into practical use. (c) Amount of information must be equal to that required from a specification.

In *Hills v. Evans* (d) Lord Westbury said: "The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent. By the words of the statute of James it is necessary for the validity of a patent that the invention should not have been known, or used at the time. These words are held to mean, 'not publicly known or publicly used.' What amounts to public knowledge or public use is still to be ascertained. One of the means of imparting knowledge to the public is the publication of a

(a) *Betts v. Neilson*, L. R. 3 577; *Lewis v. Marling*, 10 B. & Ch. 429. C. 22; 4 C. & P. 52; 1 Webs.

(b) *Oxley v. Holden*, 8 C. B. P. R. 490.

(N. S.) 660. (d) 4 De G. F. & J. 300; 8

(c) *Young v. Fernie*, 4 Giff. Jur. (N. S.) 529.

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book or the recording of a specification of a patent. If, therefore, in disproving that allegation which is involved in every patent that the invention was not previously known, appeal be made to an antecedently published book or specification, the question is what is the nature and extent of the information thus acquired which is necessary to disprove the novelty of the subsequent patent? There is not I think any other general answer that can be given to this question than this, that the information as to the alleged invention given by the prior publication must for the purpose of practical utility be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever therefore is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication." And in *Betts v. Menzies* (a) his lordship said, "A barren general description, probably containing some suggested information or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding for want of novelty, a subsequent specification or invention which involves a practical truth productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical information."

General description not vitiate subsequent patent.

Antecedent publication must enable public to use invention.

The amount of information must be such as to enable the public to use the invention, if not with infallible success, at least with certainty, (b) and the novelty of a patent will not be impeached by proof that a patent for a similar invention has been taken out many years pre-

(a) 10 H. & C. 154.

(b) *Betts v. Neilson*, L. R. 3 Ch. 435.

viously, if it can be shown that the object of the second could not have been obtained by the first even with the assistance of subsequent knowledge and improved machinery. (a)

If an alleged discovery is made, but is not claimed, and no article is made according to it, it is a strong argument that the alleged discoverer has not been able to make the principle available for general use, (b) and any person who subsequently discovers a practical method of using such principle will be entitled to a patent. (c)

No valid patent can be granted for an invention which has been publicly used and generally known, that is to say, known to the public generally, or at least to that portion of the public whose attention is turned to such matters, even though the user is unknown to the patentee. (d) A very slight amount of user is enough to vitiate a patent, provided that it is public. Thus, where a patent was taken out for a process of bleaching, and the great utility of the invention and the fact that the process was not known to bleachers was proved; but it was shown that another person had used the same process for five or six years anterior to the date of the plaintiffs' patent and had kept his method secret from all but his two partners and two servants employed in working the process, Lord Ellenborough non-suited the plaintiff on the ground of previous user. (e) In *Cornish v. Keene* (f) Sir N. C. Tindal

Public user of an invention vitiates subsequent patent.

(a) *Muntz v. Foster*, 2 Webs. 345; *Stevens v. Keating*, 2 Exch. P. R. 93; *Betts v. De Vitre*, 11 772; 2 Webs. P. R. 192; *McCormick v. Gray*, 7 H. & N. 26.
L. T. (N. S.) 445; *Neilson v. Betts*, L. R. 5 H. & I.

(b) *Minter v. Mower*, 1 Webs. P. R. 139; *Morgan v. Seaward*, 1 Webs. P. R. 186.
(d) *Stead v. Anderson*, 2 Webs. P. R. 149.

(c) *R. v. Wheeler*, 2 B. & Ald.
(e) *Tennant's Case*, Dav. P. C. 429; 1 Webs. P. R. 125, n.

(f) 1 Webs. P. R. 508.

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said: "The main question is whether this invention was or was not in use in England at the time of granting these letters patent; was it or was it not in the language of the Act of Parliament, such a manufacture (which has a very wide and extended meaning you may almost call it invention); was it or was it not such an invention at the time of making the letters patent as was current in use? If it was at the time these letters patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly so that any other person might have the means of acquiring the knowledge of it, as well as this person who obtained the patent, then the letters patent are void."

Public user is
user in public.

The public user and exercise of an invention means a user and exercise in public, not by the public, such a user as to come to the knowledge of others than the inventor as contradistinguished from the user of it by himself in private. Thus where the plaintiff was the inventor of a new lock, and it was proved that a similar lock had been used on a gate adjoining the public road for several years, and also that several dozens of the locks had been made in England and sent abroad without any secrecy, it was held that this was such a public user and exercise of the invention as to avoid the patent. (a)

User need not
come down to
date of patent.

It is not necessary that the user should come down to the time when the patent was granted. (b) In the case of *The Househill Iron Co. v. Neilson*, (c) Lord Lyndhurst said: "If it is proved distinctly that a machine of the same kind was in existence and was in public use, that is, if use or if trials had been made of it in the eye and in the

(a) *Carpenter v. Smith*, 9 M. & W. 300; 1 Webs. P. R. 543.

(c) 9 C. & F. 788; 1 Webs. P. R. 709.

(b) *Ibid.*

presence of the public, it is not necessary that it should come down to the time when the patent was granted. If it was discontinued, still that is sufficient evidence in support of the prior use so as to invalidate the letters patent. . . . I never heard it before questioned that the notorious public use of an invention before the granting of the letters patent, though it may have been discontinued, is sufficient to invalidate the letters patent.”

General user in public must however be distinguished from experiments and trials kept secret by the inventor or experiments abandoned as useless. (a)

General user to be distinguished from experiments.

But if a person who has made a discovery does not publish it, a subsequent patent for the same invention will not be void. In order to constitute such publication as will defeat a subsequent patent, there must have been some user of the invention, some steps must have been taken to make it known. In *Boulton v. Bull*, (b) the case of *Dollond's* patent was referred to and Buller, J., said: “The objection to *Dollond's* patent was that he was not the inventor of the new method of making object glasses. But it was holden that as Dr. Hall had confined it to his closet and the public were not acquainted with it, Dollond was to be considered as the inventor.”

If invention kept secret, subsequent patent not vitiated.

In *Hill v. Thompson*, (c) Dallas, J., said: “It is not enough to have discovered what was unknown to others, if the discovery be confined to the knowledge of the party having made it; but it must have been communicated more or less, it must have been more or less made use of so as to constitute discovery as applied to subjects of this sort,” and the learned judge referred to *Dollond's case*

(a) See *post*, title experiments.

(c) 8 Taunt. 382; 2 B. Moore,

(b) 2 H. Bl. 470.

433; 1 Webs. P. R. 244.

and *Tennant's case* (a) as illustrating the distinction between public user and user in private. (b)

In *Lewis v. Marling*, (c) Bayley, J., said : “ If I make a discovery and am entitled to produce an effect from my own experience, judgment and skill, it is no objection that some one else has made a similar discovery by his mind unless it becomes public. So if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have received privately a communication from abroad which would have enabled him to have made his machine.”

And in *Carpenter v. Smith*, (d) a case which turned entirely on the question of public user, Lord Abinger, C. B., said : “ What is meant by public use is this—a man is entitled to a patent for a new invention, and if his invention is new and useful he shall not be prejudiced by any other man having invented that before and not made any use of it, because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions if they are not brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them. A great many patents have been taken out, for example, upon suggestions made in a very celebrated work by the Marquis of Worcester, and many ingenious patents have been derived from hints and speculations by that ingenious author. But yet as he never acted on them, as he never brought out any

(a) Dav. P. C. 429 ; 1 Webs. P. R. 125, n.

(b) See also *Smith v. Davidson*, 19 Dec. of Ct. of Sess. 2nd series, p. 691.

(c) 4 C. & P. 57 ; 10 B. & C. 22 ; 1 Webs. P. R. 497.

(d) 1 Webs. P. R. 534.

machines whatsoever, those patents are good, so that the meaning of the words 'public use' is this, that a man shall not by his own private invention which he keeps locked up in his own breast, or in his own desk, and never communicates, take away the right that another man has for the same invention." On a motion for a new trial on the ground of misdirection, the Court of Exchequer refused to grant a rule, and agreed with law as thus laid down by Lord Abinger. (a)

In *Betts v. Menzies*, (b) Sir W. P. Wood, V.C., said: "If a man sits down and takes out a patent from his own conjectures without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless," and His Honour referred to the Marquis of Worcester's book, and the valid patents taken out from hints contained in it.

The accidental user of a piece of machinery forming part or the whole of a mechanical contrivance, which may be applied afterwards to some ulterior purpose without any intention of producing the result, is not such a user of the invention as to prevent a patent from being taken out by another person, who afterwards discovers that the contrivance may be attended with beneficial results, and *bonâ fide* invents a means of carrying it into effect. (c) And if in a patent for a combination of materials, it is

Accidental user of piece of machinery not vitiate patent;

nor accidental combination of materials;

(a) *S. C.* 9 M. & W. 300; 1 Webs. P. R. 541. See also *Gibson v. Brand*, 4 Scott (N. R.) 879; 4 M. & Gr. 198; 1 Webs. P. R. 638.

(b) 3 Jur. (N. S.) 357.

(c) *Harwood v. Great Northern Railway Co.*, 2 B. & S. 209; *S. C. nom. Harrison v. Great Northern Railway Co.*, 6 Jur. (N. S.) 996.

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shown that they have been accidentally combined before, but not for the purposes for which the patent has been taken out, the patent will not be invalidated. (a)

nor use of
method or
principle in
ignorance.

The user of a method or principle in a machine in ignorance of the effect which may be produced by a proper adaptation will not vitiate a subsequent patent in which the method or principle is utilised with greater success. (b)

User for pri-
vate purposes.

If the antecedent invention has been used for private purposes only, there will, nevertheless, be such a public user as to defeat a subsequent patent. Thus, where in an action for the infringement of a patent for wood-paving, it was proved on behalf of the defendants that wood-paving had been used in the portico of a private house, it was held that if the mode of making the paving was similar to the plaintiff's, that would be a sufficient user to destroy his patent, though put in a place to which the public had not free access. (c)

Manufacture
by the inventor
before patent
not user if
secret.

If a patentee makes some of the patented articles before the date of the patent, but does not sell them or expose them for sale, and keeps his invention secret, that will not be such a user as to defeat his patent. (d)

Where the patentee, a few months before the date of his patent, which was for improvements in the construction of paddle-wheels, caused two pairs of the wheels to be made by an engineer, under an injunction of secrecy; which was observed; on the express ground that he was about to take out a patent, and after the wheels were

(a) *Muntz v. Foster*, 2 Webs. P. R. 130; *Stead v. Anderson*, 2 Webs. P. R. 149.

(b) *Minter v. Mower*, 1 Webs. P. R. 140, 142; 6 A. & E. 744. (d) *Bramah v. Hardcastle*, Hol. 81; 1 Webs. P. R. 44, n.; *Betts*

(c) *Stead v. Williams*, 2 Webs. v. *Menzies*, 5 Jur. (N. S.) 1164.

made, they were taken to pieces, and sent abroad, and used, after the patent was taken out, in foreign steam-boats belonging to a company of which the patentee was manager, it was held that this transaction could not be considered as a user by others, or a public user within the meaning of the statute. (a)

But if the patentee makes the patented article and sells it in the public market before the date of the patent, the patent will be void, (b) and it appears that if an inventor were to make the article and sell it, and keep the process secret, he would not afterwards be able to take out a patent. The point, however, has not been expressly decided. (c)

It is sufficient to constitute public user if the article has been manufactured openly and not for the purpose of experiment. (d)

Where in a patent for improvements in the manufacture of iron and steel, which consisted in making steel by applying a combination of carbon and manganese producing carburet of manganese, it was proved that five firms of ironmasters had used a similar process by which a perfect manufactured article was produced for profit in large quantities, it was held that this was not a mere experiment, and that as the process had been used openly by three of the firms there was such a user as to avoid the subsequent patent. (e)

(a) *Morgan v. Seaward*, 2 M. & W. 544; M. & H. 56; 1 Webs. P. R. 187. And see *Smith v. Dickinson*, 3 Bos. & Pul. 630, and 15 & 16 Vict. c. 83, s. 10, as to fraud.

(b) *Wood v. Zimmer*, Holt (N. P.) 60; 1 Webs. P. R. 44.

(c) *Heath v. Smith*, 3 El. & Bl. 271.

(d) *Betts v. Neilson*, L. R. 3 Ch. 429.

(e) *Heath v. Smith*, 3 El. & Bl. 270.

Unless sale.

Manufacture by other persons before patent constitutes user.

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Exposing for
sale is user
though no sale
effected.

The publicly making and exposing an article for sale, though there is no demand or use for it, will vitiate a subsequent patent; (a) and it is not necessary to show that any sale has been effected. (b)

Where in an action for infringement of a patent it was proved that the defendants had made articles of the same description before the plaintiff's patent was taken out, that they had no shop for the exhibition of goods, and that the articles had been deposited for sale in their warehouse, it was held that there was sufficient evidence of user to defeat the plaintiff's claim to novelty in the invention. (c)

Experiments
by inventor
not user.

An inventor is entitled to make experiments, to test the sufficiency of his invention, and experiments conducted for that purpose only, in private, will not constitute such a user of the invention as to deprive him of his right to a patent. (d)

If an invention has already been ascertained by previous experiment to be useful, the inventor's public user of it for profit is a gift of the invention to the public, and avoids a subsequent patent; but a user before the patent, merely experimental and tentative, does not avoid it. (e)

Must be in
private.

Where a machine was invented during the progress of some public works, on which the inventor was engaged, and was tested in a place accessible to the public for four months during the progress of the works, it was held that such user amounted to a dedication to the public, and an

(a) *Losh v. Hague*, 1 Webs. P. R. 205.

(b) *Mullins v. Hart*, 3 C. & K. 297; *Oxley v. Holden*, 8 C. B. (N. S.) 666; *Betts v. Neilson*, L. R. 3 Ch. 429.

(c) *Mullins v. Hart*, 3 C. & K. 297.

(d) *Bramah v. Hardcastle*, Hol. 81; 1 Webs. P. R. 44, n.

(e) *Re Newall and Elliott*, 4 C. B. (N. S.) 294.

application for a patent was refused. Lord Cranworth said: "The petitioner admits he completed his invention in May, 1855, and that he used it publicly for upwards of four months before applying for the patent. No doubt an experiment might have been made; and if made *bonâ fide* only for the purpose of testing the merits of an invention, I do not think it would have amounted to a dedication to the public; but where, as in the present case, thousands of persons had the opportunity of seeing the apparatus at work for a period of four months, during the carrying on of the petitioner's contract, and in the regular course of the undertaking, it is quite clear that no intention of applying for a patent originally existed; and under such circumstances, and after the lapse of such a time, I must hold that there was a dedication to the public, and refuse the application." (a)

But a necessary and unavoidable disclosure to the public, if it be only made in the course of mere experiments, is no publication; although the same disclosure, if made in the course of a profitable user of an invention previously ascertained to be useful, would be a publication. An experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, is not necessarily a gift of the invention to the world. Thus, where a person had invented an improved apparatus for laying down submarine telegraphic cables and experiments on dry land were found to be indecisive, and the inventor successfully used his apparatus in the course of a contract for laying down a cable at sea, and immediately afterwards took out a patent, it was held that there was not

Unless disclosure unavoidable.

(a) *Adamson's Patent*, 6 D. M. G. 420.

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such a publication as to prevent him from obtaining a patent. (a)

Where the inventor of a carding-machine lent it to a person in order to test it, and the machine was used in a room in a mill where men were constantly going backwards and forwards, it was held that this was not such a user of the invention as to deprive the inventor of his right to a patent. (b)

Unsuccessful experiments by a previous inventor will not vitiate a subsequent patent.

If an experiment towards an invention is made, and fails, and is abandoned, the invention of a subsequent inventor, who in effect remedies the defects in the first invention, though he has never seen it, will not be vitiated by the previous user. Thus, where the plaintiff in an action for infringement had taken out a patent for wheels constructed on the suspension principle, and for the defence it was shown that previously to the date of the patent a Mr. Strutt had made wheels on the same principle, Patteson, J., in summing up, said: "If, on the whole of this evidence, either on the one side or the other, it appeared that this wheel constructed by Mr. Strutt's orders was a wheel on the same principle, and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that it was used openly in public, so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent—undoubtedly, then, that would be a ground to say that the plaintiff's invention is not new, and if it is not new, of course his patent is bad, and he cannot recover in his action; but if, on the other hand, you are of opinion that Mr. Strutt's wheel was an experiment, and

(a) *Re Newall and Elliott*, 4 C. B. (N. S.) 295.

(b) *Bentley v. Fleming*, 1 C. & K. 587.

that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention which came afterwards was his own invention, and remedied the defects, if I may so say, although he knew nothing of Mr. Strutt's wheel, he remedied the defects of Mr. Strutt's wheel, then there is no reason for saying that the plaintiff's patent is not good, it depends entirely upon what is your opinion upon the evidence with respect to that." (a)

Where a patent was taken out in 1818 for the application of a rotary cutter in shearing cloth from list to list, it was proved that in 1811 a specification in which the principle was stated was brought over from America and a machine commenced but never finished, that in 1816 a model of such a machine was brought over and though no machine was made from it, the model was shown to several persons, that the American invention was in fact useless, and that the persons who had the model of it bought and used machines made by the plaintiffs,—Lord Tenterden, C.J., said: "It is no doubt incumbent on the plaintiffs to show that their machine is new, but it is not necessary that they should have invented it from their own heads, it is sufficient that it should be new as to the general use and public exercise in this kingdom. If it were shown that the plaintiffs had borrowed from some one else, then of course their patent would fail . . . it appears to me that the defendant has failed to prove that such a machine was generally known or generally used in England before the taking out of this patent by the plaintiffs. (b)

(a) *Jones v. Pearce*, 1 Webs. P. R. 122.

(b) *Lewis v. Marling*, 4 Car. & P. 52; 1 Webs. P. R. 490.

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In *Carpenter v. Smith*, (a) Alderson, B., said that *Lewis v. Marling* went to the very extreme point of the law; and in *Morgan v. Seaward* (b) the same learned judge said that he should have entertained very considerable doubt as to whether there had not been a publication of the invention.

Both *Jones v. Pearce* and *Lewis v. Marling* appear, however, to have been decided on the ground that the former machines were mere experiments, which totally failed, and in *Murray v. Clayton* (c) Sir W. M. James, L. J., said: "I am not aware of any principle or authority upon which the exhibition of a useless machine which turns out a failure can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines," and referred to the ruling of Patteson, J., in *Jones v. Pearce*.

The following cases support the proposition that an unsuccessful experiment will not vitiate a subsequent patent for a similar invention.

In *Galloway v. Bleaden* (d) Sir N. C. Tindal, C. J., said: "A mere experiment or a mere course of experiments for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments, that is not such an invention as will prevent another person, who is more successful or perseveres with greater energy in the line that has been laid out for him by the preceding inventor, from availing himself of it and having the benefit of it."

(a) 9 M. & W. 300; 1 Webs. P. R. 543.

(b) 2 M. & W. 553; 1 Webs. P. R. 190.

(c) L. R. 7 Ch. 581.

(d) 1 Webs. P. R. 525.

In *The Househill Co. v. Neilson*, (a) Lord Lyndhurst said that their Lordships must not be understood to have given any decision as to the case of an invention which had been formerly used and abandoned many years ago, and the whole thing lost sight of.

In *Stead v. Williams* (b) Cresswell, J., said: "I take it that there is a great difference between the knowledge of an invention as a thing that would answer and was in use, and the knowledge of it as a mere experiment that had been found to be a failure and thrown aside. If you are dealing with an article of merchandise or with an article of ordinary use; if a person has had a scheme in his head and has carried it out, but after a trial has thrown it aside and the thing is forgotten and gone by, then another person re-introducing it may within the meaning of this Act be the inventor and the first user of it so as to justify a patent."

And in *Hills v. The London Gas Light Co.*, (c) Sir G. W. Bramwell, B., said: "If there has been a user of an invention, not of a substantial character but in the character of an experiment, then although the thing has been done before, it does not preclude a person from taking out a patent for it."

It must be shown that the article made before answered the purposes and had the properties of that which the patentee has made and claims as his invention, and also that it was known and used. (d) Thus where it is proved that there was an invention in existence before the patent was taken out which has never been properly completed so

The former article must have had the same properties as that claimed by the patentee.

(a) 9 C. & F. 816; 1 Webs. P. R. 717.

(c) 5 H. & N. 312.

(b) 2 Webs. P. R. 135.

(d) *Walton v. Bateman*, 1 Webs. P. R. 617.

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as to have any practical effect, and which if it had appeared after the patent, would have been held to be a colourable imitation, the subsequent patent will not be invalidated. (a)

It is difficult to distinguish accurately where the use of an invention for the mere purpose of experiment stops, and the employment or user of it as a completed invention which the inventor thinks cannot be made more perfect begins, and the test seems to be, has the inventor used the invention for the purpose of making a profit by it in trade? (b)

Exhibitions of new inventions at international exhibitions not to prejudice patent rights.

By 33 and 34 Vict. c. 27, s. 2, it is provided that the exhibition shall not, nor shall the publication during the period of the holding of such exhibition of any description of such invention, nor shall the user of such invention within the place where the same may be held, nor shall the user of such invention elsewhere by any person without the priority and consent of the true and first inventor thereof, prejudice the right of the exhibitor thereof, he being the true and first inventor, within six months from the time of the opening of such exhibition, to obtain letters patent for his invention.

The question of user is for the jury to decide.

The question of public user is a question of fact which it is for the jury to decide. (c) The question whether or not the manufacture was in public use in England before the date of the patent, or whether the evidence only shows that experiments have been made which have been abandoned, is one of considerable delicacy; a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of

(a) *Daw v. Eley*, L. R. 3 Eq. 496; *Murray v. Clayton*, L. R. 7 Ch. 585.

(b) *Lang v. Gisborne*, 31 Beav. 135.

(c) *Elliott v. Aston*, 1 Webs. P. R. 224.

deciding it is to leave to the jury; and if they hear the evidence patiently, and apply it with intelligence, their verdict will not be disturbed. (a)

A machine does not cease to be the subject of a patent merely because of the length of time during which the inventor may keep it by him after it has been made a complete invention. (b)

Delay in
publication.

An inventor will not be permitted to shelter himself under wilful ignorance, but will be fixed with knowledge not only of what he did know, but of what he would have known if he had made the inquiries, which it is incumbent on him to make. (c)

Wilful igno-
rance.

The meaning of the word "manufacture" has often been discussed. (d) In the case of *Boulton v. Bull*, (e) Eyre, C. J., said: "According to the letter of the statute the saving goes only to the sole working and making; the sole buying, selling and using remain under the general prohibition. It was admitted that the word manufacture in the statute was of extensive signification, that it applied not only to things made, but to the practice of making; to principles carried into practice in a new manner; to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class in the first place new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions,

What is a new
manufacture.

Things made.

(a) *Per* Sir N. C. Tindal, C. J., in *Cornish v. Keene*, 4 Scott, 352; 3 Bing. (N. C.) 588; 1 Webs. P. R. 519; *Walton v. Bateman*, 1 Webs. P. R. 619.

(b) *Bentley v. Fleming*, 1 C. & K. 587.

(c) *Westrupp and Gibbins' Patent*, 1 Webs. P. R. 555; *Honibull's Patent*, 9 Moo. P. C. C. 390.

(d) See Webster on Subject Matter, p. 98.

(e) 2 H. Bl. 492.

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Practice of
making.

whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making, we may class all new artificial manners of operating with the hand or with instruments in common use, new processes in any art producing effects useful to the public."

In *R. v. Wheeler*, (a) Abbott, C. J., said "that the word 'manufacture' had generally been understood to mean either a thing made or some part of an engine or instrument to be employed in making some previously known article or in some other useful purpose."

Manufacture
means either
the machine
or mode of
constructing
it.

"The word 'manufacture' in the statute," said Parke, B., "must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine." (b) In *Ralston v. Smith*, (c) it was said that it is not every useful discovery that can be made the subject of a patent, but that the words "new manufacture" will comprehend not only a production, but the means of producing it, and in *Bush v. Fox*, (d) Coleridge, J., said: "Manufacture includes both process and result."

Amount of
invention im-
material.

The amount of labour and thought bestowed, or expenditure of money, is immaterial in considering whether or not a patent should be granted, for inventions are of various kinds, sometimes they are the result of study, sometimes of accident. (e)

It was objected in *Orane v. Price*, (f) that the quality

(a) 2 B. & Ald. 349.

(b) *Morgan v. Seaward*, 2 M. & W. 558; M. & H. 58; 1 Webs. P. R. 193.

(c) 11 H. & C. 223.

(d) Macr. 176.

(e) *Liardet v. Johnson*, Bull

(N. P.) 76; 1 Webs. P. R. 53.

(f) 4 M. & G. 604; 5 Scott (N. R.) 390; 1 Webs. P. R. 410.

or degree of invention was so small, that it could not become the subject matter of a patent, but Sir N. C. Tindal, C. J., said that in point of law the labour of thought or experiments, and the expenditure of money, are not the essential grounds of consideration on which the question, whether the invention is or is not the subject matter of a patent ought to depend, for if the invention is new and useful to the public, it is not material whether it is the result of long experiments and profound research, or of some sudden and lucky thought, or mere accidental discovery. Where the invention consisted in the manufacture of tubes without the use of a maundril, so as to weld them without hammering them on any solid surface, "though that seems to be a very simple invention," said Lord Lyndhurst, "it has been productive of great advantages, inasmuch as it has enabled the manufacturer to construct pipes for gas and other purposes very correctly, and also of lengths much beyond what could be done previously to this discovery." (a)

In the case of *Lewis v. Davis*, (b) the amount of invention was very small, but the patent was supported. The patent was for a machine to shear from list to list, by means of rotary cutters. Before the patent the shearing of cloth from list to list by means of shears was known, and the shearing it from end to end, by means of rotary cutters, was also known. Lord Tenterden said: "If, before the plaintiff's patent, the cutting from list to list, and the doing that by means of rotary cutters, were not combined, I am of opinion that this is such an invention

(a) *Russell v. Cowley*, 1 Webs. P. R. 467; 1 C. M. & R. 875.

(b) 1 Webs. P. R. 488.

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by the plaintiffs as will entitle them to maintain the present action."

Mode or process of manufacturing apart from things produced is good subject matter for a patent.

It was at one time considered doubtful whether a mode, or process of producing a result, apart from the thing produced could be the subject of a patent. The point was not actually decided until the case of *Orane v. Price*, (a) but it had previously been discussed in several cases, and the received opinion was that such a patent would be valid. In *Boulton v. Bull*, (b) Eyre, C. J., said: "When the effect produced is some new substance or composition of things, it should seem that the privilege of the 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 patent can only be for the mechanism, if new mechanism is used, or for the process, if it be for a new method of operating, with or without old mechanism by which the effect is produced." His lordship then referred to the case of *Hartley's patent*, where the invention consisted in the method of applying iron plates to secure buildings from fire, and to a list of patents with which he had been furnished, where there were several for new methods of manufacturing articles in common use, and said that he thought these methods might be said to be new manufactures. His lordship then proceeded, "The patent" (which was for a method of lessening the consumption of steam and fuel in fire engines) "cannot be for the effect produced, for it

(a) 4 M. & G. 602; 5 Scott
(N.R.) 388; 1 Webs. P. R. 409.

(b) 2 H. Bl. 493.

is either no substance at all, or, what is exactly the same thing as the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed, it must then be for the method, and I would say in the very significant words of Lord Mansfield in the great case of the copyright, it must be for method detached from all physical existence whatever." In *R. v. Wheeler*, (a) Abbott, C. J., said that the word "manufacture" might extend "to a new process to be carried on by known implements or elements acting upon known substances and ultimately producing them in a cheaper or more expeditious manner, or of a better or more useful kind."

In *Hall v. Boot*, (b) the patent was for applying the flame of gas to singe off the superfluous fibres of lace where the flame of oil had been used before for the same purpose, and the patent was supported.

In *Losh v. Hague*, (c) the patent was for the use of an old wheel on railways. Lord Abinger, C. B., referring to the above case, said that that was the application of a new contrivance to an old object and was good, but that applying a new contrivance to an old object and applying an old contrivance to a new object were different things. (d) In *Gibson v. Brand*, (e) the jury specially found that the alleged invention was not new or a new combination, but that it was an improved process. Sir N. C. Tindal, C. J., said that it was not necessary to go into the question, whether or not a patent could be supported

(a) 2 B. & Ald. 350.

(b) 1 Webs. P. R. 100.

(c) 2 Webs. P. R. 207.

(d) See also *Stevens v. Keating*,

2 Webs. P. R. 183; *Curtis v. Platt*, 11 L. T. (N. S.) 245.

(e) 4 M. & Gr. 199; 4 Scott

(N. R.) 1879; 1 Webs. P. R. 633.

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for a process only, and that if the specification were properly prepared it might probably be considered a fit subject for a patent, and in support of his opinion cited the remarks of Eyre, C. J., and Abbott, C. J., noted above.

Shortly after the decision in *Gibson v. Brand* the case of *Crane v. Price* (a) came before the same court, when the question as to whether there could be a patent for a process was fully discussed. The patent was "for an improvement in the manufacture of iron." The specification described the subject of the invention to be the application of anthracite or stone coal, combined with hot air blast, in the smelting or manufacture of iron from ironstone mine or ore. It was distinctly stated that the patentee did not claim the use of a hot-air blast separately as his invention, when uncombined with the application of anthracite or stone coal; nor did he claim the application of anthracite or stone coal when uncombined with the use of hot-air blast; but that what he did claim as his invention was the application of anthracite or stone coal and culm, combined with the use of the hot-air blast in the smelting and manufacture of ironstone mine or ore. The question in the suit therefore was whether, admitting the use of the hot-air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite or stone coal to have been known before in the manufacture of iron with the cold blast, but that the combination of the two together (the hot-air blast and the anthracite) was not known before in the manufacture of iron, such combination could be the subject of a patent. Sir N. C. Tindal, C. J., in delivering the judgment of the Court, said: "We are of

(a) 5 Scott (N. R.) 388; 4 M. & Gr. 602; 1 Webs. P. R. 409.

opinion that if the result produced by such a combination is either a new article or a better article or a cheaper article to the public than that produced before by the old method, such combination is an invention or a manufacture intended by the statute, and may well become the subject of a patent."

The decision in *Crane v. Price* was questioned in *Horton v. Mabon*, (a) by Willes, J., who said that the only ground on which it could be supported was that the product was a materially better article, but it has never been overruled. In *Murray v. Clayton*, (b) Sir W. M. James, L. J., said: "No doubt *Crane v. Price* has been questioned, and if I may be permitted to say so with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, was simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel in the making of iron; and neither I, nor, so far as I am aware, any other judge, has ever questioned the principles upon which that case was decided," and his lordship quoted the judgment of Sir N. C. Tindal cited above.

In *Stevens v. Keating*, (c) Sir F. Pollock, C. B., said: "The real invention may be not so much for the thing when produced, as for the mode in which it is produced; and its novelty may consist not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and therefore

(a) 12 C. B. (N. S.) 448.

(c) 2 Webs. P. R. 182.

(b) L. R. 7 Ch. 584.

although the language of the Act has been said to apply only to manufactures and not to processes, when you come to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because although an old thing, if made in a new way, the very making of it in a new way makes it a manufacture."

In *Newall v. Elliott*, (a) the patent was for "improvements in apparatus employed in laying down submarine telegraph wires." The specification claimed: "First, coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of the rings in connection with the cone as described." The patent was objected to as being for a mode, but it was held that there was such an improvement as to constitute a good subject matter for a patent.

Meaning of
the words
method and
mode.

"A method of performing a process," said Rooke, J., "means the mode or manner of effecting. A newly invented method, therefore, means the idea of a new mode of construction;" and Heath, J., said that when a mode of doing a thing is referred to something permanent it is properly termed an engine; when to something fugitive, a method. (b)

"Engine and method," said Lawrence, J., in *Hornblower v. Boulton*, (c) "mean the same thing and may be the subject of a patent. Method, properly speaking, is only placing several things and performing several operations in the most convenient order; but it may signify a contrivance or device, so may an engine, and therefore I think it may answer the word method. So principle

(a) 10 Jur. (N. S.) 954; 13 W. R. 11.

(b) *Boulton v. Bull*, 2 H. Bl. 478, 468.

(c) 8 T. R. 106.

may mean a mere elementary truth, but it may also mean constituent parts."

Though a patent may be granted for a method or process of manufacturing anything apart from the thing itself, which is made, nevertheless a patent cannot be granted for a bare principle.

No patent can be granted for a principle only.

The leading case on this point is *Boulton v. Bull.* (a) The patent was for "a method of lessening the consumption of steam and fuel in the fire-engines." The specification commenced by saying, "My method of lessening the consumption of steam and consequently fuel in fire-engines consists of the following principles," and then described how they were to be carried into effect. The patent was objected to on the ground that a patent could not be granted for a principle.

The judges differed as to the construction of the specification, but they were all agreed that there could be no patent for a principle. Rooke, J., said: "The term principle is equivocal, it may denote either the radical elementary truths of a science or those consequential axioms which are founded on radical truths, but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles." Heath, J., said that the patent must be for the vendible matter and not for the principle, and that it had always been held that the organization of a machine might be the subject of a patent, but that principles could not. Buller, J., said: "The very statement of what a principle is proves it not to be a ground for a patent. It is the first ground and rule for arts and sciences, or in other words, the elements and rudiments of them. A patent must

(a) 2 H. Bl. 463.

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be for some new production from those elements and not for the elements themselves." And Eyre, C. J., said: "Undoubtedly there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or in manual occupation, I think there may be a patent." Owing to the difference of opinion among the judges as to construction of the specification the case went to the Court of King's Bench, and it was unanimously determined that there could be no patent for a principle. (a) In the case of *R. v. Wheeler*, (b) Abbott, C. J., said, "No merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." (c)

Philosophical or abstract principle cannot be patented.

But a patent may be granted for a mode of applying the principle.

A patent may, however, be granted for the application of a principle to some machine or process. The patent in such a case is not for the principle, but for the mode of carrying it into effect. (d) "You cannot," said Alderson, B., "take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying it into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect." (e)

(a) *Hornblower v. Boulton*, 8 T. R. 95. 463; *Crossley v. Potter*, Macr. 244; *Walton v. Bateman*, 1 Webs. P. R. 620.

(b) 2 B. & Ald. 350.

(c) See also *Househill Iron Co. v. Neilson*, 1 Webs. P. R. 683.

(d) *Boulton v. Bull*, 2 H. Bl.

(e) *Jupe v. Pratt*, 1 Webs. P. R. 146; *R. v. Cutler*, 1 Stark.

354; *Minter v. Mower*, 6 A. &

In *Neilson v. Harford* (a) the patent was "for the improved application of air to produce heat in fires, forges and furnaces where bellows or other blowing apparatus are required," and the specification described the invention to consist in passing a blast of air from the ordinary blowing apparatus into an air vessel which, during the continuance of the blast, was to be kept heated to a considerable temperature, and from that vessel by means of a pipe into the furnace. The form of the vessel was stated to be immaterial, and might be adapted to the local circumstances or situation. It was necessary sometimes to use water twires to prevent the pipe from melting. It was contended that the patent was void as being for a principle, but it was held that the patent was not merely for a principle, but for a principle embodied in a machine. Alderson, B., said: "The blowing apparatus was perfectly well known; the heating of air was perfectly well known; the twire was perfectly well known as applicable to blast furnaces; then what he really discovered is that it would be better for you to apply air heated up to red-heat or nearly so instead of cold air as you have hitherto done. That is the principle; that is the real discovery; but in order to take out a patent you must have an embodiment of the principle, and his embodiment of the principle is the heating of air in a separate vessel intermediately between the blowing apparatus and the point where it enters the furnace. Then he says, 'I do not mean to claim any shape in which it is done; it may be done in a vessel of any shape, provided only you have such a vessel of

E. 735; *Hullett v. Hague*, 2 A. (a) 1 Webs. P. R. 331.
& E. 370.

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such a shape, a fire so applied as that in the intermediate space between the blowing apparatus and the furnace the air arrives at the red-heat.' I take the distinction between a patent for a principle, and a patent which can be supported, to be, that you must have an embodiment of the principle in some practical mode described in the specification of carrying the principle into actual effect, and then you take out your patent not for the principle but for the mode of carrying the principle into effect. In Watt's patent, which comes the nearest to the present of any you can suggest, the real invention of Watt was, that he discovered that by condensing steam in a separate vessel a great saving of fuel would be effected by keeping the steam cylinder as hot as possible, and applying the cooling process to the separate vessel and keeping it as cool as possible, whereas before, the steam was condensed in the same vessel; but then Mr. Watt carried that practically into effect by describing a mode which would effect the object. The difficulty which presses on my mind here is, that this party has taken out a patent in substance like Watt's for a principle, that is the application of hot air to furnaces, but he has not practically described any mode of carrying it into effect. If he had perhaps he might have covered all other modes as being a variation."

The same patent was the subject of litigation before the Court of Session, in the case of *The Househill Iron Company v. Neilson*,^(a) and Lord Justice Clerk Hope said:—"It is quite true that a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature, or any property of

(a) 1 Webs. P. R. 683.

matter apart from any mode of turning it to account in the practical operations of manufacture, or the business and arts and utilities of life. The mere discovery of such a principle is not an invention in the patent law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a great general and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained.” (a) “The skill and ingenuity of the inventor,” said Lord Hatherly in *Cannington v. Nuttall*, (b) “are shown in the application of principles. Few things come to be known now in the shape of new principles, but the object of the invention generally is the applying of well known principles to the achievement of a practical result not yet achieved.” And Lord Westbury said: “I may construct an apparatus, and may in point of fact make the merit and the benefit of that apparatus depend upon the application of some natural force or property which is perfectly well known, but my invention consists in the construction of the apparatus in such a manner as to bring the natural agency or power to bear upon and

Skill of inventor shown in application of principles.

(a) And see *Dangerfield v. Jones*, 13 L. T. (N.) 142; *Baxter v. Combe*, 1 Ir. Ch. 284.

(b) L. R. 5 H. L. 216.

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effect the object which I desire to effect, and that I do by means of an apparatus constructed so as to bring into action that natural power. If, for example, I avail myself of the well-known expansive force of steam in order to effect a new object or a more beneficial result, and I introduce that by means of an apparatus constructed for the purpose of bringing this well-known expansive power into utility for my particular purpose, I have no right of invention in the discovery of that expansive power. My invention consists in the arrangement of the apparatus, in order to receive that ordinary and well-known dynamic agent, and make it a fit instrument for effecting a new result."

Instances.

In *Jones v. Pearce*, (a) the patent was for an improvement in carriage wheels, and consisted in the application of the suspension principle to their construction. The means of application was described, and the patent was supported.

In *Minter v. Wells*, (b) the patent was for "an improvement in the constructing, making, and manufacturing of chairs." The specification described the invention to consist "in the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair." The claim was in the same words. It was objected that the claim was for a principle, and not for any particular mode of applying it, but it was held that the application of a self-adjusting leverage producing the effect, constituted the machine, and that the patentee claimed that machine and the right to make it by the application of the particular form of self-adjusting

(a) 1 Webs. P. R. 121. (b) 1 Webs. P. R. 134; 1 C. M. & R. 507.

leverage. Lord Lyndhurst, C.B., said: "It is not a leverage only, but the application of a self-adjusting leverage; and it is not a self-adjusting leverage only, but it is a self-adjusting leverage producing a particular effect by the means of which the weight on the seat counterbalances the pressure against the back." It was said, in argument, that this was nothing more than one of the first principles of mechanics, and Parke, B., said: "But that not being in combination before, cannot that be patented? It is only for the application of a self-adjusting leverage to a chair—cannot he patent that? He claims the combination of the two, no matter in what shapes or way you combine them; but if you combine the self-adjusting leverage which he thus applies to the subject of a chair that is an infringement of his patent."

In *Hills v. London Gas Light Company*,^(a) it was contended that the mere application of hydrated oxides to absorb the sulphuretted hydrogen from coal gas, was not the subject of a patent, as that property of it was previously well known. It was held that the application of the hydrated oxide was the principle, and that if a man were to say, "I claim the use of hydrated oxide of iron for the purification of coal gas," without saying how it was to be applied, the objection might be well founded, but that as the patent said: "I claim it in the manufacture of gas in the way I have described," and showed how it might be used, the objection failed.

In a patent for "improvements in giving signals and sounding alarms in distant places by means of electric currents transmitted through metallic circuits," one of

(a) 5 H. & N. 369.

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the improvements was described as an improvement "whereby a set of combined conducting wires having a voltaic battery, and a set of buttons or finger keys, and also a dial with metallic needles for giving signals, as well as an apparatus for sending alarums at each end of the set, may also have duplicates of such dials with needles and apparatus for alarums, at intermediate places between the two ends; all such duplicates operating simultaneously with each other and with the two end dials and alarums, to give like signals and to sound like alarums." The jury found that "the sending of signals to intermediate stations" was a new invention of the patentees. In an action for infringement it was insisted that the giving of duplicate signals at intermediate stations was not the proper subject of a patent, being an idea or principle only, and not a new manufacture. The Court of Common Pleas, however, held that the patentees not only communicated the idea or principle, that duplicate signals might be given, but showed how it might be done, and that it was the fit subject of a patent, for though it might be probable *à priori* that a circuit having a distant coil could have an intermediate one also which would operate in the same manner, still it was a matter of experiment that it could be practically done. (a)

Particular method cannot be extended because of common principle.

Where a subject is not new, any patent taken out for a method of performing the operation will be substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general terms. (b)

(a) *Electric Telegraph Co. v. Brett*, 8 C. B. 883.

(b) *Bovill v. Pimm*, 11 Exch. 739.

If the specification does not point out the mode by which the process is to be performed, so as to accomplish the object in view, it will be a statement of a principle only, and the patent will be invalid. Thus, where a patentee stated in his specification the principle of his invention, and that he proposed to unite lead and tin by pressure, but did not give the exact proportions in which they were to be used, nor the mode in which they were to be combined; and a subsequent patentee specified the proportions of the two metals, gave the details of the mode of working, and did not claim the production of the new material, except according to the directions given, it was held that as the earlier patent only stated a principle, the latter patent, as it did not claim the discovery of the principle, but only a new mode of carrying it into effect, was valid. (a)

If the patentee claims a principle to be carried into effect in any way in which it can be used, the claim is for the principle and the patent is bad. In the course of the argument of *Neilson v. Harford* (b) the plaintiff's counsel said that the patentee claimed every vessel and every shape of vessel in which air could be heated between the blowing apparatus and the furnace. Alderson, B., said: "Then I think that is a principle, if you claim every shape. If you claim a specific shape and go to the jury and say that which other people have adopted is a colourable imitation, then I can understand it. If you claim every shape you claim a principle. There is no difference between a principle to be carried into effect in any way

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If mode not pointed out, patent will be for principle, and invalid.

So if every mode of carrying principle into effect is claimed.

(a) *Betts v. Menzies*, 10 H. & C. 117; *Bovill v. Keyworth*, 7 El. & Bl. 735.

(b) 1 Webs. P. R. 355.

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you will and claiming the principle itself; you must detail some specific mode of doing it. Then the rest is a question for the jury." But it is not necessary to claim every mode which will succeed so long as some mode is pointed out. See the remarks of Lord Abinger in the same case, p. 356.

Additions to and improvements on machines good subject matter for a patent.

There was formerly a doubt as to whether there could be a patent for an addition to an old manufacture. This doubt rested entirely on *Bircot's case*, (a) where Lord Coke held that there could not be such a patent; but in *Boulton v. Bull*, (b) Eyre, C. J., said that the principle on which it was decided had not been adhered to; and Buller, J., said: "What were the particular facts of that case we are not informed, and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was but to put a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put was old. But, in truth, the arts and sciences at that period were at so low an ebb in comparison with that point to which they have since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times whenever the point has arisen the inclination of the Court has been in favour of the patent for the improvement, and the parties have acquiesced where the objection might have been brought directly before the Court."

In *Morris v. Bransom* (c) it was decided that an addition to an old stocking frame was the subject of a patent,

(a) 3 Inst. 184.

(b) 2 H. Bl. 463.

(c) Bull (N.P.) 76 c.; 1 Webs.

P. R. 51.

Lord Mansfield saying that the objection, that there could not be a patent for an addition, would if valid go to repeal almost every patent that was ever granted. And in *Hornblower v. Boulton*, (a) Grose, J., said that if *Bircot's case* were law it would set aside many patents for very ingenious inventions in cases where the additions to manufactures before existing are much more valuable than the original manufactures themselves, and that Lord Coke's opinion seemed to have been formed without due consideration, and was not well founded. The addition or improvement must be new and of benefit to the public. The law on this point was thus laid down by Buller, J., in *R. v. Arkwright*: (b) "In the case of an invention, many parts of a machine may have been known before, yet if there be anything material and new which is an improvement of the trade that will be sufficient to support a patent."

Addition or improvement must be new and of benefit to the public.

If it appears that any part of the invention which is claimed as an improvement is not so, the patent will be void as the Crown is deceived in the grant. (c) In *Morgan v. Seaward* (d) Parke, B., in considering this point said: "Upon the authorities we feel bound to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the Common Law,

Patent void if what claimed as new is not so, as Crown is deceived in grant.

(a) 8 T. R. 104.

(d) 2 M. & W. 561; M. & H.

(b) 1 Webs. P. R. 71.

60; 1 Webs. P. R. 196.

(c) *Losh v. Hague*, 1 Webs. P. R. 208.

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and such a grant is void not against the Crown merely, but in a suit against a third person. It is on the same principle that a patent for two or more inventions when one is not new is void altogether, as was held in *Hill v. Thompson* (a) and *Brunton v. Hawkes*, (b) 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 of 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 is maintainable upon it. (c)

Claim for improvements valid though discoveries made since claim.

The claim to a patent for invention is not affected by the circumstance that by subsequent discoveries improvements have been made which lead to results being obtained which could not be obtained by the original invention. Where the plaintiff's invention was described both in the title and in the specification as consisting in "improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through metallic circuits," and it was subsequently discovered by the defendant that the circuit need not be continuously metallic, but that the earth might be used as a connecting medium, it was contended in an action for infringement that the words "metallic circuit" would mislead a person who was in possession of improvements identical with those of the plaintiff, but which he intended to use in giving signals by non-metallic circuits.

(a) 2 B. Moo. 424; 8 Taunt. 339; *Huddart v. Grimshaw*, 1
375; 1 Webs. P. R. 237. Webs. P. R. 85; *Heath v. Smith*,

(b) 4 B. & Ald. 542. 3 El. & Bl. 256.

(c) *Barber v. Grace*, 1 Exch.

It was held, however, that the title did—the earth circuit not being publicly known—give sufficient notice to any person secretly acquainted with that discovery. In delivering the judgment of the Court of Common Pleas, Cresswell, J., said, “It appears to us reasonable to hold that a claim for a patent for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to the improvements claimed. (a)

A patent for an improvement on an existing patent is valid. (b) In *Crane v. Price* (c) Sir N. C. Tindal, C. J., said that upon reason and principle there did not appear to be any objection to such a patent, the new patent after the expiration of the old one would be free from every objection, and while the former existed the new one could be legally used by the public by procuring a licence from the original patentee or by purchasing the apparatus from him or some of his agents. (d)

Improvement
on existing
patent valid.

But if the improvements cannot be used without the machine for which the first patent has been granted, the patentees must wait until the original term has expired. (e)

It is a question for the jury to decide whether the im-

Value of im-
provement
question for
jury.

(a) *Electric Telegraph Co. v. Brett*, 10 C. B. 881.

(b) *Hill v. Thompson*, 3 Mer. 629; 1 Webs. P. R. 237; *Bovill v. Moore*, 2 Marsh. 211; *Lewis v. Davis*, 3 C. & P. 502; *Harmar v. Playne*, 11 East, 101.

(c) 1 Webs. P. R. 41

(d) See *Lister v. Lea*, 8 El. & Bl. 1017.

(e) *Ex parte Fox*, 1 V. & B. 67; *Lewis v. Davis*, 3 C. & P. 502; *Fox v. Dellestable*, 15 W. R. 194.

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provements claimed are trifling and insignificant and not worth a patent. (a)

Patent for a combination of known articles in new manner valid.

A patent may be granted for a combination of machinery or substances, all of which were known and in use previously so long as the combination is new, and useful. In *Boulton v. Bull*, (b) Buller, J., said that it is no objection to a patent for a mechanical or chemical discovery that the articles of which it is composed were known and were in use before, provided the compound article which is the object of the invention is new. (c)

“There are,” said Lord Ellenborough, “common elementary materials to work with in machinery, but it is the adoption of those materials to the execution of any particular purpose that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end and beneficial to the public, it is that species of invention which protected by the king’s patent ought to continue to the person the sole right of vending.” (d)

Where the patent was for “an improvement or improvements in the making or manufacture of elastic goods or fabrics applicable to various useful purposes,” and the invention consisted in the use of elastic threads or strands of India rubber covered with filaments wound round them, with yarns of cotton or other non-elastic materials placed alternately side by side as a warp and combining them

(a) *Losh v. Hague*, 1 Webs. P. R. 205.

(b) 2 H. Bl. 487.

(c) See also *Lukie v. Robson*, 2 Jur. 201.

(d) *Huddart v. Grimshaw*, 1 Webs. P. R. 86; *Bovill v.*

Moore, 2 Marsh. 211; *Hill v. Thompson*, 8 Mer. 629; 1 Webs.

P. R. 237; *Derosne v. Fairie*, *ib.* 154; *Gamble v. Kurtz*, 3

C. B. 425; *Bateman v. Gray*.

1 C. L. R. 514; *Cannington v. Nuttall*, L. R. 5 H. L. 205.

by means of a weft, when in extreme tension and deprived of their elasticity, so that a cloth was produced in which the non-elastic threads formed a limit up to which the elastic threads might be stretched, but beyond which they could not be stretched and therefore could not be easily broken, and the materials were old; but the jury found that the combination was new, the patent was supported. (a)

In *Bovill v. Keyworth* (b) the specification of a patent for improvements in manufacturing wheat and other grain into flour, claimed as the invention exhausting the dusty air when the same had been blown through the grinding surfaces of the mill stones from the chambers receiving the meal, by means of a blast of air. This invention consisted of the combination of a blast and an exhaust, both of which had been used separately in mills, and it was held to be the subject of a patent.

“If,” said Lord Westbury, “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.” (c)

A patent may be granted for a machine formed by the mere arrangement of common elementary mechanical materials, even if it produce no other results than have been previously accomplished by other mechanical arrangements and construction, if it appears that the results ob-

(a) *Cornish v. Keene*, 4 Scott, 337; 3 Bing. (N. C.) 588; 1 Webs. P. R. 517. And see *Carpenter v. Smith*, 1 Webs. P. R. 538.

(b) 7 El. & Bl. 725.

(c) *Foxwell v. Bostock*, 12 W. R. 725.

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tained are produced with greater expedition and economy, and are of a better quality. (a)

The discovery of a property in a combination of known articles for useful purposes may be the subject of a patent. Thus the discovery that the combination of copper and zinc of a certain quality in specified proportions for the purpose of making an alloy, which combination would be defeated by the introduction of any foreign ingredients, was held to be a good subject matter for a patent. (b)

Combination does not claim each part as new.

A patent for a combination is not a claim that each part of it is new, but on the contrary each part may be old, and yet a new and useful combination of such old parts may be valid. (c)

A valid patent for a process gives protection to each part that is new and material for the process without any express claim of particular parts, and although the parts of the combination are old. (d)

Combination of things partly old and partly new.

Test of novelty of combination.

A patent may be granted for a combination of old and new machinery. (e)

In order to test whether a part of a combination for which a patent is taken out is new, it ought to be considered whether a patent could be granted for the part by itself. (f)

And in order to discover whether the whole invention is new the proper mode is to take the specification alto-

(a) *Murray v. Clayton*, L. R. Bl. 1023; *Parke v. Stevens*, L. R. 7 Ch. 570. 8 Eq. 367; on app., L. R. 5 Ch.

(b) *Muntz v. Foster*, 2 Webs. 36.
P. R. 93; *Walton v. Potter*,
Webs. P. R. 604. (e) *Sellers v. Dickenson*, 5
Exch. 312; *Newton v. Grand*

(c) *Lister v. Leather*, 8 El. & *Junction Railway Co.*, *ib.* 331.

Bl. 1017. (f) *Parke v. Stevens*, L. R.

(d) *Lister v. Leather*, 8 El. & 5 Ch. 36.

gether, and see whether the matter claimed as a whole is new. (a) "I take it," said Lord Hatherley in *Cannington v. Nuttall*, (b) "that the test of novelty is this: Is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view."

A patent cannot be granted for the application of a well known machine to purposes analogous to the purpose to which it has already been applied, unless the mode of application is new. (c)

In *Kay v. Marshall* (d) the plaintiff claimed to have invented "new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances by power." The specification, after setting forth and describing the invention and in what manner the same was to be performed, claimed as the invention in respect of new machinery, for preparing flax, hemp, and other fibrous substances certain macerating vessels, and the trough of water described in the specification; and claimed as the invention in respect of improved machinery for spinning flax, etc., the trough for holding the rovings when taken from the macerating vessels, and placing the retaining rollers and the drawing rollers nearer to each other than they had ever been placed before. It was shown that before the date of the patent fibrous substances

Application of old machine to analogous purposes or new materials cannot be patented unless mode of application new.

(a) *Newton v. Grand Junction Railway Co.*, 5 Exch. 334.

(b) L. R. 5 H. L. 216.

(c) *Losh v. Hague*, 1 Webs. P. R. 208.

(d) 2 Webs. P. R. 36.

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had been spun at a shorter reach than two-and-a-half inches, but that it was not known that flax could be spun by means of maceration, as having a short fibre at a reach of two-and-half inches. It was held by the Court of Common Pleas on a case sent by Lord Langdale that there was not such an invention as to support a patent. Sir N. C. Tindal, C. J., said: "Now whether a patent can by law be taken out for placing the retaining rollers and the drawing rollers of a spinning machine, which machine itself was known, and in use before, within two inches-and-a-half of each other under the circumstances stated in the case is the real question between the parties, and we think it cannot." The case then went to the House of Lords, where the judgment of the Court of Common Pleas was affirmed. Lord Cottenham said, p. 82, "that if a man has discovered any means of using a machine which the world has not known before the benefit of, that he has a right to secure to himself by means of a patent, but if the mode was known before, then he cannot deprive the public of having the benefit of that which they enjoyed before."

In *Pow v. Taunton* (a) the patent was for the application of a nipping lever to the surface of a wheel for the purpose of making it revolve; and it was held that, though the application of the nipping lever might be new, it must be shown that the means essential for carrying the application into effect were new also. So in *Reg. v. Cutler* (b) it was held that the application of iron tubes coated with brass to form the tubular flues of steam boilers could not be supported as, although the application of the tubes was new, neither the tubes themselves nor the mode of applying them was new.

(a) 9 Jur. 1056.

(b) 2 C. & K. 215.

In *Harwood v. The Great Northern Railway Co.*, (a) the patent was for "improvements in fishes and fish joints for connecting the rails of railways." The material part of the specification was as follows: "The fishes are made with a groove or recess in their outer surfaces, which groove serves to receive the square heads of the bolts, and prevent them turning round when the nuts are screwed on or off. Washers are placed in the groove of the fish, which is next to the nut, so as to allow of the nuts being turned round; or the fish on this side may be made without the groove. The position of the bolts and nuts may be reversed if preferred, so that the nut may be prevented from turning round while the bolt is screwed into it. The groove renders the fish lighter for an equal strength or stronger for an equal weight of metal than a fish which is made of an equal thickness throughout. The top and bottom of each fish is a plane surface, and the parts of the rail with which they come in contact are also plane surfaces forming the same angle as the top and bottom surfaces of the fish. The fishes are thus made to fit into their places with greater facility than if these surfaces were of curved or irregular forms. If, however, the surfaces of the rails are curved, the fishes may be made to fit them."

It was proved that before the date of the patent the rails of railways had been connected by fishes and fish joints, attached to each side of the rails at the joints by means of bolts and nuts, but until the time of the patent, fishes for connecting the rails of railways had never been made with a groove or recess in their outer or lateral surfaces so as to receive the square heads of the bolts.

(a) 11 H. L. C. 654.

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It was also proved that double channelled iron had been used for fishing the beams of railway bridges. Lord Westbury, in moving the judgment of the House of Lords, said: "The question is whether there can be any invention of the plaintiff in having taken that thing which was a fish for a bridge, and having applied it as a fish to a railway. Upon that, I think, the law is well and rightly settled, for there would be no end to the interference with trade and with the liberty of adopting any mechanical contrivance if every slight difference in the application of a well known thing should be held to constitute ground for a patent. . . There is the familiar contrivance of the button to the button hole taken from the waistcoat or coat, which may be applied in some particular mechanical combination in which it has not hitherto been applied, to constitute that application the subject of a patent to be granted for a new invention. No sounder doctrine was ever established than . . . that you cannot have a patent for a well known mechanical contrivance, merely when it is applied in a manner or to a purpose which is not quite the same, but is analogous to the manner or to the purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied."

In *Jordan v. Moore*, (a) it was decided that the combination of iron and timber in the construction of ships, being already well known and commonly used, a patent

(a) L. R. 1 C. P. 635.

for a peculiar combination of those two materials could not be sustained; and in *Mackelcan v. Rennie*, (a) it was said by the Court, though the point was not expressly decided, that the use of iron instead of timber in the construction of floating docks was not an invention for which a patent could be granted.

A patent cannot be taken out for the use of a machine known before, in a manner known before, so as to gain a particular advantage. (b)

Use of old machine in old manner cannot be patented.

In *Tetley v. Easton*, (c) the patent was for an invention of "certain improvements in machinery, for raising and impelling water and other liquids." The specification described the machine, which was a pump working by centrifugal force, and the part of the machine upon which the question arose was thus described: "In the interior of the case *gg* is placed a hollow wheel having hollow spokes or radial arms of which *qq* are two, *rr* I call a nave, which is hollow; and *ss* are two hollow shafts, one at each side of the wheel." "In reference to the hollow wheel, I do not confine myself to the number or to the use of hollow spokes, but in some cases propose to substitute circular discs with a narrow water channel between, and a valve or flexible valve or valves on the circumference so as to have a channel or channels in the interior thereof for the passage of liquids, and adapted to neutralize the effects of suction by having a corresponding or proportionate degree of suction each side." The patentee after disclaiming any exclusive right to wheels when consisting of hollow spokes or of a channel or

(a) 13 C. B. (N. S.) 61. See *Arnold v. Bradbury*, L. R. 6 Ch. 706.

(b) *Ralston v. Smith*, 11 H. L. C. 223.

(c) 2 C. B. (N. S.) 706.

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channels between discs, when considered apart or separate from the machinery described, claimed as his invention "the means of increasing the action of the machine by causing the liquid to enter the wheel on both sides. It was proved that the form of the patentee's wheel was not new and that the plan of admitting water at both sides for the purpose of being projected forward by centrifugal force was not new, it having been made known by a previous specification of a patent for a similar purpose. Cresswell J., said: "It may be true that the plaintiff first explained the full benefit obtained by so introducing it, but the discovery that a particular advantage was obtained by the use of a wheel known before, in a manner known before, cannot be called an invention or application to sustain a patent."

Nor application of known machine and new material.

In the case of *The Patent Bottle Envelope Co. v. Seymour*, (a) Willes, J., said that the application of a well known tool to work previously untried materials or to produce new forms is not the subject matter of a patent, and that to hold the contrary might tend to produce oppressive monopolies in the application of old and well known implements to new materials without any further novelty or merit than discovery of the material or the form into which it is to be worked; and that such a discovery was not one of a new manufacture within the statute, and that a patent for it alone could not be maintained. When a patent was taken out in the year 1853 for "certain improvements in preparing, dressing, finishing, and winding cotton and linen yarns or threads, and in the machinery connected therewith," the specification of which stated that "the yarns or

(a) 5 C. B. (N. S.) 164.

thread to be dressed are wound upon a roller or beam at one end of the machine, pass through the operation of sizing as in common use, and from thence to the corresponding beam at the opposite or finishing end of the machine ;” and in the year 1856 a patent was taken out for “an improvement in finishing yarns of wool or hair, and in the finishing of woven fabrics or piece goods,” a similar process being described by the specification, except that no mention was made of sizing, it was held that sizing was not a part of the process or apparatus patented in 1853, and that the latter patent was void as being for the application of the same machinery to a new material as had already been applied to other material with the same result. (a)

A mere improvement in performing an operation already well known and long practised cannot be the subject of a patent. In *Brunton v. Hawkes* (b) the invention consisted in casting the two flukes of an anchor in one piece; previously the two flukes had been welded to the shank, and the patent was held to be void. “A patent,” said Abbott, C. J., “for a machine, each part of which was in use before, but in which the combination of different parts is new and a new result is produced, is good, because there is novelty in the combination. But here the case is perfectly different; formerly three pieces were united together, the plaintiff only unites two; and if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should

Mere improvement in existing process not subject of patent.

(a) *Brook v. Aston*, 8 E. & B. 478; affd., 5 Jur. (N. S.) 1025; 28 L. J. Q. B. 175. See also *Bush v. Fox*, 5 H. & C. 707; *Willis v. Davison*, 1 N. R. 234; *Rushton v. Crawley*, L. R. 10 Eq. 522. (b) 4 B. & Ald. 540.

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have thought it a good ground for a patent; but unfortunately the mode was well known and long practised. I think a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose."

In *Ormson v. Clarke*, (a) it was held that casting tubular boilers in one piece, they having previously been made in several pieces, was not the subject of a patent. In *Horton v. Mabon*, (b) the patentee claimed as his invention the substitution of double angle iron, for two pieces of single angle iron in the formation of hydraulic cups or points to telescopic gas holders. It was well known that the cups might be made by riveting two pieces of single angle iron to a plate, and it was held that the substitution of double angle iron was not an invention for which a patent could be granted. Willes, J., said: "No doubt a new combination of old machinery or instruments, whereby a new and useful result is obtained, may be the subject of a patent. But there must be some invention. There is none here. By making a thing in one piece instead of as before uniting several pieces together the patentee no doubt effects a considerable saving of labour and expense. The merit is due to the person who first produced the article called double angle iron. That is old and well known, and had long been applied to purposes not dissimilar to that to which the present plaintiff applies it. The mere fact of its application to gasholders rendering their construction better or cheaper does not constitute a subject matter of a patent."

There must be
some inven-
tion

(a) 14 C. B. (N. S.) 475.

(b) 12 C. B. (N. S.) 437
affd. 16 C. B. (N. S.) 141.

The invention must consist either in some new combination of old existing materials or else in the discovery of something that did not exist before. Thus, in *Thompson v. James*, (a) it was held that the substitution of steel for whalebone hoops for distending petticoats was not the subject of a patent. (b) "The use of a new material," said Sir R. Malins, V. C., "to produce a known result is not the subject matter of a patent, but there must be some invention, something really new, something more valuable to the public than the simple use of a new material to produce a known article." (c)

If the new application of any machine or process lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought or study; it may be the subject of a patent. (d)

If the invention is in reality a modification or alteration of the original idea, and the result produced is new and useful, then it appears that a patent may be granted, although the machine or the process is old. Thus in *Steiner v. Heald*, (e) a known process applied to fresh madder, was applied by the patentee to "spent madder," which, before the date of his patent was known to contain some colouring matter, but no process was known by which it could be extracted, and it was consequently thrown away as useless. The result of the invention was to render the "spent madder" valuable. It was held that though the properties of fresh and spent madder

Some application of thought and study necessary.

A real alteration in the original idea will support a patent.

(a) 32 Beav. 573.

(b) And see *White v. Toms*, 37 L. J. Ch. 204.

(c) *Rushton v. Crawley*, L. R. 10 Eq. 522.

(d) *Penn v. Bibby*, L. R. 2 Ch.

127; *Harwood v. Great Northern Railway Co.*, 2 B. & S. 208.

(e) 6 Exch. 607.

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might be the same or might be different, it did not follow as a matter of law that the plaintiff's patent was void, but that it was a question for the jury whether the invention was a new manufacture. (a)

In *Newton v. Vaucher*, (b) the defendant obtained a patent for packing parts of hydraulic engines or machines, or rendering the same fluid tight. The invention consisted in the application of soft metal instead of elastic substances, which had been in use before for enabling the axis of the machine to work in a case and to be water, air, and steam tight. Nothing was said as to friction or bearings. After the date of the defendant's patent the plaintiff discovered that when there was pressure upon soft metal, friction was in a great degree diminished, and he took out a patent for the application of this discovery to improvements in the construction of boxes for the axles or axle-trees of locomotive engines or carriages, and for the bearings of machinery in general. It was held that the patent was for a new principle embodied in a new machine, that the application of the soft metal differed essentially from that of the specification, and that the patent was valid.

Change in order of process may be good subject matter.

Where the invention is for a mere process, any change in the order of the process constitutes a new manufacture. Thus, where the invention was the rendering fabrics waterproof, but at the same time leaving them pervious to air by immersing the fabric in a mixture of a solution of alum with carbonate of lime and then in a solution of soap, and it appeared that before the plaintiff's patent a solution of alum and soap was made in which the

(a) See also *Derosne v. Fairie*,
1 Webs. P. R. 154.

(b) 6 Exch. 859.

fabric was immersed, it was held that the plaintiff's patent was good. (a) So, where the use of soap and water in the process of felting, instead of acidulated water, was known, and the use of rollers was also known, it was held that a patent for the application of soap and water in combination with rollers was a good subject matter for a patent. (b)

The adaptation of a known substance to a purpose to which it has never before been applied, and the properties and qualities of which for the purpose of being adopted to the particular purpose have never been known or used before, is the subject of a patent. In *Walton v. Potter* (c) it was held that the adaptation of caoutchouc as a substitute for the fillets or sheets of leather which are commonly used in the construction of cards, for carding wool, cotton, silk and other fibrous substances was a new invention. (d)

Adaptation of known substance to new purpose is subject of a patent.

An invention or a discovery by means of which some part of a machine or of a process may be omitted is a useful invention, and the subject of a patent. (e) In *Russell v. Cowley*, (f) the invention was for the manufacture of tubes for gas and other purposes without the use of a maundril, which had always been previously used, and in *Booth v. Kennard* (g) the patent claimed the making gas directly from seeds and other oleaginous

Omission of part of process may be subject of patent.

(a) *Halliwell v. Dearman*, 1 4 Scott, 337; 3 Bing. (N. C.) Webs. P. R. 401. 570; 1 Webs. P. R. 517.

(b) *Allen v. Rawson*, 1 C. B. 551. (e) *Minter v. Mower*, 6 A. & E. 735; 1 Webs. P. R. 139.

(c) 4 Scott (N. R.) 145; 3 M. & Gr. 438; 1 Webs. P. R. 604. (f) 1 C. M. & R. 864; 1 Webs. P. R. 463.

(g) 1 H. & N. 527.

(d) And see *Cornish v. Keene*,

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substances, instead of making it from oil obtained from those substances, and thus got rid of one process. In both these cases it was held that, assuming the invention to be new the patent could be sustained. In *Wallington v. Dale*, (a) it appeared that in the manufacture of gelatine before the date of the plaintiff's patent the hides of animals were cut in large pieces and submitted to the action of caustic alkali, or else were reduced to pulp in a mill similar to a paper mill, and that blood was employed for the purpose of purification. The patentee's invention consisted in reducing the hides to thin slices or shavings, so as to retain a texture which could be dealt with mechanically without destroying the fibre, and by this means he avoided the use of acids or alkalis or blood, and the patent was held to be good.

New use of old materials.

A process by which old materials can be used again in the same manufacture is a good subject for a patent. (b)

A process, which makes a chemical curiosity available for practical purposes, may be patented.

A patent may be taken out for a discovery or an invention by means of which any substance previously known as a chemical curiosity may be supplied to the public for useful and economical purposes. (c)

In *Young v. Fernie* (d) the patent was for "improvements in the treatment of certain bituminous mineral substances and matters or products therefrom," and the invention consisted in treating bituminous coals in such manner as to obtain an oil containing paraffine (which

(a) 7 Exch. 888.

(b) *Hills v. The Liverpool Gas Light Co.*, 9 Jur. (N. S.) 140; *Hills v. The London Gas Light Co.*, 5 H. & N. 313; *Steiner v. Heald*, 6 Exch. 607.

(c) *Stevens v. Keating*, 2 Webs.

P. R. 189; *Sellers v. Dickinson*, 5 Exch. 326; *Bewley v. Hancock*, 6 D. M. G. 391.

(d) 4 Giff. 577.

was called paraffine oil) and from which oil paraffine was obtained. The coals which were deemed to be best fitted for this purpose were such as are usually called parrot coal, cannel coal and gas coal, as they yielded, upon distillation at a high temperature, olefiant and other highly illuminating gases in considerable quantity. Paraffine was first discovered by Dr. Reichenbach in 1830, and was first obtained from beechwood tar. What first attracted the special attention of chemists was, that paraffine, though a white solid substance, was composed of exactly the same elements in exactly the same proportion as olefiant gas. It had been supposed by some persons that paraffine might be obtained from certain schists, but the plaintiff's experiments led him to conclude that the proper materials were the cannel and highly bituminous coals. The principle of the plaintiff's discovery was the degree of heat at which the distillation was to be carried on, and this was substantially the process patented. It was proved that many practical and manufacturing chemists had been endeavouring before the plaintiff's patent to manufacture paraffine oils so as to supply the market, but that none had been successful.

In a book published by Dr. Reichenbach in 1854 occurred the following passage: "So remained paraffine until this hour, a beautiful item in the collection of chemical preparations, but it has never escaped from the rooms of the scientific man." Sir John Stuart, V.C., said: "Something therefore remained to be ascertained in order to the useful application of this article for economical and commercial purposes. This illustrates the important distinction between the discoveries of the merely scientific chemist and of the practical manufacturer

The question is whether anything remained to be discovered.

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who invents the means of producing in abundance, suitable for economical and commercial purposes, that which previously existed as a beautiful item in the cabinets of men of science.

The law looks to the inventor who supplies useful article.

Chemical and mechanical inventions widely different.

“What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for useful and economical purposes with an article which was previously little more than the ornament of a museum. . . . Inventions in mechanics are as widely different from inventions in economical chemistry as the laws and operations of mechanical forces differ from the laws of chemical affinities, and the results of analysis and experiment in the comparatively infant science of chemistry with its boundless field of undiscovered laws and undiscovered substances.”

In *Higgs v. Goodwin* (a) it was held that a patent for “treating chemically the collected contents of sewers and drains in cities, towns and villages, so that the same may be applicable to agricultural and other purposes,” by employing hydrate of lime for precipitating the animal and vegetable matter contained in the sewage water, could be supported as a process producing a new result,—manure in a particular form.

In *Hills v. The London Gas Light Co.* (b) the patent was for “an improved mode of compressing peat and of manufacturing gas and of obtaining certain substances applicable to purifying the same.” It was known before the date of the patent that hydrated oxides of iron would absorb sulphuretted hydrogen; but it was not known that they could be practically used in the purification of coal gas from sulphuretted hydrogen. It was objected that the mere application of the hydrated oxides to absorb

(a) El. Bl. & El. 529.

(b) 5 H. & N. 312.

the sulphuretted hydrogen from coal gas was not the subject of a patent, as that property of it was previously well known, but it was held that as the patentee said that he claimed the application in the manufacture of gas in the way he had described, and had shown how it might be used, the patent was good.

A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance, valuable for medical or other qualities, is a good subject matter for a patent. (a)

There may be several patents having the same object in view so long as the modes of attaining the object are different. (b) "There can be no doubt whatever," said Sir N. C. Tindal, C. J., in *Walton v. Potter*, (c) "that although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has by dint of his own genius and discovery after a patent has been obtained been able to give to the public without reference to the former one or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. In *Palmer v. Wagstaff* (d) Sir F. Pollock, C. B., said, "If any other person can discover a method of producing the same effect by a totally different means, he has a right to do so." The invention must be complete in itself and not require the use of another person's invention. (e)

There may be several patents with the same object, mode must be different.

Invention must be complete.

(a) Per Lord Cranworth in *Bewley v. Hancock*, 6 D. M. G. 391.

(b) *Huddart v. Grimshaw*, 1 Webs. P. R. 92.

(c) 1 Webs. P. R. 591.

(d) 9 Exch. 501.

(e) *Woodcroft's Patent*, 2 Webs. P. R. 27

In *Gullett v. Hague* (a) the patent was for "improvements in evaporating sugar." The specification described the invention to consist in a method or apparatus by which I am enabled to evaporate liquids and solutions at a low temperature. And my invention and improvement consist in forcing by means of bellows, or any other blowing apparatus, atmospheric or any other air, either in a hot or cold state, through the liquid or solution subjected to evaporation, and this I do by means of pipes whose extremities reach nearly (or within such distance as may be found most suitable under peculiar circumstances) to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, the other extremities of such pipes being connected with larger pipes which communicate with the bellows, or other blowing apparatus, which forces the air into them." A prior specification was proved in which the same object was attained by means of a pipe or pipes, perforated with a number of small holes, coiled at the bottom of the boiler. It was held that though the object of the two patents was the same, the mode of effecting the object was different; and that as the latter patent was for the mode or apparatus, it was not void because of the prior specification. (b)

The question as to whether an invention is a new manufacture or not is one of fact for the jury. (c)

(a) 2 B. & Ad. 370.

(b) And see *Booth v. Kenward*, 2 H. & N. 84; *Seed v. Higgins*, 8 H. & C. 550; *Losh v. Hague*, 1 Webs. P. R. 207; *Steiner v. Heald*, 2 C. & K. 1022; 6 Exch. 607.

(c) *Losh v. Hague*, 1 Webs. P. R. 207; *Steiner v. Heald*, 6 Exch. 607; *Spencer v. Jack*, 11 L. T. (N. S.) 242; *Kay v. Marshall*, 5 Bing. (N. C.) 492; *Saunders v. Aston*, 3 B. & Ad. 881; *Manton v. Parker*, Dav.

An invention must not only be new but it must also be useful. This condition is not imposed by the Statute of Monopolies (21 Jac. I. c. 3, s. 6), which only requires that the invention shall be new, not that it shall be useful; and if it is proved to be new then the condition imposed by the statute is complied with; (a) but it is a condition required by the common law, for the public have a right to receive a meritorious consideration in return for the protection which the patent claims. (b) "I think," said Ashurst, J., "that as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law and would be a reason against it, were it not for the advantages which the public derive from the communication of the invention after the expiration of the term for which the patent is granted." (c)

"A grant of a monopoly," said Parke, B., in *Morgan v. Seaward*, (d) "for an invention which is altogether useless may well be considered as 'mischievous to the state, to the hurt of trade, or generally inconvenient,' within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly, without obliging the person making use of it to purchase the useless invention; and on a review of the cases it may

P. C. 327; *De la Rue v. Dickinson*, 7 El. & Bl. 738; *Hill v. London Gas Light Co.*, 27 L. J. Ex. 60; *Bush v. Fox*, 5 H. L. C. 707.

(a) *Lewis v. Marling*, 4 C. & P. 58; 10 B. & C. 27; 1 Webs. P. R. 497.

(b) *Boulton v. Bull*, 2 H. Bl. 477.

(c) *Turner v. Winter*, 1 T. R. 605; 1 Webs. P. R. 8.

(d) 2 M. & W. 562; M. & H. 61; 1 Webs. P. R. 197.

be doubted whether the question of utility is anything more than a compendious mode introduced in comparatively modern times of deciding the question whether the patent be void under the Statute of Monopolies."

In *R. v. Arkwright*, (a) Buller, J., said that the question for the jury to consider was whether the improvement for which the patent was taken out was material or useful; and in *Morgan v. Seaward*, (b) Alderson, B., said that if the invention was useful, it was a subject to be supported by a patent, and if it was not useful, then it was no subject to be supported.

In *Manton v. Parker*, (c) the patent was held to be void, as the utility of the invention wholly failed. (d)

A patent which is taken out merely for the purpose of obstructing subsequent improvements, and to prevent the introduction of other inventions adapted to the particular subject to which it is applicable, cannot be supported. (e)

The amount of utility is not to be considered, it is sufficient if there is some utility. In *Morgan v. Seaward*, (f) Alderson, B., said: "It is not material that the improvement should be great. It is sufficient if there is an improvement at all." (g)

Amount of utility not considered.

Invention may fail in unessential particulars.

If the invention is new and useful on the whole, it is

(a) 1 Webs. P. R. 73.

(b) 1 Webs. P. R. 172.

(c) Dav. P. C. 327.

(d) See also *Manton v. Manton*, Dav. P. C. 349; *Bovill v. Moore*, *ib.* 399; *Huddart v. Grimshaw*, 1 Webs. P. R. 85; *Russell v. Cowley*, *ib.* 467; 1 C. M. & R. 874; *Hill v. Thompson*, 3 Mer. 629; 1 Webs. P. R. 237; *Min-*

ter v. Wells, 1 Webs. P. R. 129; *Brunton v. Hawkes*, 4 B. & Ald. 541.

(e) *Crossley v. Potter*, Macr. 245.

(f) 1 Webs. P. R. 172.

(g) *Brits v. Walker*, 14 Q. B. 374; *Stead v. Williams*, 1 Webs. P. R. 134.

no objection that it fails in some particular, if that has not been claimed as essential, (a) and there is no false suggestion. (b)

Where the patent was for an improved machine for shearing woollen cloths by means of rotary cutters going from list to list, and the plaintiff claimed in his specification, among other things, the application of a proper substance to brush the cloth, which turned out to be useless, but did not claim it as essential, Lord Tenterden, C. J., said: "As to the objection on the ground that the application of a brush was claimed as part of the invention, adverting to the specification, it does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent, they had made a machine to which the brush was affixed, but before any machine was made for sale, they discovered it to be unnecessary. I agree that if the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void, because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be so. Several of the cases already decided have borne hardly on the patentees, but no case has hitherto gone the length of deciding that such a claim renders a patent void, and I am not disposed to

(a) *Haworth v. Hardcastle*, 1 Bing. (N. C.) 182; 1 Webs. P. R. 480; *Boulton v. Bull*, 2 H. Bl. 498; *Neilson v. Harford*, 8 M. & W. 806; 1 Webs. P. R. 316; *Huddart v. Grimshaw*, Dav. P. C. 265.
(b) *Morgan v. Seaward*, 2 M. & W. 563.

make such a precedent." And Bayley, J., said: "Now at the period when this specification was made, the plush (the substance used) was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad on the ground that this was a deception, but if he thought that it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection." (a)

It is not necessary that a patent should be so useful as to exclude every other means of attaining the same end, it is sufficient, if on any occasion it is useful. (b)

It is for the jury to decide whether or not the invention is useful, (c) and it is not necessary to prove that the invention has actually been tried and found to answer, but the jury may accept the evidence of scientific persons that such an invention would be useful. (d) The fact of an invention not getting into use is a presumption against its utility. (e)

Question of utility is for the jury to decide.

(a) *Lewis v. Marling*, 4 C. & P. 57; 10 B. & C. 22; 1 Webs. P. R. 495. *Hardcastle*, 1 Bing. (N. C.) 182; 1 Webs. P. R. 480; *Tetley v. Easton*, Macr. 63.

(b) *Tetley v. Easton*, Macr. 63.

(d) *Neilson v. Harford*, 1 Webs. P. R. 316.

(c) *Lewis v. Davis*, 3 C. & P. 502; *Bloxam v. Elsee*, 1 C. & P. 565; 6 B. & C. 173; *Haworth v.*

(e) *Morgan v. Seaward*, 1 Webs. P. R. 186.

CHAPTER IV.

OF THE SPECIFICATION.

ALL letters patent are now granted upon the express condition that they shall be void if the patentee does not particularly describe and ascertain the nature of his invention and in what manner the same is to be performed, by an instrument in writing, called a specification, and cause the same to be filed in the office for filing specifications within six calendar months, next and immediately after the date of the letters patent. (a)

CHAP. IV.

Condition voiding letters patent if specification not accurate.

It is of the greatest importance that the specification should give the most ample and accurate description of the invention, for the description of the invention is to be taken from it and not from the patent. (b)

Accuracy important.

In *Morgan v. Seaward*, (c) Alderson, B., said: "It is absolutely necessary that the patentee should state in his specification not only the nature of his invention but how that invention may be carried into effect; unless he is required to do that, monopolies could be given for fourteen years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is in order that other persons may know the prohibited ground, and in order that the public may be made acquainted with the means by

(a) 15 & 16 Vict. c. 83, s. 9. 1 Webs. P. R. 60.

(b) *Arkwright v. Nightingale*, (c) 1 Webs. P. R. 173.

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Object of specification is to enable public to use invention at expiration of term.

which the invention is to be carried into effect." (a) Absolute precision is of course not practicable. (b) The object of the specification is that the invention shall be so described that after the term has expired the public shall have the benefit of it, (c) and the specification must so far describe the invention as to enable any person of ordinary skill to make the machine or perform the process. (d) In *R. v. Arkwright*, (e) Buller, J., said: "A man to entitle himself to the benefit of a patent for a monopoly must disclose his secret and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted, for the end and meaning of the specification is to teach the public after the term for which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it, and unless the discovery be true and fair the patent is void;" and in *Liardet v. Johnson* (f) it was said that one principal question on patents is, whether the specification is sufficient to enable others to make it up, for the meaning of it is that others may be taught to do the thing for which the patent is granted, so that the public may have the benefit of the discovery when the term has expired. (g)

(a) And see *Morton v. Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 719; *Thomas v. Welch*, L. R. 1 C. P. 201.

(b) *Boulton v. Bull*, 2 H. Bl. 493.

(c) *Arkwright v. Nightingale*, 1 Webs. P. R. 61.

(d) *Stead v. Williams*, 2 Webs. P. R. 135; *Betts v. Menzies*, 8 El. & Bl. 937.

(e) 1 Webs. P. R. 66.

(f) Bull (N. P.) 76; 1 Webs. P. R. 53.

(g) See also *Newberry v. James*, 2 Mer. 446; *Hills v. London Gaslight Co.*, 5 H. & N. 340; *Ralston v. Smith*, 9 C. B. (N. S.) 117; *Holmes v. The London and North-Western Railway Co.*, Macr. 16.

The specification is the price that the inventor pays for the patent privileges. (a)

It must describe the same invention as the patent, (b) and the patent will be void if the inventor attempts by his specification to include matters that are not of his own actual invention.

In *Hill v. Thompson*, (c) Lord Eldon said: "Not only must the invention be new and useful, and the specification intelligible, but the specification must not attempt to cover more than that which being both a matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent." (d)

In *Campion v. Benyon*, (e) a patent was obtained for a "new and improved method of making and manufacturing double canvas and sail-cloth, with hemp and flax, or either of them, without any starch whatsoever." The specification described the invention to consist in an improved texture or mode of twisting the threads, to be applied to the making of unstarched cloth. It was proved that canvas had been woven without starch before the date of the letters patent, and it was held that the patent was void as being taken out for more than the patentee had really discovered, and in *Huddart v. Grimshaw* (f) Lord Ellenborough said, that if a patentee in stating the means by which the invention is to be used; oversteps his right, and appropriates more than is his own, he cannot avail himself of the benefit of the patent.

Specification is price paid by inventor for patent. Must describe same invention as patent, and not attempt to include matters not of patentee's invention.

(a) *Walton v. Potter*, 1 Webs. P. R. 595; *Gibson v. Brand*, *ib.* 629; *Morgan v. Seaward*, *ib.* 173; *Wood v. Zimmer*, Holt (N. P.) 60; 1 Webs. P. R. 83.

(b) See the judgment of Abbott, C. J., in *R. v. Wheeler*, 2 B. & Ald. 251.

(c) 3 Mer. 626; 1 Webs. P. R. 237.

(d) And see *Rushton v. Crawley*, L. R. 10 Eq. 527.

(e) 6 B. Moo. 71; 3 Brod. & Bing. 5.

(f) 1 Webs. P. R. 86.

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Specification
must give best
mode of work-
ing known to
the patentee.

The specification must give all the inventor's knowledge to the public, and if the patentee knows a better mode of working than that which he gives to the public, the specification will be void. (a) "A man," said Pollock, C. B., "has no right to patent a principle, and then give the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it." (b) Where a substance directed to be used contained foreign matter which was injurious, and the specification did not show any method of removing it, and it was not generally known how it could be removed, the specification was held insufficient. (c)

The rule was thus laid down by Gibbs, C. J., in *Wood v. Zimmer*: (d) "A man who applies for a patent and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The 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." In this case the specification described a mode of making verdigris, but it appeared that the patentee had been in the habit of clandestinely using aquafortis, by means of which the process was hastened, and it was held that the speci-

Omission of
material part
of process bad.

(a) *Walton v. Bateman*, 1
Webs. P. R. 622.

(b) *Tetley v. Easton*, Macr. 76.
And see *Sturtz v. De la Rue*,
5 Russ. 322; 1 Webs. P. R.

83 n.

(c) *Derosne v. Fairie*, 2 C. M.
& R. 476; 1 Gale, 109; 1 Webs.
P. R. 157.

(d) *Holt* (N. P.) 60; 1 Webs.
P. R. 83.

fication was void. In *Lewis v. Marling*, (a) Bayley, J., said, "To support a patent it is necessary that the specification should make a full disclosure to the public. If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad; but if he makes a full and fair communication, as far as his knowledge extends, he has done all that is required."

In *Morgan v. Seaward*, (b) Alderson, B., said, "If a 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," and referred particularly to the case of *Liardet v. Johnson*, (c) where the patentee omitted what was very necessary for tempering steel, namely rubbing it with tallow; and Lord Mansfield held the patent to be void on that account.

Where a patent was taken out for "improvements in floating docks," and it appeared that the construction of floating docks was not novel, but the plaintiff alleged that his invention did not consist in the construction of floating docks, but in the application of iron so as to form air-tight and water-tight chambers, it was held that as there was no mention of iron in the specification, the plaintiff had not complied with the conditions of the letters patent by duly describing the nature of his invention, and the manner in which it was to be carried into effect, and that the patent was therefore void. (d)

But the specification will not be bad if the omission is slight, and goes only to the degree of the benefit conferred by the invention; and it will be sufficient if a work-

Omission not fatal if it goes only to the degree of benefit.

(a) 4 C. & P. 57; 10 B. & C. 26; 1 Webs. P. R. 496.

(c) Bull (N. P.) 76; 1 Webs. P. R. 53.

(b) 1 Webs. P. R. 175.

(d) *Mackelcan v. Rennie*, 13 C. B. (N. S.) 59.

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man is able to construct a machine that would be productive of some benefit. (a)

Specification bad if unnecessary matters stated.

If anything is stated in the specification as being material which is not so, it will be void, as the consideration of the grant has failed in part. (b)

In *Savory v. Price*, (c) the patent was "for a method of making a neutral salt or powder possessing all the properties of the medicinal spring at Seidlitz under the name of Seidlitz Powders." The specification gave recipes for preparing the ingredients to be used, and directed how they were to be mixed. It was proved that the result obtained by following the specification was new and useful, but it appeared that the ingredients were well known, and were sold in chemists' shops before the date of the patent. It was held that the specification could not be supported. Abbot, C. J., said, "It is the duty of a patentee to specify the plainest and most easy way of producing that for which the patent is granted, and to make the public acquainted with the mode which he himself adopts. By reading this specification we are led to suppose a laborious process necessary to the production of the ingredients, when in fact we might go to any chemist's shop and buy the same things ready made. The public are misled by this specification, which tends to make people believe that an elaborate process is essential to the invention."

(a) *Neilson v. Harford*, 1 Webs. P. R. 322; *Househill Iron Co. v. Neilson*, 1 Webs. P. R. 695; *Macnamara v. Hulse*, Car. & M. 471.

(b) *Huddart v. Grimshaw*, 1 Webs. P. R. 93; *Bloxam v. Elsee*, 6 B. & C. 178; *Hill v. Thompson*, 8 Taunt. 401; 2 B.

Moo. 242; 1 Webs. P. R. 244; *R. v. Arkwright*, 1 Webs. P. R. 70, where the specification stated ten different instruments, and it appeared that four only were necessary.

(c) *Ry. & Moo.* 1; 1 Webs. P. R. 83.

So if a patentee can only make the article specified with two or three of the ingredients named, and he has inserted others which will not answer the purpose, the patent will be avoided. Thus, where the specification directed different kinds of salts to be used, and it appeared that one of them only would produce the required effect, the patent was held to be void, (a) and where the specification directed the use of "the finest and purest chemical white lead," and it appeared that no such substance was known in the trade by that name, but that white lead only was known, the specification was held to be bad. (b)

If the patentee makes the article with cheaper materials than those he has named in the specification, although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit from it which he himself does. (c)

If a whole class of substances are stated as being useful and one of them is not, this will mislead and the patent will be void. (d)

In *Stevens v. Keating*, (e) the specification of a patent for "a certain process or method of combining various materials so as to form stuccoes, plasters or cements, and for the manufacture of artificial stones, marbles, and

Cheaper materials.

Class of substances, some not useful.

(a) *Turner v. Winter*, 1 T. R. 606; 1 Webs. P. R. 80.

(b) *Sturtz v. DelaRue*, 5 Russ. 322; 1 Webs. P. R. 83 n. See also *Derosne v. Fairie*, 2 C. M. & R. 476; 1 Gale, 109; 1 Webs. P. R. 163; *Lewis v. Marling*, 10 B. & C. 25; 4 C. & P. 67; 1 Webs. P. R. 493.

(c) *Turner v. Winter*, 1 T. R. 606; 1 Webs. P. R. 80.

(d) *Bickford v. Skewes*, 1 Q. B. 938; 1 Webs. P. R. 218; *Crossley v. Potter*, Macr. 246.

(e) 2 Exch. 772; 2 Webs. P. R. 192.

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other like substances used for buildings, decorations, or other similar purposes," described the invention to consist in producing certain hard cements of combinations of the powder of gypsum, of powder of limestone, and of the powder of chalk, with other materials, such combinations being, when produced according to the patentee's invention (subsequently to their being mixed) submitted to the action of heat. The process or method of making a cement from gypsum was described as consisting in uniting powdered gypsum with alkali (such as best American pearlsh) dissolved in water, the solution to be neutralized with acid, sulphuric acid being the best for the purpose; keeping the solution in agitation, and adding acid gradually until effervescence ceased. A certain proportion of water was then to be added, varying with the nature of the alkali used, powder was to be added until the mixture was of a consistence suitable to be cast or moulded into bricks or other forms which were to be heated to a red heat in a reverberatory furnace. The method of making cement from limestone and chalk did not materially differ from the above process. After describing the manner in which the cement was to be used, the specification concluded by stating that as other alkalies and acids besides those mentioned would answer the purposes of the invention, though not so well as the acid and alkali specifically mentioned, the patentee claimed as his invention the process of mixing the powdered materials, alkalies and acids as described, and subsequently burning them. It was held that the specification was bad, for either the inventor claimed all acids and alkalies, or all acids and alkalies that would answer the purpose. If the claim were for all acids and alkalies, it was bad, as there were some which would not answer

the purpose. If for those only which would answer the purpose, then it was bad in consequence of not stating those which would answer, and distinguishing them from those which would not.

Hills v. The London Gas Light Company, (a) is another case to the same effect. A patentee in the specification of a patent dated 1840, after speaking of the use of black oxide of manganese for purifying gas, continued, "The same effect may be produced by the application of the oxide of zinc and the oxide of iron treated precisely in the way above described." It was held that assuming that the patentee meant to claim all oxides of iron for purifying gas, inasmuch as some would not answer, the Court could not say as a measure of law that a patent could not be had by a person who afterwards discovered that precipitated hydrated oxides were those which it was proper to use.

But a specification will not necessarily be avoided if it contain unnecessary matter, so long as the public are not misled, as the unnecessary matter may be treated as superfluous. (b)

Unnecessary matters may be treated as superfluous.

In *Lewis v. Marling* (c) Parke, B., said that "the patent will not be void because the patentee claims to be the inventor of a certain part of the machine not described as essential, and which turns out not to be useful." (d)

It is for the jury to say whether or not any particular part of the process is a material part of the invention. (e)

Materiality of process question for jury.

It is not necessary to claim all the substances which will answer the purpose of the invention if the public are

Not necessary to claim all

(a) 5 H. & N. 312.

(d) See *ante*, p. 74.

(b) *Boulton v. Bull*, 2 H. Bl. 493.

(e) *Huddart v. Grimshaw*, 1 Webs. P. R. 94; *Beard v. Egerton*, 8 C. B. 166.

(c) 10 B. & C. 25; 4 C. & P. 57; 1 Webs. P. R. 493.

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useful substances if public not deceived.

not misled. In *Bickford v. Skewes* (a) the specification of a patent instrument called "the Miners' Safety Fuse," after describing the manner in which the case of the instrument was to be made proceeded as follows: "by means whereof I embrace in the centre of my fuse in a continuous line throughout its whole length a small portion or compressed cylinder, or rod of gunpowder, or other proper combustible matter prepared in the usual pyrotechnical manner of the firework for the discharge of ordnance." In an action for infringing the patent, it was objected that the patentee had not shown that any other material but common gunpowder had ever been used in the fuse; or, if introduced, would answer the purpose. The objection that any other material but common gunpowder had ever been used in the fuse was considered to be immaterial, because though other materials not specified but still within the description given would answer the purpose, no ambiguity was occasioned, nor was the difficulty of hereafter making the instrument increased by the introduction of terms, which imported that the patentee himself had ever used other materials than gunpowder in the construction of the instrument.

It is not necessary for the patentee to describe the mode of making everything he uses, or to detail known processes, or explain the terms appropriate to the particular art or science or branch of industry to which his invention belongs. (b)

Specification need not state exact proportions.

The specification of an invention which consists in the use of known materials in certain proportions is not bad for uncertainty, because the patentee does not limit his claim

(a) 1 Q. B. 938; 1 Webs. P. R. 341; *Derosne v. R. 218.* Webs. P. R. 341; *Derosne v. Fairie, ib. 154.*

(b) *Neilson v. Harford, 1*

to the precise proportions recommended, but the relative proportions must be ascertained. Thus where the patent was for increasing the hardness and durability of type by using tin and antimony, the best proportions being 75 per cent. of tin and 25 per cent. of antimony; but it was said that these proportions might be varied if lead were used, provided that it did not exceed 50 per cent. of the whole, and the specification was objected to on the ground of uncertainty, the objection was overruled. (a) But where the specification leaves it uncertain what proportions are to be used it will be bad. (b)

If the patentee between the time of applying for the patent and the time when the specification must be filed makes any fresh discoveries or any improvements in the method of working the patent, he is bound to introduce them into the specification and communicate his latest knowledge to the public. The object of allowing the patentee six months' protection is that he may be able freely to make experiments and improve his invention without any fear of the consequences of publication and user. (c)

The specification must describe means competent to perform all comprised in the patent. (d)

Where a patent was granted for a machine to sharpen knives and scissors, and the specification directed this to be done by passing their edges backward and forward in

All improvements must be stated.

Means competent to perform specification must be described.

(a) *Patent Type Founding Co. v. Walter*, 1 Johns. 381. And see *Hill v. Thompson*, 8 Taunt. 382; 1 Webs. P. R. 243.

(b) *Muntz v. Foster*, 2 Webs. P. R. 109; *Betts v. Menzies*, 10 H. L. C. 117. See note to *Liardet v. Johnson*, 1 Webs. P. R. 54.

(c) *Crossley v. Beverley*, 9 B. & C. 63; 1 Webs. P. R. 117; *Crane v. Price*, *ib.* 404; *Jones v. Heaton*, *ib.* 404 n.; *Liardet v. Johnson*, *ib.* 54 n.

(d) *Crossley v. Beverley*, 1 Webs. P. R. 117.

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an angle to be formed by the insertion of two circular files, and it was also stated that other materials might be used according to the delicacy of the edge; but it was proved that for scissors there ought to be one circular file and a smooth surface, and that two Turkey stones might also succeed; it was held that the specification was bad, as it neither directed the machines for scissors to be made with Turkey stones, nor to be made with one circular file and a smooth surface. (a)

Mode must be pointed out.

A claim to perform a certain process which does not point out the mode in the specification is too large and cannot be supported. (b)

One mode at least must be stated.

One mode at least which will succeed must be stated. In *Derosne v. Fairie*, (c) a patent was granted for "certain improvements in extracting sugar or syrup from cane juice, and other substances containing sugar, and in refining sugar and syrup." The specification stated the invention to consist in a means of discolouring syrups of every description by means of charcoal, produced by the distillation of bituminous schistus alone or mixed with animal charcoal, and even of animal charcoal alone. The discoloration was to be produced by means of a filter made of charcoal, and it was stated that "the carbonization of bituminous schistus has nothing particular, it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it." It appeared that the operation failed if applied to cane juice before it was

(a) *Felton v. Greaves*, 3 C. & P. 611; *Bainbridge v. Wigley*, 1 Carp. P. C. 270.

(b) *Booth v. Kennard*, 2 H. & N. 95.

(c) 2 C. M. & R. 476; 1 Gale, 109; 1 Webs. P. R. 154.

boiled, and nothing was said in the specification as to any process before filtering; but it was said that syrup in a proper state might be obtained by a mixture of sugar and water. It was shown in evidence that the process was applicable with advantage to the syrup after it had undergone a certain amount of heat before granulation took place, though it would fail if granulation had taken place. It was held, therefore, that the expression "extract" might fairly be understood to mean the process to be applied with advantage to the extracting of syrup from cane juice before it arrived at that consistency at which granulation took place.

If the specification represents that there are many modes of doing a thing when in fact one only will do, the patent will be avoided; (a) so, too, if it is stated that the invention may be carried into effect by either of two modes, and one is impracticable. (b)

Specification bad if one only of many modes successful.

The specification is bad if it is so manifestly ambiguous that its meaning cannot be discovered by any person of ordinary judgment. (c) "It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appears that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void." (d)

Ambiguity vitiat specification

(a) *Lewis v. Marling*, 4 C. & P. 57; 10 B. & C. 22; 1 Webs. P. R. 496.

(c) *Galloway v. Bleaden*, 1 Webs. P. R. 524.

(b) *R. v. Cutler*, 3 C. & K. 215; 14 Q. B. 372 n.; *Turner v. Winter*, 1 T. R. 608; 1 Webs. P. R. 82.

(d) Per Ashurst, J., in *Turner v. Winter*, 1 T. R. 605; 1 Webs. P. R. 80. See *Spencer v. Jack*, 11 L. T. (N. S.) 244.

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In *Hastings v. Brown*, (a) the specification of a patent for "certain improved arrangements for raising ships' anchors and other purposes," claimed as the invention an alleged improvement upon the structure of that part of a ship's windlass round which the chain cables of anchors are wound, and by which they are held fast without slipping. The form which was claimed by the invention was denominated a scalloped shell, and the applicability of a windlass so constructed to every size of chain cable was also claimed. It was admitted that there was no novelty in constructing a windlass so as to hold fast a single chain cable of any given size. The specification, so far as is material, was as follows:—"The scallop shell in which the iron chain cable appears in the drawing is upon a new plan to hold without slipping a chain cable of any size, as shown by the opening form of the scallop at the top and bottom of fig. 2." "And I also claim as my invention the new form of a scalloped shell (as shown in fig. 2), in conjunction with the arrangements herein described." The drawings referred to in the specification appeared to show a construction applicable either to a single cable or to cables of different sizes. It was proved that the specification and drawings would enable a competent workman to make a cable holder which would hold chains of different sizes; but it was held that, as the specification did not state distinctly for what the patent was claimed, and was ambiguous, as it did not point out clearly whether it was an invention of a cable holder to hold a chain of one particular size, or to hold cables of different sizes, it was therefore void.

In *Bloxam v. Elsee* (b) the patent was for a machine for

(a) 1 El. & Bl. 450.

(b) 6 B. & C. 169; 1 C. & P. 558.

making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. It appeared that the machine was capable only of producing paper of a definite width, and that in order to vary the width a new machine was required. It was held that the meaning of the patent was that paper varying in width between those extremes should be made by the same machine, and that the patent was therefore void.

In *Ralston v. Smith* (a) the description "a roller of hard metal or other suitable material" was considered not to be too uncertain on account of the use of the words "or other suitable material," as such words would mean any material equally sufficient for the purpose with hard metal.

And in *Macnamara v. Hulse* (b) it was held that a patent taken out for blocks for paving with "stone or other suitable material" would include wood pavement, although no wood pavement was in actual use at the date of the patent, and although the inventor might not have had wood pavement in contemplation.

It is usual in the specification, after the patentee has described his invention and the means for carrying it into effect, to insert a short clause, in which the patentee expressly states what he claims as his invention. But a claim is not an essential part of the specification, nor necessary for the protection of the invention. (c)

Claim in the specification not necessary.

The claim is introduced for the security of the patentee that he may not be supposed to claim more than what he can support as an invention; it is not intended to be any

Its object.

(a) 11 H. L. C. 223.

(b) Car. & M. 471.

(c) *Lister v. Leather*, 8 El. & Bl. 1004.

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description of the means by which the invention is to be performed, but is for the purpose of making the description intelligible, not to aid it, but to ascertain the extent of what is claimed as new. (a)

A patentee describing his invention in the specification is to be taken to claim as part of his invention all that he describes as the means by which it is to be carried into effect, unless he clearly expresses a contrary intention. (b)

Where the specification of a patent for "improvements in apparatus for stitching and sewing," to which drawings were attached, after describing an instrument marked "g," continued, "It is the arranging an instrument 'g' as herein described, which, while it is the means of holding the fabric . . . is also the means by which the step-by-step motion is given to the fabric, which constitutes the peculiarity of my invention." It was held that this was not a claim of all instruments which were at once the means of holding and moving the fabric; nor on the other hand of the exact machine with all its arrangements contained in the drawings; but a claim to the exclusive right to use "g," or any similar instrument, for the purpose of holding and moving the fabric at the same time. (c)

Where the patent was for "a method of discharging or giving fire to artillery, and all other fire arms, mines, chambers, cavities, and places in which gunpowder or other combustible matter is or may be put for the purpose of explosion," and the means, by which the invention was to be applied, were pointed out in the specification, the patentee was held to be entitled to the exclusive applica-

(a) *Kay v. Marshall*, 3 My. & Cr. 373; 2 Webs. P. R. 39.

(c) *Thomas v. Welch*, L. R. 1 C. P. 192.

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

Means of effectuating invention considered as claimed.

tion of the detonating mixture as priming, whatever the construction of the lock by which it was discharged. (a) So where the invention consisted in the discovery of the principle that air heated to a high temperature was very beneficial in blast furnaces, and the patentee directed that it should be heated in a vessel immediately before entering the furnace, it was held that the specification was not void, because no particular shape of vessel was claimed. (b)

A claim for the application of a new material to an old purpose is good, and will not affect the validity of the patent. (c)

If the specification, as containing the description, be sufficiently precise, it is of no consequence that expressions are used in the claim, which would be too general if they professed to be part of the description. (d) Thus where the specification described the invention and the machinery by which the manufactured article was produced, and said that the article was made by machinery, and that nothing but machinery would avail to make it, a claim to perform the work "by machinery" was held not to be too large. (e)

But if the specification says definitely that the invention is to be carried out by a particular process or machine; describing it; which is claimed; the claim will be confined to the operation of the process or machine. In *Barber*

Claim for application of new material to old purposes good.

General words which do not profess to be part of the description do not vitiate claim.

Claim may not be more extensive than specification.

(a) *Forsyth v. Rivière*, 1 Webs. P. R. 97. See also *Neilson v. Thompson*, *ib.* 283; *Cochrane v. Braithwaite*, 1 Carp. P. R. 493; *Neilson v. Baird*, 6 Dec. of Ct. of Sess., 2nd series, 51.

(b) *Neilson v. Harford*, 8 M. & W. 806; 1 Webs. P. R. 371.

(c) *Neilson v. Betts*, L. R. 5 II. L. 1.

(d) *Kay v. Marshall*, 1 My. & Cr. 373; 2 Webs. P. R. 39.

(e) *Arnold v. Bradbury*, L. R. 6 Ch. 706.

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v. Grace(a) it was held that a specification which claimed as the invention a process of finishing hosiery by means of a press heated by steam, and the drawings represented the press as consisting of two boxes; could not also include a process of finishing goods by means of heated rollers.

Where the patentees claimed certain machinery for giving diagonal or vibratory motion to the selvages of cloth, and went on to say, "as it is not practicable to describe every possible mode in detail, we desire it to be understood that any mode even of moving one side or selvage of the cloth whilst the other remains stationary, we shall consider to be an evasive imitation of our invention, if for the purpose of drawing the threads into diagonal positions by mechanical means instead of manual labour;" it was held that the patentees only claimed as their invention those improvements on the old machine that gave the vibratory motion to the fabric while in the course of drying. (b)

In *Minter v. Wells*(c) the patentee claimed as his invention "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair as above described," Alderson, B., said: "If it could be shown that any self-adjusting leverage had been before the plaintiff's patent applied to a chair, the patent would be void, because the priority of the specification given by him would claim every species of the application of a self-adjusting leverage to the back and seat of a chair; he would have claimed, not the par-

(a) 1 Exch. 339.

(c) 1 Webs. P. R. 130.

(b) *M'Alpine v. Mangnall*, 3 C. B. 496.

particular way of accomplishing the particular purpose by the particular engine, but he would have claimed too much, because he would have claimed the application of such self-adjusting leverage to the back and seat of a chair."

A patentee cannot by making a general claim obtain the benefit of improvements of which he was ignorant at the date of his patent. (a)

General claim does not include improvements.

The specification is not conclusive evidence of that for which the patent was obtained, but parol evidence of the patentee is admissible to prove that the patent was not obtained for some of the things obtained in the specification, but for the new combination of several old matters. (b)

Parol evidence may be admitted to explain claim.

Where a patent is for a new mode of applying old materials, the claim must be for the materials and the mode of applying them together, else the patent will be void. A patentee claimed "the metal fixings and the mode of applying the same, described herein as the second part of my invention." The jury found that the metal fittings by themselves were old, but that the mode of applying them was new. Erle, C. J., said:—"If the true construction is, that the metal fittings are claimed separately from the mode of applying the same, the patent is void for want of novelty. Then are the metal fittings claimed separately? We think not. The context expresses that one part of the invention consists of metal fittings, and the mode of applying them described herein. If the patentee meant to claim the metal fittings as one separate part, and the mode of applying them as another part, his words do not express that meaning." (c)

Specification of patent for new mode of applying old materials must claim materials and mode of applying them.

(a) *Tetley v. Easton*, Macr. 77.

(c) *Oxley v. Holden*, 8 C. B.

(b) *Bateman v. Gray*, 8 Exch. (N. S.) 705.

906; Macr. 111; *Crossley v. Potter*, Macr. 253.

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Discovery of principle and application of principle to be distinguished.

If a principle is claimed while the invention consists only in the application of the principle by new machinery, the specification is bad. Thus where a patentee claimed the principle of introducing fuel at the lower part of the grate in a perpendicular or oblique direction, and the principle was not new, though the application of the principle as described was, the patent was held to be void. (a)

Specification of patent for application of old invention to new material or purpose must claim means of effectuating invention.

Where the patent is for the application of a known instrument to a new material or purpose, it must appear that the means essential for carrying the application into effect are new, and the specification must claim them. Thus where the patent was for the invention of a nipping lever for causing the rotation of wheels, shafts or cylinders, and in the specification the patentee claimed as his invention "the nipping lever, with its tusk sliding box (before described), applied to a rimmed wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together with any shaft, cylinder, or other suitable machinery which may be attached thereto," and it appeared that the nipping lever was not new, but that its application by means of the sliding boxes was, it was held that it must also be shown that the use of the sliding boxes was necessary or essential to the use of the invention. (b)

Specification of patent for addition or improvement must be for addition or improvement only.

If the invention is for addition or improvement, the patent must be taken out not for the whole machine with the addition, but for the addition or improvement only (c) as the public have a right to purchase the improvement

(a) *R. v. Cutler*, 1 Stark. 354.
See also *Gamble v. Kurtz*, 3 C. B. 425.

(c) *Hornblower v. Boulton*, 8 T. R. 103; *Bovill v. Moore*, 2 Marsh. 214.

(b) *Pow v. Taunton*, 9 Jur. 1056.

by itself without being incumbered by other things, (a) and if the specification claims discovery when the invention is merely for an addition or improvement, it is bad. In *Hill v. Thompson*, (b) the specification contained among other things the following claim, "and that my said improvements do further consist in the use and application of lime to iron, subsequently to the operations of the blast furnace, whereby that quality in iron from which the iron is called 'cold short' howsoever and from whatever substance such iron be obtained, is sufficiently prevented or remedied and by which such iron is rendered more tough when cold. And I do further declare that I have discovered that the addition of lime or limestone or other substances consisting chiefly of lime, and free or nearly free from any ingredient known to be hurtful to the quality of iron, will sufficiently prevent or remedy that quality in iron from which the iron is called 'cold short,' and will render such iron more tough when cold; and I do for this purpose—if the iron, howsoever, and from whatever substance the same may have been obtained, be expected to prove 'cold short'—add a portion of lime or limestone or of the other said substances, of which the quantity must be regulated by the quality of the iron to be operated upon, and by the quality of the iron wished to be produced; and further, that the said lime or limestone or other aforesaid substances may be added to the iron at any time subsequently to the reduction thereof in the blast furnace, and prior to the iron becoming clotted or coming into nature, whether the same be added to the iron while it is in the refining or in the

(a) *Boulton v. Bull*, 2 H. Bl. 489.

(b) 8 Taunt. 424; 2 B. Moo. 424; 1 Webs. P. R. 237.

puddling furnace, or in both of them, previous to the said iron being put into either of the said furnaces." It appeared that "cold short" had been prevented by the use of lime before; and Dallas, J., said: "The purpose is to render bar iron more tough by preventing that brittleness which is called 'cold short,' and which renders bar iron less valuable; the means of prevention stated are application of lime. In what way, then, is lime mentioned in the patent? The first part of the specification, in terms, alleges certain improvements in the smelting and working of iron, during the operations of the blast furnace; and then, introducing the mention of lime, it states that the application of it to iron subsequently to the operation of the blast furnace will prevent the quality called 'cold short.' So far, therefore, the application of lime is in the terms claimed as an improvement—and nothing is said of any previous use—of which the use proposed is averred to be an improvement; it is, therefore, in substance a claim of entire and original discovery. The recital should have stated, supposing a previous use to be proved in the case, that, whereas lime has been in part, but improperly, made use of, etc., and then a different mode of application and use should have been suggested as the improvement claimed. But the whole of the patent must be taken together and this objection will appear to be stronger as we proceed. And here, again, looking through the patent in a subsequent part of the specification, the word 'discovery' first occurs and I will state the terms made use of in this respect: And I do further declare that I have discovered that the addition of lime will prevent that quality in iron from which the iron is called 'cold short' and will render such iron more tough when cold; and that for this purpose

I do add a portion of lime or limestone, to be regulated by the quantity of iron to be operated upon, and by the quality of iron to be produced, to be added at any time subsequently to the reduction in the blast furnace, and this from whatever substance the iron may be produced, if expected to prove 'cold short.' Now this appears to be nothing short of a claim of discovery in the most extensive sense of the effect of lime applied to iron to prevent brittleness, not qualified and restrained by what follows as to the preferable mode of applying it under various circumstances, and therefore rendering the patent void, if lime had been made use of for this purpose before; subject to the qualification only of applying it subsequently to the operations in the blast furnace." (a)

In *Bramah v. Hardcastle*, (b) Lord Kenyon, C. J., said: "Unlearned men look at the specification and suppose everything to be new that is there. If the whole be not new it is hanging terrors over them."

Where the plaintiff's invention which was admitted to be ingenious and useful consisted in the insertion of a pipe into an old stove for conveying the air into it; but the specification claimed the whole apparatus, and did not confine the invention to the application or addition of the pipe to an old stove, the patent was held to be void. (c)

And where the specification claimed the exclusive liberty of making lace, composed of silk and cotton-thread mixed not of any particular mode of mixing them; and it was proved that silk and cotton-thread had often previously been mixed on the same frame for lace, in different modes, the patent was held to be void, as the

(a) See also *Saunders v. Aston*,
3 B. & Ad. 886.

(c) *Williams v. Brodie*, 1
Webs. P. R. 75.

(b) 1 Webs. P. R. 76.

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specification did not claim the particular mode of mixing the lace. (a)

A claim for a patent for improvements in the mode of doing something by a known process is sufficient to entitle the patentee to a patent for his improvements when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim so long as it remains identical with regard to improvements claimed and their application. (b)

Where a patent is for an entirely new invention, it is not necessary that the specification should describe and distinguish the different parts. But where the invention consists of additions or improvements, all the parts which are new must be described, and distinguished from those which are old, (c) and must be distinctly claimed as new. (d) It is not sufficient to give a general description of the construction of the machine without making such distinction. (e) In *Saunders v. Aston* (f) the specification of a patent for making buttons stated the improvement to consist in the substitution of a flexible material for metal shanks by the help of a metal collet. The use of the collet was new, but it was not claimed, and the specification was held to be bad. Littledale, J., saying: "Neither the button nor the flexible shank was new, and they did not

Additions and improvements must be distinguished.

(a) *R. v. Elsee*, Bull (N. P.) 76; 1 Webs. P. R. 76.

(b) *Electric Telegraph Co. v. Brett*, 10 C. B. 838.

(c) *Nichols v. Ross*, 8 C. B. 723; *Dangerfield v. Jones*, 13 L. T. (N. S.) 144.

(d) *Morris v. Bransom*, Bull (N. P.) 76; 1 Webs. P. R. 51;

Ormson v. Clark, 14 C. B. (N. S.) 490.

(e) *Macfarlane v. Price*, 1 Stark. 199; 1 Webs. P. R. 74; *R. v. Cutler*, 1 Stark. 354; 1 Webs. P. R. 76; *R. v. Arkwright*, 1 Webs. P. R. 67.

(f) 3 B. & Ad. 881; 1 Webs. P. R. 75 n.

by merely being put together constitute such an invention as could support the patent. It is contended that the operation of the collet under the present patent is new, but that is not stated in the specification as the object of his invention, and is in fact only one mode of carrying it into effect." Lord Westbury in *Foxwell v. Bostock*, (a) laid down the rule as follows: "In a patent for an improved arrangement or new combination of machinery the specification must describe the improvement and define the novelty otherwise, and in a more specific form than by the general description of the entire machine, it must assign the *differentia* of the new combination. This obligation flows directly from the condition of the patent that the specification shall particularly describe and ascertain the invention." (b)

A patent which includes the subject matter of an existing patent is valid, but the specification must properly distinguish the new from the old. (c) In *Harmar v. Playne*, (d) it was held that a specification describing a whole machine the subject of two patents, but not referring to the former specification or pointing out the particular improvements the subject of the latter patent, except in so far as the second specification recited the former, was sufficient. (e) Where a patentee has taken out a fresh patent for improvements on his original invention, it is sufficient, if on reading his second specification with the first, an artisan would have no substantial difficulty in ascertaining what was claimed. (f)

Improvement on existing patent valid, but must be distinguished.

(a) 4 De G. J. & S. 313; 10 L. T. (N. S.) 144.

(b) And see *Parke v. Stevens*, L. R. 8 Eq. 358; *Murray v. Clayton*, L. R. 7 Ch. 585.

(c) *Crane v. Price*, 4 M. & Gr. 580; 5 Scott (N. R.) 338;

1 Webs. P. R. 413; *Bovill v. Moore*, 2 Marsh. 211.

(d) 11 East, 101.

(e) And see *Foxwell v. Bostock*, 10 L. T. (N. S.) 144.

(f) *Parke v. Stevens*, L. R. 8 Eq. 358.

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If there is a patent for a machine and also for an improvement in the use of it, if it cannot be supported for the machine, although it might be for the improvement merely, it is bad on account of its attempting to cover too much. (a) But if taking the whole specification together the court can see that the improvements only are claimed it will be sufficient. (b) Thus where the specification of a patent for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein" described a process of plaiting fabrics by means of a reciprocating knife in combination with a sewing machine and claimed (1) the general construction, arrangement and combination of machinery for producing plaited frills or trimming in a sewing machine; (2) the application and use of a reciprocating knife for crimping fabrics in a sewing machine; and (3) the peculiar manufacture of crimped or plaited frills or trimming "as hereinbefore described" and illustrated by a drawing; it was contended that the manufacture described included the use of the sewing machine, or that it was a manufacture by means not only of the reciprocating knife, but of a sewing machine, without which the completed article could not be produced in the manner described. It was held, however, looking at the whole specification and claim, that this was only pointed out as the best mode of completing the manufacture, as the sewing machine was treated as a known invention already in use, and it was separate and distinct from the mode of crimping or plaiting to which the plaintiff laid claim. (c)

(a) *Hill v. Thompson*, 3 Mer. 626; 1 Webs. P. R. 237.

(b) *McAlpine v. Mangnall*, 3 C. B. 515.

(c) *Wright v. Hitchcock*, L. R. 5 Exch. 37.

Where the invention is partly original and partly communicated from a foreign country, the part communicated from the foreign country must be defined in the specification. (a)

Part of invention foreign must be distinguished.

If a patent is taken out for an invention consisting of distinct parts, and any one of them is not new, the whole is void. In *Kay v. Marshall*, (b) the patent was for "new and improved machinery for preparing and spinning flax, hemp and other fibrous substances by power." The specification claimed as the patentee's invention in respect of new machinery for preparing flax, etc., the macerating vessels marked B in the plan or drawing annexed to the specification, and the trough of water marked C; and in respect of improved machinery for spinning, the wooden or other trough marked D for holding the rovings when taken from the macerating vessels, and placing the retaining rollers *e e* and the drawing rollers *c c* nearer to each other than they had ever before been placed, say within two-and-a-half inches of each other for the aforesaid purpose. Before the date of the patent, flax, hemp and other fibrous substances were spun with machines with slides, by which the reach was varied according to the length of the staple or fibre of the article to be spun, and the reach varied in different kinds of spinning between $\frac{7}{8}$ of an inch and 14 inches, but it was not known that flax could be spun by means of maceration as having a short fibre at a reach of $2\frac{1}{2}$ inches, or about those limits. On a case sent to the Court of Common Pleas by Lord Langdale it was held; and affirmed on appeal to the House of Lords, (c)

Specification bad where one of distinct parts not new.

(a) *Renard v. Levenstein*, 10 L. T. (N. S.) 177.

(b) 5 Bing. (N. C.) 492; 7 Scott, 548; 2 Webs. P. R. 71.

(c) 8 C. & F. 245; 2 Webs. P. R. 79.

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that there were two distinct processes, and that though the first relating to macerating the flax was new and useful, and the proper subject of a patent, yet that the second being merely an application of a piece of machinery already well known and in use, to the new macerated state of the flax, the specification claiming both processes as invention could not be supported. (a)

One of several inventions not improvement patent void.

If a patent is taken out for several inventions which are claimed as improvements, and one of them is not an improvement, the patent is void. (b)

In *Brunton v. Hawkes* (c) the patent was for improvements in the construction of ship's anchors, windlasses, and chain cables or moorings. That part of the patent which related to the manufacture of anchors was proved not to be new, and the whole patent was therefore held to be void, although there was great merit in the other inventions:

Patent for combination does not claim each part as new; but if specification claims whole combination as new, when not so, it is bad.

A patent for a combination, is not a claim that each part of the combination is new; (d) but if the specification of a patent for a combination of things partly new and partly old, claims the whole combination as new, the patent will be void; the nature of the invention must be described in such a manner that a person of ordinary intelligence can, on reading it, see what is claimed as new, and what is old.

In the case of *Holmes v. The London and North*

(a) And see *Templeton v. Cornish v. Keene*, 1 Webs. P. R. *Macfarlane*, 1 H. L. C. 595; 505; *Losh v. Hague*, ib. 204; *Gibson v. Brand*, 4 Scott (N. R. v. Arkwright, ib. 72. R.) 844; 4 M. & G. 179; 1 Webs. P. R. 634.

(c) 4 B. & Ald. 542.

(d) *Lister v. Leather*, 8 El. &

(b) *Morgan v. Seaward*, 2 M. & W. 544; 1 Webs. P. R. 197; Bl. 1017.

Western Railway Co., (a) the specification of "an improved turning table for railway purposes" described the invention "to consist in supporting the revolving plate and upper platform of the turning table, as also its stays, braces, arms and supports, on the top of a fixed post, well braced and resting on, or planted in, the ground, the top of which post forms a pivot for the table to turn on, while the supporting arms, radiating from a frame work (the weight of which is also suspended on the post), moving round the bottom part of the post with friction rollers, and fastened to the outer edges of the plate, stay the plate at all sides, and keep it steady to receive the superincumbent weight of carriages or whatsoever is to be turned upon it." The manner in which the invention was to be performed was then described with reference to drawings, and the specification concluded as follows:—"Now, whereas I claim as my invention the improved turning-table hereinbefore described, and such my invention being, to the best of my knowledge and belief, entirely new, and never before used, I do declare this to be my specification of the same; and that I do verily believe this my specification doth comply in all respects fully, and without reserve or disguise, with the proviso in the hereinbefore in part recited letters patent contained; wherefore I hereby claim to maintain exclusive right and privilege to my said invention." The jury found that the only novelty in the plaintiff's invention consisted in the suspension rods; as it was proved that, previous to the date of the specification, the rest of the machinery had been described in a patent for an invention for the same purpose, granted to another person,

(a) 12 C. B. 831.

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Or if it claims
part as new
which is not
so.

and it was held that as the plaintiff's specification claimed the whole combination as new, the patent was void.(a)

If the specification claims any portion of the combination as new which is not so, the patent is void.(b) Where letters patent were granted for "improvements in agricultural machines," and the specification described the invention to consist in "the constructing and placing of holding fingers, cutting blades, and gathering reels respectively, in a manner described, and the embodiment of these parts so constructed and placed, all or any of them, in machines for reaping purposes," it was held that the patent was for the combination, and that the use of a knife alone similar to that described in the patented machine was not an infringement.(c)

In *Thomas v. Foxwell*,(d) the patentee of a sewing machine claimed "the application of a shuttle in combination with a needle, as shown in the drawing, for forming and securing loops of thread or other substances for the purpose of producing stitches, either to unite or ornament fabrics, whatsoever may be the means employed for working such shuttle and needle when employed together." The shuttle and needle had been worked together previously; and it was held that as the claim was not confined to the single application of a shuttle in combination with a needle, as shown in the drawings, but extended generally to the application of a shuttle in combination with a needle, for the purposes of the invention, the patent was void.

(a) See also *Bovill v. Moore*, 2 Marsh, 211; *Carpenter v. Smith*, 1 Webs. P. R. 532.

(b) *Lister v. Leather*, 8 El. & Bl. 1017.

(c) *McCormick v. Gray*, 7 H. & N. 25; *Parkes v. Stevens*, L. R. 8 Eq. 367.

(d) 5 Jur. (N. S.) 37; affd. 6 Jur. (N. S.) 271.

A patentee will not however be presumed to have claimed anything so generally in use that he must have known that to claim it would be to vitiate his patent.(a)

Patentee not presumed to claim anything well known.

If a patent includes matters some of which are new and some are old, it may be read by limiting the claim to the particular combination in the particular manner described in the specification.(b)

Claim in specification may be limited.

A patent is a patent for a combination, if a combination is expressly stated in the specification to be a part of the invention, although the combination is not actually claimed.(c)

Combination need not be expressly claimed.

A patent will be good, although each principle or process in it is well known to all persons engaged in the trade to which the patent relates, provided that the mode of combination is new and produces a beneficial effect, and also that the specification claims, not the old processes, or any one of them, but only the new combination.(d)

Combination of old matters.

The rules governing the construction of specifications are the ordinary rules for the interpretation of written instruments, having regard especially to the rule that the specification is void if it does not particularly ascertain and describe the nature of the invention and the manner in which it is to be performed.(e)

Rules of construction.

The title must be read in connection with the specification, and the whole instrument must be taken together for the purpose of interpretation.(f)

Title and specification read together.

(a) *Haworth v. Hardcastle*, 1 Webs. P. R. 484.

(c) *Lister v. Leather*, 8 El. & Bl. 1004.

(b) *Daw v. Eley*, L. R. 3 Eq. 496; *Seed v. Higgins*, 8 H. L. C. 261, where there was an express disclaimer of previous inventions; *Foxwell v. Bostock*, 4 De G. J. & S. 298; 10 L. T. (N. S.) 144.

(d) *Cannington v. Nuttall*, L. R. 5 H. L. 205.

(e) *Simpson v. Holliday*, 13 W. R. 578, on app. L. R. 1 H. L. 320.

(f) *Beard v. Egerton*, 8 C. B.

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Specification construed favourably to inventor.

Formerly specifications were construed more strictly against the inventor than they are now, the reason being that a patent was looked upon as a monopoly prejudicial to the public interest. In *Hullett v. Hague*,^(a) Lord Tenterden, C. J., 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."

Not with object of setting aside patent.

The rule now followed is, that specifications are to be read in a spirit of fairness and candour, not astutely with the defect of setting aside the patent,^(b) but on the principles of good faith.^(c)

Nothing to be intended for or against patent.

In *Stevens v. Keating*,^(d) Sir F. Pollock, C. B., said: "I take the rule to be that you are not to intend anything in favour of a specification or patent, and certainly not to intend anything against it."

Intention of patentee to be looked to.

In *Palmer v. Wagstaff*,^(e) the same learned judge said, "A patent should be construed in the sense in which the patentee intended, and if any expressions are ambiguous, the Court will endeavour to give effect to the intention, and will expound the patent favourably to the patentee. But the Court will not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate."

168; *Newton v. Vaucher*, 6 Exch. 834; *Crossley v. Beverley*, 3 C. & P. 514; 1 Webs. P. R. 117; *Househill Iron Co. v. Neilson*, 1 Webs. P. R. 679; *Neilson v. Harford*, 8 M. & W. 323; 1 Webs. P. R. 312; *Russell v. Cowley*, 1 Webs. P. R. 470.

(a) 2 B. & Ad. 377.

(b) *Bickford v. Skewes*, 1 Q. B. 951; 1 Webs. P. R. 219; *Stead v. Anderson*, 2 Webs. P. R. 153; *Sellers v. Dickenson*, 5 Exch. 326.

(c) *Neilson v. Harford*, 1 Webs. P. R. 341; *Russell v. Cowley*, 1 Webs. P. R. 470.

(d) 2 Webs. P. R. 187.

(e) 9 Exch. 501.

“There can be no rule of law,” said Sir N. C. Tindal, C. J., “which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts would warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent. (a)

In *Turner v. Winter*, (b) Buller, J., 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;” and in *Cartwright v. Arnott*, (c) Lord Eldon said that patents were to be considered as bargains between the inventors and the public, to be judged of on the principle of keeping good faith, by making a fair disclosure of the invention, and to be construed as other bargains.

Any objection must be clearly made out. (d) After a patent has stood inquiry and the test of time, the Court do not encourage verbal objections to the specification. (e) “The patentee should not be tripped up by captious objections, which do not go to the merits of the specification.” (f)

Must be fair discovery.

Objections must be clearly made out, and verbal objections discouraged.

(a) *Haworth v. Hardcastle*, 1 Webs. P. R. 485.

(b) 1 T. R. 606; 1 Webs. P. R. 81.

(c) Easter Term, 1800, cited 11 East. 107.

(d) *Bickford v. Skewes*, 1 Q. B. 951; 1 Webs. P. R. 219.

(e) *Neilson v. Betts*, L. R. 5 H. L. 1; *Muntz v. Foster*, 2 Webs. P. R. 95.

(f) Per Alderson, B., in *Mor-*

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Evident mistake or misuse of words not vitiate specification.

An evident mistake will not vitiate a specification, as where air was described as "an imponderable substance;" (a) nor will the misuse of words vitiate a specification. Thus, where the patentee, a foreigner, used the word "baked" for boiling, and the word "discoloration" for discharge from colour, it was held that the specification was not to be avoided on that account, Lord Abinger, C. B., saying, "One would not be disposed, from any obscure word in the specification, which might be interpreted in favour of the patentee, to deprive him of his patent;" (b) and the specification will be sufficient, if, although foreign words are used in it, skilful mechanics can make the machine with the assistance of the drawings annexed. (c)

Nor use of scientific terms.

The use of scientific terms, unintelligible to ordinary workmen, will not vitiate a specification. "Where," said Lord Abinger, "a specification uses scientific terms, which are not understood, except by a person acquainted with the nature of the business, the specification is not bad because an ordinary man does not understand it, provided a scientific man does; but where the specification does not make use of technical terms, where it uses common language, and where it states that by which a common man may be misled, though a scientific man would not, when it does not profess to use scientific terms, and an ordinary man reading the specification is misled by it, it would not be good." (d)

gan v. Seaward, 1 Webs. P. R. 174.

P. R. 157; *Minter v. Mower*, 1 Webs. P. R. 141.

(a) *Neilson v. Harford*, 1 Webs. P. R. 340.

(c) *Bloxam v. Elsee*, 1 C. & P. 563.

(b) *Derosne v. Fairie*, 2 C. M. & R. 476; 1 Gale, 109; 1 Webs.

(d) *Neilson v. Harford*, 1 Webs. P. R. 341.

The terms of a specification are to be construed according to the state of knowledge at the time it was drawn up.^(a)

The language of the specification is the language of the patentee himself;^(b) and the words used in it are to be construed according to their ordinary and proper meaning,^(c) and a fair and reasonable interpretation given to them, unless there is something in the context, which may be explained by evidence, to show that there ought to be a different construction.^(d) In *Elliott v. Turner*,^(e) the specification stated that part of the invention consisted in "the application of such fabrics only wherein the ground or face of the ground thereof is produced by a warp of soft or organizine silk, such as is used in weaving satin and the classes of fabrics produced therefrom, which are well known, viz., satin ground, with ornamental centre figure, &c.;" and the patentee claimed as his invention the application of such figured, woven fabrics to the covering buttons with flexible shanks, made by pressure in dies, as have the ground, or the face of the ground, woven with soft or organizine silk for the warp, when such fabrics have ornamental designs or figures for the centre of buttons. Parke, B., in delivering the judgment of the Court, said: "The word 'or,' in its ordinary and proper sense, is a disjunctive particle; and the meaning of the term 'soft or organizine' is properly either one or the other; and so it ought to be construed, unless there be something in the context to give it a different meaning."

Specification be construed according to state of knowledge when drawn.

Language of specification is language of inventor.

Words construed according to ordinary meaning.

(a) *Crossley v. Beverley*, 3 C. & P. 514; 1 Webs. P. R. 107.

(b) *R. v. Wheeler*, 2 B. & Ald. 349.

(c) *Househill Iron Co. v. Neilson*, 1 Webs. P. R. 679.

(d) *Beard v. Egerton*, 8 C. B. 165.

(e) 2 C. B. 446.

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In *Simpson v. Holliday*(a) the invention described by the patentee consisted in the mixing of aniline with dry arsenic acid for the purpose of producing a rich purple colour; and the patentee, after describing that process, added: "Or I accelerate the operation by heating it to or near to its boiling point." It was proved that mixing aniline with dry arsenic acid, without the application of heat, would not produce any effectual result. It was contended that the word "or" ought to be read "and;" but the House of Lords, affirming the decision of Lord Chancellor Westbury, held there were two operations described in the specification, and that there was nothing in the terms of the description, nor upon the face of the specification itself, which could justify the Court in changing the form of the expression.

Construction of specification is for the Court, after terms of art explained by jury.

The construction of the specification is the duty of the Court after the meaning of any terms of art or of commerce has been ascertained by the jury.(b) In *Neilson v. Harford*,(c) Parke, B., said: "The construction of the specification, as 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 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 the words or circumstances are necessarily

(a) 13 W. R. 577, on app., L. R. 1 H. L. 315.

rosne v. Fairie, 1 Webs. P. R. 156.

(b) *Hill v. Thompson*, 3 Mer. 626; 1 Webs. P. R. 237; *De-*

(c) 8 M. & W. 823; 1 Webs. P. R. 370.

referred to them;" and in *Hills v. Evans*(a) Lord Westbury laid down the rule as follows: "It is undoubtedly true as a proposition of law that the construction of a specification, as of all other written instruments, belongs to the court; but the 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 proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) —that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which, undoubtedly, it is the province and the right of a jury to decide. But when those 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."(b)

(a) 4 De G. F. & J. 288; 8 Jur. (N. S.) 527.

(b) See too *Bovill v. Pimm*, 11 Exch. 719; *Simpson v. Holliday*, L. R. 1 H. L. 320; *Betts*

v. Menzies, 10 H. L. C. 153; *Spencer v. Jack*, 11 L. T. (N. S.) 242; *Thomas v. Foxwell*, 6 Jur. (N. S.) 271.

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Terms of trade
to be used in
ordinary com-
mercial sense.

Where in a specification terms of trade are used, they must be construed according to their ordinary commercial meaning. Thus where a specification described the articles used as "the best selected copper" and "that quality of zinc known in England as foreign zinc," it was held, that what the patentee was endeavouring to describe for the information of the public was, that the copper and zinc should be of the best kind which at that time were known to exist and were represented by that description of each respective article, and that the patent was not void because "best selected copper" was well known before the patent was granted, and that "foreign zinc" was no longer made; (a) and in *Stevens v. Keating*, (b) Sir F. Pollock said that a claim for the use of "acids" would not vitiate the patent if some very unimportant acids known only in the laboratory would not answer the purpose, but that it was otherwise when an acid well known in trade was useless.

But where one of the ingredients in a composition was a white substance imported from Germany, and which could only be purchased at one or two colour shops in London, and the only description given of it in the specification was "the purest and finest chemical white lead," and there was no article known by that name in the trade, or in the shops where white lead is usually sold, and the finest white lead which could be obtained would not answer the purpose, it was held that the specification was insufficient. (c)

Identical terms
of art may
have different
meanings at
different dates.

In construing similar specifications of different dates, it must be remembered that it is possible that the terms of art used, although identical, may have different mean-

(a) *Muntz v. Foster*, 2 Webs. P. R. 104.

(b) 2 Webs. P. R. 187.

(c) *Sturtz v. De la Rue*, 5 Russ. 322; 1 Webs. P. R. 33, n.

ings owing to the advance of science, and it is necessary, therefore, to ascertain whether or not this is so by evidence. In *Betts v. Menzies*,^(a) where the patent was objected to on the ground of prior publication in a specification, the following question was put to the judges: "Can the court pronounce B's patent to be void, simply on the comparison of the two specifications without evidence to prove identity of invention?" The answer of the judges was in the negative, and Lord Westbury in moving the judgment of the House, said that the answer showed that "even if there is identity of language in two specifications, and (remembering that those specifications describe external objects) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the same *identical* external object, unless you ascertain that the terms of art used in the one have precisely the same signification and denote the same external objects at the date of the one specification as they do at the date of the other."

After the meanings of the terms of art have been ascertained by the jury and the Court has put the legal construction upon the specifications, there still remains the comparison of the specifications, which is the duty of the jury. In *Hills v. Evans*,^(b) Lord Westbury said: "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

Comparison of specifications is question for jury.

(a) 10 H. L. C. 117.

(b) 4 De G. F. & J. 288; 8 Jur. (N. S.) 527.

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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," (a) and his lordship also said that the observation of Lord Cranworth in *Bush v. Fox*, (b) "that it is the duty of the Court to compare the two specifications together" is an *obiter dictum*, and cannot be taken as a declaration of the law.

Unless there is no question to go to the jury.

But where the want of novelty appears distinctly on the face of the specification, and the question of novelty depends solely on its construction, and no evidence of fact is required, and there is no question to go to the jury, then it is for the Court to determine the identity of the inventions. In *Seed v. Higgins*, (c) Lord Campbell said: "Where novelty or infringement depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises, how far one machine imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact, which must be left to the jury."

The specification of a patent for improvements in the manufacture of gas, described the invention to consist in the direct use of seeds, leaves, flowers, and beech nuts, fruit, and other substances, and matters containing oil or oily and resinous matter, and stated that the mode of using the seed and constructing the apparatus might be

(a) See too *Muntz v. Foster*, M. & Gr. 411; 1 Webs. P. R. 2 Webs. P. R. 105; *Walton v.* 585, 597.

Potter, 4 Scott (N. R.) 91; 3 (b) 5 F. L. C. 707.

(c) 8 M. L. C. 261.

the same as the apparatus used in the mode of making gas from coal; but that the inventor preferred placing the seed in a red-hot retort, and the claim was "for making gas direct from seeds and matters therein named for practical illumination or other useful purposes instead of making it from oils, resins, or gums, previously extracted from such substances." It was proved that a patent had previously been granted to A for improvements in artificial light, the patentee using the residuary matter obtained in the manufacture of fatty substances, and also the residuum after the oil had been pressed from the seeds, such as oil cakes, and also beech nuts, or mast, cocoa nuts, and all others abounding in oil. The judge directed the jury to find for the defendant, and it was held that the direction was right, as the two patents were substantially the same and it was the province of the court to take notice of the identity apparent upon the written document, and the consequent want of novelty, and that it was not necessary to submit the question of novelty to the jury.(a)

Whether or not the description of the invention contained in the specification is intelligible is a matter of fact for the jury to decide,(b) and their finding is conclusive.(c)

Sufficiency of the specification is a question for the jury.

In *Walton v. Potter*,(d) Sir N. C. Tindal, C. J., said, referring to the objection that the specification did not particularly describe the nature of the invention: "Generally speaking, the rule which is laid down upon

(a) *Booth v. Kennard*, 2 H. & N. 84. See also *Thomas v. Foxwell*, 5 Jur. (N. S.) 37; 6 Jur. (N. S.) 271; *Allen v. Rawson*, 1 C. B. 571; *Tetley v. Easton*, 2 C. B. (N. S.) 706 *Hills v. London Gas Light Co.*, 5 H. & N. 312.

(b) *Hill v. Thompson*, 3 Mer. 626; 1 Webs. P. R. 235; *Wellington v. Dale*, 7 Exch. 888; *Morton v. Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 718.

(c) *Bickford v. Skewes*, 1 Q. B. 938; 1 Webs. P. R. 220.

(d) 1 Webs. P. R. 595.

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occasions where the sufficiency of the specification is called in question is this—that as these specifications are drawn by men who are more conversant with the particular article than juries, who are selected indiscriminately from the public, and certainly much more than judges whose knowledge is confined to one particular department, credit is given to witnesses if they are conversant with the subject-matter of the invention, and they tell you and you believe it that they see enough on the face of the specification to enable them to make the article without difficulty it always is a proper answer when a patent is set up to say that you have not so described it that it may not be understood.”

Exaggerated cases must be discarded.

All exaggerated cases on both sides must be discarded, and if the jury think in substance that the information really communicated would be enough in all ordinary cases or in such cases as are likely to occur, the specification will be sufficient.(a)

Sufficiency only to be ascertained by experiment.

Whether or not a specification contains a sufficient description can only be ascertained by an experiment, and in making the experiment, knowledge and means may be employed which have been acquired since the date of the patent.(b)

Specification may be construed with the aid of plans or drawings.

The specification may be read with the aid of plans or drawings which will be considered part of it, so as to limit the claim.(c) In *Bloxam v. Elsee*,(d) Abbott, C. J., said

(a) *Morgan v. Seaward*, 1 *ib.* 178; *Ex parte Fox*, 1 V. & Webs. P. R. 180; *Neilson v. Baird*, 6 Dec. of Ct. of Sess. 2nd series, 51. Dec. of Ct. of Sess. 3rd series, 718; *Daw v. Eley*, 14 W. R.

(b) *Betts v. Neilson*, L. R. 3 Ch. 429. 126; 11 Jur. (N. S.) 923.

(c) *R. v. Arkwright*, 1 Webs. P. R. 71; *Morgan v. Seaward*, (d) 1 C. & P. 564. And see *Barber v. Grace*, 1 Exch. 339.

“An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the specification, and if by a comparison of the words and drawings the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient.”

But plans or drawings are not necessary. In *Boulton v. Bull*,^(a) Rooke, J., said: “I am not aware of any rule of law which requires a model or drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement merely because no drawing or model is annexed.”

But they are not necessary.

If, however, in a patent for improvements the patentee is unable to distinguish the new from the old parts of the machine by words only, he must do so by reference to plans or drawings.^(b)

Unless patentee cannot distinguish new from old by words only.

It is not necessary that the plans or drawings should be very skilfully executed or highly finished, it is enough if they would give an ordinary workman sufficient information to enable him to make the machine.^(c)

Plans or drawings need not be skilfully executed.

A drawing alone may apparently be a sufficient specification. In *Brunton v. Hawkes*,^(d) Abbott, C. J., said that if a drawing or figure enabled workmen of ordinary skill to construct the improvement it was as good as any written description, and in *Foxwell v. Bostock*,^(e) Lord Westbury said that a patent for a new machine might be good if

Drawing alone may be sufficient specification.

(a) 2 H. Bl. 480.

(c) *Bovill v. Moore*, 2 Marsh.

(b) *Macfarlane v. Price*, 1 Stark. 201; 1 Webs. P. R. 74, n.

211; Dav. P. C. 368.

(d) Carp. P. R. 410.

(e) 4 De G. J. & S. 303; 10 L. T. (N. S.) 144.

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the specification contained nothing but clear drawings and a description of them.

If experiments necessary to produce beneficial effect, specification bad.

The specification must be so clearly expressed as to enable the machine to be constructed or the process to be performed, simply from reading the description without the necessity of trying experiments.

In *R. v. Wheeler*, (a) Abbott, C. J., said that a specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad. There the patent was for "a new and improved method of drying and preparing malt." The specification stated that the invention consisted in exposing malt previously heated to a very high degree of heat; but it did not describe any machine for this purpose, nor the state in which the malt was to be taken for undergoing the process, whether moist or dry, nor what was the proper amount of heat to be applied, nor how it was to be known when the process was completed and the patent was held to be void.

In *Turner v. Winter*, (b) the specification directed heat to be applied until the result aimed at was obtained. It appeared that fusion was necessary, but it was not mentioned, and Buller, J., said that the specification was deficient for that reason.

Where the patent was for "an improved method of drying and finishing paper," and the specification described the invention to consist in conducting paper by means of cloth, or cloths, against a heated cylinder, and contained these words: "which cloth may be made of any suitable material, but I prefer it to be made of linen warp or woollen weft," the patentee knowing, from repeated trials, that no other substance would do, Lord

(a) 2 B. & Ald. 349.

(b) 1 T. R. 607; 1 Webs. P. R. 81.

Tenterden, C. J., said: "The patent was obtained for the discovery of a proper conducting medium. The plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in his specification, yet he says the cloth may be made of any suitable material, and merely that he prefers the particular kind there mentioned. Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail, and the public therefore has not the full and entire benefit of the invention." (a)

In *R. v. Arkwright* (b) a witness stated that he should, from reading the specification, have made one part of the machine differently from the same part in the patentee's machine, but that from the knowledge he had acquired by seeing the machine he could now make it properly; and Buller, J., said that it does not prove a specification to be sufficient, that a man, from the knowledge he has got from trials and from seeing people employed about the machine, is able to make it. In *Morgan v. Seaward*, (c). Alderson, B., said: "The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect so as to save a party the trouble of making experiments and trials," and his lordship said that the criterion was whether at the time when the spe-

(a) *Crompton v. Ibbetson*, Dan. & L. 33; 1 Webs. P. R. 83. See too *Macnamara v. Hulse*, 2 Webs. P. R. 128, n.; *Stevens v. Keating*, 2 Exch. 778; 2 Webs. P. R. 194; *Hills v. Liverpool*

Gas Light Co., 9 Jur. (N. S.) 140; *Muntz v. Foster*, 2 Webs. P. R. 109.

(b) 1 Webs. P. R. 67.

(c) 1 Webs. P. R. 179

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Greatest effect. cification was introduced to the world, a witness who had been employed to make models for the patentee for the purpose of the trial, would have been able to construct the machine with his ordinary knowledge and skill, without the peculiar knowledge he had since obtained from his employment. But it appears that the specification is not defective if the experiments are only necessary to produce the greatest beneficial effect. (a)

Specification must be enough to enable skilled workmen to make the machine or perform process.

The specification must be so clear as to enable skilled workmen to make the machine or perform the process. "It must," said Lord Ellenborough, "convey to the public a corresponding advantage with that of the individual whose sole right is protected, so that any person who is skilled in the subject may accomplish the end." (b)

Technical words not necessary.

Technical words are not necessary so long as the specification shows the patent to be for a manufacture, and enables a workman to make the machine. (c)

Amount of skill necessary.

The amount of skill demanded from a workman employed to construct the machine depends entirely upon the subject-matter of the invention. "The specification," said Lord Loughborough, "is addressed to persons in the profession having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible." (d)

Competent skill.

In *Morgan v. Seaward*, (e) Alderson, B., said: "A speci-

(a) *Neilson v. Harford*, 1 Webs. P. R. 320.

(b) *Huddart v. Grimshaw*, 1 Webs. P. R. 86; *Gibson v. Brand*, 1 Webs. P. R. 629; *Betts v. Menzies*, 8 El. & Bl. 937.

(c) *Hornblower v. Boulton*, 8 T. R. 98; *Boulton v. Bull*, 2 H. Bl. 475; *Minter v. Mower*, 1 Webs. P. R. 141.

(d) *Arkwright v. Nightingale*, 1 Webs. P. R. 176.

(e) 1 Webs. P. R. 176.

fication is addressed to all the world, and therefore all the world, at least those possessed of competent skill, ought to be able to construct the machine by following that specification;" and in *Neilson v. Harford* (a), Parke, B., said: "You are not to ask yourself the question whether persons of great skill—a first-rate engineer or a second-rate engineer—whether they would do it, because, generally, those are men of great science and philosophical knowledge, and they would upon a mere hint in the specification probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed. It is supposed to be addressed to a practical workman who brings the ordinary degree of knowledge and the ordinary degree of capacity to the subject." (b)

The specification has also been said to be addressed to persons of ordinary (c) or tolerable skill. (d)

The specification must be such that workmen may be able to make the machine by following the directions given, without any new inventions or additions of their own. Where the patent was for spinning machinery, and the specification said nothing as to the comparative velocity of the rollers, Buller, J., said: "The man that comes to give an account of the invention says, 'I had

Ordinary or tolerable skill.

Specification bad if addition by workmen necessary.

(a) 1 Webs. P. R. 314.

621; *Beard v. Egerton*, 8 C. B. 212.

(b) And see also *Househill Iron Co. v. Neilson*, 1 Webs. P. R. 692; *Bickford v. Skewes*, 1 Q. B. 938; 1 Webs. P. R. 218; *Elliott v. Aston*, 1 Webs. P. R. 224; *Galloway v. Bleaden*, *ib.* 524; *Walton v. Bateman*, *ib.*

(c) *Sturtz v. De la Rue*, 5 Russ. 327; *Foxwell v. Bostock*, 10 L. T. (N. S.) 147.

(d) *Manton v. Manton*, Dav. P. C. 349.

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—

calculated it, and the difference of the velocity was to be as five to one; this is the way I made my rollers.' Now the defendant has not said a word of that in his specification. In that he has kept back the knowledge he had as to the size of the rollers, and velocity, and it is left to people to find it out, as chance may direct." (a)

In *Morgan v. Seward*, (b) Alderson, B., said that people in trade ought to be told the manner in which the invention ought to be carried out, "not by themselves becoming inventors of a method of carrying it into effect, but by following the specification without making a new invention, or making any addition to the specification. If the invention can only be carried into effect by persons setting themselves a problem to solve, then they who solve the problem become the inventors of the method of solving it, and he who leaves persons to carry out his invention by means of that application of their understanding, does not teach them in his specification that which, in order to entitle him to maintain his patent, he should teach them, the way of doing the thing, but sets them a problem which, being suggested to persons of skill, they may be able to solve. That is not the way in which a specification ought to be framed. It ought to be framed so as not to call on a person to have recourse to more than those means of ordinary knowledge (not invention) which a workman of competent skill in his art or trade may be presumed to have. You may call on him to exercise all the actual existing knowledge common to his trade, but you cannot call upon him to tax his ingenuity or invention."

(a) *R. v. Arkwright*, 1 Webs. P. R. 66. See also *R. v. Fussell*, 1 Carp. P. R. 449.

(b) 1 Webs. P. R. 174.

If the specification contains a false statement in any material circumstance of such a nature that if literally acted upon by a competent workman it would mislead him, and he would be unable to make the machine, it will be void, although there is evidence to prove that it is not likely that competent workmen would be misled; for this would be to support the invention by the workman's skill and not on its own merits. (a)

Untrue statement vitiates specification even if it would not deceive workman.

But when in the specification of a patent for improvements no directions are given respecting a portion of the machine which any competent workman would know to be necessary, the specification will not be void. In *Crossley v. Beverley* (b) the patent was for an "improved gas apparatus," the specification omitted to state that a condenser was necessary, but as it was shown that any workman who was able to construct a gas apparatus would know that a condenser was necessary, the specification was held to be good.

But omission not fatal if it does not mislead.

A deviation from the precise dimensions shown by the specification and model, so as to make the different parts work together, is within the knowledge of any workman. Thus where the defendants put in a model made according to the specification which would not work though a very slight alteration would have made it work, Alderson, B., said: "Now a workman of ordinary skill when told to put two things together, so that they should move, would of course by the ordinary knowledge and skill he possesses make them of sufficient size to move. There he would have to bring to his assistance his knowledge that

(a) *R. v. Arkwright*, 1 Webs. 371; *Simpson v. Holliday*, L. R. P. R. 67; *Neilson v. Harford*, 8 1 II. L. 315.

M. & W. 824; 1 Webs. P. R. (b) 9 B. & C. 63; 3 C. & P. 515; 1 Webs. P. R. 110, n.

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the size of the part is material to the working of the machine. That is within the knowledge of every workman. He says: 'I see this will not work, because it is too small,' and he makes it a little larger and finds it will work; what is required is that the specification should be such as to enable a workman of ordinary skill to make the machine; with respect to that therefore I do not apprehend you will find much difficulty." (a)

In *Neilson v. Harford*, (b) the specification of a patent for "the improved application of air to produce heat in fires, forges and furnaces where bellows or other blowing apparatus are necessary," did not state that it was necessary to use water twires in order to protect the pipe conveying the hot air into the blast furnace. It was proved that the blast could be used to a beneficial extent without the water twires, and that any person acquainted with smelting would apply them if necessary, and the patent was held to be good. In *Russell v. Cowley*, (c) the patent was for improvements in manufacturing tubes for gas and other purposes without the use of a maundril, which had always been used previously in the manufacture of iron tubes. The specification did not give any directions as to omitting the use of the maundril, but it was held that on reading the specification any person of ordinary intelligence would see that the invention was for the manufacture of tubes without a maundril.

Where the specification is of a long and complicated process consisting of several operations following one another in regular order and the description as a whole is sufficient, it will not be void because of some obscurity

(a) *Morgan v. Seaward*, 1 Webs. P. R. 176. also *Househill Iron Co. v. Neilson*, *ib.* 687.

(b) 1 Webs. P. R. 318. See (c) 1 Webs. P. R. 457.

in a part of the description which would not mislead a competent workman. In *Beard v. Egerton*, (a) the patent was for "a new and improved mode of obtaining the spontaneous reproduction of all the images received on the focus of the camera obscura." The specification stated that the process was divided into five operations. "The first consists in polishing and cleaning the silver surface of the plate, in order to properly prepare or qualify it for receiving the sensitive layer or coating upon which the action of the light traces the design. The second operation is, the applying that sensitive layer or coating to the silver surface. The third in submitting in the camera obscura the prepared surface or plate to the action of light so that it may receive the images. The fourth in bringing out or making appear the image, picture or representation, which is not visible when the plate is first taken out of the camera obscura. The fifth and last operation is that of removing the sensitive layer or coating which would continue to be affected, and undergo different changes from the action of light, this would necessarily tend to destroy the design or tracing so obtained in the camera obscura." A description was then given of the first operation, preparing the silver surface of the plate; the concluding part of which directed that nitric acid dissolved in water was to be applied three different times, care being taken to sprinkle the plate each time with powder, and rub it dry and very lightly with clean cotton. No objection was made to this part of the specification, but some further information was given respecting the preparation of the plate as follows: "When the plate is not intended for immediate use or operation, the acid may be used only twice upon

(a) 8 C. B. 214.

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its surface after being exposed to heat. The first part of the operation, that is, the preparation as far as the second application of the acid, may be done at any time; this will allow of a number of plates being kept prepared up to the last slight operation. It is however considered indispensable, that, just before the moment of using the plates in the camera, or the reproducing the design, to put at least once more, some acid on the plate, and to rub it lightly with pounce as before stated: finally, the plate must be cleaned with cotton from all pounce dust which may be on the surface or its edges." Upon this part of the specification it was contended that the direction to apply acid just before the moment of using the plates in the camera (which was the third operation) was a direction to use it after the second operation, viz. the coating the plate with iodine; and that using acid at that period would entirely spoil the whole process. It was held however that the specification was free from any such mistake or obscurity as would mislead a person of fair intelligence. "It must be remembered," said Sir T. Wilde, C. J., "that the passage in question is part of the directions given for performing the first operation, viz. preparing the plate to receive the iodine. It is to be observed when the plate is not intended to be used immediately, and where it has previously been partially, but not entirely, prepared for the iodine, this last application of acid is still to precede the second operation. The whole passage may be considered as in a parenthesis; and the expression, "just before the moment of using the plate in the camera," is put in opposition to the time of partially preparing the plate; after which it is supposed to have been laid by for future use. That this is the real meaning of the passage, is further mani-

fested by what follows in a subsequent part of the printed specification. ‘After this second operation (viz. the application of iodine) is completed, the plate is to be passed to the third operation, or that of the camera obscura. Wherever it is possible, the one operation should immediately follow the other.’ It is plain therefore that the patentee did not intend any separate operation to intervene between the application of iodine and the introduction of the plate into the camera obscura. The last application of acid must therefore have been intended to precede the second operation.

“This we think is the fair construction of the language of the specification. And although there may at first sight be some appearance of obscurity in it, we think that it is cleared away by a construction of the whole; and that it is sufficient to be understood by an operator of fair intelligence.”

But the omission must appear distinctly on the face of the specification and drawings. In *Simpson v. Holliday* (a) Lord Westbury said, “When it is stated that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is, because such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry; neither is the proposition true of an erroneous

The omission
must be patent.

(a) 13 W. R. 577.

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statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describes several processes or several combinations of machinery and affirms that such will produce a certain result, which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be perceived by an ordinary workman.”

Evidence.

The Court may, in the exercise of its discretion, refuse to consider questions arising on the construction of the specification until the evidence on the whole of the case has been heard. (a)

The evidence of persons who say that they could not make the machine from the specification, and that they think it is not probable that the person who drew the specification meant to describe the invention is nothing more than a corollary from their own opinion, because it is not intelligible to them. (b)

(a) *Young v. Fernie*, 4 Giff. 577.

(b) *Arkwright v. Nightingale*, 1 Webs. P. R. 61.

CHAPTER V.

OF DISCLAIMERS.

BEFORE the year 1835 a patentee whose specification was void by reason of unnecessary matter having been introduced into it, was unable to obtain any relief, although his invention might in other respects be meritorious. By 5 & 6 Will. IV. c. 83, s. 1, it was provided that "any person who as grantee, assignee, or otherwise hath obtained, or who shall hereafter obtain, letters patent for the sole making, exercising, vending or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively as the case may be, having first obtained the leave of His Majesty's Attorney-General or Solicitor-General in case of an English patent, or of the Lord Advocate or Solicitor-General of Scotland in the case of a Scotch patent, or of His Majesty's Attorney-General or Solicitor-General for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may with such leave as aforesaid enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall 'extend' the exclusive right granted by the said letters patent."

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5 & 6 Will.
IV. c. 83.
Any person
having ob-
tained letters
patent for any
invention may
enter a dis-
claimer of
any part of
his specifica-
tion or a memo-
randum of
alteration
therein.

Reasons must
be stated.

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The reason for a disclaimer is no part of the disclaimer itself. (a)

Meaning of word "extend."

The word "extend" in the above section cannot be used in its ordinary sense of "adding to" or "enlarging," because the exact meaning of the term "disclaimer," to which it is applied, is the renunciation of some previous claim actually made or apparently made or supposed to be made. It must, therefore, be intended to comprehend a case where the disclaimer would give the patentee a right which he could not have enjoyed under the specification as originally framed. (b)

Object of the act that unnecessary matter may be struck out.

The object of the act is that where a specification is void for claiming too much, the patent is not necessarily to be avoided, but may be amended by disclaiming the useless part; that is to say, if there is a general claim and a particular claim, and by a disclaimer the general claim is struck out, the particular claim may be good. "The spirit of the Act," said Maule, J., "seems to be this, that where there are objections that go only to a small and insignificant part of a patent, which if sustained would defeat it altogether, the patentee may relieve himself from the difficulty by a disclaimer." (c) In *Ralston v. Smith* (d) the law was very fully laid down by Lord Westbury, who said, "The object of the Act authorizing disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of

(a) *Cannington v. Nuttall*, L. R. 5 H. L. 227. *stock*, 4 De G. J. & S. 306; 10 L. T. (N. S.) 144.

(b) Per Lord Chelmsford in *R. v. Mill*, 10 C. B. 395.

(c) *Ralston v. Smith*, 11 H. & C. 254. See also *Foxwell v. Bo-*

(d) 11 H. L. C. 243.

being severed, leaving the original description in its integrity, good and sufficient without the necessity of addition, then you might, by the operation of a disclaimer, lop off the vicious matter and leave the original invention as described in the specification untainted and unimpaired by that vicious excess. But it was never intended that you should convert a bad specification, in the sense of its containing no description of any useful invention at all, into a good specification by adding words that would convert a barren and unprofitable generality into a specific and definite and practical description. It is quite clear that if that could be done you would have an opportunity of introducing into a bad patent which contained no useful invention whatever, some discovery that might be developed by further experiment and which was altogether unknown at the time of the original specification and not at all included in the description contained in it.

But bad specification cannot be made good by adding words.

But a further observation occurs upon this, that not only was it never intended by the statute that a patentee should take advantage of it for the purpose of converting a bad description into a good description in this sense, or that when the original description was wholly bad and contained no new invention it should be converted into a description containing a good invention; but the statute never contemplated that a patentee should have the power under the form of a disclaimer of making material additions to the original specification, so as by the aid of the corrected form of words and the additions so made to introduce into the specification an accurate and perfect description of an invention, which you seek for in vain in the original specification."

In this case the patent was for "improvements in em-

bossing and finishing woven fabrics, and in the machinery employed therein," and in the specification the patentee said: "I employ a roller of metal, wood, or other suitable material, and groove, flute, engrave, mill, or otherwise indent upon it any desired design." If the design were engraved longitudinally the material would be destroyed. The patentee afterwards entered a disclaimer by which he disclaimed the latter portion of the words of the title, and the use of any pattern rollers except those having circular grooves around their surfaces. It was held that the disclaimer was bad, as the specification was originally drawn up in general terms, and the disclaimer sought to extend the right by describing the alleged invention so as to enable the patentee to assert a right under the patent which he could not have maintained upon the original specification alone.

In *Seed v. Higgins* (a) the patentee claimed by his specification "the application of the law or principle of centrifugal force to the flyers employed" in certain machinery for roving cotton, and described how the force was to be applied. He afterwards disclaimed "all application of the law or principle of centrifugal force as being part of my said invention, or as being comprised in my claim of invention contained in the said specification, except only the application of centrifugal force by means of a weight acting upon a pressure so as to cause it to press against a bobbin, as described in the specification." Lord Cranworth said: "I think we must understand the patentee to have said that he claimed as his invention the application of centrifugal force to the flyers, as described. But then he did not confine himself to that mode; he

(a) 8 H. L. C. 550.

claimed, further, the application of the principle of centrifugal force to flyers used in machinery for preparing and roving cotton, in whatever way it might be applied. The effect of the disclaimer was to strike out of the specification this latter general claim, leaving only the claim for the particular mode of application specially described."

In *R. v. Mill(a)* the title of the patent was for "improvements in instruments used in writing and marking, and in the construction of inkstands." The specification described eleven heads of invention, some of which were void for want of novelty and utility. The patentee disclaimed "all those parts of my said invention which are respectively described and claimed in the said specification as being the fifth, the sixth, the seventh, and the eighth parts of the said invention." These claims related to pens and instruments used for marking with a stamp. The remaining claims were for improvements in pen-holders and pencil-cases, and in the construction of inkstands, and it was held that as the specification as amended by the disclaimer described improvements in instruments used in writing and marking, viz., pens and pencils, and improvements in the construction of inkstands, the title was satisfied by the specification so amended.

All the claiming clauses may be struck out of the specification by a disclaimer, if there remain in the body of the specification words sufficiently distinguishing what the invention is which the patentee claims. (b)

All claiming clauses may be struck out.

The effect of a disclaimer is merely to strike out from the specification those parts of the invention which are

Effect of disclaimer.

CHAP. V.

disclaimed; it cannot be read as explanatory of that which remains. (a) An alteration verbal merely, and not substantive, will not make a patent void. (b) It is not necessary to disclaim matters which manifestly form no part of the invention. (c) The effect of the statute is to render the disclaimer, when made, part of the patent and specification; and the patentee, from the moment of the disclaimer, becomes patentee of the undisclaimed part only. (d)

Disclaimer when filed to be deemed part of specification.

The disclaimer, or memorandum of alteration, being filed with the specification, is to be deemed and taken to be part of such letters patent or such specification in all courts whatever. (e) Formerly disclaimers were required to be enrolled, but it is now provided that disclaimers and memoranda of alteration shall be filed in the office appointed for filing specifications in Chancery, with the specification to which they relate, instead of being entered or filed and enrolled, as provided in the principal Act, and in the Act 12 & 13 Vict. c. 109. (f)

The disclaimer operates as part of the letters patent and specification from the date of the grant. (g) There is no express enactment in the statute that the disclaimer, if it transgresses the statutory limit by extending the exclusive right, shall be void to all intents and purposes; and unless it be so it must remain enrolled with and al-

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

(b) *Thomas v. Welch*, L. R. 1 C. P. 192.

(c) *Lister v. Leather*, 8 E. & B. 1004; *Morton v. Middleton*, 1 Dec. of Ct. of Sess. 3rd series, 718.

(d) *Clark v. Kenrick*, 12 M. & W. 219.

(e) 5 & 6 Will. IV. c. 83, s. 1.

(f) 15 & 16 Vict. c. 83, s. 39.

(g) *R. v. Mill*, 10 C. B. 379; *Stocker v. Warner*, 1 C. B. 148.

ways accompany the letters patent and specification. It might be proper to hold that the disclaimer is inoperative for the excess only when that excess is clearly distinguishable. (a)

The filing of a copy of the disclaimer is a compliance with the provisions of the Act. (b)

The Act of the 5th & 6th Will. IV. c. 83 only gave the patentee the right to disclaim, and as it was considered doubtful whether the assignee of a patent could enter a disclaimer, it was by the 7th & 8th Vict. c. 69, s. 5, enacted,—“that in case the original patentee or patentees hath or have departed with his or their whole or any part of his or their interest, by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the principal Act; and such disclaimer and memorandum of such alteration, having been so entered and filed as in the said recited Act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf.”

Under the latter part of this section it was held that a disclaimer will be valid, although the patentee at the

Filing of copy sufficient.

7 & 8 Vict. c. 69, s. 5.

Disclaimer and memorandum of alteration may be entered although the original patentee may have assigned his patent right.

(a) Per Lord Westbury in *Foxwell v. Bostock*, 4 De G. J. & S. 307; 10 L. T. (N. S.) 144.

(b) *Wallington v. Dale*, 7 Exch. 888.

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time he entered it had assigned all his interest in the patent. (a)

Filing to be conclusive as to the right of the party.

By the Patent Law Amendment Act (15 & 16 Vict. c. 83, s. 39) it is provided "that such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officers as in the principal Act mentioned, certified as therein mentioned, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the said Act; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf."

Disclaimer not to affect actions pending.

The Act of the 5th & 6th Will. IV. c. 83, s. 1, provided that "no disclaimer or memorandum of alteration shall be receivable in evidence in any action or suit (save and except in any proceedings by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted."

Act not retrospective where infringement.

Under this section it was decided that where a patent is originally void, but is amended by a disclaimer, the Act has not a retrospective operation, so as to make a party liable for an infringement committed prior to the time of entering the disclaimer, even though the parts

(a) *Wallington v. Dale*, 7 Exch. 888.

infringed have not been affected by the disclaimer; (a) and by the Patent Law Amendment Act (15 & 16 Vict. c. 83, s. 39) it is provided that "no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the law officer shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration."

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 Action may not be brought without leave of law officer.

The law officer may before granting his fiat require the applicant to advertise his disclaimer or memorandum of alteration in such manner as he may think fit, and if he requires such advertisement, must certify in his fiat that the same has been duly made. (b)

Law officer may require disclaimer or memorandum of alteration to be advertised.

Any person may enter a *caveat* against such disclaimer or memorandum of alteration, which gives him a right to have notice of the application being heard by the law officer. (c)

Caveats against disclaimer may be entered.

All applications for leave to enter a disclaimer or memorandum of alteration are to be made, and all *caveats* relating thereto are to be lodged, at the office of the commissioners, and are to be referred to the law officer. (d)

Applications for disclaimers and caveats to be at the office.

All the provisions of the Acts of the 5th and 6th Will. IV. and 7th and 8th Vict. c. 69, respectively relating to disclaimers and memoranda of alterations in letters patent,

Provisions of 5 & 6 Will. IV. c. 83, and of 7 & 8 Vict. c. 69, as to disclaimer and memorandum of alteration to apply to patents under the Patent Law Amendment Act.

(a) *Perry v. Skinner*, 2 M. & W. 471; *R. v. Mill*, 10 C. B. 379.

(c) *Ib.*

(b) 5 & 6 Will. IV. c. 83, s. 1. See also App. Rules of Practice before Law Officer.

(d) 15 & 16 Vict. c. 83, s. 39. See also App. Rules of Practice before Law Officer.

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are applicable and apply to any letters patent granted and to any specification filed under the provisions of the Patent Law Amendment Act. (a)

Stamp duties.

The application for leave to disclaim must be impressed with a stamp of £5 ; a caveat with a stamp of £2. (b)

(a) 15 & 16 Vict. c. 83, s. 39.

(b) 16 Vict. c. 5.

CHAPTER VI.

OF THE METHOD OF OBTAINING LETTERS PATENT.

THE law relating to the grant of letters patent is now regulated by the "Patent Law Amendment Act, 1852," (a) and the acts of the 16th Vict. c. 5, 16 & 17 Vict. c. 115, and 22 Vict. c. 13. The first five sections of the Patent Law Amendment Act relate to the Commissioners of Patents, their seal, their power of making rules, and to their office and officers. (See post, chap. vii.)

The first step for an applicant for letters patent to take is to petition the Crown for a grant. The petition states that the petitioner is in possession of an invention (naming it); that he believes that it will be of great public utility; that he is the first and true inventor; and that it is not in use by any other person or persons to the best of his knowledge and belief. The application must be for one invention only. (b) The petition is accompanied by a declaration in support. Forms of petition and declaration will be found in the schedule to the Act.

Lithographed forms of petition and declaration may be obtained from law stationers.

In any application for a patent which is stated to be a

(a) 15 & 16 Vict. c. 83.

(b) See App. Third Set of Rules, cl. 1.

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Petition for grant of letters patent the first step.

Declaration where patent communicated from abroad.

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communication from abroad, the declaration ought to state the name and address of the party from whom it has been received in the following manner:—

No. 1. When declaration is made in the United Kingdom,—“That it has been communicated to me from abroad by (here insert name and address in full).”

No. 2. In other cases,—“That it is a communication from (A. B.), a person resident at (here insert the address in full).” (*a*)

Petition and declaration to be accompanied by a provisional specification.

The petition and declaration are then left at the office of the commissioners. There is also left at the same time a statement in writing, called a provisional specification, signed by or on behalf of the applicant, describing the nature of the invention. The day of the delivery of these documents is endorsed on them and recorded, and a certificate given to the applicant or his agent. (*b*)

Size of documents.

The petition for the grant of letters patent and declaration and the provisional specification must be written upon sheets of paper of twelve inches in length by eight inches and a-half in breadth, leaving a margin of one inch and a half on each side of the page, so that they may be bound in the books to be kept at the office. The drawings accompanying the provisional specification must be made upon a sheet or sheets of parchment, paper, or cloth, each of the size of twelve inches in length by eight inches and a-half in breadth, or of the size of twelve inches in breadth by seventeen inches in length, leaving a margin of one inch on every side of each sheet. (*c*)

(*a*) Rule of 23rd Feb. 1859.

(*c*) See First Set of Rules,

(*b*) 15 & 16 Vict. c. 83, cls. 1, 2.

s. 6.

All provisional specifications must be written on one side only of the sheet. (a)

No amendment or alteration at the instance of the applicant will as a rule be allowed in a provisional specification after it has been recorded, except for the correction of clerical errors or of omissions made *per incuriam*. (b)

The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprised of the improvement, and of the means by which it is to be carried into effect. (c) The application and provisional specification are then referred to one of the law officers of the crown. (d) He may call to his aid such scientific or other person as he may think fit, who is to be paid such sum by the applicant as the law officer may direct. If the law officer is satisfied that the provisional specification describes the nature of the invention he will allow it and give a certificate of his allowance, which is filed in the office, and the invention is then protected for the term of six months from the consequences of use and publication. (e)

The provisional specification must as a rule be for one invention only. (f)

The title of the patent must point out distinctly and specifically the nature and objects of the invention. (g) "Every patent must stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it

Amendment
of provisional
specification.

Provisional
specification
must be dis-
tinct.

Reference to
law officer.

Provisional
specification
must be for
one invention
only.

Title must be
distinct.

(a) Rule of 23rd Feb. 1859.

(b) Second Set of Rules, cl. 9.

(c) *Ib.* cl. 10.

(d) 15 & 16 Vict. c. 83, s. 7.

(e) *Ib.* s. 8.

(f) Third Set of Rules, cl. 1.

(g) Third Set of Rules, cl. 2;

Househill Iron Co. v. Neilson, 1

Webb. P. R. 673.

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must stand on the ground of the discovery of something altogether new; and the patent must distinguish and adopt itself accordingly. If the patent be taken out for discovery when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void.” (a)

The title must give some idea, and so far as it goes a true idea, of the alleged invention. Where the title described the invention to be “for certain improvements in copper and other plate printing,” and it appeared that copper plate printing consisted of a great variety of processes; it was held that an improvement in the preparation of the paper which rendered the lines on the plate engraving more clear and distinct might be considered as an improvement in copper plate printing, and that the title was not too vague. (b)

In *Nickels v. Haslam*, (c) letters patent were obtained for “improvements in the manufacture of plaited fabrics.” The specification described only a single improvement in the mode of manufacture. It was held that there was not such an inconsistency between the title of the invention and the description as to invalidate the patent.

In *Wright v. Hitchcock* (d) the title of the patent described it as being for the invention of “improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein.” The specification described a process of plaiting fabrics by means of a reciprocating knife having a straight or serrated edge and provided with suitable notches on its edge for the passage of the

(a) Per Lord Eldon in *Hill v. Thompson*, 3 Mer. 626.

(b) *Sturtz v. De la Rue*, 5 Russ. 324.

(c) 8 Scott (N. R.) 97. See also *Penn v. Bibby*, L. R. 2 Ch. 127.

(d) L. R. 5 Exch. 37.

needle or needles of a sewing machine with which it was worked in combination. The claims were—1. The general construction, arrangement and combination of machinery, apparatus or means for producing crimped or plaited frills or trimmings in a sewing machine. 2. The application and use of a reciprocating knife for crimping fabrics in a sewing machine. 3. The peculiar manufacture of crimped or plaited frills or trimmings as hereinbefore described and illustrated by fig. 8 of the drawings. The drawing showed a double frill, or a middle plaited strip with a frill above and a frill below. It was held that the patent was not for the manufactured product but for the process of manufacturing it. Sir F. Kelly, C. B., said: “The title of the patent describes it as being for the invention of “improvements in the manufacture of frills or ruffles and in the machinery employed therein.” It is not for an improvement in frills or ruffles, still less for an improved frill or ruffle, but for an improvement in the manufacture of frills or ruffles and the machinery employed therein. The specification also relates entirely to the machinery, and contains from beginning to end nothing which could lead us to construe it as a specification of the articles manufactured.” (His lordship then stated the third claim, and proceeded:) “But is it the kind of frill that is made the subject of the claim? On the contrary, it is the peculiar mode of manufacturing it, or the frill as manufactured by a reciprocating knife. Therefore, whether we look at the title of the patent, the specification, or the claim, the patent is not for the article manufactured, but for the mode by which the article described is brought into existence.”

Where the title is not inconsistent with the speci-

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fication and no fraud is practised it is not a fatal objection that the title is so general as to be capable of comprising a different invention from that for which the patent is claimed. (a) It must be consistent with the specification, with which it may be read for the purpose of explanation. (b)

Instances of
sufficient title.

In the following cases the titles were considered to be sufficiently precise. In *Cook v. Pearce* (c) the patent was taken out for improvements in carriages, and the invention was in fact an improvement in German shutters which were used only in some kinds of carriages. A patent was taken out for "certain improvements in the doors and sashes of carriages." In the specification, after describing it, the patentee said: "I have shown my invention as applied to railway carriage doors and window fittings, although they are equally applicable to the doors and windows of any other description of carriage or in any position where windows and doors are subject to jar and vibration," and the claim in the specification was held not to be larger than the title of the patent. (d)

Before the date of a patent it was known that sulphuret of iron produced by the action of sulphuretted hydrogen upon hydrated oxide of iron would be re-oxidized by being exposed to the action of atmospheric air; but it was not known that when the sulphuret was produced by the exposure of hydrated oxide of iron to the action of sulphuretted hydrogen mixed with coal gas,

(a) *Cook v. Pearce*, 8 Q. B. 8 M. & W. 806; *Oxley v. Holden*, 1044; *Neilson v. Harford*, 8 M. & W. 806. (c) 8 Q. B. 1044.

(b) *Sturtz v. De la Rue*, 5 Russ. 324; *Neilson v. Harford*, (d) *Oxley v. Holden*, 8 C. B. (N. S.) 666.

the re-oxidation of the iron might be prevented by the cyanogen compounds of ammonia and tarry matter which would be mixed with it. It was held that a patent might be had for re-oxidizing the iron by exposure to the air after it had been used in the purification of coal gas, and also that the invention came within the title of the patent as an improved mode of manufacturing gas. (a)

In *Beard v. Egerton*, (b) a title which described the patent to be for a certain invention of "a new or an improved method of obtaining the spontaneous reproduction of all the images received in the focus of the camera obscura" was held to be sufficiently precise and certain; and in *Stead v. Williams*, (c) a title which described the invention as being for a mode of "making or paving public streets and highways, and public and private roads, courts and bridges, with timber or wooden blocks" was held not too vague.

In *R. v. Mill*, (d) the title of patent was for "improvements in instruments used for writing and marking," and the specification contained a claim for "improvements in pencil-cases, pen-holders and pens." It was held that the specification was as comprehensive as the title, as pen-holders and pencil-cases might be described as instruments used for marking as well as writing.

But where the patent was for "improvements in the manufacture of gas for the purpose of illuminating, and in the apparatus used when transmitting and measuring gas," and the title of the specification described the invention as consisting of "improvements in the manufacture of gas for illumination and in the apparatus used

Instances of
bad titles.

(a) *Hills v. The London Gas Light Co.*, 5 H. & N. 312.

(c) 2 Webs. P. R. 126.

(b) 3 C. B. 97.

(d) 10 C. B. 379.

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therein, and when transmitting and measuring gas," and the specification stated the invention to relate "first to a mode of manufacturing gas for the purpose of illumination; secondly, to improvements in setting and heating clay retorts for making coal gas; thirdly, to a mode of manufacturing clay retorts; and fourthly, to improvements in apparatus for measuring gas when it is being transmitted to the consumer," it was held that there was a material variance between the invention specified and that described in the title: as the claim for making retorts could not be called either a mode of manufacturing gas or the apparatus used in measuring and transmitting gas, and that therefore the patent was void. (a)

In *R. v. Metcalfe*, (b) a brush differing from a common one in no other respect than that the hairs or bristles were of unequal length, was held to be improperly described as a "tapering brush" by Lord Eldon, who said, "If the word tapering be used in its general sense the description is defective, there is no coming to a point. If the term has had a different meaning annexed to it by the usage of the trade it may be received in its perverted sense." In the case of *R. v. Wheeler*, (c) the patent was for "a new and improved method of drying and preparing malt," and the specification showed that the invention was, not as would be supposed, for a method of making malt from barley, but for making a colouring matter for beer from prepared malt; Abbott, C.J., said: "The language in which the supposed invention is described in a patent of this nature is the language of the patentee himself. He represents to the Crown that he has invented this thing or that thing, and

(a) *Croll v. Edge*, 9 C. B. 479.

(b) 2 Stark. 249.

(c) 2 B. & Ald. 345.

that he is the first and sole inventor thereof, and the Crown yielding to his representations and willing to give encouragement to all arts and inventions that may be for the public good, grants to the patentee the sole liberty and privilege of using his said invention for a certain time under the conditions before noticed. It is obvious, therefore, that if the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true if it should happen that the patentee has invented some other matter or thing of which upon a true representation thereof he might have been entitled to a grant of the exclusive use."

In *Cochrane v. Smethurst*, (a) it was held that a patent "for an improved method of lighting cities, towns and villages" could not be supported by a specification describing an improved lamp; and in *Brunton v. Hawkes*, (b) it was held that a patent for improvements in the construction of ship's anchors, windlasses and chain cables could not be supported unless there was novelty in each invention.

If the law officer is of opinion that the title is too large or insufficient, he may allow or require it to be amended. (c)

Amending
title.

Where a provisional specification is left, and provisional protection is thus obtained, there is nothing to prevent another provisional specification for a similar invention being left, and letters patent may be granted to the second applicant, within six months of the time when the first provisional specification was left. (d)

No right of
priority gained
by leaving
provisional
specification.

(a) 1 Stark. 205.

(c) 15 & 16 Vict. c. 83, s. 8.

(b) 4 B. & Ald. 542.

(d) *Ex parte Bates & Red-*

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Complete specification may be left instead of provisional specification, such deposit to confer for a limited time the like rights as letters patent.

Instead of leaving a provisional specification, the applicant may, if he thinks fit, file an instrument under his hand and seal called a complete specification, particularly describing and ascertaining the nature of the invention, and in what manner it is to be performed. This instrument must be mentioned in the declaration. The day of delivery of any of the above mentioned documents is endorsed on them, and recorded in the office, and a certificate given to the applicant or his agent. The invention is then protected for six months, and the applicant during that time enjoys the privileges of a patentee. (a)

All specifications, in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, must be written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth; they may be written on both sides of the sheet, but a margin must be left of one inch and a half on every side of each sheet.

The drawings accompanying such specification must be made upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth, or upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in breadth by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of each sheet. (b)

The applicant does not, by taking this course, acquire the rights of a patentee, so as, during the six months

But not so as to prevent previous applicant for similar patent from obtaining grant.

gate, L. R. 4 Ch. 577; *Ex parte Bailey*, L. R. 8 Ch. 60; *Ex parte Henry*, *ib.* 169.

(a) 15 & 16 Vict. c. 83, s. 9.

(b) Order 1st Oct. 1852.

protection, to prevent any other person, who has previously applied for a patent for a similar invention, from obtaining a patent. (a)

Any part of the provisional specification may be omitted from the complete specification, if there is no fraud, and the effect of the remainder is not altered by the omission. Thus, in *Thomas v. Welch*, (b) the provisional specification of a patent for sewing machines claimed amongst other improvements, that a certain instrument which improved the work, "or another acting therewith," acted to hold the work during the insertion of the needle, while the complete specification appeared to describe only one instrument as moving and holding the work. It was held that this was not such a variance as could invalidate the patent.

Variance between provisional and complete specifications.

The office of the provisional specification is not to disclose the entirety of the invention, but only to show that the invention fully specified is the same in substance as that presented to the law officer. (c)

Office of provisional specification.

The statute requires, that in the provisional specification "the nature of the invention" shall be described, but that the complete specification shall particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed." If, therefore, it were possible to depart from the nature of the invention described in the provisional specification, protection might be given to a patentee for something described in it, from which he might depart altogether when he filed his complete specification. It is, at all

The invention described in the two specifications must be the same.

(a) *Ex parte Henry*, L. R. 8 Ch. 167. R. 15; S. C. on app. 4 C. B. (N. S.) 269; *Thomas v. Welch*,

(b) L. R. 1 C. P. 192. L. R. 1 C. P. 502; *Wright v.*

(c) *Newall v. Elliott*, 13 W. *Hitchcock*, L. R. 5 Exch. 42.

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events, requisite that the invention, as shown in the two specifications, shall be one and the same. No addition or alteration ought to be made by which the nature of the invention, as described in the complete specification, becomes in a material respect different from the nature of the invention described in the provisional specification. (a)

Complete specification need not extend to everything included in provisional specification.

The complete specification must not claim anything different from that which is contained in the provisional specification, but it need not extend to everything so included. Thus, where the provisional specification of a patent for "an improvement in the bearings and bushes for the shafts of screw and submerged propellers" described the invention to consist in employing wood in the construction of such bearings and bushes, and the complete specification afterwards, in describing the mode in which the wood was to be used, claimed the employment of wood in the construction of bearings and bushes "as therein described," it was held that there was not such a variation between the provisional and complete specifications as invalidated the patent. (b)

Provisional specification may be in some respects incomplete.

If it were necessary that the provisional specification should enter into all the minute details as to the manner in which the invention is to be carried out, it would have to be as full as the complete specification and drawn with as much care. The statute by the use of the word "complete" implies that the provisional specification may be in some respects executory and incomplete. It enacts that the provisional specification is to describe the nature of the invention and no more, and that the complete specification shall describe not only the nature of the in-

(a) Per Lord Westbury in *Foxwell v. Bestock*, 4 De G. J. & S. 298; 10 L. T. (N. S.) 144.

(b) *Penn v. Bibby*, L. R. 2 Ch. 127.

vention but also particularly ascertain the manner in which it shall be performed. In *Re Newall & Elliot*, (a) the inventor of an improved apparatus for laying down submarine telegraph cables described his invention in the provisional specification as follows:—"The cable or rope containing the insulated wire or wires is passed round a cone, or if it is a long cable round several cones, so that the cable in being drawn off the coil is prevented from kinking by means of the cone; and there is a cylinder on the outside which prevents the coil from shifting in its place;" and in the complete specification after repeating the above description the inventor went on to say: "When the wire or cable is to be laid down I place over the cone an apex or top which is conoidal as shown in the drawing, or conical, and around this I suspend several rings of iron or other metal by means of cords so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed; and the combination of these parts of the apparatus prevents the wire or cable from running into kinks." He claimed as his invention 1st coiling the wire or cable round a cone, 2ndly the supports placed cylindrically outside the coil round the cone, 3rdly the use of the rings in combination with the cone as described. It was held that the omission of the rings from the provisional specification did not invalidate the patent.

The provisional specification cannot be read for the purpose of interpreting the complete specification. (b)

Where the applicant has filed a complete specification

(a) 4 C. B. (N. S.) 293.

(b) *Mackelcan v. Rennie*, 13 C. B. (N. S.) 52.

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Conditions voiding the patent.

and letters patent are granted to him ; instead of a condition voiding the letters patent in case the invention is not described and ascertained by a subsequent specification, such letters patent will be conditional to become void if such complete specification does not particularly describe and ascertain the nature of the invention and how it is to be performed. (a)

Provisional or complete specification obtained in fraud not invalidate letters patent.

Letters patent granted to the true and first inventor of an invention, will not be invalidated by reason of a provisional specification or complete specification deposited in fraud (b).

Commissioners to cause protections to be advertised.

Where any invention is provisionally protected under the Act, or protected by deposit of a complete specification, the commissioners are to cause such protection to be advertised, (c) the advertisement will be in the "London Gazette," and sets forth the name and address of the petitioner, the title of his invention, the date of the application, and in the case of a complete specification, that such has been deposited. (d)

Application for letters patent to be advertised, and also oppositions to the same.

As soon as he thinks fit, after the foregoing steps have been taken, the applicant may give notice at the office of commissioners of his intention to proceed with his application ; the commissioners then cause the application to be advertised. Any persons having an interest in opposing the grant may leave particulars of their objections to the application as follows. (e) The notice of intention to proceed is advertised in the "London Gazette," and the advertisement sets forth the name and address of the petitioner, and the title of his invention ; and that any persons having an interest in opposing such application are to be

(a) 15 & 16 Vict. c. 83, s. 9.

(b) *Ib.* s. 10.

(c) *Ib.* s. 11.

(d) First set of Rules and Regulations, cls. 3, 4.

(e) 15 & 16 Vict. c. 83, s. 12.

at liberty to leave particulars in writing of their objections to the application at the office within twenty-one days after the date of the Gazette in which the notice is issued. (*a*)

The notice of the applicant's intention to proceed must be left at the office eight weeks before the expiration of the term of provisional protection, and no notice to proceed may be received unless the same has been left in the office eight weeks at the least before the expiration of such provisional protection. The Lord Chancellor may upon special circumstances allow a further extension of time.

After the time for delivery of such objections shall have expired, the provisional specification, or complete specification, and particulars of objection, are referred to the law officer to whom the application has been referred. (*b*)

The law officer may by certificate order, by or to whom the costs of any hearing or inquiry upon any objection or otherwise in relation to the grant of the letters patent or in relation to the provisional or other protection shall be paid, and in what manner and by whom they are to be ascertained. If they are not paid within four days after they are ascertained, the law officer may make an order for payment, which may be made a rule of court. (*c*)

After the hearing the law officer may cause a warrant to be made for the sealing of letters patent. This warrant is to be sealed with the seal of the commissioners, and sets forth the tenor and effect of the letters patent. The law officer may direct the insertion of all such restrictions, conditions and provisoes as he may deem usual and expedient. The warrant "shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant." The application for the

Time when notice to proceed to be left at office.

Specifications and objections to be referred to the law officer.

Power to law officer to order by or to whom costs shall be paid.

Power to law officer to cause a warrant to be made for sealing of letters patent.

When application for warrant to be made.

(*a*) First set of Rules and Regulations, cl. 5.

(*b*) 15 & 16 Vict. c. 83, s. 13.

(*c*) 15 & 16 Vict. c. 83, s. 14.

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warrant of the law officer and for letters patent must be made at the office twelve clear days at least before the expiration of the term of provisional protection, and no warrant or letters patent will be prepared unless such application has been made within the time fixed. The Lord Chancellor may upon special circumstances allow a further extension of time, on being satisfied that the same has become necessary by accident and not from neglect or wilful default of the applicant or his agent. (a)

All powers which the Lord Chancellor had at the time of the passing of the Act are reserved to him. (b) In the case of a provisional specification only having been left, a provision requiring a complete specification to be filed within six months from the date of the application must be inserted. (c)

Nothing to affect the prerogative of the Crown in granting or withholding grant of letters patent.

It is provided that nothing in the Act shall extend to abridge or affect prerogative of the Crown in relation to the granting or withholding of any letters patent, and that it shall be lawful for Her Majesty by warrant under her Royal sign manual to direct the law officer to withhold his warrant, or that any letters patent for the issuing of which he has issued a warrant shall not issue, or to direct the insertion in any letters patent of any restrictions, conditions or provisions which she may think fit, and also to direct any complete specification to be cancelled. (d)

A grant of letters patent to a subject does not, according to the decision in the case of *Feather v. The Queen*, (e) exclude the Crown from using the invention without the licence of the patentee, and the Court of

(a) Third set of Rules, cl. 6.

(d) 15 & 16 Vict. c. 83, s. 16.

(b) 15 & 16 Vict. c. 83, s. 15.

See *In re Schlumberger's Patent*,

(c) Second set of Rules and

9 Moo. P. C. C. 1.

Regulations, cl. 8.

(e) 6 B. & S. 257.

Queen's Bench will not issue a mandamus to any Government officers to compel them, if they use the invention, to settle terms according to the patent. (a) If they have infringed the patent, the remedy is by action, and not by way of petition of right. (b)

Improvements in instruments or munitions of war may be assigned by the inventor to the Secretary of State for War, who may certify to the Commissioners of Patents that the invention should be kept secret. In such a case the petition for letters patent and the specification, and all documents relating to the invention, are left with the Clerk of the Patents, under the seal of the Secretary of State, to whom at the end of the term of letters patent they are delivered up. (c)

As soon after the sealing of the warrant as required by the applicant, the Commissioners cause letters patent to be prepared according to the tenor of the warrant. The Lord Chancellor then causes these to be sealed with the Great Seal. Such letters patent extend to the whole of the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man. If the warrant so directs, they may be made applicable to the Colonies, or such of them as may be mentioned in the warrant. They confer the like powers, rights, and privileges as letters patent issued under the Great Seal. But nothing is to give effect to any letters patent in any colony in which they would be invalid by the law of the colony. (d)

No letters patent, except in the case of letters patent destroyed or lost, may issue on any warrant, unless appli-

Munitions of war.

Issue of letters patent.

Extent.

No letters patent issued after three months from date of warrant.

(a) *Ex parte Pering*, 4 A. & E. 949.

(c) See 22 Vict. c. 13.

(d) 15 & 16 Vict. c. 83, s. 18.

(b) *Feather v. The Queen*, 6 B. & S. 257.

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cation be made to seal them within three months after the date of the warrant; (a) nor after the protection given by the Act has expired, unless the application to seal has been made during that time, and has been delayed by reason of a *caveat*. In such a case they may be sealed at such time as the Lord Chancellor shall direct. (b)

Power to Lord Chancellor to order letters patent to be sealed in certain cases.

By a later Act (c) it is provided that where letters patent have not been sealed during the continuance of the provisional protection through accident, the Lord Chancellor may seal them within a month after the expiration of the provisional protection, and may date the sealing as of any date before the expiration of such provisional protection.

The petition praying for extension, and the affidavit accompanying it, must be left at the office. Where the delay in sealing is alleged to have been caused by adjourned hearings of objections to the grant of letters patent before the law officer, the petitioner, before leaving his petition, must obtain the certificate of the law officer that such allegations are correct, and that the delay has not been caused by the neglect or default of the petitioner. (d)

Delay accidental or caused by order of government.

In *Re Hersee & Smith* (e) leave was given to extend the time, within which the application for the warrant of the law officer and for the letters patent ought to have been made, the delay being small and accidental. And in another case the time was extended, the petitioner having been ordered to delay making his application by the War Office. (f)

Where applicant dies during continuance of protection grant may be to personal representatives.

In case the applicant dies during the continuance of the protection, the letters patent may be issued to his

(a) 15 & 16 Vict. c. 83, s. 19.

(c) L. R. 1 Ch. 518.

(b) 15 & 16 Vict. c. 83, s. 20.

(f) *Mackintosh's Patent*, 2

(c) 16 & 17 Vict. c. 115, s. 6.

Jur. (N. S.) 1242.

(d) Order of 17th July, 1854.

personal representatives during the continuance of the protection, or at any time within three months after the death of the applicant, notwithstanding the expiration of the term of protection. (a)

In case any letters patent are destroyed or lost, others of the like tenor and effect, sealed and dated as of the same day, may be issued. (b)

By an order of the 15th of October, 1852, it is provided that every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and that such notice shall be left at the office, and shall contain particulars in writing of the objections to the sealing of such letters patent. It is not necessary for any opposer to apply to the Court for leave to give notice of opposition. (c)

No person who has not opposed before the law officer, except in cases where the reason for not having so opposed is fully explained, will be allowed to oppose before the Lord Chancellor, (d) and the opposer cannot bring forward before the Lord Chancellor any facts which were within his knowledge when before the law officer, but which he did not then bring forward, nor can he raise any new legal argument on those facts, or produce any evidence which he could have previously produced. (e)

Leave may be given to oppose the sealing of letters patent notwithstanding the time for entering an opposition has expired, if there is no question of *laches*, and the reason for the delay is properly accounted for. (f)

(a) 15 & 16 Vict. c. 83, s. 21.

(b) *Ib.* s. 22.

(c) *Vincent's Patent*, L. R. 2 Ch. 341, overruling *Heathorn's Patent*, 4 N. R. 489.

(d) *Mitchell's Patent*, L. R. 2 Ch. 343.

(e) *Ex parte Sheffield*, L. R. 8 Ch. 237.

(f) *Brennand's Patent*, 7 Jur. (N. S.) 690.

Letters patent destroyed or lost.

Opposing the grant before the Lord Chancellor.

Application to Court not necessary.

Must have been opposition before law officer.

Extension of time for opposing grant.

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Duty of the law officer where similar inventions.

It is the duty of the law officer to investigate and decide in the first instance whether two inventions for similar inventions interfere with each other, or which of the two applicants is the true and first inventor, (a) and the question ought not to be remitted to the Lord Chancellor by directing warrants for both patents. (b) In *Re Fawcett's Patent*, (c) on a caveat being entered before the Great Seal had been affixed, the Lord Chancellor declined to enter into the merits of the opposition, but referred the matter back to the law officer. (d)

This judgment not interfered with.

The judgment of the law officer will not be interfered with; unless a case is made of surprise or fraud, or unless some material fact has come to the knowledge of the appellant which if brought to the knowledge of the law officer would have led him to decide differently. (e)

Letters patent will be sealed unless clearly bad.

Unless a patent is clearly bad, the Lord Chancellor will not refuse to sign it, as the effect of such refusal, if erroneous, would be irremediable, whereas the sealing of a bad patent leaves every one at liberty to dispute it. (f) It is for the opposer to show that he has so clear a case as to make it right to do that which, if wrongly done, would, so far as relates to the patentee, be irreparable, but which, if left undone, could not inflict upon the opponent any irreparable injury. (g)

The person who first obtains a patent has priority.

Where there are several applicants for patents for

(a) *Griffith and Samuda's Patent*, 5 L. T. 141.

(b) *Ex parte Henry*, L. R. 8 Ch. 167.

(c) 2 D. M. G. 439.

(d) And see *Stoll's Patent*, 22 L. T. 233; *Ex parte Hen-son*, 1 Webs. P. R. 432.

(e) *Vincent's Patent*, L. R. 2 Ch. 341.

(f) *Spence's Patent*, 3 De G. & J. 523; *Russell's Patent*, 2 *ib.* 130.

(g) *Ex parte Sheffield*, L. R. 8 Ch. 240; *Tolson's Patent*, 6 D. M. G. 422.

similar inventions, the one who first obtains the letters patent to be sealed will have priority, though another applicant may have applied for provisional protection first, (a) unless it is perfectly clear that there has been fraud, as the opposer will still be able to get the patent repealed. (b)

Where a later applicant for protection obtains his patent first, letters patent will not be granted to an earlier applicant for any part of his invention, which is covered by the letters patent already obtained by the later applicant. (c) But in a case where the relation of master and servant existed between the applicants, and the master became acquainted with the servant's invention, and the evidence showed that there was great suspicion that the master had profited by the servant's invention, it was held that, under the circumstances, the letters patent for the servant's invention might be sealed and bear the date of his provisional specification. (d)

If a patent has been actually sealed, and another is applied for, which is objected to on the grounds that the alleged invention is not new, and is a mere evasion or colourable imitation of the invention for which a patent has been already granted, it will be referred to the law-officer to say whether, having regard to the prior patent, the present application ought to be granted; (e) and if it appears that part of the invention for which the patent is

Later patent not allowed to cover any part of earlier.

Reference to law officer where patent sealed and another applied for which is objected to.

(a) *Ex parte Bates and Redgate*, L. R. 4 Ch. 579; *Simpson and Isaacs' Patent*, 21 L. T. 81.

(b) *Lowe's Patent*, 25 L. J. Ch. 454.

(c) *Ex parte Bates and Red-*

gate, L. R. 4 Ch. 577; *Ex parte Henry*, L. R. 8 Ch. 169.

(d) *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(e) *Ex parte Yates*, L. R. 5 Ch. 1; *Ex parte Manceaux*, *ib.* 518.

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sought is identical with part of an invention which is the subject of the existing patent, a second patent will not, except under special circumstances, be granted for that part, although the validity of the first patent is disputed. (a)

Objection that first patent obtained by fraud.

Where the sealing of a patent was opposed on the ground of public user, and the applicant contended that such user took place in consequence of fraud, which, under 15 and 16 Viet. c. 83, s. 10, would destroy the effect of the user, it was held that this was a question of fact, which ought to be tried by a jury on *vivâ voce* evidence, and that the patent ought to be sealed, so as to allow such trial to take place. (b)

Lord Chancellor may impose terms.

The Lord Chancellor may, if he thinks fit, direct the letters patent to be sealed upon terms. (c)

Where it appeared that a master and his foreman had both invented certain improvements, for which the master sought letters patent, they were granted on the terms of being vested in trustees for both parties. (d) As to the terms of a compromise in a similar case see *Brandies' Patent*. (e)

It is no objection to the grant of a patent that another person has been making experiments and working towards a similar invention. (f)

Delay in applying.

Where, in April, two months after the petition for a patent had been left, the petitioner applied to have the

(a) *Ex parte Manceaux*, L. R. 6 Ch. 272; *Stoll's Patent*, 21 L. T. 233.

(b) *Vincent's Patent*, 2 Ch. 341.

(c) *Daines' Patent*, 26 L. J. Ch. 298.

(d) *Re Russell's Patent*, 2 De G. & J. 130.

(e) 1 Eq. Rep. 121.

(f) *Ex parte Henry*, L. R. 8 Ch. 167.

great seal affixed, and a *caveat* was entered a week afterwards, and in September the applicant presented a petition for sealing, it was held that the delay was no objection. (i)

By an order of the 11th February, 1873, it was directed that every order made by the Lord Chancellor upon the hearing of petitions against or relating to the sealing of letters patent shall be drawn up, passed and entered by the Registrar of the Court of Chancery in attendance, and that an office copy of such order shall be remitted by him, without fee, to the clerk of the combined offices of the Great Seal and the office of the Commissioners of Patents for inventions, to be filed with the petition.

Where there was only one affidavit distinctly swearing to the public use and sale of an alleged invention, prior to the date of the application for a patent, which was not corroborated by the person alleged to have sold the goods, the patent was ordered to be sealed. (b) So, too, the patent was ordered to be sealed when the affidavits in opposition were only filed on the morning of the day on which the petition was ordered to be heard. (c)

Leave was given to serve notice of a petition for sealing upon the solicitor of a person who had entered a *caveat* in opposition, and who was out of the jurisdiction of the Court. (d)

The effect of a *caveat* is merely to entitle the person lodging it to notice. (e)

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Lord Chancellor's orders to be drawn up by registrar in attendance.

Affidavits in opposition.

Substituted service.

Effect of caveat.

(a) *Ex parte Bailey*, L. R. 8 Ch. 60.

(b) *Tolhausen's Patent*, 14 W. R. 551.

(c) *M'Kean's Patent*, 1 De G. F. & J. 2.

(d) *Campbell's Patent*, 22 L. T. 93.

(e) *R. v. Cutler*, 3 C. & K. 215.

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Costs.

The costs caused by an unsuccessful *caveat* will have to be paid by the person entering it, and will be taxed upon the principle upon which costs in a cause are taxed as between party and party. (a) And costs caused by notice of objections which were withdrawn were ordered to be paid by the opposer. (b) But where the opposition was considered not to be unreasonable, costs were not given. (c)

Of reference to law officer.

Costs of reference to the law-officer will have to be paid by the opposer, if unsuccessful, unless there is fraud. (d)

Date of letters patent.

Notwithstanding 18 Henry VI. c. 1, letters patent may be sealed, and bear date as of the day of the application for the same. (e)

Reckoned inclusively.

The day of the date is reckoned inclusively. (f) They are usually dated as of the date of the provisional protection. But where a second applicant for a patent for a similar invention has obtained letters patent before the first applicant, the first applicant on applying to have the Great Seal affixed, will not be allowed to have his letters patent dated as of the date of the provisional protection, but they will be dated as of the day of the application for sealing; (g) even where it is alleged that the second applicant obtained his letters patent to be sealed first by fraud. (h)

(a) *Cutler's Patent*, 4 My. & Cr. 510; *Alcock's Patent*, *ib.*

(b) *Cobley's Patent*, 31 L. J. Ch. 333.

(c) *Ex parte Fox*, 1 V. & B. 67.

(d) *Ex parte Yates*, 5 Ch. 1; *Ex parte Munceaux*, *ib.* 518.

(e) 15 & 16 Vict. c. 83, s. 23.

(f) *Russell v. Iedsam*, 14 M. & W. 574.

(g) *Ex parte Bates and Redgate*, L. R. 4 Ch. 579; *Sarby v. Hennett*, L. R. 8 Exch. 210.

(h) *Ex parte Bailey*, L. R. 8 Ch. 60; *Ex parte Scott and Young*, L. R. 6 Ch. 274.

Any ante-dated letters patent have the same validity as if they had been sealed on the day of the date. But no legal proceedings can be taken in respect of any infringement committed before they were actually granted, except where a complete specification has been filed. (a)

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Ante-dated
letters patent.

Letters patent do not prevent the use of the invention in any foreign ships in English ports or English waters, where the invention is not used for the manufacture of any goods for sale in the kingdom or for exportation, unless the laws of the State to which the ships belong do not allow English ships to use foreign inventions. (b) This section was the result of the decision in *Caldwell v. Vanvlissingen*, (c) where an injunction was granted against foreigners to restrain them from using the patented invention (a screw propeller) on board ships within the dominions of England without the licence of the plaintiffs.

Use in foreign
ships.

Any person who uses the name of the patentee without authority, or who counterfeits his stamp or mark, is liable to a penalty of £50 for each offence. (d) It is no defence to an action for a penalty under this section; for putting on an article, made according to a patent, words which imitate the mark of the patentee, without his licence; that the invention is not a new manufacture; but it is necessary to prove that such words do imitate and are so put on with a view of imitating the mark. (e)

Penalty for
using name of
patentee.

All letters patent except those granted after the filing of a complete specification are to require the specification

Specifications
to be filed in-
stead of being
enrolled.

(a) 15 & 16 Viet. c. 83, s. 24.

(d) 5 & 6 Will. IV. c. 83, s. 7.

(b) 15 & 16 Viet. c. 83, s. 26.

(e) *Myers v. Baker*, 3 H. &

(c) 9 Hare, 415.

N. 802.

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to be filed in the Court of Chancery, instead of requiring it to be enrolled, and no enrolment is requisite. (a)

Specifications, &c., to be filed in such office as Lord Chancellor shall direct.

Every specification to be filed in pursuance of the condition of any letters patent is to be filed in such office of the Court of Chancery as the Lord Chancellor shall appoint, and every provisional specification and complete specification left or filed at the office of the Commissioners on the application for any letters patent is forthwith, after the grant of the letters patent, or if no letters patent are granted, then immediately on the expiration of six months from the time of such application, to be transferred to and kept in the office appointed for filing specifications in Chancery. (b) The office appointed for filing is the Great Seal Patent Office. (c)

Filing cannot be dispensed with.

It was decided before the Act that enrolments could not be dispensed with in order to keep the invention secret; (d) and a specification cannot be left at the office conditionally, but can be delivered there only for the purpose of being filed. (e)

Time for filing.

The time within which the specification must be filed (six months) (f) begins to run from the day after the date of the patent. (g)

Extension of time.

When the specification has not been filed within the time limited, provided that the delay has arisen from accident and not from the neglect or wilful default of the patentee, the Lord Chancellor may, if he think fit, extend the time for filing for one month. (h) Every petition

(a) 15 & 16 Vict. c. 83, s. 27.

(b) s. 28.

(c) Order of the 1st Oct. 1852.

(d) *Ex parte Koops*, 6 Ves. 294.

599; *Ex parte Heathcote*, 1 Webs. P. R. 431.

(e) *Re Brough*, 7 Beav. 104.

(f) Second set of Rules, cl. 8.

(g) *Watson v. Pears*, 2 Camp.

(h) 16 & 17 Vict. c. 115, s. 6.

praying for extension of the time for filing and the affidavit accompanying the same must be left at the office of the Commissioners. And where the delay is alleged to have been caused by adjourned hearings of objections to the grant of the letters patent before the law officer to whom the objections have been referred, the petitioner before leaving his petition must obtain the certificate of the law officer to the effect that the allegations in respect of such adjourned hearings and causes of delay are in his opinion correct, and that the delay has not been caused by the neglect or default of the petitioner. (a)

Where the petitioners had been unable to file their specification within the time required by the rules, owing to objections having been filed, the time was extended for one month. (b) So, too, where the delay was caused by the non-delivery of a letter, dispatched in time, containing directions for filing, the time was extended. (c) But the time will not be extended where there has been any neglect or default. (d)

The Master of the Rolls has jurisdiction to alter a specification for correction of clerical errors or mistakes from inadvertency. (e) Where before the Act a patent was dated the 24th May, 1852, and the writ of the Privy Seal the 22nd May, 1852, and the enrolment was required to be made within six months after the date of the writ, but the patentee, not being aware of the

Amending
complete
specification.

(a) Order of the 17th July, 1854.

(b) *Simpson and Isaacs' Patent*, 21 L. T. 81.

(c) *Re Harris*, 25 L. T. 90.

(d) *Campbell's Patent*, 22 L. T. 93.

(e) *Sharp's Patent*, 1 Webs. P. R. 641. See as to amending clerical errors, *Re Redmund*, 5 Russ. 44; *Nickel's Patent*, 1 Webs. P. R. 650; *Rubery's Patent*, 1 Webs. P. R. 649, n.; *Re Dismore*, 18 Beav. 538.

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discrepancy, took the specification to be enrolled a day too late, it was ordered that as the mistake arose from a misprision of the clerk, the enrolment should be amended. (a) There must be no delay in making the application for amendment. (b)

Duty of patent agent.

It is the duty of an agent to know the latest state of the law respecting patents, and where, owing to the agent not knowing the decision in *Ex parte Bates and Redgate*, (c) a second applicant for a similar invention was enabled to get his patent sealed before the first applicant, it was held that there was evidence of negligence. (d)

Of the stamp duties to be paid.

Formerly the whole expenses incident to the application for and grant of letters patent had to be paid at the time the patent was taken out. It is now provided, (e) that all letters patent granted under the provisions of the "Patent Law Amendment Act, 1852," shall be made subject to the condition that they shall be void at the expiration of three and seven years respectively from their date, unless there is paid before the expiration of the three and seven years respectively the stamp duties in the schedule annexed to the Act, viz. £50 and £100 respectively. (f) The day of the date of the patent is excluded, and the three years do not expire until twelve o'clock at night of the anniversary of the day on which the letters patent were granted. (g)

Agreement to pay stamp duties.

By an agreement in writing between the plaintiff (an inventor) and the defendant, it was agreed that the

(a) *Adams' Patent*, 21 L. T. 38.

(e) 16 Vict. c. 5, s. 2.

(b) *Re Blamond*, 3 L. T. (N. S.) 800.

(f) See also ss. 3—7.

(c) L. R. 4 Ch. 577.

(g) *Williams v. Nash*, 27 Beav. 93.

(d) *Lee v. Walker*, L. R. 7 C. P. 121.

plaintiff should do all necessary acts, matters and things, excepting the advance of money, as inventor, for the purpose of procuring, securing and perfecting letters patent, and should immediately after the same were procured, make and execute to the defendant or his nominee a full and effectual assignment and assurance of one-third part or share in the letters patent, and that the defendant should bear payment and discharge all fees and disbursements necessary for procuring and perfecting letters patent. It was held that the whole consideration for the payment of the money by the defendant was the assignment to him by the plaintiff, that the execution of the assignment was a condition precedent to his right to insist upon the payment being made, and that the assignment not having been executed, the plaintiff could not sue the defendant for not paying the £50 necessary to be paid within three years. (a)

(a) *Hill v. Mount*, 18 C. B. 72.

CHAPTER VII.

OF THE OFFICE OF THE COMMISSIONERS.

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Certain persons constituted Commissioners of Patents for Inventions, three of whom may act, the Chancellor or Master of the Rolls being one.

Seal of the Commissioners.

Power to the Commissioners to make rules and regulations.

BY the "Patent Law Amendment Act, 1852," the Lord Chancellor and Master of the Rolls, the law officers of the Crown for England, Scotland and Ireland respectively, together with such other persons as may from time to time be appointed by her Majesty, are to be Commissioners of Patents for Inventions; her Majesty may from time to time by warrant under her royal sign manual, appoint such other person or persons as she may think fit to be a Commissioner or Commissioners. Every person so appointed is to continue in office during her Majesty's pleasure, and all the powers vested in the Commissioners may be exercised by any three or more of them, the Lord Chancellor or Master of the Rolls being one. (a) The Commissioners are empowered to cause a seal to be made for the purposes of the Act, and to cause all warrants for letters patent, and all instruments and copies proceeding from the office, to be sealed therewith. Judicial notice is taken of the seal. (b)

The Commissioners may from time to time make such rules and regulations (not inconsistent with the provisions of the Act) respecting the business of the office and all matters and things which under the provisions

(a) 15 & 16 Vict. c. 83, s. 1.

(b) S. 2.

of the Act are to be under their control and direction, as may appear to them necessary and expedient for the purposes of the Act. The rules are to be laid before both Houses of Parliament within fourteen days if Parliament is sitting, and if Parliament is not sitting, then within fourteen days after the next meeting of Parliament; and the Commissioners are to cause a report to be laid annually before Parliament of all proceedings under and in pursuance of the Act. (*a*)

Commissioners
to report
annually to
Parliament.

The Commissioners of the Treasury are to provide proper officers for the purposes of the Act. (*b*) It was provided by the first set of rules (*c*) that the Great Seal Patent Office and the office of the Commissioners should be combined, and that the clerk of the Patents for the time being should be the clerk of the Commissioners for the purposes of the Act.

Treasury to
provide offices.

The Commissioners, with the consent of the Commissioners of the Treasury, have power from time to time to appoint such clerks and officers as they may think fit, and to remove any clerks or officers so appointed. (*d*)

Commissioners
to appoint
clerks.

A true copy under the hand of the patentee or applicant or agent of the patentee or applicant of every specification and of every complete specification, with the drawings accompanying the same, if any, must be left at the office of the Commissioners on filing. (*e*)

Copies of
specifications,
&c., to be left
at the office.

Transcripts of the letters patent are transmitted to the Director of Chancery in Scotland, upon payment of such fees as the Commissioners require, in the same manner and to the same effect as letters patent passing under

Transcript of
letters patent
to be forwarded
to Scotland.

(*a*) s. 3.

(*d*) 15 & 16 Vict. c. 83, s. 5.

(*b*) s. 4.

(*c*) 16 & 17 Vict. c. 115, s. 3.

(*e*) cl. 6.

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the seal appointed by the Treaty of Union to be used in place of the Great Seal of Scotland were formerly recorded. Extracts from the records are furnished on payment of the fees required by the Commissioners, and are received in evidence in Courts in Scotland. (a)

Copies of specifications, &c., to be transmitted to Scotland and Ireland to be evidence, without production of originals.

Certified printed copies under the seal of the Commissioners of all specifications, complete specifications, and facsimile printed copies of drawings accompanying them, if any, disclaimers and memoranda of alterations, are transmitted to, and filed in, the Chancery Courts in Scotland and Ireland, and certified copies or extracts from such documents are furnished to all persons requiring the same, upon payment of such fees as the Commissioners may direct, and are received in evidence without further proof or production of the originals. (b)

The office of the Directory of Chancery in Scotland is also the office of the Patent Commissioners. (c)

Copies of specifications to be open to inspection at office of Commissioners, and at Edinburgh and Dublin.

True copies of all specifications (other than provisional specifications) disclaimers and memoranda of alterations are open to the inspection of the public at the office and at an office in Edinburgh and Dublin. Transcripts of all letters patent are transmitted for enrolment in the Court of Chancery in Dublin, and the transcript or exemplification has the same effect as if the original letters patent had been enrolled there, and all parties have their remedy by *scire facias* or otherwise, as if the letters patent had been granted to extend to Ireland only. (d) The enrolment office of the Court of Chancery in Dublin is also the office of the Patent Commissioners. (e)

(a) 15 & 16 Vict. c. 83, s. 18.

(d) s. 29.

(b) 16 & 17 Vict. c. 115, s. 5.

(e) Second set of Rules, cl. 4.

(c) Second set of Rules, cl. 1.

True copies of all provisional specifications left at the office of the Commissioners are open to the inspection of the public at such times after the date of the record as the Commissioners may direct. (a)

All specifications, disclaimers and memoranda of alterations are printed and published and sold as the Commissioners think fit, as soon after filing as convenient. The Commissioners may present copies of all such publications to such public libraries and museums as they may think fit, and may allow the person depositing or filing any such specification, disclaimer or memorandum of alterations to have any number not exceeding twenty-five of the copies so printed and published, without payment. (b)

Indexes of all specifications, disclaimers and memoranda of alterations are open to the inspection of the public, and the Commissioners have power to cause such indexes to be printed and published and sold to the public. (c)

A register of patents is kept at the Great Seal Patent Office; all letters patent, the deposit and filing of specifications, disclaimers and memoranda of alterations, all confirmations and extensions of letters patent, the expiry, vacating or cancelling of letters patent, with the date, and all other such matters affecting their validity as the Commissioners may direct, are entered and recorded in chronological order in it; and such register or a copy of it is open to the inspection of the public. (d)

The Lord Chancellor and Master of the Rolls and the Commissioners have power to appoint the fees to be paid

(a) 16 & 17 Vict. c. 115, s. 2.

(b) s. 30.

(c) s. 32.

(d) s. 34. See also *post*,
chapter on Registration.

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Copies of provisional specifications to be open to inspection.

Specifications and other documents to be printed and published.

Indexes to be printed and published.

Register of patents to be kept.

Fees to law officers.

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to the law officers in cases of opposition to the granting of letters patent, and in cases of disclaimers and memoranda of alterations and for office and other copies of documents. (*a*)

(*a*) s. 47. And see generally as to fees, ss. 48—51.

CHAPTER VIII.

OF EXTENSION OF THE TERM OF LETTERS PATENT.

BEFORE the Act of the 5th and 6th Will. IV. c. 83 was passed, the only means of obtaining an extension or renewal of the term of letters patent was by an Act of Parliament. The cases in which patents have been so prolonged will be found in 1 Webs. P. R. 37.

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5 & 6 Will. IV.
c. 83.

By s. 4 of the above-mentioned Act power was given to a patentee to petition the Judicial Committee of the Privy Council for an extension of the term of using and vending the invention, and it was provided that "the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years, and his Majesty is hereby authorized and empowered if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom or usage to the contrary in any wise notwithstanding: Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

Mode of proceeding in case of application for the prolongation of the term of a patent.

The last proviso in the above section was repealed by 2 & 3 Vict. c. 67, s. 1, which, after reciting that it had happened since the passing of the said Act, and might

2 & 3 Vict.
c. 67, s. 1.

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Repealing provision requiring the application by petition to be prosecuted with effect before the expiration of the term of the patent.

happen again, that parties desirous of obtaining an extension of the term granted in letters patent of which they were possessed and who might have presented a petition for such purposes in manner by the said recited Act directed before the expiration of the said term might nevertheless be prevented by causes over which they had no control, from prosecuting with effect their application before the Judicial Committee of the Privy Council; and that it was expedient therefore that the said Judicial Committee should have power, when under the circumstances of the case they should see fit, to entertain such application and to report thereon, according to the provisions of the said recited Act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended might have expired, it was enacted "that so much of the said recited Act as provides that no extension of the term of letters patent shall be granted as therein mentioned, if the application by petition for such extension be not prosecuted with effect before the expiration of the term originally granted in such letters patent, shall be repealed."

This enactment was the result of the decision in *Bodmer's Patent*.^(a) There the petition was duly presented on the 21st of May, 1838, and notices of intention to apply on the 26th of June for a day to be fixed for the hearing were given by advertisement. On that day two *caveats* were entered, and the persons entering them being entitled to four weeks' notice of the time appointed for hearing, the petition could not be heard within the term of the ordinary sitting of the committee, and the

(a) 2 Moo. P. C. C. 471; 1 Webs. P. R. 740.

letters patent would have expired before the next sittings. Under these circumstances the 17th of August was fixed for hearing the petition, but on that day a sufficient number of members could not be got together to form a council. On the application being made on the 29th of November the Attorney-General took the objection that the application had not been prosecuted with effect before the expiration of the term of the letters patent, and the objection was held to be fatal.

By section 2, it is enacted "that it shall be lawful for the Judicial Committee of the Privy Council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application, and to report thereon as by the said recited Act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for Her Majesty, if she shall think fit, on the report of the said Judicial Committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited Act directed before the expiration of the term sought to be extended, nor in case of petitions presented after the 30th day of Novem-

Term of patent right may be extended in certain cases, though the application for such extension not prosecuted with effect before the expiration thereof.

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ber, 1839, unless such petition shall be presented six calendar months, at the least, before the expiration of such term, nor in any case, unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term."

Limit of time.

The application is "prosecuted with effect" if it is made, and the report of the Judicial Committee is obtained before the expiration of the original term. (a)

7 & 8 Vict.
c. 69, s. 2.
On petition
Her Majesty
may grant an
extension of
patent terms in
certain cases.

By another Act (7 and 8 Vict. c. 69, s. 2), after reciting that it was expedient for the further encouragement of inventions in the useful arts, to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expenses of the invention have been greater than the time then limited by the law would suffice to reimburse; it was enacted "that if any person having obtained a patent for any invention shall, before the expiration thereof, present a petition to Her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration; then, if the matter of such petition shall, by Her Majesty, be referred to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents; and if the said committee shall be of opinion, and shall so report to Her Majesty, that a further period greater than seven

(a) *Ledsam v. Russell*, 1 H. L. C. 687.

years extension of the said patent term ought to be granted to the petitioner, it shall be lawful for Her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner and subject to the same rules as the extension for a term not exceeding seven years is now granted under the powers of the said Act."

It is then provided that nothing therein contained "shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed." (a)

The provisions of the above Acts as to prolongation apply to patents granted under 15 and 16 Vict. c. 83. Section 40 of that Act provides, "that it shall be lawful for Her Majesty to grant any new letters patent as in the said Acts mentioned; and in the granting of any such new letters patent Her Majesty's order in council shall be a sufficient warrant and authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said order mentioned; and the Lord Chancellor, on the receipt of the said order in council, shall cause letters patent, according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant of the law-officer. Provided always that such new letters patent shall extend to and be available in and for such places as the original letters patent extended to and were available in; provided also that such new letters patent shall be sealed, and bear date as of the day after

Her Majesty may grant extension for a lesser term than that prayed.

Provisions of 5 & 6 Will. IV. c. 83, 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, as to prolongation to apply to patents under this Act.

(a) 7 & 8 Vict. c. 69, s. 3.

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the expiration of the term of the original letters patent which may first expire.

Form of Report
and Order in
Council.

The following is the report and order in council, made in pursuance of the above section in *Heath's Patent*: (a)
 “Their lordships do agree humbly to report to Her Majesty, as their opinion that (in case your Majesty should think fit) a further extension of the letters patent for England, Wales, and the town of Berwick-upon-Tweed, obtained by Josiah Marshall Heath, now deceased, and bearing date at Westminster, 15th of April, 1839, the same being now vested in the petitioner, Charlotte Catherine Heath, widow and administratrix of Josiah Marshall Heath, ought to be granted to Charlotte Catherine Heath, and that such extension should be for the term of seven years from and after the expiration of the term granted by the original letters patent.” And the report having been taken into consideration, it was ordered, “That the Right Honourable the Lord Chancellor, upon the receipt thereof, do cause new letters patent, according to the term and effect of this order, to be made and sealed for such part of the United Kingdom of Great Britain as the original letters patent extended to and were available in, namely, for England, Wales, and the town of Berwick-upon-Tweed, for ‘certain improvements in the manufacture of iron and steel,’ as described in the patent granted to Josiah Marshall Heath, and bearing date at Westminster on the 15th day of April, 1839, and such new letters patent are to be granted to Charlotte Catherine Heath, in whom the legal interest of the original letters patent is now vested, for the further term of seven years from and after the expiration of the term granted in the original letters patent, and whereof the

(a) 8 Moo. P. C. C. 225.

Right Honourable the Lord Chancellor and all other persons whom it may concern are to take notice and govern themselves accordingly.”

It was doubted whether the provision of 15 & 16 Vict. c. 83, s. 40, extended to the making and sealing of new letters patent, where such new letters patent were granted by way of extension of the term of letters patent issued before the commencement of the Act, and as it was considered expedient that such new letters patent granted by way of extension should be granted according to the provisions of the Act, it was by 16 & 17 Vict. c. 115, s. 7, provided, “that where Her Majesty’s Order of Council for the sealing of new letters patent shall have been made after the commencement of the said Act, the said provision of the said Act for making and sealing in manner aforesaid of new letters patent, shall extend and shall as from the commencement of the said Act be deemed to have extended to the making and sealing in manner aforesaid of new letters patent for a further term, as well where the original letters patent were made before as where such original letters patent have been issued since the commencement of the said Act.”

Removing doubts as to provisions of 15 & 16 Vict. c. 83, respecting the making and sealing of new letters patent for a further term.

The Judicial Committee of the Privy Council have somewhat similar powers of discretion in considering whether or not to grant extension of the term of a patent to those formerly exercised by the three branches of Parliament, (a) and they will only exercise this power on the most special grounds alleged and proved in reference to each case. (b)

Jurisdiction, extent of.

After the term of a patent has once been extended, and new letters patent have been granted, the Judicial Com-

As to renewed letters patent.

(a) *Morgan's Patent*, 1 Webs. P. R. 739.

(b) *Jones' Patent*, 1 Webs. P. R. 579.

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mittee have no power to recommend an extension of the term of the new patent. (a)

As to petition to revoke order.

Under 3 & 4 Will. IV. c. 41, the fourth section of which is as follows: "It shall be lawful for His Majesty to refer to the said Judicial Committee for hearing on consideration any such other matters whatsoever as His Majesty shall think fit, and such committee shall thereupon hear or consider the same, and shall advise His Majesty thereon in manner aforesaid," it has been decided that the Judicial Committee have power to hear and consider a petition which has been referred to them by the Crown, praying that an order in council, made upon their recommendation, to extend letters patent, may be revoked, and also that any warrant for making new letters patent may be annulled. (b)

Extension not a matter of course when no opposition.

It is anything but a matter of course that an application for extension should be granted where there is no opposition, either by the public or by the Attorney General on behalf of the Crown. (c) The Judicial Committee will not place themselves precisely in the situation of the legislature, and refuse extension where an Act of Parliament would not have been granted; (d) but the applicant must show that he is entitled to extension on the usual grounds with as much accuracy as if the petition had been opposed; (e) and the circumstances of each case, (f) and the merits of the invention will be carefully examined. (g)

(a) *Goucher's Patent*, 2 Moo. P. C. C. (N. S.) 532.

(b) *Re Schlumberger*, 9 Moo. P. C. C. 1.

(c) *Jones' Patent*, 1 Webs. P. R. 579; *Cardwell's Patent*, 10 Moo. P. C. C. 490.

(d) *Morgan's Patent*, 1 Webs. P. R. 739.

(e) *Derosne's Patent*, 4 Moo. P. C. C. 418; *Honiball's Patent*, 9 Moo. P. C. C. 393.

(f) *Petitt Smith's Patent*, 7 Moo. P. C. C. 137.

(g) *Perkins' Patent*, 2 Webs. P. R. 181; *Morgan's Patent*, 1 Webs. P. R. 739.

By the joint operation of the Acts of 5 & 6 Will. IV. c. 83, and 16 & 17 Vict. c. 115, s. 7, the extension of a patent is the same as a new grant. (a)

CHAP. VIII.

Effect of extension

Where separate patents had been granted for an invention in England, Scotland, and Ireland, previous to the passing of the Patent Law Amendment Act for terms expiring at the same date, and new letters patent reciting the separate original patents were granted, extending for a term of five years the privileges granted by the three original patents, one of which was void for want of novelty, it was held that the effect was the same as if the three patents had been separately extended, and that the fact of one of the patents being void would not prevent the new letters patent being valid as an extension of the other patents. (b)

on several patents.

As all that it is necessary for the patentee to do is to prosecute his claim with effect before the expiration of the term of the original letters patent, the new letters patent will not be void because they are dated after the expiration of that term. (c)

Date of new letters patent.

Where the original patent has been taken out for a variety of inventions, and they have not all come into use, an extension of the part only which is useful may be recommended if the other requisites to extension are present. (d) It is not quite clear whether in such a case the patentee will be required to disclaim the useless parts. In *Bodmer's Patent*, (e) the original patent embraced and

Part of patent only may be extended.

(a) *Betts' Patent*, 1 Moo. P. C. C. (N. S.) 57; *Aubé's Patent*, 9 Moo. P. C. C. 43; *Bodmer's Patent*, 8 Moo. P. C. C. 282.

(b) *Bovill v. Finch*, L. R. 5 C. P. 523.

(c) *Ledsam v. Russell*, 1 H. L. C. 687.

(d) *Lee's Patent*, 10 Moo. P. C. C. 226; *Bodmer's Patent*, 8 Moo. P. C. C. 282.

(e) 8 Moo. P. C. C. 282.