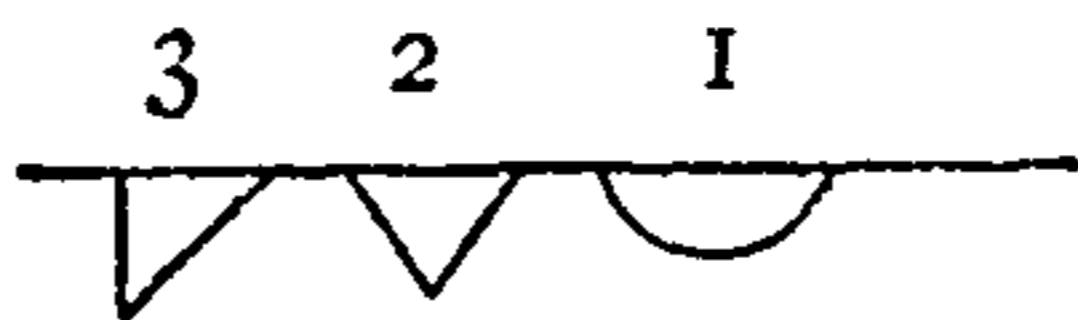


to the reflected light. Plaintiff took out a patent for pavement-lights with prisms of peculiar shape for deflecting the light nearly horizontally (Fig. 3). Held in the C. A. to display sufficient invention. "It

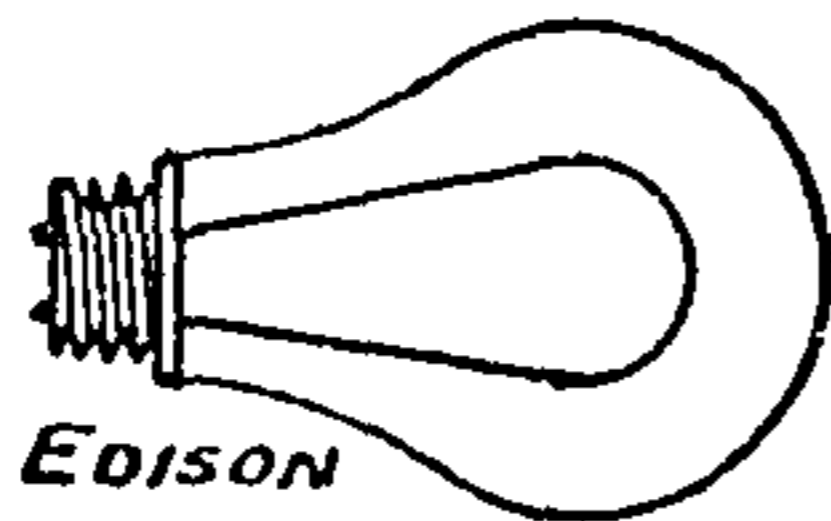


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is very strange if it is no invention, that it has never been done before" (*per* Bramwell, L.J.).

Edison v. Woodhouse, 1886, 3 R. P. C. 165, 4 R. P. C. 79.—By this action the validity of the Edison patent of 1879, for the electric incandescent or glow-lamp was established. When electricity is passed through any conductor it always does work in that conductor proportioned to the resistance experienced in its flow. The work usually is developed in the form of heat. The greater the resistance in proportion to the electric energy passing through it the more violent the action and the hotter the conductor becomes.



EDISON



SWAN.

With a certain quantity of electricity the conductor becomes red hot, then white hot, radiating out both light and heat, and the greater the temperature, the greater is the amount of light given as compared with the heat. So that if one desired an economical form of lighting apparatus, the resistance should be great, and the temperature as high as possible. At this high temperature all metals fuse, and most metallic earths, such as clay. A few oxides, such as that of zirconium, will resist, but one of the very best substances, which is also a conductor of electricity, is carbon, on account of its extraordinary infusibility. Unfortunately it oxidises very easily, so that in order that it may be used it has

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to be enclosed in a very perfect vacuum, or else it would burn away in an instant.

Up to the year 1879 no good incandescent lamp was practically known, but incandescent wires of platinum and rods and spirals of carbon had been used in glass vessels from which the air was exhausted. It was known that high resistances were necessary. Moreover, Swan, in 1878, had exhibited a slender rod of carbon, one-twenty-fifth of an inch in diameter, in incandescence, hermetically sealed into an exhausted globe. Edison's patent was for a "filament" of carbon of high resistance sealed into a glass globe from which the air was exhausted. It was urged that this was no invention when once it was known that high resistance was required, that carbon was suitable, and a vacuum necessary; but Butt, J., decided for the plaintiffs. This was confirmed on appeal on the ground that what Edison had discovered was the necessity for the use of *threads* of carbon, one way of making which he described, and the value of the invention was shewn by the success which attended it, and the failure of all previous experiments.

Next year, however, the question was tried over again: *Edison and Swan Electric Light Co. v. Holland*, 1888, 5 R. P. C. 459. At this trial fresh evidence was produced, which had been mainly obtained by forcing the plaintiffs to disclose information which had been prepared by Swan, to enable him to contest an action against him by Edison before they united. Kay, J., thought that inasmuch as the necessity of high resistance was known, and carbon was known, no one could have a patent for uniting them. He also found that there was insufficient description, and that the claim was too wide. On appeal, however, this judgment was reversed, on the

ground that though Swan's lamp might, and probably would, have been an anticipation if it had been a commercial success, yet that it had been a mere abandoned experiment: 6 R. P. C. 243.

Closely connected with this patent is one also owned by the Edison and Swan Company. It was found that when filaments were made by carbonizing threads or strips of fibre in closed retorts, that the carbonized fibres were uneven, and were burned up at the weak places. To secure uniformity, a very ingenious process was patented called "flashing." The filaments were placed in a gas or liquid rich in carbon, such as coal gas or petroleum, and then heated by a current of electricity. This caused the carbon to be deposited from the gas or liquid on to the filament. But as the electricity heated the fibres most, just at their weakest points, a greater deposition of carbon from the gas or liquid was caused to take place on their weaker parts than elsewhere, and so the filament was rendered uniform. It was endeavoured to shew that Sidot and Depretz and others had previously known that hydro-carbons could thus be deposited, but inasmuch as it could not be shewn that this fact had ever been utilized for any process akin to "flashing," the patent was supported: *Edison v. Woodhouse*, 1886, 3 R. P. C. 183, 4 R. P. C. 99.

Otto v. Linford, 1881, 46 L. T. (N.S.) 35; *Otto v. Steel*, 1886, 3 R. P. C. 109.--The part of the patent which really came in question was for an old form of gas-engine. The gas-engines of Lenoir and others worked very like a steam-engine, simply sucking in the mixture of gas and air during the commencement of the piston's motion, then, when this had been done, igniting it, whereby the piston was driven forward during the

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remainder of its stroke. On its return the piston expelled the foul exploded air from the cylinder, which was then ready for a fresh charge. The improvement of Otto in this patent consisted of letting some pure air in first, then behind it some mixed air and gas, and as these were all sent in from behind he concluded that the state of the cylinder just before ignition was a residuum of burned gas and air next to the piston, then air, and behind all the explosive mixture. The light being applied from behind he argued that the explosion would be gradual through these three layers. Experiments seemed to justify this view, and the practical result of improved working was certain. The scientific accuracy of this explanation of the matter is perhaps open to question, for the kinetic theory of gases shews that layers will mix with a rapidity so great that it is doubtful whether these layers would have remained, even if they ever existed, for more than a very short time. On the evidence, however, coupled with the fact that whatever the theory was, there was a great increase of efficiency; the patent was supported. Most gas-engines now work by igniting gases in a compressed state, which was the subject of Otto's second claim, but was not disputed, after De Rocha's alleged anticipation had been held not to have been published in England.

Walling v. Stevens, 1886, 3 R. P. C. 37, 147.—The plaintiff patented a tip-waggon, in which the body of the waggon ran on small wheels on a frame attached to the axles. When pushed backwards, a pin on the body caught in a notch at the back of the frame, and the body of the waggon tipped over, and was prevented falling by a retaining rod (not shewn in the figure). Previously to this another inventor had patented Fig. 2,

the action of which sufficiently appears from the drawing. The Court held this no anticipation, for the body was

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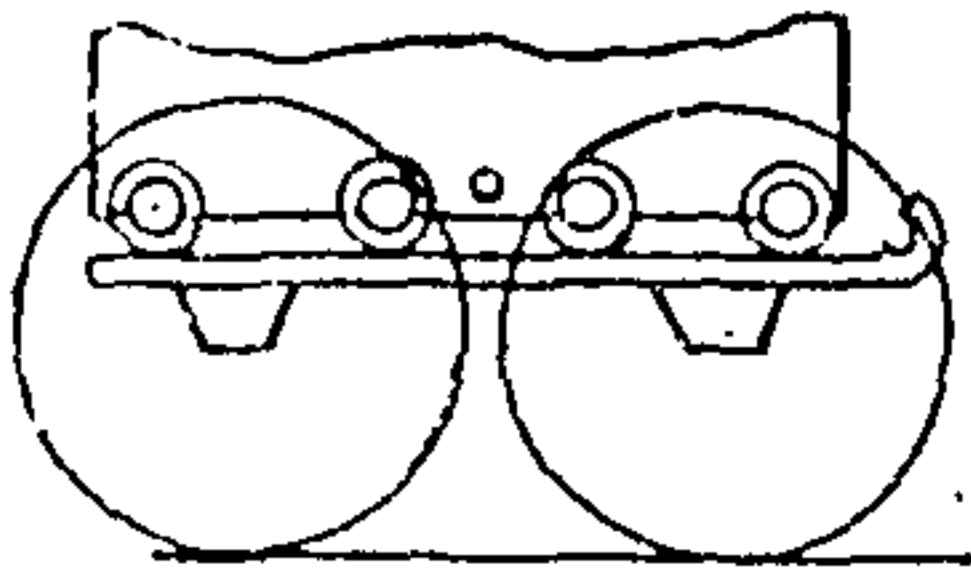


Fig. 1.

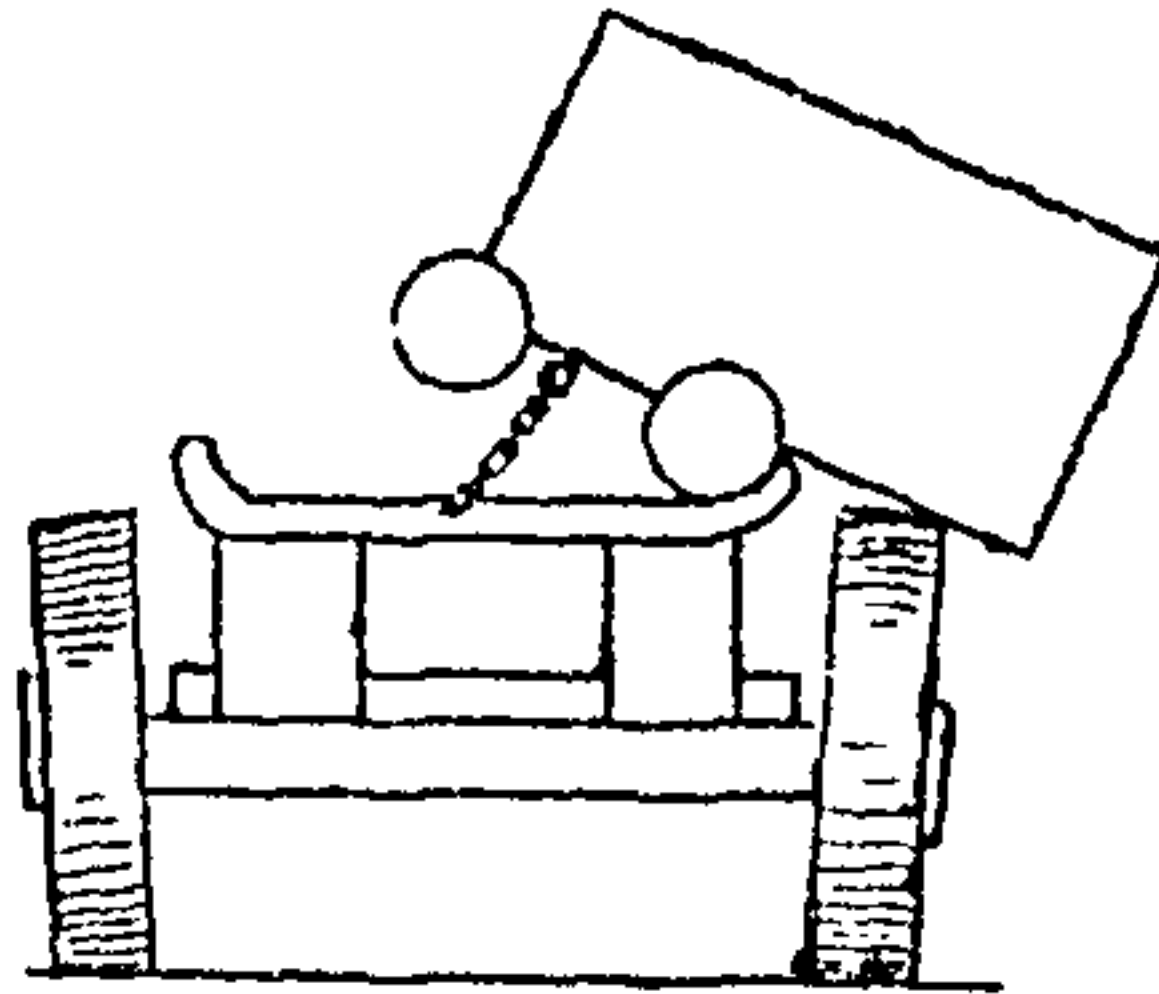
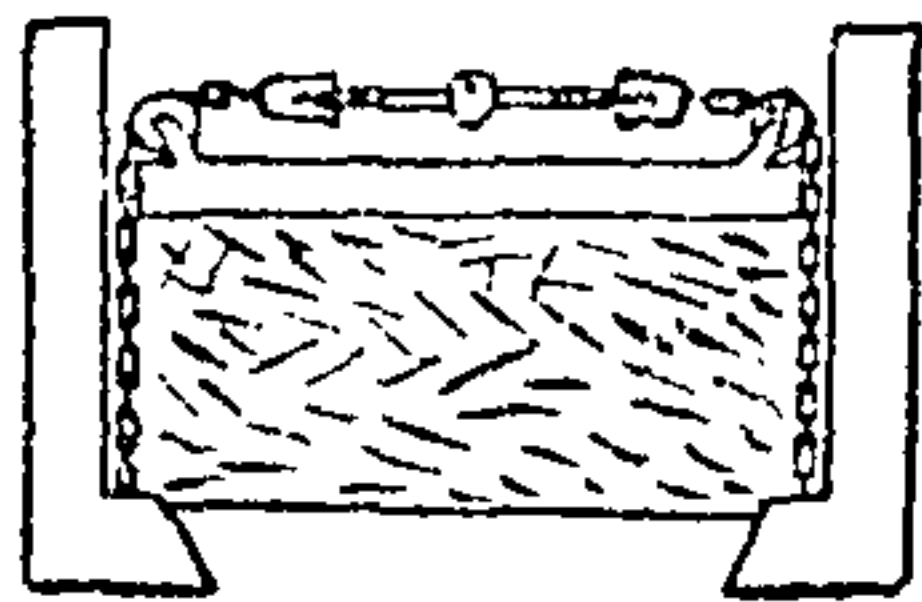


Fig. 2.

not properly supported by its wheels, and would break, and was considered different in construction from the plaintiffs, though the leading idea on which it was constructed was the same.

Reynolds v. Amos, 1886, 3 R. P. C. 215.—Plaintiff patented an invention for compressing ensilage, consist-

ing of chains fastened to the bottom of the pit or passing under the ensilage, and fastened with pegs after being strained tight by a jack or lever. Before this dead weights



had been used to compress the ensilage, and the ensilage had been compressed by screw-jacks. Held (by Bacon, V.C.), to display invention.

Moseley v. Victoria Rubber Co., 1887, 4 R. P. C. 241; 55 L. T. (N.S.) 482. The cold process for vulcanising india-rubber, or india-rubber coated fabrics, had been invented by Parkes in 1846. Instead of heating the india-rubber with sulphur, the sheets of india-rubber are immersed in a solution of chloride of sulphur in disulphide of carbon, or other solvent, or else merely exposed to the vapour of that solution. It had been previously known

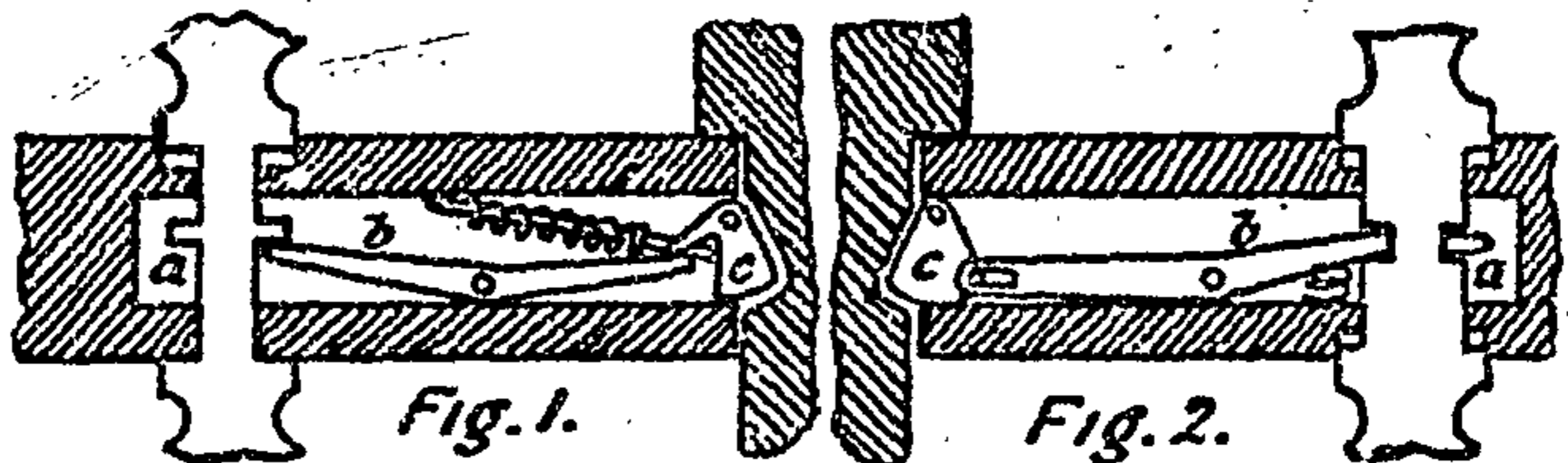
See remarks on this case in *Sharp v. Brauer*, 1886, *post*, p. 123.

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also, that if before being heated with the vapour, the fabrics were covered with farina, a silky bloom was imparted to them. The plaintiff further discovered that in the state when covered with farina, the cloth was peculiarly susceptible to being printed with colours in patterns. This was due to the very absorbtive nature of the coating of farina. He patented the invention. It was objected that the invention was only the application of ordinary colour printing rollers to farina-coated india-rubber goods. But Chitty, J., held that, inasmuch as such printing only succeeded on farina covered goods, it was not a mere adaptation of an old process, but one which was a new invention.

Kaye v. Chubb, 1887, 4 R. P. C. 23, 289; 5 R. P. C. 641.— This was an invention for a door-latch, in which the bolt was drawn back to open the door, simply by pulling the handle from the inside, or pushing it from the outside. The spindle had a collar *a*, acting on a lever *b*, which



actuated the bolt *c*, and a spring kept the bolt in place (Fig. 1).—In anticipation, a patent was produced of Imray (Fig. 2). The only difference was that a notch *a* was substituted for the collar, and the position of the spring was different. It was argued for the plaintiff that there was no anticipation, because the notch in Imray's lock was not equivalent to the collar in Kaye's lock, and for this reason, that if you tried to shut the door

with Kaye's bolt, the collar receded and left the bolt free to slam into the catch plate. But if you tried to shut the door with Imray's latch, the act of pressing the handle from the inside, or pulling from the outside, only jammed the bolt fast, and prevented it from shutting properly. This could be cured either by making the groove *a* very much wider, or else substituting a collar. In his specification, Imray had used the words, "With a groove in it, or with a projection or collar on it, which engages with a lever connected with the spring bolt." At the trial, Matthew, J., considered that what was here meant was only a collar *equivalent* to the groove, *i.e.* a collar on both sides of which the lever should engage. The Court of Appeal thought he meant to point out the mechanical alternative, and that he had contemplated the plan of the plaintiff. But, on appeal to the House of Lords, they thought that, in using the alternative words "projection or collar," the same sort of engagement must have been meant, as was meant when a lever or groove were used, *viz.*, a double engagement, and hence that the plaintiff's invention was an advance on Imray's, and the subject of a patent. Inasmuch as the defendant's lock was just like that of the plaintiff, except only that he pressed the bolt *a* with a V-spring, instead of a spiral spring, the Court held the infringement proved, and gave judgment for the plaintiff.

Siddell v. Vickers, 1888, 5 R. P. C. 81, 416, 7 R. P. C. 292.—Endless chains worked by cog-wheels, or winches, or by hooks, to turn forgings about, were known, but were not portable, and had never been much used. Plaintiff patented an endless chain, worked by a portable cog-wheel and hand-ratchet, for the same object. Held, that this machine was a new combination. Patent supported.

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Ehrlich v. Ihlee, 1888, 5 R. P. C. 437, 7 R. P. C. 292.—Plaintiff's patent was for a circular disc of card with holes in it, by means of which levers were actuated, which played a small organette. Prior to this, bands of cards had been used for the same object, very like the arrangements in a Jacquard loom. Circular cards had been suggested for the Jacquard loom. Circular cards with holes in them had been used in organettes, not to actuate levers, but to be blown through, *i.e.*, to open and stop pipes. Circular cards had also been proposed by Peabody with "dents" in them to actuate levers for an organ, but the specification was not in England at time of plaintiff's patent, and besides, was so badly drawn as to be unintelligible. The plaintiff's machine was admitted to be a great commercial success. Held a good patent.

Haslam v. Hall, 1888, 5 R. P. C. 1.—The principle of the machine of the plaintiffs depended on the fact that if air is compressed, it becomes heated. Suppose that while still compressed, it is allowed to cool, and thus to dissipate the heat. Then let the pressure be removed. If the air were inelastic, it would remain compressed, but being elastic it again expands. In expanding it must become cooler by the amount of the heat it lost during the time it was allowed to cool. In this cool state, it is ready to absorb from surrounding bodies heat sufficient to restore it to the same temperature as at first, before the pressure was applied. Thus then we can construct a "heat dissipating and absorbing machine," and by putting substances near it, we can heat some of them, and cool others. This is the principle of mechanical refrigerators largely used for preserving meat during its voyage from the colonies. But if meat is shut up in refrigerators, it

gives up moisture, and if air which is being cooled contains moisture, that moisture is deposited as ice, hoar-frost, or snow, which is apt to clog the pipes and machinery. This difficulty the plaintiff by his patent sought to remove. He passed the air over the meat, and then over pipes which cooled it, and then arranged his pipes in which the cooling took place at such inclinations and with such cocks, that the moisture which had come from the meat could be drawn off as soon as it had got into the liquid form of water, and before it reached the solid stage of ice or snow. It was like wiping the meat with a cold towel, and then drying the towel again. Evidence was given of prior machines by Windhausen and Nerlich, which also had cocks, but it was not satisfactorily shewn that these cocks were more than experiments, or that they were deliberately made and used for the same purpose as the cocks of the plaintiff. It was objected that if once it were known that condensed moisture was likely to freeze and block the machine, it was no invention simply to incline the pipes to let the condensed moisture drain away, and to put a cock to draw it off. But it being proved that the plaintiff's use of cocks had resulted in a great commercial success by the obviation of a previously felt difficulty, it was held that, though a simple invention, it had merit, and could sustain a patent. "The effect of a great deal of the examination appears to us to be this: that the inventor of the (plaintiff's) machine did make a step forward in the process of invention, of the highest practical importance, although previous inventions had led up to it in such a manner, that now that the thing is done, it seems as if any one might have done it, by the use of a little power of invention. This, however, is, I believe, practically speaking, the history of a very large number,

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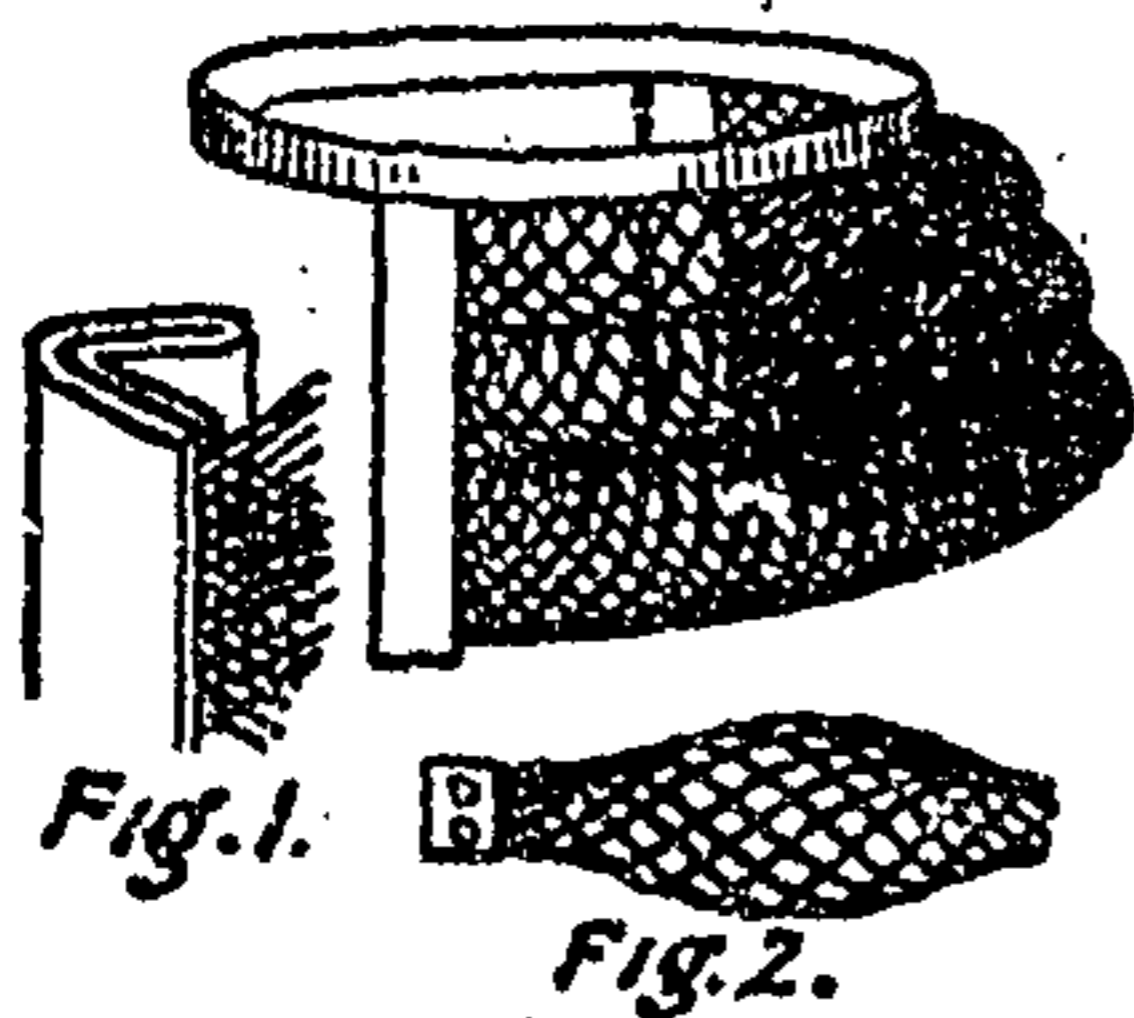
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perhaps of the great majority, of useful discoveries" (per Stephen, C.J.). Judgment was given against the plaintiff, however, as one of his claims was old. This was afterwards cured by disclaimer.

Dowling v. Billington, 1889 (Ireland), 7 R. P. C. 191.—A patent for a new method of weaving wire mattresses. It was shewn that they could be woven on well-known machines, but the patent described a new and improved arrangement of the warp and weft. It was argued that, as the machines were old, those who possessed them could weave what they liked upon them; but patent supported, as a new way of using an old machine.

Badische Anilin Fabrik v. Dawson, 1889, 6 R. P. C. 387.—Plaintiffs' patent was for a new chemical substance produced by the use of an additional quantity of sulphuric acid in one of the stages of manufacture of an old substance, *viz.*, dinitro-naphthol. Such additional use produced a totally new substance. Held good.

American Braided Wire Co. v. Thomson, 1889, 4 R. P. C. 316; 5 R. P. C. 113, 375, 696; 6 R. P. C. 518; 7 R. P. C. 47, 152.—This patent (1885) was for making ladies'



bustles out of braided wire. The wire was first woven into long cylinders. Several lengths being taken, their ends were squeezed together, and then clamped without solder by inserting them into a V-shaped piece of metal, squeezing it tight, and doubling it over (Fig. 1). The V-shaped pieces of metal were then fastened to a waistband. In 1880 Jenkins had taken out a patent for braided wire, in which he proposed its application to all sorts of uses,

such as bell ropes, bird-cage perches, arms and legs of chairs, walking sticks, and also for stiffeners, for use in corsets, skirts or other articles of dress. He clamped the ends by means of V-shaped pieces of metal put on with rivets or solder (Fig. 2). The use of braided wire for cushions had also been patented in 1884. Kekewich, J., thought that the plaintiff's patent had been anticipated, but was reversed on appeal, and finally also in the House of Lords, Lords Watson, Herschell and McNaughten thought that the patent was valid for the particular combination described: Lords Halsbury and Fitzgerald dissented.

Lord Herschell said: "If I thought that the patentee had claimed the mere use of tubular sections of braided wire as a bustle, however fastened or secured, I should arrive at the conclusion that the defendants' contention was well founded. . . . In my opinion it is the combination alone for which protection is sought, and the method of fastening the ends by clamping-plates is an essential part of that which is claimed." This case was, however, considered on the margin, as appears from the remarks of Lord Watson in *Morgan v. Windover*, 1890, 7 R. P. C. 136 (*post*, p. 417).

Thomson v. Batty, 1889, 6 R. P. C. 84; *Thomson v. Moore*, 1889, 6 R. P. C. 426.—Sir W. Thomson, having applied himself to the study of the mariner's compass, arrived at the conclusion that what was required was an exceedingly light card to diminish friction, the weight disposed chiefly round the rim, to give a large moment of inertia, and very small magnets, so as to be less sensitive to local disturbances. He carried out these ideas by attaching the card rim by threads to the magnets, which were made very small. The result was a great practical

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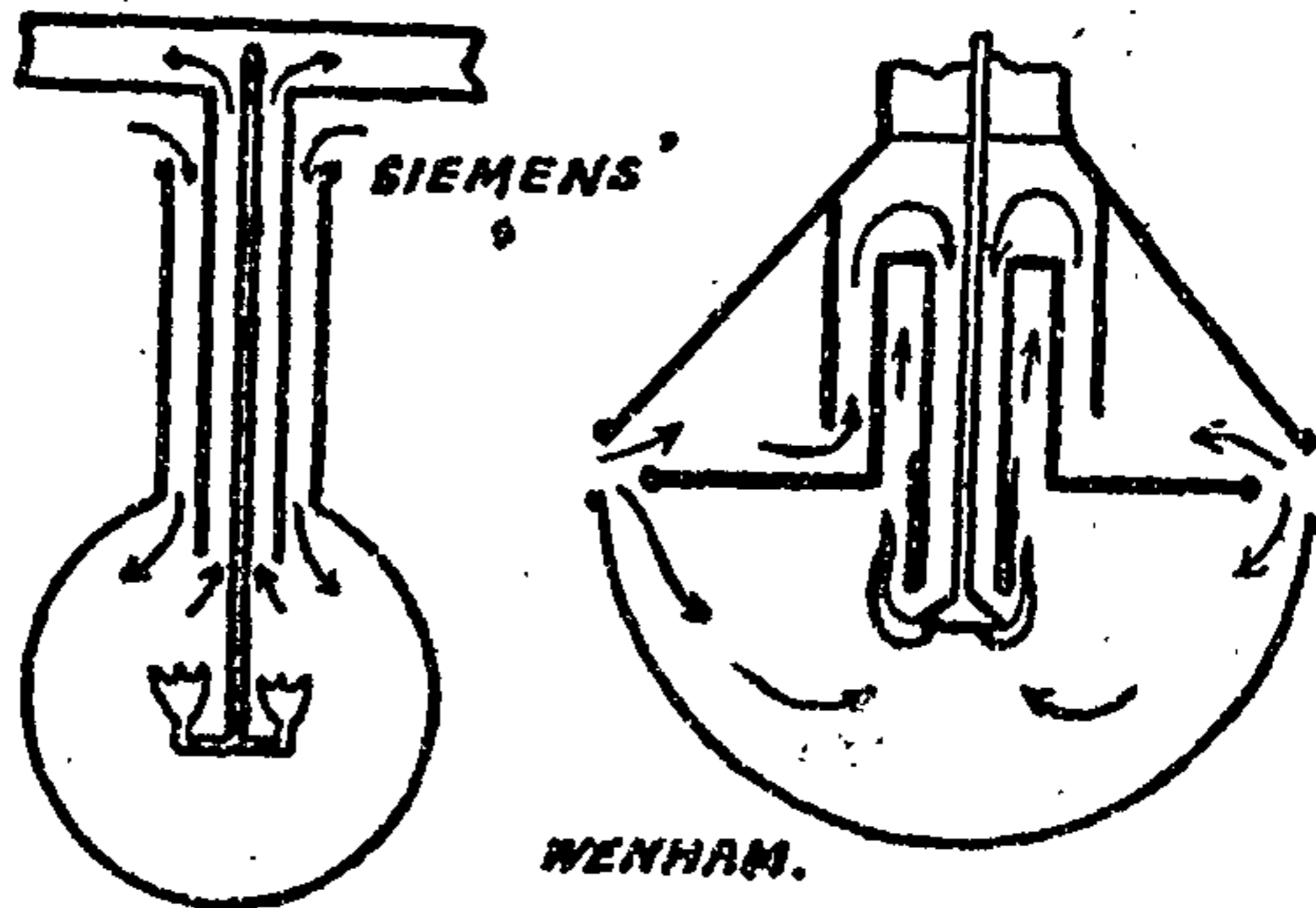
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success. Held, that though all the parts were old, yet the combination was clearly subject-matter for a patent.

Shaw v. Jones, 1889, 6 R. P. C. 328.—The plaintiff's specification contained no drawings, but stated the invention to be for "blocks of various sizes and geometrical squares, angles, curves, etc. So that by this means a compositor may construct a block poster, etc., in the same way as he would proceed to set up a combination border." The alleged anticipation was in a patent for somewhat the same thing, but with drawings shewing how blocks of a few different shapes could be used to build up various designs. The defendants complained of the vagueness of the plaintiff's specification, but proof being given that the plaintiff's patent was useful and that blocks could be made from the descriptions in it, the patent was supported.

Wenham Gas Co. v. Champion Gas Co., 1891, 8 R. P. C. 313, 9 R. P. C. 49.—Siemens had invented a lamp in



which arrangements were made to warm the air before it was applied to the flame. The arrangement is shewn in the Figure. The hot air ascending warmed the gas-pipe. Wenham invented a form of lamp shewn in the

second figure. It was held that this was an advance on Siemens', and was consequently good subject-matter for a patent. In the Wenham lamp the entering current of air is divided into two portions, one of which circulates round the outer globe, the other is heated, and feeds the flame.

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Farben Fabrik v. Bowker, 1891, 8 R. P. C. 389.—A new dye, obtained by putting in practice known chemical facts, held good.

Pirrie v. York Street Flax Co., 1892, 10 R. P. C. 34.—Dry paper tubes had been used for winding cotton yarn upon, for spinning. A patent for similar tubes for use with wet flax yarn held good, on special advantages being shewn by their use for that purpose.

Miller v. Scarle, 1893, 10 R. P. C. 106.—This was an action brought upon two patents, one for a clip for securing lamps to velocipedes, the other for a more elaborate mode of attachment with the same object. The alleged anticipation of the first patent is so vague as to be hardly comprehensible.

The second patent (Fig. 2), and its alleged anticipation (Fig. 1), are as follows: In Fig. 1 the lamp is suspended on four arms, giving a

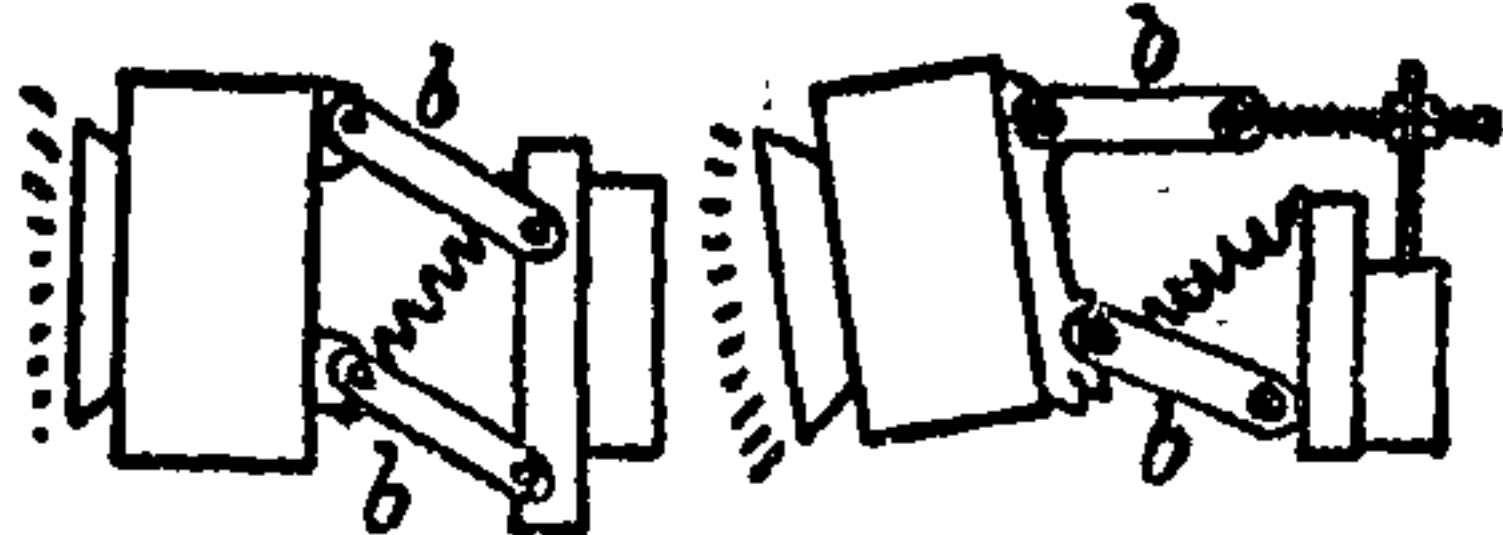


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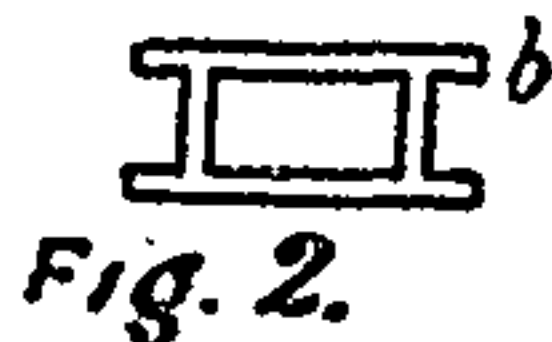


FIG. 2.

parallel motion, which is controlled by a spiral spring diagonally arranged. In Fig. 2 the arrangement is similar, except that the arms are braced together by cross pieces, and that linings of india-rubber are inserted into all the joints and axes to minimise vibration. The patent (Fig. 2), was found to display invention enough to support a patent.

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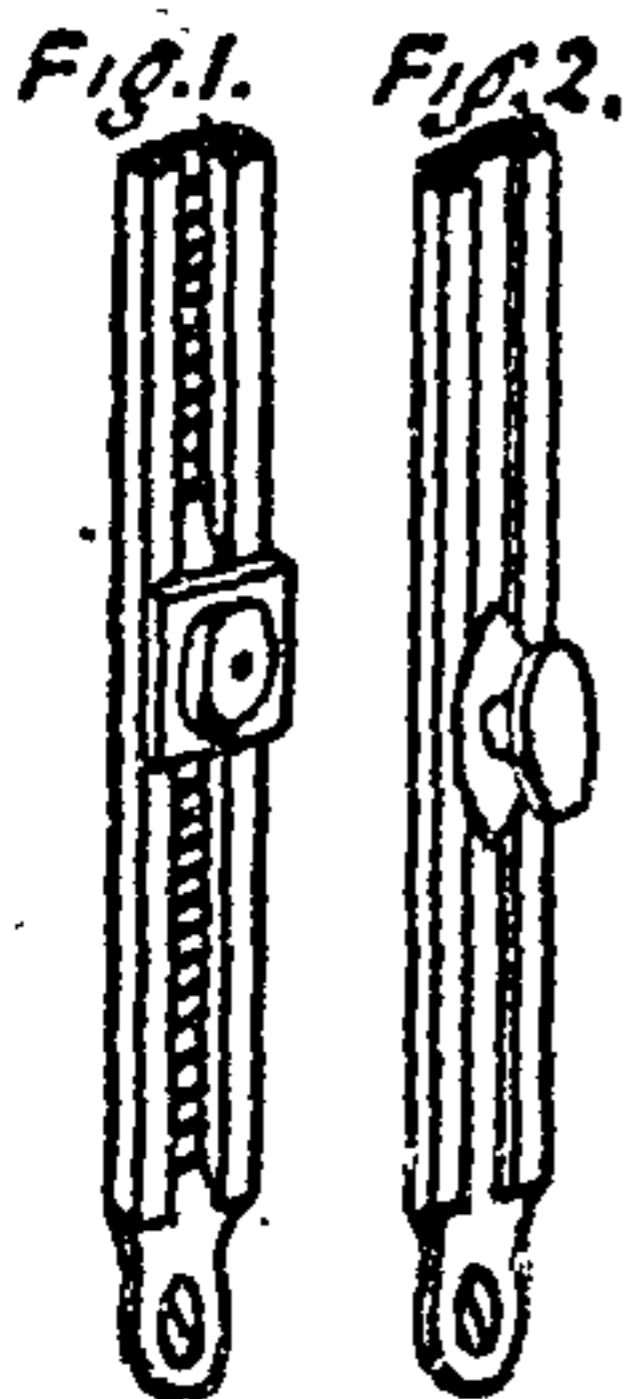
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Fosh v. Hague,
1838, ante,
p. 26.

7. Examples of patents held bad for want of ingenuity.—*Brunton v. Hawkes*, 1821, 4 B. & Ald. 541, 1 C. P. C. 405.—Patent for making anchor flukes in one piece with shank rivetted on, instead of in two pieces welded on to shank, held bad, because mushroom anchors and kege anchors had been similarly made.

Kay v. Marshall, 1841, 2 W. P. C. 34.—Plaintiff had patented (*inter alia*) the placing of rollers for spinning flax, hemp, and other fibrous substances, “nearer together than they had previously been placed, say within $2\frac{1}{2}$ inches of each other.” This was to prevent the fibres from breaking after they had been macerated in water (which process was not new). Previously, flax rollers had been put 15–20 inches apart, cotton rollers $1\frac{1}{8}$ inch apart, and, in fact, the distance had been regulated to suit its fibre. Patent held bad.

R. v. Cutler, 1847, M. P. C. 124.—The mere application of a known article to an analogous use is not patentable. Iron tubes for boilers were old; brass-coated iron tubes were old; a patent for using brass-coated iron tubes for boilers held bad.



Dobbs v. Penn, 1849, 3 Ex. 427.—Patent for a pulley for window blinds (Fig. 2), which differed only from a previous invention (Fig. 1) by the omission of an ornamental escutcheon, and the use of a screw instead of a rack.

Bush v. Fox, 1852, M. P. C. 166, 178, 23 L. J. Ex. 257, 25 L. J. Ex. 251, 5 H. L. C. 707.—Caissons for excavating earth under water. The caisson was shaped like a diving-bell, so as to keep out the water, and sank into the earth as the excavation

proceeded. Exactly similar means had been used for excavating in mines on land, the caissons also serving in this case to keep the water from coming in. "If a man were to take out a patent for a telescope to be used for making observations on land, I do not think anyone could say, 'I will take out another patent for that telescope, to be used for making observations on the sea'" (*per Pollock, C.B.*). Patent held bad.

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Brook v. Aston, 1857, 8 E. & B. 478, 27 L. J. Q. B. 145, 28 L. J. Q. B. 175.—A patent had been granted for strengthening and polishing linen and cotton yarns by means of friction brushes. Another patent could not be obtained for applying the same process to yarns of wool or hair, or to fabrics made of cotton, linen, silk, wool, or hair.

Patent Bottle Envelope Co. v. Seymer, 1858, 5 C. B. (N.S.) 164, 28 L. J. C. P. 22.—Plaintiffs patented and claimed a peculiar method of making bottle envelopes upon a bottle-shaped mould. Defendants used a different method of making envelopes upon a bottle-shaped mould. Held (1), that there was no infringement, and (2) that the mere use of a bottle-shaped mould could be no invention, for moulds were well known for giving shape to pliable materials.

Ralston v. Smith, 1860. (See this case at Chap. III., sect. 3.) Compare with *Dowling v. Billington*.

ante, p. 88.

ante, p. 114.

Harwood v. G. N. Rail. Co., 1860, 2 B. & S. 194, 222, 11 H. L. C. 654, 29 L. J. Q. B.

193, 31 L. J. Q. B. 198, 35 L. J. Q. B. 27.—Fishplates of iron, grooved so that a square-headed bolt, put through a hole in them,



would not turn round, so that the nut on the bolt could be

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screwed up tight, had been used in timber construction. Held, no invention to apply them for uniting railway rails. "You cannot have a patent for a well-known mechanical contrivance, merely because it is applied in a manner, or to a purpose, which is analogous to the manner, or to the purpose, in or to which it has been hitherto notoriously used."

Hyde v. Trent, 45 Newton's Lond. Journal, 135.—Where crushing-rollers had been used for hemp fibre, no patent could be had for using them for cocoanut fibre.

Calvert v. Ashburn, 7 Prac. Mech. Journal, 2nd Series, p. 97.—Caustic alkali had been used to dissolve gluten to make starch. Held, no patent to use the same means to make size.

Compare
Ormson v.
Clarke, infra.

Horton v. Mabon, 1862, 16 C. B. (N.S.) 141, 31 L. J. C. P. 255.—Troughs round the joints of telescopic gas-holders had previously been made of two pieces of iron, L-shaped in section, riveted together. A patent for making the troughs of one piece of U-shaped iron (U-shaped iron being known before) held bad for want of invention.

Mackelcan v. Rennie, 1862, 13 C. B. (N.S.) 52.—It was queried whether the use of a new material, such as iron, in floating docks, where wood had been used before, was patentable, but not decided.

Thompson v. James, 1863, 32 Beav. 570.—The substitution of steel for whalebone in petticoat hoops held insufficient.

Willis v. Davison, 1863, 1 N. R. 234.—The application of an old compensating valve to an old pneumatic lever for organs held bad for want of invention.

See *Newsum v.*
Mann, post,
p. 47, and
Horton v.
Mabon, supra.

Ormson v. Clarke, 1862, 32 L. J. C. P. 8, 291, 13 C. B. (N.S.) 337, 14 C. B. (N.S.) 475.—It had been usual to cast hot-water tubes for conservatories in separate

lengths, and then to place them parallel in groups with their ends cemented into rings made with sockets to receive them, so as to unite them all together. A patent for casting them, rings and all, in one piece, described how to do it, and then claimed, not any special mode of casting, but the doing it in one piece. Held bad for want of invention.

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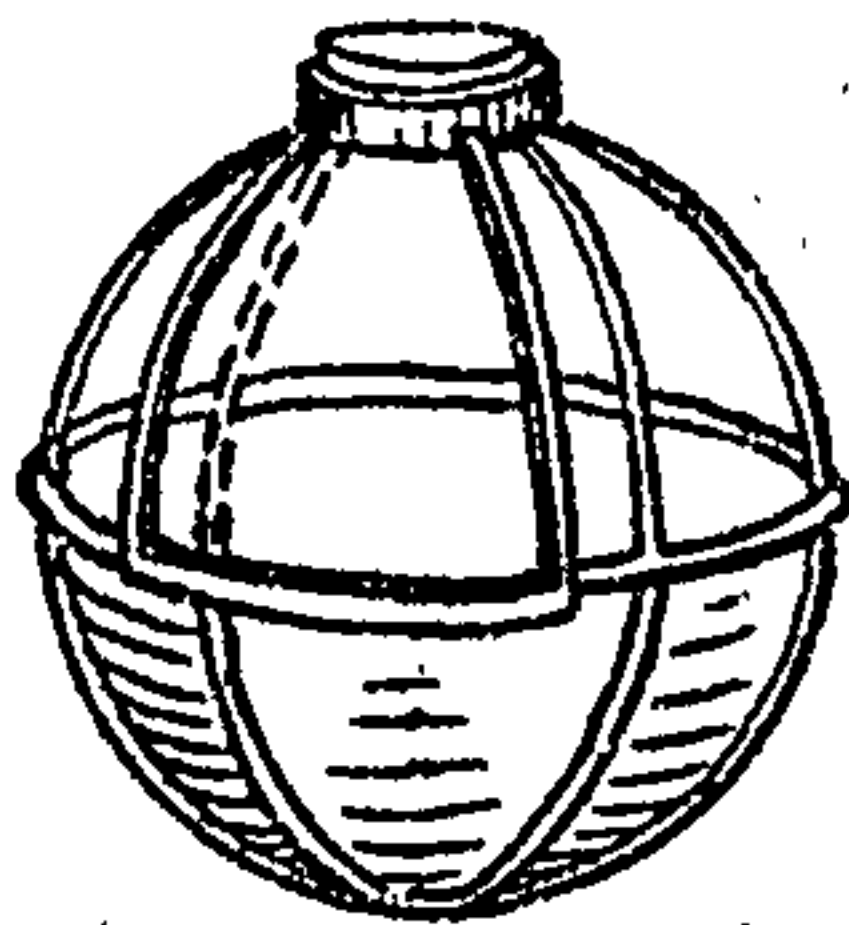
Jordan v. Moore, 1866, L. R. 1 C. P. 624, 35 L. J. C. P. 268.—Iron plates on iron frames for ships were old; so also was wood planking on wooden frames. Held, no invention to use wooden planking on an iron frame (*Harwood v. G. N. R. C.* followed).

Compare with
Crane v. Price,
ante, p. 57.

White v. Toms, 1867, 37 L. J. Ch. 204, 17 L. T. (N.S.) 348.—There is no invention in covering the falls of mourning hats or bonnets on the inside with similar pleats to those which before were used on the outside, so that when turned back the appearance of the fall is improved.

Parkes v. Stevens, 1869, L. R. 5 Ch. 3, 6.—Sliding doors had been used for cylindrical lamps. Held, no novelty to apply them to spherical lamps.

Rushton v. Crawley, 1870, L. R. 10 Eq. 532.—Wool had been used for making chignons. Plaintiff claimed wool, particularly Russian wool, for that purpose. Held, an absurd claim.



Crane v. Price doubted (*per Malins, V.-C.*).

Saxby v. Gloucester Waggon Co., 1881, L. R. 7 Q. B. D. 305, 50 L. J. Q. B. 577.—A patentee had, by two patents of 1870 and 1871, made improvements in interlocking railway signals. In 1874 he patented a combination of the parts contained in the other two patents,

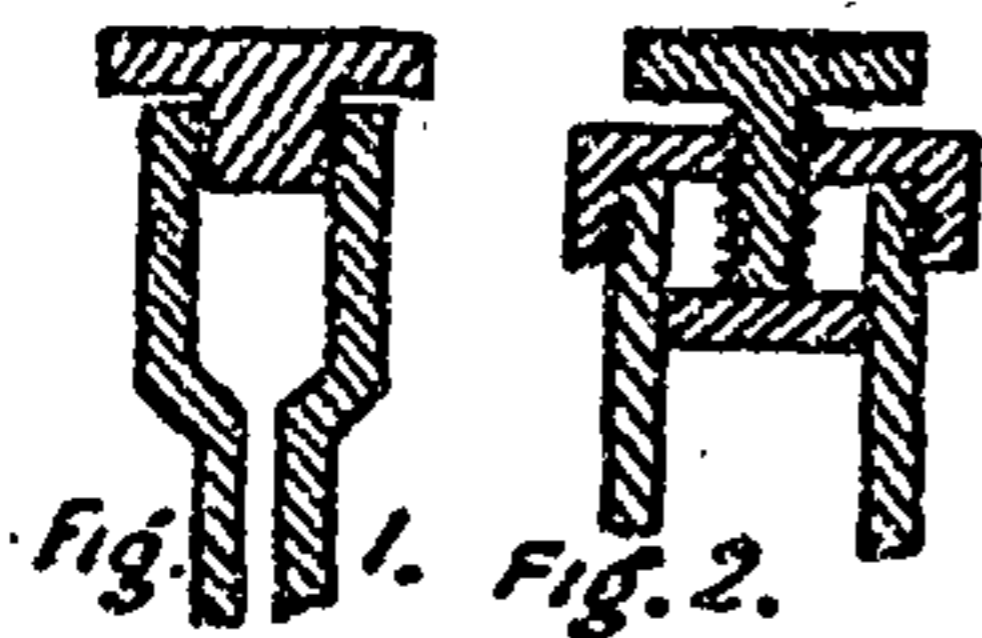
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which, however, effected no results which were new. After an examination of the invention, the Court held that the combination patent of 1874 was such as "any person of ordinary knowledge would be able to effect, without further experiment, by placing the inventions of 1870 and 1871 side by side." Patent held bad.

Eades v. Starbruck Waggon Co., 1881, W. N. 160.—A tramcar pivotted on its frame was old. Plaintiff's patent was for the same thing, with the difference, that the car was longer, and that the frame had two segmental arcs for better support. Held bad.

Croysdale v. Fisher, 1884, 1 R. P. C. 17.—A machine had been invented by Forest for treating nitrogenous refuse with sulphuric acid heated by gas, air, or by a furnace, to produce a manure. Plaintiff's patent was for a similar machine to do this by means of steam, so as to produce the manure in a dry powder, according to a method described by him. Manure made into powder from the manure made according to the first patent was known. Held, that the mere substitution of steam heating for other modes of heating would not support a patent, though had the result, *viz.*, manure *in powder*, been new; the patent might have been good.

Jensen v. Smith, 1885, 2 R. P. C. 249.—The substitu-



tion of a screwed cap working in a thread cut in the inner or outer surface of an oil box (Fig. 1), and substituted for a previously-known piston in the box driven forwards by a screw working in a collar

(Fig. 2), held not sufficient for a patent.

Philpot v. Hanbury, 1885, 2 R. P. C. 33.—A patent for a dressmaker's measuring machine held anticipated.

(The construction of the various instruments is somewhat complicated.)

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SECT. 9.

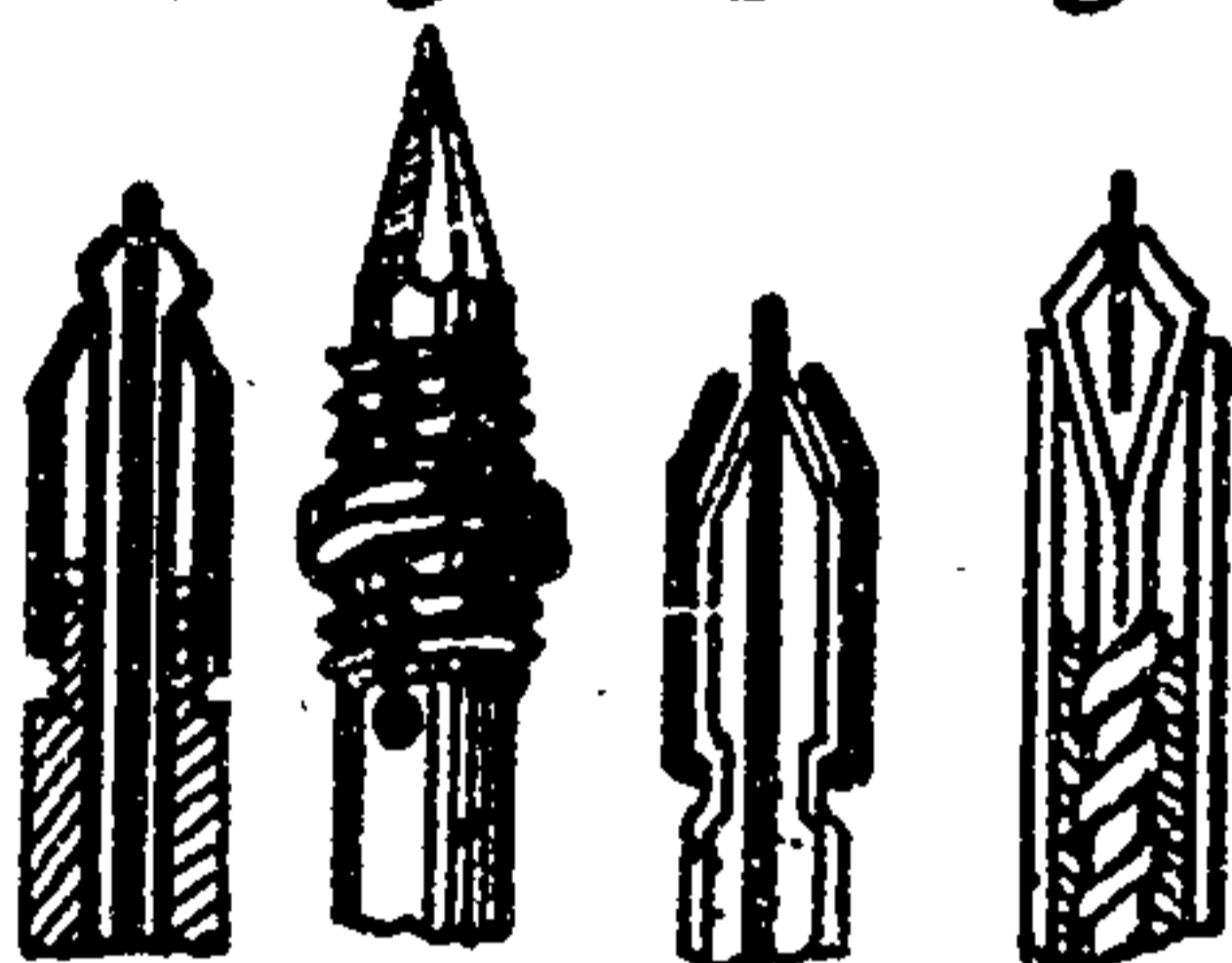
Jackson v. Needle, 1885, 2 R. P. C. 192.—Two boxes, one inside the other, with packing between them, for sending by parcels post, held no invention.

Cases of insufficient ingenuity to support the patent.

Lawrence v. Perry, 1885, 2 R. P. C. 183.—This patent was for a pencil, in which the lead was secured as shewn in Fig. 1. by unscrewing the cap, so that it squeezed together the claws. As

anticipations, Fig. 2 was put forward, being an invention of J. D. Harding, the well-known artist. And also Fig. 3, which attained the same result, by simply pushing back a cap. Fig. 4, for an adapting key for

Fig. 1. Fig. 2. Fig. 3. Fig. 4.



watches was also adduced as an anticipation. Indeed the general features of the plan are very old, having been used for jewellers' vices, and by optical instrument makers for years. The patent was held to have been anticipated.

Moss v. Malings, 1886, 3 R. P. C. 378.—The alteration in the shape of a tennis-bat handle with a groove on each side and a lump at the end, so as to resemble a shin-bone, was considered good, "though somewhat slight matter for a patent." But in a second action brought by the patentee, the Court of Appeal pronounced the patent bad: *Slazenger v. Feltham*, 1889, 6 R. P. C. 232.

Sharp v. Brauer, 1886, 3 R. P. C. 196.—Plaintiff took out a patent for strips of paper or metal joined at the edges so as to make folding screens for windows. Such screens had been previously used for fireplaces. "A luminous idea occurred to him that this old-fashioned

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ante, p. 109.



thing, which everybody might have used whenever he liked, and wherever he liked, would be very handy for a window. . . . It is the very essence of a patent that it must contain an invention. That has been carried very far in the ensilage case (*Reynolds v. Amos*, 1886, 3 R. P. C. 215). The ground upon which I decided that case was that there was a clear invention Here nothing is invented" per Bacon, V.-C.).

Albo-Carbon Light Co. v. Kidd, 1887, 4 R. P. C. 535.—Liquid naphthaline had been used for enriching gas by supplying it with carbon in a state of vapour. Held, that a patent for using solid naphthaline (a well-known form of naphthaline) for the same purpose was bad for want of invention.

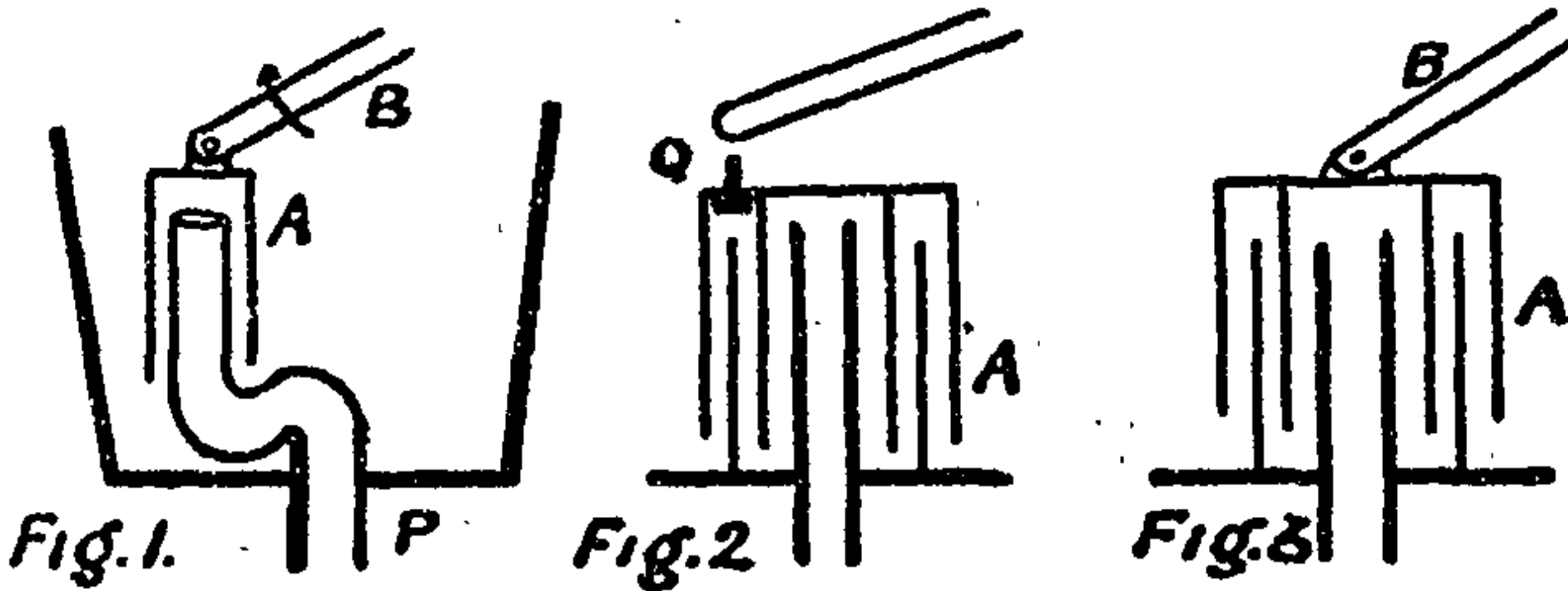
Rowcliffe v. Morris, 1886, 3 R. P. C. 17; *Rowcliffe v. Longford Wire Co.*, 1887, 4 R. P. C. 281.—In old four-post bedsteads it was usual to attach one end of the sacking on which the mattress rested to one end of the bed-frame; the other end of the sacking was fastened to a cross-piece of wood, the ends of which slid in grooves on the inner faces of the bed-frame. This piece of wood was then drawn towards the other end of the bed-frame by screws and nuts, so as to stretch the sacking tight. After the invention of wire-wove mattresses or webs the plaintiff patented a similar method of attaching them to frames without legs, with this difference, that his cross-pieces slid on the surface of the frame instead of in grooves in it; this enabled the web to be wider than before. Held to display no invention.

Humpherson v. Syer, 1887, 4 R. P. C. 184, 407.—In

1881, Winn invented a form of waste preventer for W.C.'s shewn in Fig. 1. When the cap, A, is raised by the lever, B, the water enters the syphon and flushes down the pipe, P. But when the cistern re-fills, the pressure of air in the cap, A, prevents the water entering the mouth of the syphon till the cover, A, is raised again. In January, 1885, Syer invented a modification of this by substituting for Winn's cap and syphon, a double cap (Fig. 2). The action is scientifically exactly the same, only the syphon is formed by the cap itself. Fearing that this similarity would invalidate his patent, he con-

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trived another mode of working his machine, by placing in it an air valve, Q, actuated by a lever, or else by a simple button, to let out the compressed air which the rise of the water in filling the cistern had forced into the cap. This had just the same effect as raising the cap. He also caused a workman to make a preventer on his system adapted to work by raising the cap. In February, 1885, Humpherson patented Fig. 3, which really was the same as Syers', only that the cap was raised by a lever instead of an air valve being actuated by the lever. He thus did exactly what Syer had been afraid to do. Syer then made a waste preventer resembling Humpherson's, who brought an action. Held, that Winn's was not an anticipation of Humpherson's; that on the true in-

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terpretation of Syer's patent he only claimed a stationary cap and air valve, and hence these two were not an anticipation of Humpherson, who obtained a judgment, which was reversed on appeal, on the ground that the model made by Syer had been published, and that, taking Winn's and Syer's patents together, the plaintiffs presented no sufficient feature of novelty: for it was only to apply Winn's method of lifting to Syer's cap.

Oddy v. Smith, 1888, 5 R. P. C. 503.—Patent for holding down leather (on to places to which it was to be cemented) by spiked bars while the cement was drying. Held, no subject-matter.

Longbottom v. Shaw, 1888, 5 R. P. C. 497, 6 R. P. C. 143, 8 R. P. C. 333.—Separate



hooks fastened to frames or reels had been used for holding fabrics.

A patent for making rows of hooks by stamping or casting them in one piece, and then fastening it on, held bad for want of invention.

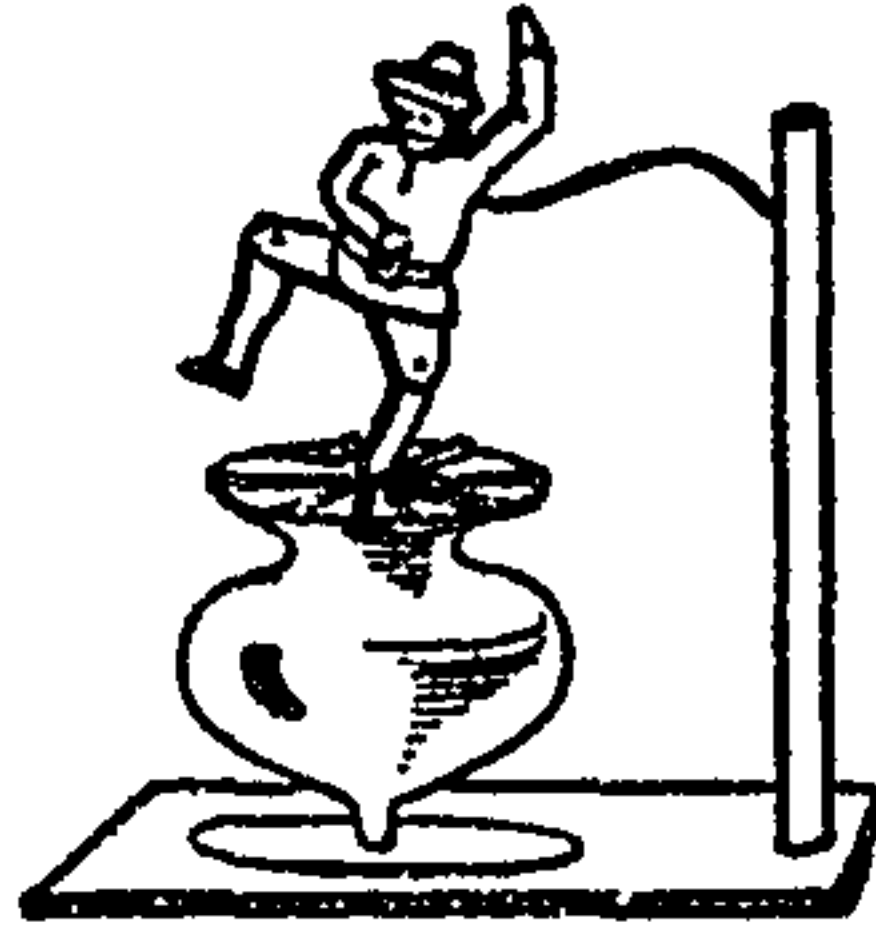
Tickelpenny v. Army and Navy Society, 1888, 5 R. P. C. 405.—Hollow columns were old, and when filled with water had, at least partially, supported a floor on which tanks rested. Held, no invention simply to apply them in the support of fire-proof floors, for the former user would be an infringement of the patent.

Fletcher v. Arden, 1888, 5 R. P. C. 46.—A patent was taken out for a contrivance for grilling and boiling over gas flames. The grill was hinged or pivotted so that it could be pushed out of the way when not wanted. The specification had originally claimed a sliding grill, but this was disclaimed. A previous invention had caused the grill to *slide* out of the way. Held, that the idea of hinging or pivotting the grill instead of making it slide

was not the subject-matter of a patent, as it was the mere substitution of a known mechanical equivalent.

Cole v. Saqui, 1888, 5 R. P. C. 489; 6 R. P. C. 41.—

An upright with a flexible arm was fitted to a stand, and from it was hung a figure whose toes touched a top spinning on a china plate fixed to the stand. When the top was spun the figure was made to dance. It was proved that one Dean had registered a similar machine, in which the top was not freely spun in a plate, but rotated in a fixed bearing. Patent held bad.



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Britain v. Hirsch, 1888, 5 R. P. C.

74, 226.—A top dressed like a dancing doll contained a gyroscope (Fig. 1), which was caused to spin by means of a coiled spring in a separate stand released by a detent (Fig. 2). A coiled spring with a detent in a box had been previously used for spinning tops. Held, no invention to apply it to that particular sort of top.

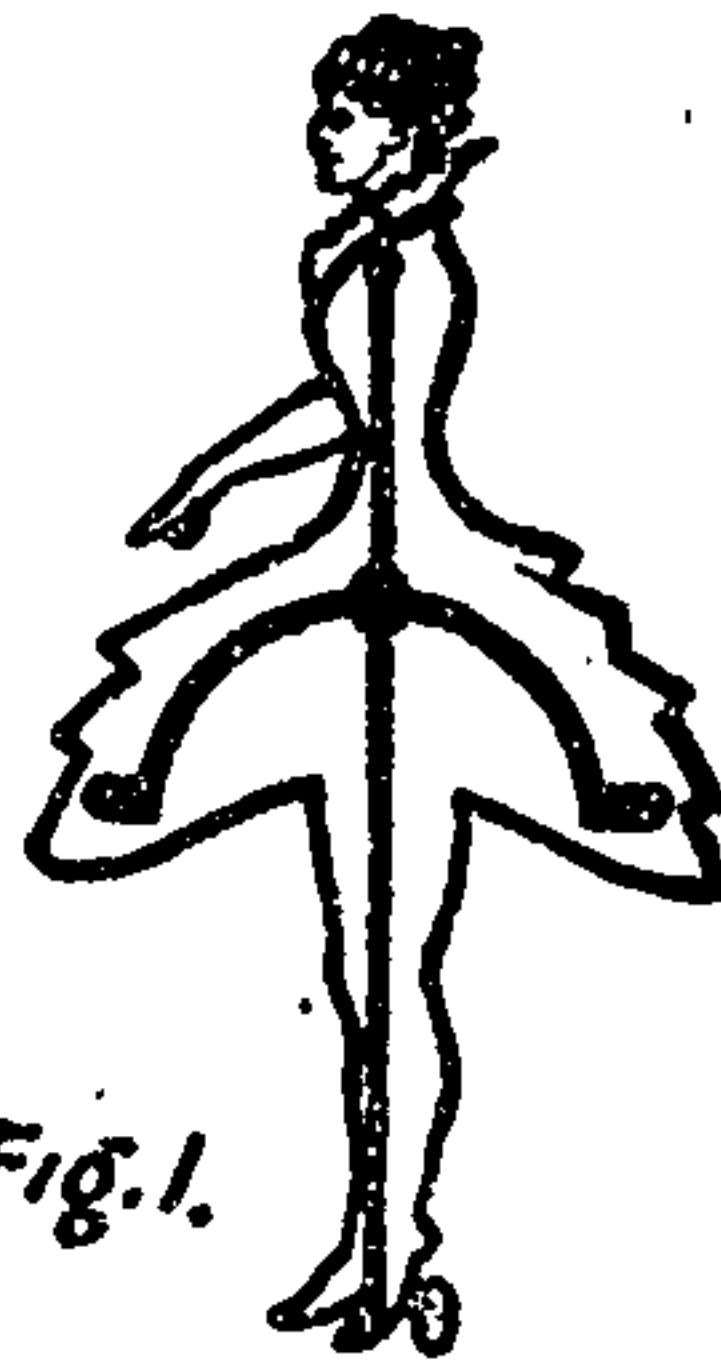


Fig. 1.

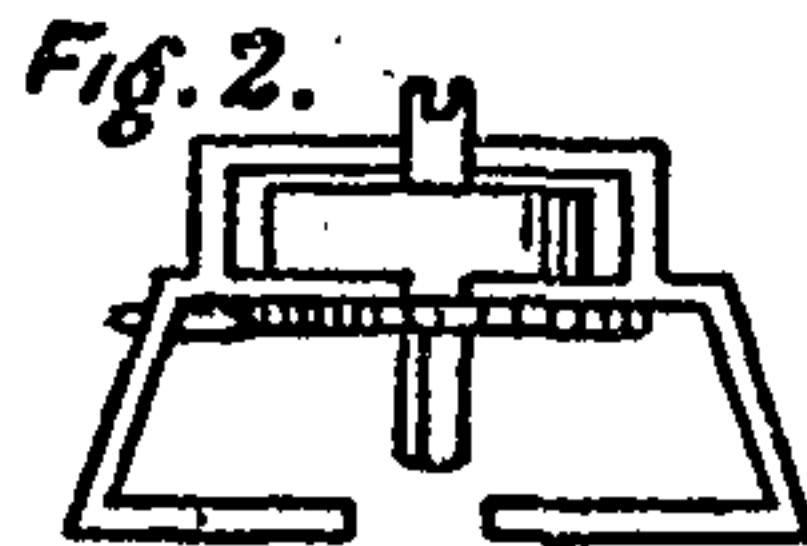


Fig. 2.

In re Goulard and Gibbs, 1888, 5 R. P. C. 536.—Petition for revocation. Goulard and Gibbs took out a patent,

which, as amended, did not claim any special form of instrument, but claimed generally the sending a high-tension alternating current of electricity through the primary circuits of a number of induction coils, each of which had a secondary coil from which a current of different tension was drawn

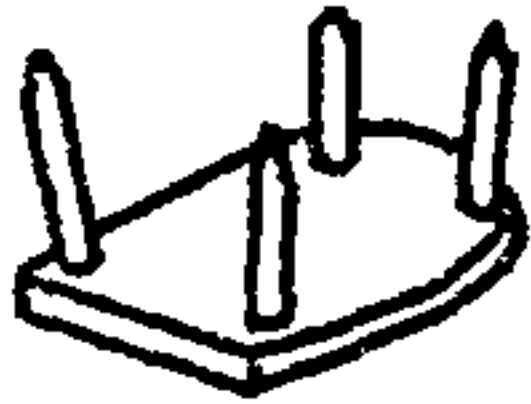
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for lighting or power. Induction coils were old, and had been used before for electric lighting. The patent did not say that the instrument was to be so arranged that the current drawn off the secondary coils for use was to be lower than the current supplied to the primary coils; on the contrary, the arrangement was such that the tension could be raised according to the desire of the consumer. It was known that such coils could be used either to raise or lower the tension of alternating currents, though in general such coils had previously been used to raise it. Held, that the patent could not be supported. (Before this case is quoted, it requires careful attention, because it seems that if the patent had been more carefully restricted, it could have been made to hold.)

See *Fletcher v. Arden*, ante, p. 126.

United Horseshoe Co. v. Swedish Horse Nail Co., 1888, 6 R. P. C. 1.—Substitution of a pivot for a hinge in nail-making machine held bad.

Blakey v. Latham, 1889, 6 R. P. C. 29, 184.—Clinkers,



i.e., double-pronged nails, had been used in the toes of boots, and plates of iron had also been nailed on. Held, that a patent for pieces of iron cast in one piece with a

number of spikes upon them, to be driven on to the soles and heels of boots, displayed no inventive power in spite of evidence of large user.

Griffin v. Feaver, 1889, 6 R. P. C. 396.—The plaintiff's



Fig. 1.



Fig. 2.

patent was for a preserved meat tin box, which could be opened by putting a lever under the edge of the

lid, and raising it (Fig. 1). It had been anticipated by

Fig. 2 in which, however, a subsidiary thin cover was added, to be cut away as soon as the cover was removed. The patent was declared bad.

Herrburger v. Squire, 1889, 6 R. P. C. 194.—The mere alteration in the position of the lever in a piano-string damper is not the subject of a patent. (It is, however, to be noted here, that evidence was given that the very same alteration had been shewn on a previously-published drawing, so that the patent was bad for anticipation as well as want of invention.)

Williams v. Nye, 1890, 7 R. P. C. 62.—Plaintiff patented a sausage-making machine consisting of cutters revolved by a shaft, and on the same prolonged shaft, a series of propeller blades for forcing the minced meat into the skins after the mincing had been finished. Prior to this, a propeller had been combined with the cutters by Gilbert and Nye, and a new form of cutter, of shape like the plaintiff's, had been invented by Donald. Plaintiff had, therefore, only put Donald's cutter on to Gilbert and Nye's machine. Held bad.

Morgan and Windover, 1888, 5 R. P. C. 296, 7 R. P. C. 131.—It was proved that prior to the plaintiff's patent the old form of coach had a body suspended from C-springs at front and back, but in order to make the carriage capable of turning, it was necessary to fix at least one of the pairs of wheels, preferably the front one, to a vertical pivot so that the axles could become inclined to one another instead of always remaining parallel. This necessitated the use of a perch or rigid framework whose front end was pivoted to the front axle. The back axle was rigidly fixed to the perch (Fig. 1). This plan was gradually superseded by "elliptic springs" consisting of two elliptic segments fastened together, as

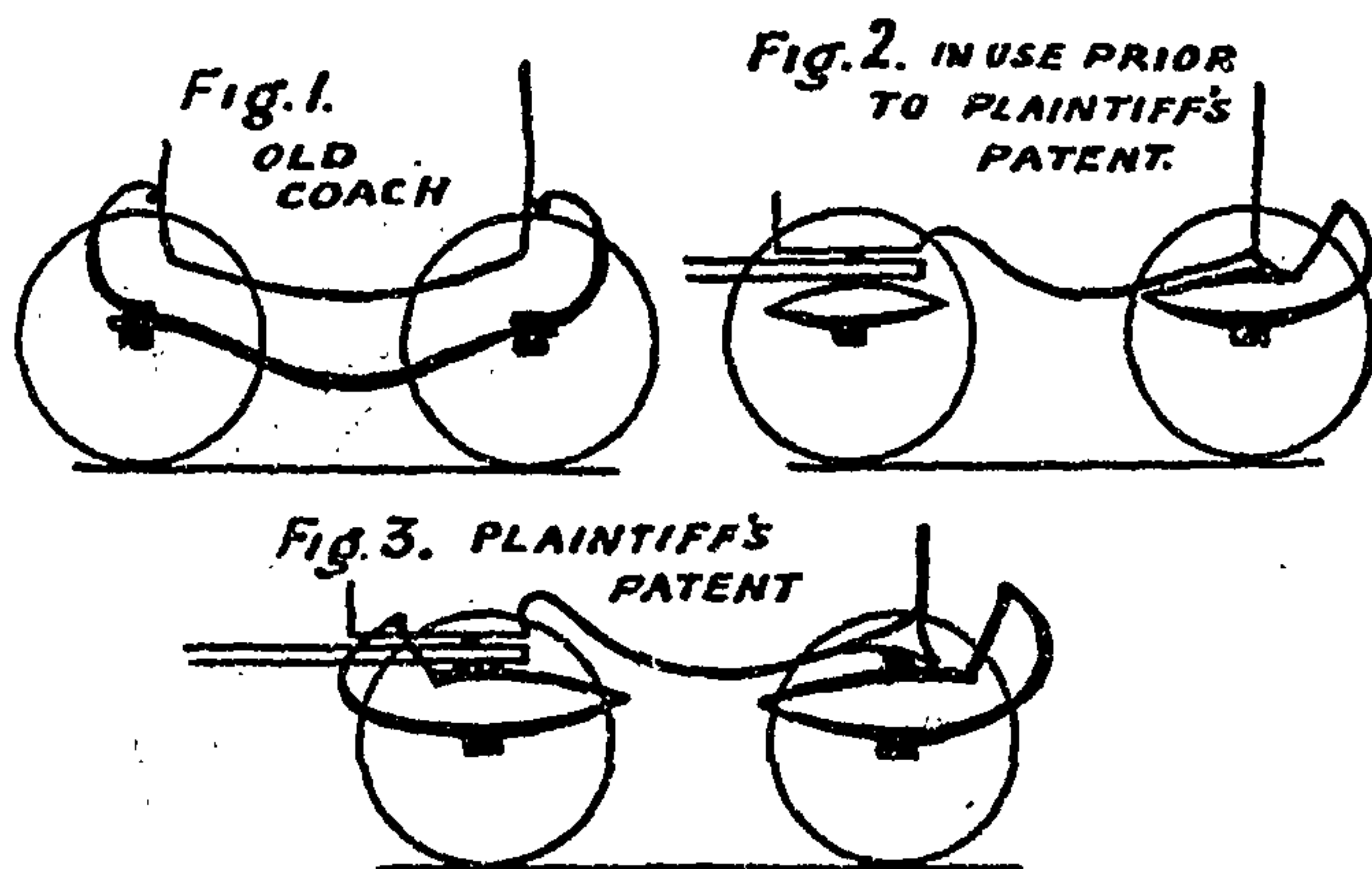
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now in use. But to make the motion more easy, a combination of the elliptic spring and the C-spring was used as shown in Fig. 2. This combination was only fitted to the back axle perhaps because it was not readily seen how to adapt it to the front axle, which could not be rigidly attached to the carriage, but required to turn on a pivot. The plaintiff surmounted this difficulty (which, if it ever existed, was a very imaginary one) by simply



substituting for the front elliptic spring, a combined C and elliptic spring, such as had been used (Fig. 2) for the back of the carriage, and arranged it so that the upper end of it should be attached, not to the body of the coach, as in the case of the back spring, which would have prevented the pivoting action, but to the movable part to which the shafts were fastened. The question was whether this exhibited ingenuity: The Court below, and the Court of Appeal, thought it did, but the House of Lords decided that it did not.

Elias v. Gravesend Tinplate Co., 1890, 7 R. P. C. 455.—Prior to the plaintiff's patent, one Morewood, had

invented a machine for dipping iron plates in grease to clean them before being tinned. They were removed from the grease by being lifted up a short way by a cradle till the ends were caught between vertical rollers, which raised them up out of the grease. All that the plaintiff did, was to double the length of the tank and of the rollers, so as to work two plates simultaneously. Patent held bad.

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Leadbeater v. Kitchin, 1890, 7 R. P. C. 235.—A safety guard had been used to protect persons from injury by geared cogwheels in motion. No patent could be granted for the same contrivance for protecting them from belted pulley wheels, for this would be merely the analogous use of an old contrivance.

Newsom v. Mann, 1890, 7 R. P. C. 307.—A patent which claimed making the parts of a printing machine in one casting, which had previously been made separate, held bad: (*Ormson v. Clarke* followed.)

ante, p. 120.

Tucker v. Kaye, 1891, 8 R. P. C. 61.—Door locks had been made with a detent so as when the handle was turned, to catch and hold back the bolt, which remained back till the door was again shut, upon which a pin on the *face* of the door struck the jamb and released the detent, and the bolt shot home. A patent for a lock containing a bolt held back by a detent which was released by the pressure of the door-jamb against a pin on the *edge* of the door held bad.

Winby v. Manchester Steam Tram Co., 1891, 8 R. P. C. 68.—In a patent for switches for tramway crossings, held, that the substitution of a spring for its mechanical equivalent, a weighted lever, was bad.

Nuttall v. Hargreaves, 1891, 8 R. P. C. 273.—A tap, which differed from previous ones only by having a

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gauze strainer instead of a perforated metal strainer, held bad.

Embossed Metal Co. v. Saupe, 1891, 8 R. P. C. 355.—Embossing thick metal sheets between non-elastic dies was known; also the embossing of thick metal by tools upon pitch; also by engraved rollers pressing thin plates on indiarubber. Patent for embossing thick plates by stamping them from the reverse side on to a soft india-rubber pad held bad.

Fairfax v. Lyons, 1891, 8 R. P. C. 401.—A patent for improvements in moving targets held bad, because the mechanical means, which were complicated and varied were not materially different from similar means employed previously for a similar object.

Heyes v. Hallmark, 1891, 9 R. P. C. 27.—A patent for a window-sash weight which only differed in shape from others in previous use held bad.

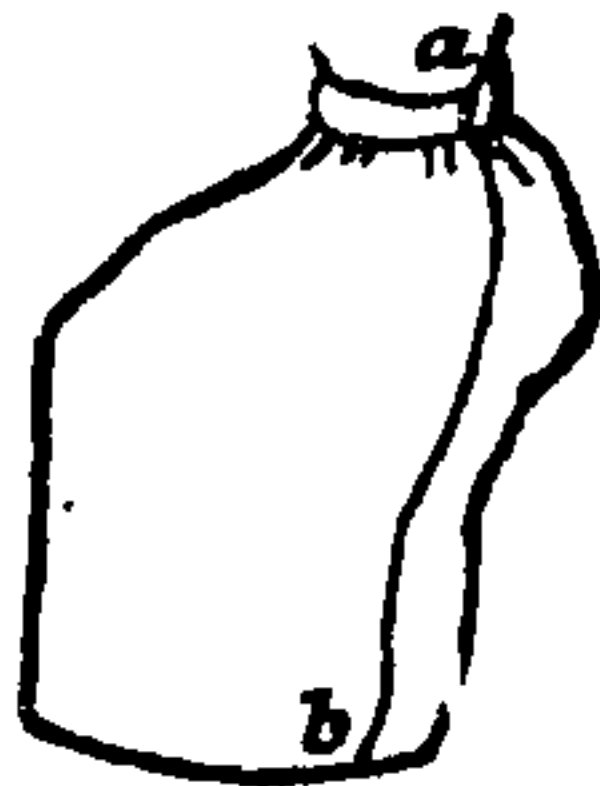
Wilson v. Union Oil Mills Co., 1892, 9 R. P. C. 57.—It is of course well-known that soap is made by mixing fat or oils with alkalis, such as soda to make hard soap, or potash to make soft soap. Cotton-seed oil is used for soap-making. Soap could also be made by adding soda to the fatty substance (called railway grease) which is left after the distillation of cotton-seed oils, but it is dark and has a bad smell. The plaintiff patented the use of chlorine or hypochlorite of soda boiled with it to bleach and deodorize it. Hypochlorite of soda was better than using chlorine gas, as the pure chlorine, not in the form of hypochlorite of soda, was apt to injure the fatty matter. But it was proved that hypochlorite of soda had been used before for bleaching other sorts of soap, and chlorine water had been used to bleach cotton-seed soap. The patent was therefore held to have been anticipated.

Baker v. Kinnell, 1892, 9 R. P. C. 441.—A joint had previously been used for hot-water coils. Held, no invention to apply it to boiler tubes in which the heat was applied outside the tube; that this was an application of an old thing to a merely analogous purpose.

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Nicoll v. Swears, 1893, 10 R. P. C. 240.—The plaintiff's patent was for a riding skirt for ladies with a burstable seam on the left side, *a*, *b*, continued right up to, and including the waist. If the lady fell, and her skirt caught in the pommel, the seam burst, and she fell clear of the skirt which was left on the saddle.



Prior to this, Busvine had patented a burstable riding habit, with a large hole in it on the right hand side into which the pommel of the saddle projected. This would of course be certain to catch, in case of a fall. To prevent it, a slit was made downwards from the hole to the bottom of the skirt, and laced up with elastic which tore away in case of a fall, so that the skirt remained on the wearer. It was held that, having regard to the fact that burstable seams were old, the plaintiff's invention displayed no novelty.

8. Want of ingenuity in part of the subject matter of a patent will render the patent void.—This depends on the principle that part failure in the consideration recited in a Crown grant, renders the whole grant bad. See Chap. I., sect. 8.

ants, p. 60.

CHAPTER IV.

THE EFFECT OF COMMERCIAL SUCCESS UPON A PATENT.

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Compare ante,
p. 20.

1. General Remarks.—In supporting a patent, it is of the utmost importance to try and shew that the subject of it was a commercial success, and that all similar inventions which have preceded it were failures. For commercial success goes far to prove utility by the best of all possible methods, namely, by actual use; it also is evidence of ingenuity, for if the thing was obvious, it would probably have been invented before; and it is also evidence of novelty, for its success when tried is evidence that if it had been known before it would have been put in practice. Hence, no form of argument in support of a patent is more effective than to shew that the invention was one which all the world had been looking for, and trying to get, that attempts had been made before but had failed; then came the patentee, who shewed how to do it, and made an immediate commercial success.

2. The effect of Commercial Success of an invention as evidence of its utility.—The effect of commercial success as evidence of utility is very considerable, specially when contrasted with the failure of previous efforts to attain a result: see the judgment of Bowen, L.J., in *The American Braided Wire Co. v. Thomson*, 1888, 5 R. P. C. 125—patent for bustles. With regard to

this case, Kekewich, J., said: "I conceive the following proposition to be established by that case, and by other cases in which similar questions have been discussed. If, within a short time of the manufacture and sale, an article of commerce commands a ready and extensive sale, that fact, which is proof of utility, must also be accepted as evidence, not conclusive, but cogent, of novelty": *Ehrlich v. Ihlee*, 1888, 5 R. P. C. 205. "When a man proves that in the course of I think rather less than two, or about two, years, he has sold 5,448 dozens of this new toy (dancing dolls). . . I think that is strong evidence of utility, and conclusive until it is contradicted" (Kekewich, J.): *Cole v. Saqui*, 1888, 5 R. P. C. 495; see also *Deutsche Nähmaschinen Fabrik v. Pfaff*, 1890, 7 R. P. C. 16, 251. On the other hand, mere want of commercial success is not conclusive against the utility of an invention, "for possibly it might at once have been superseded by simpler constructions, involving the same principle" (*per* Lord Maclaren): *United Telephone Co. v. Maclean*, 1882, *Engineering* newspaper quoted with approval in *United Telephone Co. v. Bassano*, 1886, 3 R. P. C. 313, and followed in *Edison v. Holland*, 1889, 6 R. P. C. 283; and see *Otto v. Linford*, 1881, 46 L. T. (N.S.) 41; or again, the state of the arts and sciences might explain the non-user of the invention in spite of its utility: *Goulard v. Gibbs' Patent*, 1883, 5 R. P. C. 536. In truth, utility has really two meanings, and it is often difficult to see which of them is being used. There is utility in the sense that a machine will work well and efficiently, and there is utility in the sense that it is useful to and desired by the public. The latter must always be proof of the former, but it may well be that a most excellent machine which works well, may not, for

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The effect of commercial success of an invention as evidence of its utility.

ante, p. 65.

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The effect of commercial success of an invention as evidence of its utility.

ante, p. 67.

some reason, be appreciated. The cases shew that it is the good working of the machine that is necessary to constitute utility, and that commercial success is only relevant as evidence of this.

It is, therefore, not needful that a patent should be commercially useful at the exact time it was patented, for "a process which at one time could not be worked at a profit on account of the expense of the materials employed, may shortly afterwards be so worked by reason of a diminution in the cost of those materials. Is the person who patents such a process to be deprived of all benefit of his invention when it becomes a commercial success, because at the time of the patent it could not be worked at a profit?" (*per* Lord Herschell): *Badische Anilin und Soda Fabrik v. Levinstein*, 1887, 4 R. P. C. 466, 12 App. Cas. 719, followed in *Siddell v. Vickers*, 1888, 5 R. P. C. 96; *Otto v. Linford*, 1882, 46 L. T. (N.S.) 41. (*Simpson v. Holliday*, 20 Newton's Lond. Journal (N.S.) 107, 120, must therefore, on this point, be considered as disapproved.)

post, p. 337.

Under the heading Extension of Patents, Chap. XXV., sect. 13, many instances will be found in which the Privy Council allowed the apparent want of utility of an invention arising from its non-user, to be explained by such circumstances as public prejudice, strikes, want of money, and other similar difficulties.

3. Commercial success is also evidence of Novelty, that is to say, of absence of Anticipation, but is not so strong evidence of novelty as it is of utility: *Ehrlich v. Ihlee*, 1888, 5 R. P. C. 205.

4. Commercial success is also evidence of ingenuity.—"It is true that where there has been for some

time a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained uncomplied with, is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere in some shape. But it may be that the demand is quite new, and that the novelty of the demand has produced immediately, and without any operation of ingenuity, an obvious article to satisfy it" (*per* Bowen, L.J.): *Gosnell v. Bishop*, 1888, 5 R. P. C. 158. In *Edison v. Holland*, 1889, 6 R. P. C. 283, Lindley, L.J., remarks: "If Swan's lamp had been a commercial success instead of a failure, it would, in my opinion, have been an anticipation of the plaintiff's patent": see also *Otto v. Linford*, 1882, 46 L. T. (N.S.), p. 41.

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Commercial
success is also
evidence of
ingenuity.

CHAPTER V.

ANTICIPATION.

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1. A patent will be bad, if prior public knowledge of the invention can be shewn.—For the consideration of a patent is, the introduction of some new art or manufacture. “If the public once becomes possessed of an invention, by any means whatever, no subsequent patent for it can be granted either to the first and true inventor himself, or to any other person; for the public cannot be deprived of the right to use the invention, and the patentee could not give any consideration to the public for the grant, the public already possessing everything that he could give”: Hindmarch; cited with approval by Lord Blackburn in *Patterson v. Gas Light & Coke Co.*, 1877, L. R. 3 App. Cas. 239, 47 L. J. Ch. 402, and again by Bowen, L.J., in *Humpherson v. Syer*, 1857, 4 R. P. C. 414. There are three different ways by which an invention may become so public as not to be the subject of a patent, viz., (1) by prior public knowledge; (2) by prior user; or, (3) by prior publication.

All the inventions which are commonly found in books, encyclopædias and dictionaries, are part of the common heritage of knowledge, and in a patent case it is not necessary in shewing that those inventions are old to specify peculiar instances. For example, if a plaintiff sued on a patent for a lever, or screw, it would not be

needful to rely on particular anticipations, general evidence of prior knowledge would be sufficient. Nor, of course, need such knowledge be general. It is enough that knowledge should be shewn on the part of those who usually practice the trade to which the invention relates. Thus, in *Plimpton v. Malcolmson*, L. R. 3 Ch. D. 556, Jessel, M.R., said: "When you say a thing is known to the public, and part of common knowledge, of course you do not mean that every member of the public knows it. That would be absurd. What is meant is, that if it is a manufacture connected with a particular trade, the people in the trade shall know something about it; if it is a thing connected with a chemical invention, people conversant with chemistry shall know something about it. And it need not go so far as that. If a sufficient number know it, or if the communication is such that a sufficient number may be presumed or assumed to know it, that will do. Now how are they to know it? They are to know it by being told of it, or informed of it in some way. You may shew that they know it by shewing that the trade had commonly used it. That is the best evidence you can have. You may shew the thing was known because it was used and brought into practice. . . . But you may shew that they knew it in another way, that it was published, or made known to the public."

The general law was laid down at length by Tindal, C.J., in *Cornish v. Keene*, 1835, 1 W. P. C. 508, and it is to be noted that in questions of prior public knowledge there is great difference between the practical public knowledge of manufacturers and the knowledge of learned persons in their studies. The latter will always have a far weaker effect on the validity of a patent than

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the former: *Gibson v. Brand*, 1841, 1 W. P. C. 628; *Betts v. Menzies*, 10 H. L. C. 117; *Shaw v. Jones*, 1889, 6 R. P. C. 336; *Hills v. Evans*, 4 De G. F. & J. 288; *Edison v. Holland*, 1889, 6 R. P. C. 277; see further on this point, Prior Publication by Documents in General Chap. V., sect. 9 (*post*, p. 151).

2. Prior public user.—There is a second sort of prior publicity of an invention which will render a patent invalid, arising from prior user. Where such prior user is so general that the invention is commonly known, then it may be said to be part of the common stock of public knowledge, and comes within the cases discussed in the preceding chapter. But where the prior user is not such as indicates a common public knowledge, but has been confined to certain persons and places, several questions arise of some intricacy. For the prior user may be by the patentee, or by others; and again it may be secret or in public; and again it may be experimental or for manufacturing purposes. It is believed that all possible cases may be brought under one or other of the three following groups which will be treated in order.

(1.) Where prior public user is shewn of such a character as fully to reveal to the public the nature of the invention, the patent is void, whether such user be by the patentee or any one else.

(2.) Merely private and experimental user by the patentee or by others, will not avoid a subsequent patent.

(3.) Where the prior user is of such a character that though the results of the invention are made public, the art by which those results are obtained is not revealed, then it will depend whether the prior user has been by

the patentee or by "others." If by the patentee, he can still have a valid patent. If the user has been by "others," the conditions of the Statute of Monopolies will have been broken, for the invention will not be one which "others" at the time of granting the letters patent did not use.

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By public user is not meant user *by* the public, but user *in* public: *Croysdale v. Fisher*, 1884, 1 R. P. C. 17; *Elias v. Gravesend Tin-plate Co.*, 1890, 7 R. P. C. 466. Thus, in *Carpenter v. Smith*, 1842, 1 W. P. C. 539, 9 M. & W. 300, a lock having been for some years on a gate in a public place, a subsequent patent for it was invalidated. And where pavement had been laid in a covered portico of a private house, the user was still considered sufficiently public to avoid a patent for similar pavement: *Stead v. Williams*, 1844, 2 W. P. C. 136; *Stead v. Anderson*, 1846, 2 W. P. C. 149. In *Adamson's Patent*, 1856, 6 De G. M. & G. 420, 25 L. J. Ch. 456, an invention for machinery which had been used for building a pier in a place to which the public had access, was held not patentable.

One, Jackson, having publicly ridden a bicycle, called by the neighbours, "Jackson's threshing machine," was held to have anticipated by public user a patent for a similar machine: *Brereton v. Richardson*, 1884, 1 R. P. C. 163; see also *Lifeboat Co. v. Chambers*, 1891, 8 R. P. C. 418. Where five firms used an invention for making steel by means of carburet of manganese, held, a public user: *Heath v. Smith*, *Heath v. Unwin*, 1854, 2 W. P. C. 268. See also *Westley Richards v. Perkes*, 1893, 10 R. P. C. 193.

In *Podmore v. Wright*, 1888, 5 R. P. C. 380 (Umbrella-top Notches); *Badham v. Bird*, 1888, 5 R. P. C. 238

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(Sewer Manholes); *Cheetham v. Oldham*, 1890, 7 R. P. C. 116; *Lister v. Norton*, 1886, 3 R. P. C. 210, prior public user was established. These cases do not contain any express enunciation of the principles, but are examples of the kind of evidence necessary to establish prior user.

But though prior public user will invalidate a patent for an invention, the mere public use of articles made according to the invention, but whose nature is not such that by looking at them an expert could tell how they were made, will not of itself invalidate a subsequent patent. Thus, in *Hancock v. Somervell*, 1851, 39 Newton's London Journal, 158, the patent was for vulcanising india-rubber goods by means of sulphur. The prior user which the defendant endeavoured to establish was the public sale in England of some goloshes made with sulphur in America. It was urged, and evidence was given that by the appearance of the articles and their smell an expert could tell that the india-rubber composing the goloshes had been made with sulphur. Williams, J., directed the jury that if they thought so, they should find for the defendant, but that if they thought not, then they should find for the plaintiff. This direction seems plainly in accordance with the principles of the Statute of Monopolies which was passed (*inter alia*) for the encouragement of those who should discover the secrets of the modes of manufacturing articles abroad, and reveal them to their own countrymen.

3. Prior private user of an experimental character will not invalidate a patent.—It is quite clear that prior user of an experimental character, and which has never been made public, will not invalidate a patent,

whether such user be by the patentee, or by others. Thus, where Dr. Hall discovered the achromatic telescope, but kept his experiments secret, a patent afterwards granted to Dollond was upheld (1776) cited 1 W. P. C. 43; and prior secret user by the patentee himself was held not to invalidate: *Bentley v. Fleming*, 1844, 1 C. & R. 587, 1 C. B. 479; *Betts v. Menzies*, 1857, 8 E. & B. 937, 1 E. & E. 990. On the other hand, prior public user by the patentee himself would invalidate his patent, whether such user were experimental or not. *Morgan v. Seaward*, 1837, 2 M. & W. 559, 1 W. P. C. 194.

In *Newall v. Elliot*, 1858, 4 C. B. (N.S.) 269, 27 L. J. C. P. 337, the experimental user of a submarine cable-laying machinery did not vitiate the patent, and the fact that the patentee had received benefit made no difference. But the Court laid stress on the fact that it had only been done once, and not repeatedly. In *The Useful Patents Co. v. Rylands*, 1885, 2 R. P. C. 254, where even 600 dozens of bottles, together with the tools with which they were made, were sent to an aërated water company for trial, it was still held that this was experimental. In *Morgan v. Seaward*, 1837, 2 M. & W. 544, 1 W. P. C. 187, a number of wheels were made in confidence and exported; this was held no prior public user. All these cases seem to turn on the meaning of the word "use" in the Statute of Monopolies, which means not "experimentally use," but "use for a regular trade purpose": see the preceding section.

Jessel, M.R., seems to have thought that the intention to take out a patent was essential to prevent experimental user, even in secret, from establishing prior user. In the House of Lords, Lord Blackburn thought that the

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See also sect. 7 as to prior user, but subsequent abandonment of the invention.

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intention might be presumed from the fact of the user being experimental: *Saxby v. Gloucester Waggon Co.*, 1883, Griff. App. 57; see also *re Adamson's Patent*, 1856, 25 L. J. Ch. 457, and as to secrecy, see *Humpherson v. Syer*, 1887, 4 R. P. C. 414. It is not merely the article made which must be shewn to have been anticipated by user, but the invention. Thus, in *Poupard v. Fardell*, 1869, 18 W. R. 59, 127, 21 L. T. (N.S.) 696, where the tail-piece of a skid for wheels had been previously lengthened *for the purpose of hanging it up*, it was held that a patent might be had for lengthening the skid for making it more effective in skidding.

4. Prior user of the invention by the patentee or others within the realm of such a character, that the results of it are made public, but not the means whereby they are brought about.—It is quite clear that where the mere inspection of the articles reveals the invention, prior public user of them will avoid a subsequent patent.

Thus, where the defendants proved that tea-pots, similar to those patented, had been previously sold by others, the plaintiff was defeated. *Hollins v. Capper*, 1888, 5 R. P. C. 289. See also, *Guilbert-Martin v. Kerr*, 1886, 4 R. P. C. 18, where the sale of steam gauge glasses similar to those patented, invalidated a patent. See also *Honiball v. Bloomer*, 1854, 2 W. P. C. 199.

Nor is it needful that the article should be sold. If it is placed in some public position where it can be seen, and the nature of the invention understood by inspection, here also the patent will be defeated. *Life Boat Co. v. Chambers*, 1891, 8 R. P. C. 418; *Mullins v. Hart*, 1852, 3 C. & K. 297.

Again, where a patentee uses his invention in his own works without concealment, and publicly sells the proceeds, there is little doubt that this would be considered a prior user, even although it would not be possible from the look of the article to tell how it was made. Thus, in *Wood v. Zimmer*, 1815, 1 W. P. C. 82, the patentee made paint in his own factory, but apparently took no particular means to keep it secret, and sold the proceeds. It was held (*inter alia*) to invalidate his patent, though no one on looking at the paint could tell how it was made. And again, in *The Germ Milling Co. v. Robinson*, 1886, 3 R. P. C. 259, where the patentee had, prior to his patent, made the article in his own mills and sold it, this was held to invalidate his patent.

On the other hand, where the only publicity that a patentee gives to his invention is to sell the results of it, and at the same time instead of using the invention regularly and openly in his factory, conceals his operations in order that his method may not become known, it seems more consonant with reason that he should afterwards be able to take out a valid patent.

It is true there are some *dicta* contrary to this view. Thus, in *Morgan v. Seaward*, 1836, 1 W. P. C. 195, Heath, J., says: "If an inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another, take out a patent for it, he might have practically a monopoly for a much longer period than fourteen years." But in truth a monopoly consists of a right to prevent the competition of others, and this he would not have except for fourteen years. Again, in *Heath v. Smith*, 1854, 2 W. P. C. 278, Erle, J., expresses a doubt upon the point, but it seems very

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difficult to reconcile the cases of *Hills v. London Gas Light Co.*, 1860, 5 H. & N. 336, with this view.

And if the prior sale in England of goloshes made by others in America by a process which is not published, would not invalidate a patent, by the same reasoning the sale of goloshes made in England by the patentee, by a secret process ought not to invalidate it: *Hancock v. Somervell*, 1851, 39 Newton's Lond. Journal 158.

Lastly, let us suppose a case of a prior secret user of the invention in Great Britain by others than the patentee, and of a public sale by them of the proceeds, but that the character of the articles sold is such that the nature of the invention by which they were made could not be ascertained by inspection. Here clearly is no publication of the *invention*. The only questions are (1.) whether the invention can be said to be one which "others at the time of making such letters patent and grant shall not use," or (2.) whether in such circumstances the patentee can be said to be the true and first inventor? As to the second point there does not appear to be much difficulty. If the prior secret use by others without sale of the products would not prevent the patentee from being the true and first inventor, it is hard to see why a sale in circumstances which did not reveal the invention could make him the less the true first inventor. The first point is, however, more difficult. For by the use of the word *others* the statute expressly seems to differentiate prior user by "others," from prior user by the patentee. It is submitted that it is clear that such prior user by others in the circumstances above named would vitiate the patent. To see this we have only to consider the state of the arts and manufactures in

England at the time of the Statute of Monopolies. For in those days, in consequence of the want of books, and difficulty of locomotion, almost every trade was a mystery, and it was quite in accordance with popular notions that it ought to be so, and very many trades were only carried on by a single manufacturer. Hence if it had been held that any third person might have a patent for any mystery that was at that time only practised by one or two people, a large number of the trades then in existence might have been stopped.

Moreover, in the early days of patents and until the reign of Queen Anne, *publication* of the invention was not needed at all as a condition of its grant. See, *e.g.*, *The Smalt Patents*, 1606, 1 W. P. C. 9, and *Bailey v. Roberton*, 3 App. Cas. 1074.

But before this, the mere introduction even of a secret trade or mystery was considered to deserve a patent for a limited time (*Mansell's patent*, 1624, 1 W. P. C. 19), and hence to grant a patent to a man which would give him a monopoly of a mystery already practised by others, and that, too, with no condition that he should publish it, would have been plainly against the spirit of the Act. It was, of course, quite a different matter to give him a monopoly, for a limited time, of an art which he had himself invented or brought from abroad, and which others did not use, even though he might have invented it some time previously. For that would clearly be for the encouragement of trade, and would not injure any one else.

Accordingly, in *Tennant's Case*, 1798, 1 W. P. C. 125, it was held that prior secret user of a process of bleaching by others than the patentee, vitiated the patent. See also *Hill v. Thompson*, 1818, 1 W. P. C. 240; *Cornish v. Keene*, 1835, 1 W. P. C. 511. Again, in *Cheetham v.*

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Oldham, 1890, 7 R. P. C., at p. 124, the patentee had invented a peculiar method of veneering felt hats, with a layer of finer wool. But it was proved that hats had been previously made and sold by persons other than the patentee, and the appearance of which was not necessarily an indication how they were made. This was held to invalidate the patent.

5. **Prior user by sale, or offering for sale.**—It is not necessary in proving prior user to prove that the article had been made for sale, but of course proof of sale in Great Britain even of an article made abroad, where the nature of the invention could be seen by inspecting the article, will avoid a subsequent patent: *Jensen v. Smith*, 1885, 2 R. P. C. 249; *Honiball v. Bloomer*, 1854, 2 W. P. C. 199 (new form of lubricating apparatus). And so will proof of an article having been made publicly in England for exportation: *Carpenter v. Smith*, 1841, 1 W. P. C. 536.

The mere offering of the article for sale, if done publicly, is sufficient to invalidate a subsequent patent: *Hancock v. Somervill*, 1851, 39 Newton's Lond. Journal, 158; *Oxley v. Holden*, 1860, 8 C. B. (N.S.) 666; *Mullins v. Hart*, 1852, 3 C. & K. 297.

6. **The user necessary to invalidate a patent, must be in the United Kingdom.**—*Brown v. Annandale*, 1842, 1 W. P. C. 433, 8 Cl. & F. 437; *Roebuck v. Sterling*, 1774, 1 W. P. C. 45, 451 n., where a distinction was endeavoured to be drawn between England and Scotland. But user in a Crown Colony would not avoid an English patent: *Rolls v. Isaacs*, 1878, 19 Ch. D. 268.

7. Public user at public exhibitions held either in or out of the kingdom, certified as such by the Board of Trade, does not invalidate a patent, nor does its publication during the holding of the exhibition, nor its use elsewhere without the privity of the inventor. But an exhibitor, before exhibiting the article, must give seven days' notice that he intends to apply for a patent, and must do so within six months of the opening of the exhibition: Patents Act, 1883, s. 39; Patents Act, 1886, s. 3; Patent Rules, 1890, 15, Form O, and Schedule of Fees; see also the International Convention of Paris, March 20, 1883, between Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland: Article XI. In addition to this, special enactments are often passed to encourage exhibitors. Thus, the U.S. Congress passed a law that at the Chicago Exhibition no exhibitor of any other country should be held to have infringed a U.S. patent by reason of anything done at the exhibition: see Patent Journal, May 4, 1892, p. 1. As a rule there is a growing feeling among manufacturers against exhibiting at exhibitions other things than merely their finished goods. It is most dangerous for inventors to exhibit incomplete inventions, and of late years medals of bronze, silver, and gold (which in some cases the winners have been requested to pay for), have been showered with such profusion as to render these honours (even if they are worth attaining at all), certainly not worth the risk of causing an invention to be improved upon by a rival patentee.

post, pp. 457, 477.*post*, pp. 485, 527.*post*, p. 558.

8. The effect of a prior invention which has been abandoned, upon subsequent patents for the same invention.—Evidence of prior public user, or prior

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publication, is often met, by shewing that the invention was after a short time abandoned. This fact, however, standing alone would not be sufficient to rebut clear evidence of prior publication or user; it would only be *evidence* that the prior invention was imperfect, or else different from that which was made the subject of a posterior useful and successful patent. "Suppose an invention executed, not merely in the progress of invention, but an invention completed; then it is one of the greatest errors that can be committed in point of law to say, with respect to such an invention as that, it signifies one rush whether it was completely abandoned or whether it continued to be used down to the very date of the patent" (*per* Lord Brougham): *Househill Co. v. Neilson*, 1843, 1 W. P. C. 713, approved; *Morgan v. Windover*, 1888, 5 R. P. C. 306; and in *King, Brown & Co. v. Anglo-American Brush Co.*, 1889, 6 R. P. C. 424. At the same time, however, the fact of the abandonment of an invention, even after it has been publicly used, is strong evidence that it was not completed or perfected, and thus has not really anticipated the subsequent patent: *Househill Co. v. Neilson*, *supra*, at p. 692, and see *Lewis v. Marling*, 1829, 1 W. P. C. 492 n.; *Minter v. Mower*, 1835, 1 W. P. C. 139; *Morgan v. Seaward*, 1836, 1 W. P. C. 186; *Jones v. Pearce*, 1832, 1 C. P. C. 529, 1 W. P. C. 122; *Galloway v. Bleaden*, 1839, 1 W. P. C. 525; *Boswill v. Goodier*, 1866, Griff. App. 48. "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, though there may be a degree of similarity between some of the details of the two machines" (*per* James, L.J.): *Murray v. Clayton*, 1872, L. R. 7 Ch. 581,

20 W. R. 650. See also *Lyon v. Goddard*, 1893, 10 R. P. C. 121.

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The principles upon which the abandonment of an unsuccessful invention is considered as evidence of its difference from a subsequent successful one, resemble closely those in accordance with which commercial success is considered evidence of novelty and utility: see Chap. IV.

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ante, p. 134.

A worthless or abandoned patent may likewise be an anticipation of a subsequent invention if it describes such invention in terms which fully and sufficiently disclose it, and the manner in which it is to be practised (*semble*): *Kaye v. Chubb*, 1888, 5 R. P. C. 648.

9. Prior publication by documents in general, and sufficiency of description in the anticipating document.—Prior publication of an invention in a book, newspaper, or other document will invalidate a patent by reason of the public knowledge thereby afforded, subject, however, to two principles: first, that the prior information must be clear, practical, such as an ordinary intelligent workman accustomed to the trade could understand, and not merely contained in a theoretic form in some scientific treatise, nor requiring further experiment or ingenuity to discover it. And secondly, though the information may be contained in more than one document, it must not, in order to be an anticipation, require experiment or invention, or even extended labour, to piece the information together.

The general principles applicable to the question of prior publication are laid down in *Hill v. Evans*, 1862, 31 L. J. Ch. 463, 8 Jur. (N.S.) 529: "The information given by the prior publication must, for the purposes of

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Compare the *Plimpton Skate patents*, post, p. 395.

practical utility, be equal to that given in the subsequent patent; whatever is essential to the invention must be read out of the prior publication. . . . To carry me to the place at which I wish to arrive is very different from merely putting me on the road that leads to it" (*per Westbury, L.C.*). In *Neilson v. Betts*, 1871, 40 L. J. Ch. 326, Lord Westbury repeated and confirmed what he had said here, which was read with approval in *Bray v. Gardner*, 1887, 4 R. P. C. 405. In this case the patent was for a hook for securing boot-laces, made by milling and boring from a solid wire. It consisted of a head, b^2 , a neck, e , a shoulder, c , and a tube, a , which was inserted into a hole in the leather and swedged out like an eyelet. The same patentee had patented the invention in America, and the Official Gazette contained the drawing of it, with this description: "A stud or hook for lacing



boots and shoes, and other purposes, having a tubular sank or body, a , closed at one end and provided with a shoulder, discs b^1 and b^2 , and an eccentric neck, e , all made from a single solid piece of wire substantially as and for the purpose described." Kekewich, J., held that this drawing and description were insufficient to enable a workman to make the hook, and hence were no anticipation of the plaintiff's patent. This case goes far: see also *Haslam v. Hall*, 1888, 5 R. P. C. 19. The same principles are also laid down by Grove, J., in *Philpot v. Hanbury*, 1885, 2 R. P. C. 43, who expressed an opinion that the degree of accuracy requisite to make an anticipation need not be so great as that required to make a specification good: see also as to this last point *Kaye v. Chubb*, 1887, 4 R. P. C. 23, 289, 5 R. P. C. 641.

Anticipation by a prior publication deprives a patentee of being the "first and true inventor," even if he got the information from his own wits, and quite independently of the publication: *Stead v. Williams*, 1844, 2 W. P. C. 142; though in the same case, and in accordance with the principles laid down above, sect. 1, Tindal, C.J., remarked that a copy of a work brought from a depository where it had "long lain in a state of obscurity" would, as an anticipation, stand on a different footing from an Encyclopædia.

"Publications . . . must be regarded as of two classes, those addressed to the scientific world, and those addressed to working or practical men. . . . There is the scientific literature, and there is the technical literature . . . publications having reference to chemical science and intelligibly expressed will always be enquired after, and studied in the laboratories by scientific chemists . . . but generally it is not the fact that such publications are sought after by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained" (*per* Bagallay, L.J.): *Badische Anilin und Soda Fabrik v. Levinstein*, 1885, 29 Ch. D. 385.

One Dobbs had patented in 1804 the coating of lead with tin by rolling them together when clean. He did not specify the thickness of the plates. Betts in 1859 patented casting lead plates about $\frac{3}{4}$ -inch thick and tin plates from $\frac{1}{4}$ th to $\frac{1}{8}$ th thick. The lead plates were then separately rolled to about $\frac{1}{4}$ -inch thick and the tin to about $\frac{1}{20}$ th of the thickness of the lead. Then both lead and tin were rolled together till they adhered and were quite thin, and fit to be made into capsules for wine bottles. Held, by the House of Lords, that Betts' patent

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was good in the absence of expert evidence to shew that Dobb's patent was really an anticipation of it: *Betts v. Menzies*, 1861, 31 L. J. Q. B. 233.

The patent was then tried again in the Chancery Division: *Betts v. Neilson*, 1865, 34 L. J. Ch. 537. At this trial expert evidence was given that Dobbs' patent would work, and was really the same as Betts'. The Vice-Chancellor rejected the evidence on account of the House of Lords' decision in *Betts v. Menzies*. On appeal (37 L. J. Ch. 321), the Chancellor thought the evidence relevant, but insufficient. The case was then carried to the House of Lords, when the patent was confirmed, on the ground that the evidence was insufficient. It was, however, explained that the decision in *Betts v. Menzies* did not mean that Dobbs' patent clearly could not be an anticipation of Betts', but only that it *required evidence* to shew it to be so: see also *Betts v. De Vitre*, 1864, 11 L. T. (N.S.) 445, 533. The principles laid down in *Betts v. Neilson* were followed by Jessel, M.R., in *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 568. In *Ehrlich v. Ihlee*, 1888, Cotton, L.J., said: "We know what is necessary if there is said to be anticipation, not by the existence of an actual thing, but by description either in a specification or otherwise, that the description must be sufficient to enable anyone competent to make the machine for which protection is claimed by the patentee, and to make it from the description given": 5 R. P. C. 450 referred to with approval in *Winby v. Manchester Steam Tram Co.*, 1889, 6 R. P. C. 363. "The mention in a book does not signify unless it is in such a way that anybody could easily make it and use it" (*per* Lord Brougham): *Woodcroft's Patent*, 1846, 2 W. P. C. 23. "If it requires this mosaic of extracts from annuals and treatises spread over

post, p. 294.

a series of years to prove the defendant's contention, that contention stands self-condemned . . . his diligent study of such works would as much entitle (the patentee) to the character of an inventor, as the diligent study of the works of nature would do" (*per James, L.J.*): *Von Heyden v. Newstadt*, 1880, 50 L. J. (N.S.) Ch. 128; quoted with approval in *Moseley v. Victoria Rubber Co.*, 1887, 4 R. P. C. 252. A patent for a dressmaker's measuring-machine was held to have been anticipated by two prior specifications taken together, or probably even taken separately. "If the previous specification," says Grove, J., "reasonably discloses what the invention is, so that a person skilled in the trade can practise the invention from it, then I am of opinion that there is anticipation": *Philpot v. Hanbury*, 1885, 2 R. P. C. 43; see also *Otto v. Linford*, 1882, 46 L. T. (N.S.) at p. 44; *Betts v. De Vitre*, 1864, 11 L. T. (N.S.) 445, which decided that the fact that all the world had been desiring the invention, but that it had not been made, was strong evidence that the prior description had not been sufficient to amount to an anticipation. It is not needful that the prior publication should have been put in practice, provided that it properly discloses the invention: *Thomson v. Macdonald*, 1891, 8 R. P. C. 8.

CHAP. V.
SECT. 9.

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Prior publication by documents in general, and sufficiency of description in the anticipating document.

10. **Prior publication by a provisional specification.**—The mere filing in the Patent Office of a provisional specification is no publication of the invention, for under the Patents Act, 1885, s. 4, provisional specifications are not published or printed unless the patent is proceeded with. Nor is the filing of the provisional specification a dedication of the invention to the public: *Oxley v. Holden*, 1860, 8 C. B. (N.S.) 666, 30 L. J. C. P. 68; followed *post*, p. 476.

CHAP. V.
SECT. 10.

Prior publi-
cation by a
provisional
specification.

in *Lister v. Norton*, 1884, 3 R. P. C. 199. In *Stoner v. Todd*, 1876, L. R. 4 Ch. D. 58, Jessel, M.R., said: "A provisional specification was never intended to be more than a mode of protecting an invention until the time for filing the final specification. It was not intended to contain a complete description of the thing so as to enable any workman to make it." He was therefore of opinion that in general, even in the days when abandoned provisional specifications were published, mere publication in a provisional specification would not be an anticipation, unless it was so complete and perfect as to enable the article to be actually made. In *Lister v. Norton*, 1884, 3 R. P. C. 199, it was further held that user by a patentee under a provisional specification was not such user as would amount to an anticipation of a subsequent patent to him for the invention.

It appears, therefore, that a patentee might take out a series of provisional protections and successively abandon them, without any prejudice to his invention, while he was completing it, provided he worked it secretly. Of course this would not protect him against the danger of the publication of his invention by another person; but if that occurred, he could then at once complete the last of his provisional specifications and thus save his patent. He would, of course, also be exposed to the danger that some rival inventor, working on the same lines (and who had sent in a provisional specification prior to his own last provisional), might incorporate the invention in a final specification.

11. Prior publication by a complete specification.—This was discussed at some length in *Betts v. Menzies*, 1862, 10 H. L. C. 117.

A final specification stands on the same footing as any other document. In *Betts v. Neilson*, 1868, L. R. 3 Ch. D. 429, 37 L. J. Ch. 321, it is pointed out that a prior specification may well avoid a subsequent patent, although such prior specification is itself bad for want of sufficient description. The point is further explained by Jessel, M.R., in *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 567. In *Otto v. Linford*, 1881, 46 L. T. (N.S.) 35, Brett, L.J., said that the question to be considered was whether the prior specification fairly read by a person conversant with such matters would give a reasonably clear description of the latter invention: see *Dobbs v. Penn*, 1849, 3 Ex. 427; *Kaye v. Chubb*, 1888, 5 R. P. C. 648.

CHAP. V.
SECT. 11.

Prior publication by a complete specification.

12. **Prior publication in a book.**—The question, what is sufficient publication in a book, must rest upon the same ground. Thus, in *Arkwright's Case*, 1785, 1 W. P. C. 72, the patent was held anticipated by a description in a book by Emmerson: see also *Plimpton v. Spiller*, 1877, 6 Ch. D. 412. In *Harris v. Rothwell*, 1885, 35 Ch. D. 416, a German patent, a copy of which had been in the Patent Office Library, and notice of it given in the Patents Journal, was held an anticipation: *Hill v. Thompson*, 1817, 8 Taunt. 375, 1 W. P. C. 232 (Aikin's Dictionary). But in accordance with the principles above set forth, a book merely generally describing an invention, and not specifying how to carry it out, would, of course, be insufficient: *Woodcroft's Patent*, 1846, 2 W. P. C. 23 (Tredgold's book). A valuable note upon the whole subject is to be found in 1 W. P. C. 718.

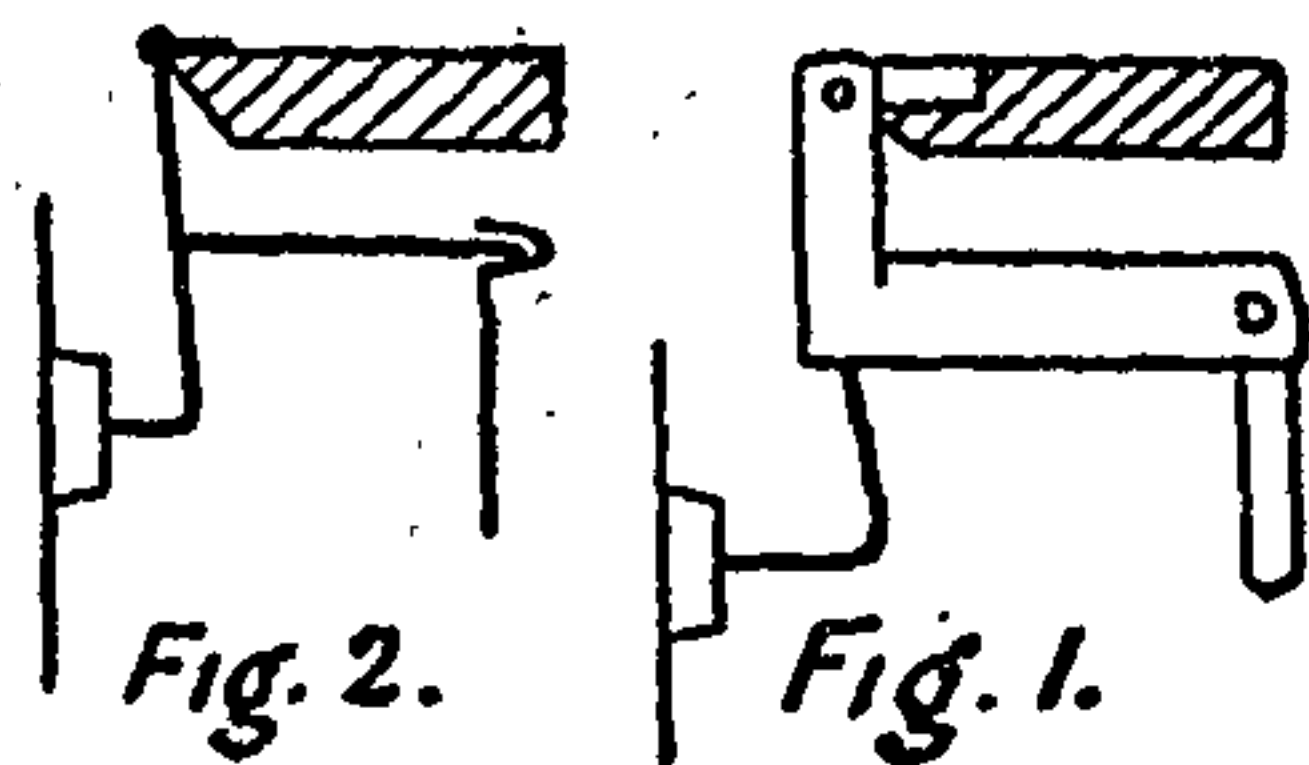
13. A book in a foreign language may also be an anticipation: *Harris v. Rothwell*, 1887, 35 Ch. D. 425

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SECT. 13.

A book in a
foreign
language.

(German); *United Telephone Co. v. Harrison*, 1882, 21 Ch. D. 720, 51 L. J. Ch. 705 (German); *Heurteloup's Patent*, 1836, 1 W. P. C. 553 (French); *Otto v. Steel*, 1885, 31 Ch. D. 241 (French); *Lang v. Gisborne*, 1862, 31 Beav. 135, 31 L. J. Ch. 770 (French). It may, however, be doubted whether languages rarely understood, such as Russian or the Oriental languages, would be sufficient. The point was mentioned, but not decided, in *Harris v. Rothwell*, 1887, 35 Ch. D. 426.

14. Drawings.—Publication by drawings without any description may avoid a patent: *Herrburger v. Squire*,



1889, 5 R. P. C. 581, 6 R. P. C. 194. In this case a pianoforte string-damper (Fig. 1.) made of wood, was held to have been anticipated by the drawing (Fig. 2.) of a similar

damper in metal without a description. *Tetley v. Easton*, 1852, 2 C. B. (N.S.) 706, 26 L. J. C. P. 269. See also the *Plimpton Skate* cases, *post*, p. 294.

15. Models.—Prior publication may be by the exhibition of models: *Humpherson v. Syer*, 1887, 4 R. P. C. 415; *Winby v. Manchester Steam Tram Co.*, 1889, 6 R. P. C. 359, 7 R. P. C. 30; *Galloway v. Bleaden*, 1839, 1 W. P. C. 526. The exhibition of a specimen lifeboat in dockyards, with no precautions as to secrecy, was held fatal: *Lifeboat Co. v. Chambers*, 1891, 8 R. P. C. 418.

16. The prior publication must have been accessible to the public.—This will be a question of fact

in each case. It is not necessary that the book should have been actually sold, but it must have been exhibited or deposited in a public place. "The existence of a single copy of a work brought from a place of obscurity would afford a very different inference from the production of an encyclopædia": *Stead v. Williams*, 1844, 2 W. P. C. 143. Mere mention of a book in a catalogue circulated in England would be insufficient: *Otto v. Steel*, 1885, 31 Ch. D. 241. But if once the book is deposited on the shelves of a library open to the public, it will be enough, even though it is the only copy so accessible: *United Telephone Co. v. Harrison*, 1882, 21 Ch. D. 731. Or even though only one person has seen it: *Harris v. Rothwell*, 1887, 35 Ch. D. 427, 3 R. P. C. 383, 4 R. P. C. 225. This latter case is important, because from the judgment of Cotton, L.J., and Lindley, L.J., it seems as though, even after proof had been given of the deposit of the book in a public place, if the patentee could shew that no one had as a fact seen it who could understand it, his patent might be upheld. But Lopes, L.J., took a different view, holding that, once the book had been accessible to the public, it did not the least matter whether it had been seen as a fact or not (p. 432). On the other hand, if the book were in a private room in a public library, and not accessible to the public, nor catalogued, and (*semble*) that if only one copy of it had been merely put in a shop window one day, and destroyed the next, this would be insufficient: *Plimpton v. Malcolmson*, 1876, 3 Ch. D. 557, where the whole subject is treated at length by Jessel, M.R.; approved, *Plimpton v. Spiller*, 1876, 6 Ch. D. 412. In *Pickard v. Prescott*, 1892, 9 R. P. C. 195, a book kept by the Edinburgh branch of a firm of publishers contained an entry shewing the

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The prior
publication
must have
been accessible
to the public.

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The prior
publication
must have
been accessible
to the public.

sending to a customer of a French periodical, fourteen days before the application for the patent. The customer was called, and said he had read it but did not remember when. Held, that this was evidence of prior publication. The conclusion to be drawn from these cases seems to be that proof of the deposition of an anticipating document in some place accessible to the public, and in a language which is fairly well known, is strong and *prima facie* evidence of publication, but that it is not necessarily conclusive, and that each case must be considered on its own merits.

17. Anticipation in a part of an invention will invalidate the whole patent: *Templeton v. Macfarlane*, 1848, 1 H. L. C. 595; *Pether v. Shaw*, 1893, 10 R. P. C. 297.

CHAPTER VI.

THE SPECIFICATIONS AND THE TITLE OF A PATENT.

THE enormous number of patents now taken out in England and America, renders it a matter of great difficulty for an inventor to know whether what he has discovered is really new. In consequence, few patents can be drawn so as to ensure novelty in all parts of them, and almost every specification contains claims of a more or less speculative character.

CHAP. VI.
SECT. 1.
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The impossibility of knowing what has been previously done, is producing a growing tendency to rely on special details which are less likely to have been anticipated. The principles which ought to govern the choice of a title, and the drafting of the specifications, will be treated in detail, but they may be summarized in the following leading rules.

1. The specifications must be clear and intelligible to an ordinary workman who understands the trade to which the invention relates.
2. They must define the invention, distinguishing the new from the old, and the useless from the useful.
3. They must give the best information at the disposal of the applicant, at the date on which they are sent in.
4. They must contain no misleading statements.
5. The title, provisional and complete specifications, must conform to one another.

CHAP. VI.
SECT. 1.

General principles regulating the choice of a title.

1. General principles regulating the choice of a title.

—The general principles which regulate the form of the title of a patent are :—

- (1) That it must correctly describe the invention.
- (2) It must be framed in the utmost good faith.
- (3) It must not be ambiguous.
- (4) It must neither be too wide nor too narrow.
- (5) In construing a title the specification may be looked to to explain it.

A change has come over the spirit in which titles used to be interpreted. For (prior to 1852) when no provisional specifications were filed, the title of the invention was the only check on the patentee who had filed a title from putting anything he liked into a specification. An example of this is *Crossley v. Potter*, 1853, M. P. C. 240. An inventor had invented a machine for weaving coach lace. He filed a title "for improvements in weaving figured fabrics." The specification as prepared by him and handed over to the assignees was only for weaving coach lace. He sold the patent; the assignees did not use his specification, but filed a new final specification, describing the machinery as suitable for making (*inter alia*) carpets. The inventor, on cross-examination, admitted that carpets were not in his mind when he filed his title, and the patent was upset. "In my mind the safest course for patentees to adopt, in framing their specifications, is, instead of claiming everything, to confine themselves specifically to one good thing, and a jury will always take care, that if it be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of his genius" (*per Pollock, C.B.*).

As soon as the use of provisional specifications was intro-

duced, the use of the title became more what it is at present—to indicate to a searcher the general scope of the invention. By the Patents Act, 1883, the duty of seeing that the title is suitable is now cast on the Comptroller, and is no longer a ground of opposition (s. 7, 11, Patents Act, 1883, s. 2). But a faulty title may still invalidate a patent. The following list of cases decided upon titles to inventions is useful, always, however, remembering that the title is now less strictly looked at than formerly, so that many of the older cases would now probably not be followed.

Hornblower v. Boulton, 1799, D. P. C. 220, 8 T. R. 95.—“The specification may be looked at to explain the title.”

Bainbridge v. Wigley, 1810, Parl. Rep. 1829, 197, 1 C. P. C. 270.—Title for improvements in a flute, “whereby notes were produced which never before were produced.” Only one new note was produced. Patent held bad.

Cochrane v. Smethurst, 1816, D. P. C. 354.—Title was for an improved method of lighting cities: the specification only shewed a new sort of lamp. Held bad (doubted in *Cook v. Pearce*, 1843, 8 Q. B. 1043).

R. v. Metcalf, 1817, 1 W. P. C. 141 n., 2 Stark. 249.—Title for a tapering brush. The specification only shewed that the bristles were of unequal length. Held bad.

R. v. Wheeler, 1819, 2 B. & Ald. 345.—Title, “A new or improved method of drying and preparing malt.” The specification shewed only a process for colouring the malt, by further heating after it had been dried. Held bad.

Campion v. Benyon, 1821, 6 B. Moo. 71.—The title as well as the specification was for a “new mode of making double canvas and sailcloth, without any starch what-

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See *Newton v. Vaucher*, post, p. 166.

Compare with *Derosne v. Fairie*, p. 164; and *Hastings v. Brown*, p. 186.

post, p. 165.

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General
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post, p. 90.

ever." Held to mean that the invention was for dispensing with starch, that canvas had previously been made without starch, and that the title was bad for suggesting as new that which was really old.

Bloxam v. Elsee, 1827, 6 B. & C. 169.—Title, "A machine for making paper of various widths, from 1 to 12 feet wide." Held to represent that *one* machine would make all different widths, whereas each machine only made paper of one width. Held bad.

Sturtz v. De la Rue, 1828, 1 W. P. C. 83.—Title, "Improvements in copper and other plate printing." *Seem*, that that was enough to cover an invention for preparing paper for copper-plate printing, by means of size and whitelead. (Patent held bad on other grounds.)

Crossley v. Beverley, 1829, 9 B. & C. 63, 1 W. P. C. 112.—Title, "For extracting inflammable gas by heat from pit coal, tar, or other substance from which gas or gases capable of being employed for illumination, can be extracted by heat." At the trial it was shewn (1) that inflammable gas could be got from oil, but at great expense, (2) that patentee's process would not do for oil. Held, that the words "or other substances," must be read "ejusdem generis." That no workman would have considered oil as ejusdem generis with coal or tar. Patent supported.

See *Wright v. Hitchcock*,
post, p. 166.

Felton v. Greaves, 1829, 3 C. & P. 611.—Title, "A machine for sharpening knives, razors, scissors, and other cutting instruments." The machine would do for knives but not for scissors. Patent held bad.

Derosne v. Fairie, 1835, 1 W. P. C. 154.—The word "improvements" was held sufficient in the title, though only one improvement was shewn, as the patent was for a process consisting of various steps.

Fisher v. Dewick, 1838, see *Cook v. Pearce*, 8 Q. B. 1056.—“Improvements in machinery for making bobbinet lace.” The effect of the machinery was to make spots on the lace. Held sufficient.

Neilson v. Harford, 1841, 8 M. & W. 806, 1 W. P. C. 295.—Title for “the improved application of air to produce heat in fires, forges, and furnaces.” “Though that is ambiguous, it is sufficiently explained by the specification, and not at variance with it, as was the case in *Rea v. Wheeler*” (*per Parke, B.*). The same question again arose in *The Househill Co. v. Neilson*, 1843, 1 W. P. C. 678; *Nickels v. Haslam*, 1844, 13 L. J. C. P. 146, 7 M. & G. 378 (same point as in *Derosne v. Fairie, supra*).

Cook v. Pearce, 1843, 8 Q. B. 1044.—Title, “Improvements in carriages.” The invention was for a peculiar mode of fixing folding shutters to carriages. Held bad on the authority of *Cochrane v. Smethurst (supra)*; reversed on appeal. *Cochrane v. Smethurst* doubted.

Stead v. Williams, 1844, 2 W. P. C. 136.—“A mode of making and paving public streets and highways with timber or wooden blocks.” Held, not too vague.

Beard v. Egerton, 1846, 3 C. B. 97, 15 L. J. C. P. 270.—Title, “A new or improved method of obtaining photographic images.” Held, not ambiguous.

Croll v. Edge, 1850, 19 L. J. C. P. 261, 9 C. B. 479.—Title, “Improvements in the manufacture of gas . . . and in the apparatus used when transmitting and measuring gas.” The specification recited the patent, as for “improvements in the manufacture of gas, and in the apparatus used therein, when transmitting and measuring gas.” Held bad, as extending the original title, which did not claim any apparatus for manufacturing gas.

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General principles regulating the choice of a title.

Hornblower v. Boulton, ante, p. 163; and *Lister v. Norton*, post, p. 167.

N.B.—In 1852, *Provisional Specifications* were introduced, after which titles were less strictly construed, post, p. 168.

Electric Telegraph Co. v. Brett, 1851, 10 C. B. 838, 20 L. J. C. P. 123.—Title, “Improvements in giving signals . . . in distant places, by means of electric currents transmitted through *metallic* circuits.” Held, to cover cases where part of the circuit was an earth return.

Newton v. Vaucher, 1851, 21 L. J. Ex. 305, 6 Ex. 866. “Specifications must be read together with their titles.”

Patent Bottle Envelope Co. v. Seymer, 1858, 28 L. J. C. P. 22, 5 C. B. (N.S.) 164.—Title, “Improvements in the manufacture of cases and envelopes for bottles.” The specification claimed “a certain combination of machinery for this purpose, and the making of the envelopes as described.” Held, not to be a claim for the form of envelope, but the mode of making it.

Oxley v. Holden, 1860, 8 C. B. (N.S.) 707, 30 L. J. C. P. 74.—“Improvements in doors and sashes of *carriages*.” The specification described the invention as applied “to carriages, or in any other position where windows and doors are subject to vibration.” It was urged this carried the invention outside the title, but it was held the title and specification might be read together, and being so read, the invention was sufficiently limited.

Hills v. London Gas Co., 1860, 5 H. & N. 370, 29 L. J. Ex. 409.—“A new mode of *purifying* gas.” Held, sufficiently described as “Improved mode of manufacturing gas.”

Newall v. Elliot, 1864, 13 W. R. 15, Pollock, C.B., stated that, when Attorney-General, he refused an application for a patent for “An improvement in locomotion,” as too general.

Wright v. Hitchcock, 1870, L. R. 5 Ex. 37, 39 L. J. Ex. 97.—Title, “Improvements in the manufacture of frills or ruffles.” The specification described it as for “frills,

ruffles, and *trimmings*." The last word held to be *ejusdem generis*, and the title wide enough.

Lister v. Norton, 1884, 3 R. P. C. 203.—Title, "Improvements in the manufacture of velvets and of pile fabrics in imitation of sealskin." There the word velvet was read as if it, as well as the pile fabrics, was intended to be in imitation of sealskin. This reading supported the patent. "The repetition of the preposition 'of' before pile fabrics gives rise to the defendant's argument that velvets are here spoken of without reference to the imitation of skins. If the title is read alone, that might be the strict grammatical meaning, but I think that reading the specification as a whole . . . velvets are spoken of, not separately, but in reference to imitation skins" (*per Chitty, J.*).

Brown's Patent, 1887, Griff. App. 1.—The title, "Improvements in casks and tubs," was objected to by the Comptroller-General, as not covering the specification which described improvements in casks, tubs, and analogous vessels. The Attorney-General thought the title sufficient, without expressing any opinion as to whether it limited the claim to casks and tubs only.

The examiners frequently suggest to patentees improvements in the wording of the title. In this case if the patentee accepts the suggestion, the alteration is made without expense to him, the copies sent in being merely initialled and re-signed. Great caution should be exercised in accepting alterations proposed by examiners, for they have no conclusive legal validity, and may perhaps in reality injure the patent, although suggested with the best intention.

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SECT. I.

General principles regulating the choice of a title.

See *Crossley v. Beverley*, ante, p. 164.

CHAPTER VII.

THE PROVISIONAL SPECIFICATION.

CHAP. VII.
SECT. 1.
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1. General remarks.—Under the old procedure, before 1852 a patentee received a patent merely on the suggestion that he was the inventor of a new manufacture, and after the time of Queen Anne the grant was made conditional on his filing, within a specified period, a specification explaining for the benefit of the public how his invention was to be performed.

In 1852 it was required, in addition, that he should file a provisional specification explaining more fully the scope of his invention than the mere title could do. The patent was then sealed, but with the condition that it should be of no effect unless a final specification were filed. Thus, the use of the provisional specification was to explain the title more precisely. The provisional and final specifications were always published if filed, whether the application was proceeded with or not.

post, p. 476.

By the Patents Act, 1885, s. 4, this is modified. The provisional specification is never published unless the applicant goes on with the complete specification (sect. 4), and the patent is not sealed until after the complete specification has been sent in and accepted; Patents Act, 1883, s. 12.

post, p. 446.

There is no doubt, therefore, that the true function of

a provisional specification is to describe the invention, and that the true function of the complete specification is not only to describe it, but also to say in what manner it is to be performed. In truth, this distinction is the source of some confusion. For if the object of the provisional is to *describe* and *define* the invention, then, according to strict logic, the claims ought to be affixed to the provisional, leaving the complete to point out, not *what* the invention is, but only the manner of performing it. As it is, the present law requiring the claims, which *define* the invention, to be in the complete specification, whereas the description is to be in the provisional, really is often a source of error, constantly tempting inventors to go beyond the provisional specification, to the great danger of their patents; for any claim which extends the invention beyond that described in the provisional specification, is bad. And, on the other hand, if the provisional specification is required, not merely to foreshadow the invention and describe its general nature, but to limit and define it, then the only course for an inventor, in order to be safe, will be to make his complete specification a mere repetition of his provisional with, perhaps, a few details to make the manner of performing it more clear. In this case, the advantage of nine further months to develop his invention will almost disappear. In most patent cases disconformity is now pleaded, and the end of it will probably be to compel an alteration of the law.

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General
remarks.

2. The object therefore of a provisional specification is to describe the nature of the invention (Patents Act, 1888, s. 5, s-s. 3), but not to describe how the invention is to be performed, nor to give instructions

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SECT. 2.

The object therefore of a provisional specification is to describe the nature of the invention (Patents Act, 1888, s. 5, s-s. 3), but not to describe how the invention is to be performed.

for the performing it, but to describe it, so that it can be known what it is that the patentee has discovered. "The function of a provisional specification is very different from that of a complete specification. . . A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention so as to protect the inventor until the time of filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within the ambit of his invention as disclosed in his provisional specification" (*per* Cotton, L.J.): *Woodward v. Sansum*, 1887, 4 R. P. C. at pp. 176-178. He cited this opinion with approval in *Siddell v. Vickers*, 1888, 5 R. P. C. at p. 426. "The office of the provisional specification, as appears by sect. 6 of 15 & 16 Vict. c. 83, and sect. 7 of the Patents Act, 1883, is to describe the nature of the invention—nothing more is desired of it" (*per* Chitty, J.): *Moseley v. Victoria Rubber Co.*, 1887, 4 R. P. C. p. 248, citing with approval the judgment of Blackburn, J., in *Bailey v. Robertson*, 1878, L. R. 3 App. Cas. 1055, 27 W. R. 17, and also that of Jessel, M.R., in *Stoner v. Todd*, 1876, L. R. 4 Ch. D. 58, 46 L. J. Ch. 32. Exactly similar opinions were laid down by the Court in *Newall v. Elliot*, 1858, 4 C. B. (N.S.) 269, 1 H. & C. 797, 32 L. J. Ex. 120; *Penn v. Bibby*, 1866, L. R. 2 Ch. 127, 132. See a paper on Provisional Protection by J. Imray, in the Proceedings of the Institute of Patent Agents, vol. x. p. 184.

ante, p. 156.

3. The complete specification must therefore not go outside the limits of the title and the provisional

specification.—This fault is called “disconformity.” What is considered an undue excess will be a matter of opinion in each case (see also cases collected under the head of “Title,” Chap. VI.). For if an inventor discovers a new and useful detail of his invention, he has not merely a right, but it is his duty, to disclose it, in his complete specification: *Moseley v. Victoria Rubber Co.*, 1887, 4 R. P. C. 241. It is therefore inevitable that to some extent the complete specification should be an advance on the provisional specification. Provided, then, the invention remains the same, improvements in detail will not invalidate the patent: *Crampton v. Patent Investments Co.*, 1888, 5 R. P. C. 397; *Lucas v. Miller*, 1885, 2 R. P. C. 159; *Penn v. Bibby*, 1866, L. R. 1 Eq. 548, 2 Ch. 127; *Horrocks v. Stubbs*, 1886, 3 R. P. C. 236; *Watling v. Stevens*, 1886, 3 R. P. C. 151. And in *Woodward v. Sansum*, 1887, 4 R. P. C. 166, the question of disconformity was discussed, and it was held that improvements in the disposition of parts within the scope of the provisional specification could not produce disconformity.

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SECT. 3.
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“Discon-
formity.”

On the other hand, an unnecessary part mentioned in the provisional specification may in the complete specification be omitted: *Thomas v. Welch*, 1866, L. R. 1 C. P. 192.

The principle upon which the cases went before 1883 was, that on filing his provisional specification, representing what he had invented, the patentee got his patent sealed. If, then, he exceeded it in his complete, he had deceived the Crown, and his patent was void. Thus, in *United Telephone Co. v. Harrison*, 1882, 21 Ch. D. 746, the provisional specification described an instrument whereby the friction of a point on a moving surface was

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electrically caused to vary its pressure in accordance with changes in the vibrations of the human voice. Varying sounds were thus produced, as when a slate-pencil is made to squeak upon a slate. The final specification also included the phonograph. Held, a fatal disconformity.

For some time after the Act of 1883 was passed it was thought by some that objections on the ground of non-conformity were obsolete. For the complete was sent in before the patent was granted, and being, moreover, the subject of examination in the Comptroller's Office, it might be supposed that if, after such examination, the sealing of the patent was ordered, the Crown ought to be considered satisfied.

In *Siddell v. Vickers*, 1888, 5 R. P. C. 426, Cotton, L.J., says: “I do not at all enter into the question of non-conformity, as it is called, of the complete and provisional specification. That is a matter upon which . . . I think it better not to express my opinion. I only mention this, that if the question ever necessarily arises I may be free to deal with the question how far the fact that the complete specification goes beyond the nature of the invention described in the provisional will have the effect under the present law of vitiating the patent. Of course we must have to consider the great alteration in the law made by the Act of 1883.” This case was carried to the House of Lords, where the necessity for conformity was affirmed: 7 R. P. C. 303. After this the following cases were decided: *Morgan v. Windover*, 1888, 4 R. P. C. 423, 5 R. P. C. 295, in which the question of disconformity was raised but not decided. In *re Goulard v. Gibbs*, 1888, 5 R. P. C. 533, the point was again raised, but the decision went on other grounds.

In the Court of Appeal, however (6 R. P. C. 215), the necessity for conformity was affirmed: *Hutchinson v. Pattullo*, 1888, 4 R. P. C. 329, 5 R. P. C. 351. In *King, Brown & Co. v. Anglo-American Brush Corporation*, 1889, 6 R. P. C. 421, the provisional had described a cylindrical commutator for a dynamo, the complete introduced metal insulated segments to fill up the gaps and make the wear uniform. This was considered too great a departure. The patent was also found to have been anticipated, so that the decision did not go alone upon disconformity. Finally the question came directly before the Court of Appeal in *Nuttal v. Hargreaves*, 1891, 8 R. P. C. 450, when it was formally decided that disconformity was still an objection, and accordingly in 1892, in the case of *Lane Fox v. The Kensington Co.*, the patent was held bad on this ground: 9 R. P. C. 221. This case was confirmed on appeal: 9 R. P. C. 413. It may be interesting to give a short account of it. With small and fluctuating sources of electricity, there is always some difficulty in arranging incandescent lamps so as to burn well in parallel. For electricity always takes the easiest path. Hence, if one lamp has a greater resistance than another, the greater part of the electricity goes through the lamp of least resistance, and the other is improperly lit. When gas lamps are close together something of a similar effect may be observed. The obvious manner of rectifying these defects, is to improve the lamp construction, and to afford a large reservoir of electricity at a very steady pressure. Before, however, the remedy was seen, the problem was stated as "the dividing the electric light," and in early days the newspapers were full of sensational announcements that some one had "divided the electric light." One of the first people who ever saw

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the true nature of the problem and its solution, was St. George Lane Fox.

In his patent of 1878, he pointed out the necessity of forming “reservoirs” of electricity which he accomplished by placing groups of “storage cells” or accumulators at various points of his system. He also invented a form of electrometer, by which when the pressure varied, the steam of the engines was increased or diminished, and the proper pressure was restored. As a matter of fact, his reservoirs also had the effect of regulating the pressure, by the very fact of storing it, just as a large mill pool will steady the action of a mill. But in his provisional specification he did not indicate that he knew of this result, or proposed the accumulation as a means of attaining it. His final specification pointed out that the regulation was to be obtained both by the storage system of accumulators and by his regulating machine, which latter he subsequently disclaimed, leaving his complete specification claiming only the use of accumulators for “regulating” the pressure.

At the trial, the Judge distinguished between the use of secondary batteries “to keep the electromotive force constant in the mains for the benefit of the dynamo,” and their use “to regulate the electromotive force in the mains for the benefit of the lamps,” *i.e.*, their “storing” effect, as distinguished from their “regulating” effect, and held that, as in his provisional specification he had only described their “storing” effect, he could not, in his complete, turn the invention into one for using them for “regulating.” Of the accuracy of the principles of law laid down, there cannot be the slightest doubt: but it may admit of question, whether the words in the provisional, “the electro-motive force of the electric mains

should be kept nearly as constant as possible, say at 100 volts, or B A units of electro-motive force. A number of Plante's lead and sulphuric cells joined together in series between the main and the earth will serve as a reservoir of electricity," were not such as would fairly indicate to a reader skilled in the subject, that the cells were to be used in regulating the pressure as well as for storing the electricity.

In addition, however, to the disconformity, the patent was held bad for want of utility, because it was shewn that in order to charge accumulators, a higher pressure is required than the pressure of discharge, and hence, while the accumulators were being charged, the lamps would be over-driven, unless switches were contrived to shunt off some of the cells, which were not mentioned or described. On the evidence given this certainly appeared so, but, as a fact, accumulators can be used as regulators in this manner, without any switches at all. It was further held that the complete specification did not sufficiently shew how the invention was to be performed. On this point, opinions also might differ, but certainly the description was so vague, as to amount to little more than the emancipation of a "principle," rather than an application of a principle to practice.

This was the chief ground upon which the Court of Appeal supported the decision of the Court below, *ante*, p. 49. 9 R. P. C. 416.

In contrast with the above case, *Moseley v. The Victoria Rubber Co.*, 1887, 4 R. P. C. 242, may be cited. The patent here was for a process of colour-printing on india-rubber goods coated with farina by means of colours mixed with media, which dissolved the india-rubber. The provisional specification mentioned that the printing

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could be done, but the proper media for mixing the colours were only mentioned in the complete specification. Another objection was, that in the provisional specification the plaintiff had only mentioned the cold roller process of vulcanization, *i.e.*, wetting the fabric with the vulcanizing solution; whereas, in his complete, he described the cold vapour process, and again that whereas the provisional only contemplated printing after the farina had been applied, the complete specification also spoke of applying the farina after the printing. All these criticisms were regarded as not shewing disconformity, but only as legitimate developments of the invention. Disconformity was also held fatal in *Gadd v. Mayor of Manchester*, 1892, 9 R. P. C. 259.

These decisions shew the danger of disconformity, and where a patentee is sure that his invention has not leaked out, it may often be wise simply to abandon his provisional, and take out a new patent, filing the complete specification at once, and thus avoiding nonconformity, and obtaining a longer life for his patent (see Chap. XV.,
sect. 1).

post, p. 237.

4. A provisional specification may perhaps be looked at to assist in explaining the final, but not to cure a defect in it: *Mackelcan v. Rennie*, 1862, 13 C. B. (N.S.) 52.—The provisional specification was for a vessel with *iron* framing. The complete left out the word *iron*. Timber framing for docks was old. Held, that the provisional specification could not be used to limit the final, and the patent was bad. (This case may be advantageously compared with *Lister v. Norton*, and others collected in the chapter dealing with “Title of a Patent.”)

5. If needful for its comprehension, the provisional specification must also have drawings attached to it: Patents Act, 1883, s. 5, s-s. 3.

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post, p. 442.

6. Abandonment of provisional specification.— This does not involve publication (Patents Act, 1885 s. 4), so that it may be done and a new patent taken out. As is pointed out, Chap. V., sect. 2, user by the patentee under provisional protection does not constitute anticipation, so that if a patentee is doubtful whether his provisional will cover his final he may abandon it, and proceed to take out another patent, filing the complete specification at once if he pleases, and thus running no risk of disconformity: Patents Act, 1885, s. 4; see *Oxley v. Holden*, 1860, 30 L. J. C. P. 68, 8 C. B. (N.S.) 666; *Lister v. Norton*, 1886, 3 R. P. C. 199. But the danger of filing a complete specification in the first instance is pointed out hereafter.

ante, p. 168.

post, p. 476.

ante, p. 140.

post, p. 237.

post, p. 238.

7. The effect of provisional protection is to prevent public user between the date of the application and the sealing of the patent from invalidating it: Patents Act, 1883, s. 14.

post, p. 447.

CHAPTER VIII.

THE COMPLETE SPECIFICATION.

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SECT. 1.
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1. General Remarks.—The object of a complete specification is to put the public in possession of the invention. It is sometimes spoken of as the “consideration” or “price paid” for the grant: *e.g.*, *Brunton v. Hawkes*, 1821, 4 B. & Ald. 551; *Walton v. Potter*, 1841, 1 W. P. C. 595; *Cartwright v. Eamer*, 1800, cited 14 Ves. 136; *Gibson v. Brand*, 1841, 1 W. P. C. 629. This mode of expression is not strictly accurate; the accuracy of the complete specification is rather the “condition” of the grant, for, strictly speaking, there is no absolute bargain between the Crown and the patentee: *Feather v. The Queen*, 1865, 6 B. & S. 285. Formerly, the grant was made subject to the filing of a complete specification. Now, the patent is not sealed till after the complete has been accepted: Patents Act, 1883, s. 12.

post, p. 330.

2. The specification should point out whether the invention be a thing, or process, or a combination.—A patent may be for an article, or for a process of making it, and either the thing invented may be new, or else it may consist of a new addition to old parts, in which case it is called “an improvement,” or else it may be a com-

combination of old parts, in which case the essence of the invention is, not the parts, but the mode of combining them.

3. Claim for a new machine.—If a man “simply claims a machine” without stating that he claims any particular part, or that he claims the combination of the whole as new, then it was formerly held that his patent was to be taken to be a patent for the whole, and for each particular part, and his patent was void if any particular part turned out not to be new, or the combination itself was not new: *Carpenter v. Smith*, 1841, 1 W. P. C. 532. This rule is however now relaxed, so that a claim for a machine “as described” would not be held to mean a claim for each individual part of it if the reasonable intendment was that the patent was for the combination of parts forming the machine. Thus in *Peckover v. Rowland*, 1893, 10 R. P. C. 234, the patentee claimed “the apparatus as fully set forth and described.” The defendant’s counsel tried to treat this as a claim for each of the parts, and cited *Carpenter v. Smith* and several of the older cases; but Lord Esher decided, p. 237, that it was clearly a claim not for each of the parts, but for the combination of them: see also *Watling v. Stevens* 1886, 3 R. P. C. 41, 153.

4. Claim for an improvement on an existing machine.—In this case it is necessary to pick out and specify the improvement; it will not be sufficient merely to describe the improved machine as a whole and claim it: *Parkes v. Stevens*, 1869, L. R. 8 Eq. 365; *Hill v. Thompson*, 1818, 1 W. P. C. 247. The improvement may be specified by reference to a former specification: *Harmar v. Playne*, 1809, 11 East. 101, D. P. C. 311. In *Holmes*

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The specification should point out whether the invention be a thing, a process, or a combination.

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v. *London & N. W. Railway Co.*, 1852, M. P. C. 27, the patentee had claimed "the improved turning-table hereinbefore described," and as he had not claimed this as a combination, it was held that he must be taken to have claimed the parts as well as the whole. Only one of these parts was new. Hence his patent really was for an improved machine, and he ought so to have claimed it, and specified the improvement. His patent was held bad, as not having sufficiently distinguished the new from the old, nor shewn in what his alleged improvement consisted: see also *Potter v. Parr*, 1860, 2 B. & S. 216 n., *Cartsburn Sugar Refining Co. v. Sharp*, 1884, 1 R. P. C. 181.

ante, p. 53.
post, p. 305.

5. **Claim for a combination.**—It is obvious how difficult it frequently is to distinguish a claim for an improvement on a machine from a claim for a combination. It is, however, important to do this, because the mode of treating them at law is different. For the gist of a patent for an improved machine is the addition of something new to that which was old, or the substitution of a new part for an old one. But the gist of a combination is the uniting together of old things in a new way. In a patent for an improvement the new part must be clearly distinguished, as explained above, but in a patent for a combination, where once it is made clear that it is not any specific part, but the *combination* which is claimed, it is not necessary to explain what integral parts of the combination may have been previously used separately, or what other combination of them may have been previously made. Many inventions may be looked upon either as "improvements" or as "combinations," according to the point of view from which they

are regarded. And it is obviously often to the patentee's interest to construe his patent as a combination if he can; even though in reality it is rather of the nature of an improvement.

The law with regard to the manner in which a claim for a combination is to be construed has been developed by a series of decisions. In *Foxwell v. Bostock*, 1864, 10 L. T. (N.S.) 144, 4 De G. J. & S. 298, Lord Westbury treated a claim for a combination as though it were in fact a claim for an improvement, and therefore laid it down that "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:" see also *Newall v. Elliot*, 1863, 1 H. & C. 797, 10 Jur. (N.S.) 954; *Lister v. Leather*, 1858, 8 E. & B. 1004. Although this is perhaps strictly an outcome of the doctrine that the *invention*, and not merely the machine, must be described, yet in the case of a combination, if more were required than to specify the combination and claim it, it is obvious that it would be needful to go into all the various other sorts of combinations of the same things that had been made, and distinguish them. This would be most embarrassing, and the theory that it is necessary became so impossible in practice, that the doctrine soon afterwards was modified (*per Cairns, L.C.*): *Harrison v. Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 577. In that case Lord Hatherley said that Lord Westbury's decision in *Foxwell v. Bostock* only meant that, if you specifically claim an improvement on some specific machine which you name, you must specify your improvement. "To use an illustration which was adopted by Lord Justice James (in

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Parkes v. Stevens, 1869, L. R. 8 Eq. 365), it will not do if you have invented the gridiron pendulum to say, 'I have invented a better *clock* than anybody else,' not telling the public what you have done to make it better." Again, in *Clark v. Adie*, 1877, Lord Hatherley said, "I apprehend, my lords (and I do not read the decision in *Foxwell v. Bostock* as deciding more than I am stating), you must inform the public . . . whether you have subdivided, if I may use the term, your machine into those separate parts, and claim for each part the merit of novelty, or whether you are simply making a combination of things *per se* old, but which have never been used before in combination."

Lord Justice James, in the same case, corrected the supposed doctrine (in *Lister v. Leather*), that a combination patent could be read as claiming the parts as well as the combination. In *Moore v. Bennett*, 1884, 1 R. P. C. 138, a revival of *Foxwell v. Bostock* was attempted by Cotton, L.J., who thought that, where an *improved* combination was made, it would be necessary to specify the improvement. This theory certainly seemed to have strict logic on its side, but it was not approved in the House of Lords, where (p. 149) Lord Blackburn explained Lord Westbury's decision in *Foxwell v. Bostock*, and said: "If that principle were applied to specifications, it would, I think, make it impossible to draw a good specification for a combination of old materials without such a degree of prolixity as would render it practically impossible. That, if it had been logically and clearly followed, would certainly make it impossible to have a good patent for a combination." The Court, while affirming the decision on other grounds, expressly disapproved it on the point above mentioned (p. 152).

In *Rowcliffe v. Morris*, 1885, 3 R. P. C. 17, the patentee had described his invention as consisting of four things, but had not clearly claimed the combination of them, thus leaving it doubtful whether it was a combination he was claiming, or the whole machine, or some parts of it. Bristowe, V.-C., after an exhaustive review of *Foxwell v. Bostock* and the succeeding cases, decided on this ground against the patent. A similar defect was held fatal in *Fairburn v. Household*, 1886, 3 R. P. C. 128. On the other hand (*Watling v. Stevens*, 1886, 3 R. P. C. 41, 153), in a patent for an improved tipping-waggon, the claim was the construction of the tipping-waggon substantially as described; it was suggested that this was a claim of the individual parts. The Court, however, considered that in substance it was a claim for a combination, and the patent was supported. In *Procter v. Bennis*, 1887, 36 Ch. D. 740, 4 R. P. C. 333, a patent for a mechanical stoker claimed "the employment of certain lappets and springs, in combination with certain doors, for the purposes described. It was agreed that the portions which were new were not pointed out, but Cotton, L.J., said (p. 351): "When a combination is claimed to be an invention, if that combination is new, it is immaterial on the question of the insufficiency of the specification and the validity of the patent, that the patentee should point out how far he does or does not claim particular portions"; and Bowen, L.J., says: "When a combination, and nothing more, is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims the particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim": see also (*per* Lord

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Watson) in *Kaye v. Chubb*, 1888, 5 R. P. C. 649. The specification must make it clear, in words or otherwise, that it is a *combination* that is being claimed, and not an improvement. It is not, however, needful that the exact word "combination" should be used, if it is clear that it is a combination which is really the gist of the invention: *United Telephone Co. v. Harrison*, 1882, L. R. 21 Ch. D. 720, 51 L. T. Ch. 705.

6. A complete specification must particularly describe and ascertain (1) the nature of the invention; (2) in what manner it is to be performed; and (3) must be accompanied with drawings if required: Patents Act, 1883, s. 5, s-s. (4).

post, p. 441.

"The public, on the one hand, have a right to expect and require that the specification shall be fair, honest, open, and sufficient; and, on the other hand, the patentee should not be tripped up by captious objections" (*per Alderson, B.*): *Morgan v. Seaward*, 1836, 1 W. P. C. 174; see also *Neilson v. Thompson*, 1841, 1 W. P. C. 283; *Holmes v. London & N. W. Railway Co.*, 1852, M. P. C. 16; *Hills v. London Gas Co.*, 1860, 5 H. & N. 340; *Thomas v. Welch*, 1866, L. R. 1 C. P. 201; *Bray v. Gardner*, 1887, 4 R. P. C. 402; *Newbury v. James*, 1817, 2 Mer. 451, 1 C. P. C. 368. A specification for preserving animal substances described how to make certain solutions numbered 1, 2, 3, 4. It then proceeded to describe how to use 2, 3, 4, but left it uncertain what was to be done with 1. Held, a fatal defect: *Bailey v. Robertson*, 1878, L. R. 3 App. Cas. 1055; *R. v. Metcalf*, 1817, 2 Stark. N. P. 249, 1 W. P. C. 141 n. "These two requirements, the description of its nature, and also of the mode of performing it, must both be fulfilled" (*per*

post, p. 302.

Best, J.) : *Brunton v. Hawkes*, 4 B. & Ald. 556. In *Philpot v. Hanbury*, 1885, 2 R. P. C. 38, Grove, J., pointed out the distinction between describing what an invention is, and shewing how it is to be performed, and laid it down that both must be done : see also *Edison v. Holland*, 1889, 6 R. P. C. 243; *Morton v. Middleton*, 1863, 1 Ct. Sess. Cas. 3rd ser. 721.

7. The subject matter must be proper, and there must be utility, ingenuity, and novelty in the sense of absence of anticipation : see those various headings, Chaps. I., II., III., V.

8. If a provisional specification has preceded it, the complete must conform to it and the title : see "Title," Chap. VI., and "Provisional Specification," Chap. VII., sect. 3.

9. If the specification fail in a material part from any defect, the whole patent falls (*per* Bayley, J.) : *Brunton v. Hawkes*, 1821, 4 B. & Ald. 551; *Morgan v. Seaward*, 1836, 2 M. & W. 544, 1 W. P. C. 170, and see further, Chap. I., sect. 8.

10. The specification must be clear and unambiguous : *Galloway v. Bleaden*, 1839, 1 W. P. C. 524; *Campion v. Benyon*, 1821, 6 B. & Moo. 71, 3 B. & B. 5. "It is incumbent on the patentee to give the specification of the invention in the clearest and most unequivocal terms of which the subject is capable" (*per* Ashurst) : *Turner v. Winter*, 1787, 1 W. P. C. 77. If in the invention it is needful to use some special kind or sort of an article, it is not enough simply to direct the article to be used

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A complete specification must particularly describe and ascertain (1) the nature of the invention; (2) in what manner it is to be performed; and (3) must be accompanied with drawings if required.

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ante, p. 60.

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The specification must be clear and unambiguous.

without directing attention to the variety of the article which it is needful to employ. Thus, where a patent for grinding meal directed rollers to be covered with "china," and it was shewn that all china would not do, but only a special kind of oriental china, the patent was held bad for ambiguity: *Wegman v. Corcoran*, 1878, L. R. 13 Ch. D. 65, 83, 39, L. T. (N.S.) 563, 41 L. T. (N.S.) 358; see also *Ellington v. Clark*, 1888, 5 R. P. C. 327.

In *Hastings v. Brown*, 1853, 1 E. & B. 450, 22 L. J. Q. B. 161, a patent for "a windlass intended to hold a cable of any size" was held bad, as it did not explain whether or not the same windlass would hold different sized cables, or whether different windlasses would be required; and in *Bloxam v. Elsee*, 1825, 1 C. & P. 558, 6 B. & C. 169, a similar objection was upheld.

ante, p. 164.

11. The specification must clearly distinguish what is claimed as new from what is represented as old.—In *Manton v. Manton*, 1 C. P. C. 278, D. P. C. 349, Gibbs, C.J., said: "It is necessary that the patentee should shew that he has accurately explained the nature of his invention, separating that which is new from that which is old." "It is essential to point out that which is new from that which is old": *Macfarlane v. Price*, 1816, 1 W. P. C. 74, 1 Stark. 199; *Gibson v. Brand*, 1842, 1 W. P. C. 640. "In a combination patent, as has been shewn, sect. 5, when the combination is claimed, that is understood to be the new thing, and nothing else is considered as alleged to be new by the patentee.

ante, p. 180.

12. The specification must distinguish the useful from the useless: *Easterbrook v. G. W. Railway Co.*, 1885, 2 R. P. C. 210. In this case the patentee repre-

sented that a new apparatus for railway-signalling was useful in all cases. It turned out to be useless if used in a particular way. The patent was held bad, on the authority of *The Badische Anilin Fabrik v. Levenstein*, 1883, L. R. 29 Ch. D. 366.

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The specification must distinguish the useful from the useless.

13. The specification, in claiming a thing as an improvement, need not necessarily explain why it is an improvement: *Neilson v. Thompson*, 1841, 1 W. P. C. 283.

14. It is not needful to describe any obvious or well-known step in the process: *Boulton v. Bull*, 1795, 2 H. Bl. 497; *Morgan v. Seaward*, 1836, 1 W. P. C. 176; *Heath v. Unwin*, 1852, 2 W. P. C. 245; *Crossley v. Beverley*, 1829, 3 C. & P. 513, Moo. & Mal. 283, 1 W. P. C. 106; *Derosne v. Fairie*, 1835, 5 Tyrr. 393, 1 W. P. C. 158.

15. Nor is it necessary formally to disclaim what is obviously old.—“There are some things so old and well-known that it is not necessary for a patentee to say, ‘I do not claim them.’ If he mentions a wheel, or an inclined plane, or a screw, he is not bound to disclaim each of those well-known mechanical instruments” (*per Fry, L.J.*): *Watling v. Stevens*, 1886, 3 R. P. C. 147. “If a patentee had occasion to introduce a hinge into his machinery, it would be absurd for him to point out that the hinge is not new”: *Haworth v. Hardcastle*, 1834, 1 W. P. C. 484; *Tetley v. Easton*, 1853, M. P. C. 88.

16. A patent is not vitiated by reason of the claim of some non-material part which turns out not to be useful, in the absence of deceit or misrepresentation: *Lewis v. Marling*, 1829, 1 W. P. C. 495; but it is

Compare *post*,
p. 198.

otherwise if that part is material: *R. v. Cutler*, 1849, M. P. C. 137, 14 Q. B. 372 n.

. 17. It is not necessary to describe every known method, nor every known substance, for performing the invention; general words may be introduced where no ambiguity is caused.—Thus, “gunpowder or other proper combustible matter,” would be sufficient if those conversant with the trade would not be misled: *Bickford v. Skewes*, 1841, 1 Q. B. 948, 1 W. P. C. 218.

post, sect. 21,
p. 191.

18. It is not necessary to describe what is in reality the best method, or the best proportions, if what is described is useful, and the patentee describes the best he knows of: *Macnamara v. Hulse*, 1842, C. & M. 471; *Patent Type Co. v. Richards*, 1859, 1 John. 381, 6 Jur. (N.S.) 39; *Thomson v. Batty*, 1888, 6 R. P. C. 84; *Neilson v. Harford*, 1841, 1 W. P. C. 318; *Otto v. Linford*, 46 L. T. (N.S.) 35.

19. The specification must be intelligible to an ordinary workman who understands the subject-matter without further experiment, or seeing it tried: *R. v. Arkwright*, 1785, 1 W. P. C. 66, D. P. C. 106; *Arkwright v. Nightingale*, 1785, 1 W. P. C. 60, D. P. C. 37; *Hornblower v. Boulton*, 1799, 8 T. R. 100, D. P. C. 277; *Harmar v. Playne*, 1809, D. P. C. 318. The specification must always be sufficiently clear to enable the machine to be made from it: *Otto v. Linford*, 1881, 46 L. T. (N.S.) 44. The specification is not addressed to a person unskilled in the kindred arts: *Manton v. Manton*, 1815, D. P. C. 349; *Sturtz v. De la Rue*, 1828, 5 Russ. 327; *Galloway v. Bleaden*, 1839,

1 W. P. C. 524; *Elliot v. Aston*, 1840, 1 W. P. C. 224; *Foxwell v. Bostock*, 1864, 10 L. T. (N.S.) 147. It is addressed to artists of competent skill in the branch of manufacture to which it relates: *Bickford v. Shewes*, 1841, 1 Q. B. 938, 1 W. P. C. 214, 10 L. J. Q. B. 302; *Househill Co. v. Neilson*, 1842, 1 W. P. C. 676. "Certainly the patentee does not satisfy the law if he says men of the highest science, first-rate engineers, could understand him." "The specification is not addressed to a person who is determined to misunderstand, but to one who is willing to understand": *Beard v. Egerton*, 19 L. J. C. P. 36, 8 C. B. 165. "It is plain that the specification of a patent is not addressed to persons who are ignorant of the subject-matter. But there are various kinds of persons who know something about it. If it is a mechanical invention, you have first of all scientific mechanics of the highest class—eminent engineers. Then you have scientific mechanics of the second-class, managers of great manufactories, great employers of labour, persons who have studied mechanics—not to the same extent as the first-class, the scientific engineers, but still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who, therefore, must have made the subject a matter of considerable study, and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and like the scientific engineers, would be able to find out what was meant, even from slight hints, still more from imperfect descriptions, and would be able to supplement so as to succeed, even from a defective description, and even more than that: would be able to correct an erroneous description. That is what I would say of the first two classes,

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The specification must be intelligible to an ordinary workman who understands the subject-matter without further experiment, or seeing it tried.

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The specification must be intelligible to an ordinary workman who understands the subject-matter without further experiment, or seeing it tried.

which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. Now, as I understand, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law” (*per* Jessel, M.R.): *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. 568, followed in *Bray v. Gardner*, 1887, 4 R. P. C. 40; see also *Badische Anilin Fabrik v. Levinstein*, 1887, 12 App. Cas. 710, 4 R. P. C. 463, and *Cassella v. Levinstein*, 1891, 8 R. P. C. 475. The evidence of a workman as to what he can understand is relevant to enable the Court to say whether the specification is sufficient: *Edison v. Woodhouse*, 1887, 3 R. P. C. 183, 4 R. P. C. 99.

20. No further experiments must be needful in order to enable the invention to be worked: *R. v. Wheeler*, 1819, 2 B. & Ald. 353; *Neilson v. Harford*, 1841, 1 W. P. C. 341; *Macnamara v. Hulse*, 1842, 1 C. & M. 471, 2 W. P. C. 129; *Muntz v. Foster*, 1844, 2 W. P. C. 109; *Stevens v. Keating*, 1847, 2 W. P. C. 175, 19 L. J. Ex. 57; *Hinks v. Safety Lighting Co.*, 1876, 1 R. 4 Ch. D. 616; *British Dynamite Co. v. Krebs*, 1879, 1 Good. Pat. Cas. 91; *Gandy v. Reddaway*, 1885, 2 R. P. C. 49. In *Edison v. Holland*, 1889, 5 R. P. C. 459, 6 R. P. C. 243, at p. 278, Cotton, L.J., expressed an opinion that when an invention is new, or delicate, some small degree of experiment may frequently be necessary, however clear the specification may be.

21. The inventor in his specification must disclose the best method with which he is acquainted, and must keep nothing back which it would be of advantage to the public to know. This important rule is often neglected by ignorant inventors, who sometimes keep back a portion of their invention, or at least pretend to have done so, so as to endeavour to get employment in teaching it to those who have purchased a right to use it. By this foolish conduct, they put it into the power of anyone who hears them to destroy their patent. In *Wood v. Zimmer*, 1815, Holt. N. P. 58, 1 W. P. C. 82, the patentee used secretly to put aquafortis into the boiler in making verdigris by a process which he patented. The effect of this was simply to save labour, but he did not disclose it. Held fatal: see also *R. v. Arkwright*, 1785, 1 W. P. C. 66, D. P. C. 61; *Bovill v. Moore*, 1816, D. P. C. 400; *Morgan v. Seaward*, 1836, 1 W. P. C. 174; *Neilson v. Harford*, 1841, 1 W. P. C. 320. The inventor's best knowledge should be given up to the time of sending in the complete specification: *Crossley v. Beverley*, 1829, 1 W. P. C. 117; *Jones v. Heaton*, 1 W. P. C. 404 n. It was objected, in *Edison v. Woodhouse*, 1886, 3 R. P. C. 167, 4 R. P. C. 79, that the patentee had not revealed all he knew in the final specification, because it was shewn that, prior to sending it in, and after the provisional, he had taken out another provisional specification shewing improvements. It was held, that as he had given all he knew to the world, his complete specification could not be impugned on the ground of bad faith.

If a man knows that he can make the article for which the patent is granted with cheaper materials than those which he has enumerated in the patent, although the

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SECT. 21.

The inventor in his specification must disclose the best method with which he is acquainted.

latter will answer the purpose equally well, the patent is void (*per* Buller, J.): *Turner v. Winter*, 1787, 1 W. P. C. 81. A patentee who had taken out a patent for making brown bread, was proved to have given directions of a special nature as to how to bake it, which were very essential to the clearness of the specification, but which directions he had not revealed. Patent held bad: *Pooley v. Pointon*, 1885, 2 R. P. C. 172; see also *Walton v. Bateman*, 1842, 1 W. P. C. 622; *Tetley v. Easton*, 1852, M. P. C. 76; *Heath v. Unwin*, 1852, 2 W. P. C. 243.

In the case of a communicated invention, the importer who takes out the patent is, for the purposes of this rule, the patentee. Hence, he is the person who must communicate all he knows: *Plimpton v. Malcolmson*, 1876, 3 Ch. D. 676; *Wegman v. Goreoran*, 1879, 1. R. 13 Ch. D. 66. But where a foreign inventor has a patent taken out in the name of his agent in England, for his own advantage, it is submitted that he would not be allowed fraudulently to withhold information, and still reap the benefit of the patent, by insufficiently instructing his agent in the method of performing the invention.

42. The specification must not contain any misstatements or false statements or suggestions. Thus, if anything is described as essential which is not really so, the patent will be bad: *Parsons v. Johnson*, 1840, 1 W. P. C. 101; *Hull v. F. M. G. v. L. K. G. G.* (1841) 1 W. P. C. 101; *F. v. G.* (1842) 1 W. P. C. 101; *H. v. G.* (1843) 1 W. P. C. 101; *F. v. G.* (1844) 1 W. P. C. 101; *F. v. G.* (1845) 1 W. P. C. 101; *F. v. G.* (1846) 1 W. P. C. 101; *F. v. G.* (1847) 1 W. P. C. 101; *F. v. G.* (1848) 1 W. P. C. 101; *F. v. G.* (1849) 1 W. P. C. 101; *F. v. G.* (1850) 1 W. P. C. 101; *F. v. G.* (1851) 1 W. P. C. 101; *F. v. G.* (1852) 1 W. P. C. 101; *F. v. G.* (1853) 1 W. P. C. 101; *F. v. G.* (1854) 1 W. P. C. 101; *F. v. G.* (1855) 1 W. P. C. 101; *F. v. G.* (1856) 1 W. P. C. 101; *F. v. G.* (1857) 1 W. P. C. 101; *F. v. G.* (1858) 1 W. P. C. 101; *F. v. G.* (1859) 1 W. P. C. 101; *F. v. G.* (1860) 1 W. P. C. 101; *F. v. G.* (1861) 1 W. P. C. 101; *F. v. G.* (1862) 1 W. P. C. 101; *F. v. G.* (1863) 1 W. P. C. 101; *F. v. G.* (1864) 1 W. P. C. 101; *F. v. G.* (1865) 1 W. P. C. 101; *F. v. G.* (1866) 1 W. P. C. 101; *F. v. G.* (1867) 1 W. P. C. 101; *F. v. G.* (1868) 1 W. P. C. 101; *F. v. G.* (1869) 1 W. P. C. 101; *F. v. G.* (1870) 1 W. P. C. 101; *F. v. G.* (1871) 1 W. P. C. 101; *F. v. G.* (1872) 1 W. P. C. 101; *F. v. G.* (1873) 1 W. P. C. 101; *F. v. G.* (1874) 1 W. P. C. 101; *F. v. G.* (1875) 1 W. P. C. 101; *F. v. G.* (1876) 1 W. P. C. 101; *F. v. G.* (1877) 1 W. P. C. 101; *F. v. G.* (1878) 1 W. P. C. 101; *F. v. G.* (1879) 1 W. P. C. 101; *F. v. G.* (1880) 1 W. P. C. 101; *F. v. G.* (1881) 1 W. P. C. 101; *F. v. G.* (1882) 1 W. P. C. 101; *F. v. G.* (1883) 1 W. P. C. 101; *F. v. G.* (1884) 1 W. P. C. 101; *F. v. G.* (1885) 1 W. P. C. 101; *F. v. G.* (1886) 1 W. P. C. 101; *F. v. G.* (1887) 1 W. P. C. 101; *F. v. G.* (1888) 1 W. P. C. 101; *F. v. G.* (1889) 1 W. P. C. 101; *F. v. G.* (1890) 1 W. P. C. 101; *F. v. G.* (1891) 1 W. P. C. 101; *F. v. G.* (1892) 1 W. P. C. 101; *F. v. G.* (1893) 1 W. P. C. 101; *F. v. G.* (1894) 1 W. P. C. 101; *F. v. G.* (1895) 1 W. P. C. 101; *F. v. G.* (1896) 1 W. P. C. 101; *F. v. G.* (1897) 1 W. P. C. 101; *F. v. G.* (1898) 1 W. P. C. 101; *F. v. G.* (1899) 1 W. P. C. 101; *F. v. G.* (1900) 1 W. P. C. 101; *F. v. G.* (1901) 1 W. P. C. 101; *F. v. G.* (1902) 1 W. P. C. 101; *F. v. G.* (1903) 1 W. P. C. 101; *F. v. G.* (1904) 1 W. P. C. 101; *F. v. G.* (1905) 1 W. P. C. 101; *F. v. G.* (1906) 1 W. P. C. 101; *F. v. G.* (1907) 1 W. P. C. 101; *F. v. G.* (1908) 1 W. P. C. 101; *F. v. G.* (1909) 1 W. P. C. 101; *F. v. G.* (1910) 1 W. P. C. 101; *F. v. G.* (1911) 1 W. P. C. 101; *F. v. G.* (1912) 1 W. P. C. 101; *F. v. G.* (1913) 1 W. P. C. 101; *F. v. G.* (1914) 1 W. P. C. 101; *F. v. G.* (1915) 1 W. P. C. 101; *F. v. G.* (1916) 1 W. P. C. 101; *F. v. G.* (1917) 1 W. P. C. 101; *F. v. G.* (1918) 1 W. P. C. 101; *F. v. G.* (1919) 1 W. P. C. 101; *F. v. G.* (1920) 1 W. P. C. 101; *F. v. G.* (1921) 1 W. P. C. 101; *F. v. G.* (1922) 1 W. P. C. 101; *F. v. G.* (1923) 1 W. P. C. 101; *F. v. G.* (1924) 1 W. P. C. 101; *F. v. G.* (1925) 1 W. P. C. 101; *F. v. G.* (1926) 1 W. P. C. 101; *F. v. G.* (1927) 1 W. P. C. 101; *F. v. G.* (1928) 1 W. P. C. 101; *F. v. G.* (1929) 1 W. P. C. 101; *F. v. G.* (1930) 1 W. P. C. 101; *F. v. G.* (1931) 1 W. P. C. 101; *F. v. G.* (1932) 1 W. P. C. 101; *F. v. G.* (1933) 1 W. P. C. 101; *F. v. G.* (1934) 1 W. P. C. 101; *F. v. G.* (1935) 1 W. P. C. 101; *F. v. G.* (1936) 1 W. P. C. 101; *F. v. G.* (1937) 1 W. P. C. 101; *F. v. G.* (1938) 1 W. P. C. 101; *F. v. G.* (1939) 1 W. P. C. 101; *F. v. G.* (1940) 1 W. P. C. 101; *F. v. G.* (1941) 1 W. P. C. 101; *F. v. G.* (1942) 1 W. P. C. 101; *F. v. G.* (1943) 1 W. P. C. 101; *F. v. G.* (1944) 1 W. P. C. 101; *F. v. G.* (1945) 1 W. P. C. 101; *F. v. G.* (1946) 1 W. P. C. 101; *F. v. G.* (1947) 1 W. P. C. 101; *F. v. G.* (1948) 1 W. P. C. 101; *F. v. G.* (1949) 1 W. P. C. 101; *F. v. G.* (1950) 1 W. P. C. 101; *F. v. G.* (1951) 1 W. P. C. 101; *F. v. G.* (1952) 1 W. P. C. 101; *F. v. G.* (1953) 1 W. P. C. 101; *F. v. G.* (1954) 1 W. P. C. 101; *F. v. G.* (1955) 1 W. P. C. 101; *F. v. G.* (1956) 1 W. P. C. 101; *F. v. G.* (1957) 1 W. P. C. 101; *F. v. G.* (1958) 1 W. P. C. 101; *F. v. G.* (1959) 1 W. P. C. 101; *F. v. G.* (1960) 1 W. P. C. 101; *F. v. G.* (1961) 1 W. P. C. 101; *F. v. G.* (1962) 1 W. P. C. 101; *F. v. G.* (1963) 1 W. P. C. 101; *F. v. G.* (1964) 1 W. P. C. 101; *F. v. G.* (1965) 1 W. P. C. 101; *F. v. G.* (1966) 1 W. P. C. 101; *F. v. G.* (1967) 1 W. P. C. 101; *F. v. G.* (1968) 1 W. P. C. 101; *F. v. G.* (1969) 1 W. P. C. 101; *F. v. G.* (1970) 1 W. P. C. 101; *F. v. G.* (1971) 1 W. P. C. 101; *F. v. G.* (1972) 1 W. P. C. 101; *F. v. G.* (1973) 1 W. P. C. 101; *F. v. G.* (1974) 1 W. P. C. 101; *F. v. G.* (1975) 1 W. P. C. 101; *F. v. G.* (1976) 1 W. P. C. 101; *F. v. G.* (1977) 1 W. P. C. 101; *F. v. G.* (1978) 1 W. P. C. 101; *F. v. G.* (1979) 1 W. P. C. 101; *F. v. G.* (1980) 1 W. P. C. 101; *F. v. G.* (1981) 1 W. P. C. 101; *F. v. G.* (1982) 1 W. P. C. 101; *F. v. G.* (1983) 1 W. P. C. 101; *F. v. G.* (1984) 1 W. P. C. 101; *F. v. G.* (1985) 1 W. P. C. 101; *F. v. G.* (1986) 1 W. P. C. 101; *F. v. G.* (1987) 1 W. P. C. 101; *F. v. G.* (1988) 1 W. P. C. 101; *F. v. G.* (1989) 1 W. P. C. 101; *F. v. G.* (1990) 1 W. P. C. 101; *F. v. G.* (1991) 1 W. P. C. 101; *F. v. G.* (1992) 1 W. P. C. 101; *F. v. G.* (1993) 1 W. P. C. 101; *F. v. G.* (1994) 1 W. P. C. 101; *F. v. G.* (1995) 1 W. P. C. 101; *F. v. G.* (1996) 1 W. P. C. 101; *F. v. G.* (1997) 1 W. P. C. 101; *F. v. G.* (1998) 1 W. P. C. 101; *F. v. G.* (1999) 1 W. P. C. 101; *F. v. G.* (2000) 1 W. P. C. 101; *F. v. G.* (2001) 1 W. P. C. 101; *F. v. G.* (2002) 1 W. P. C. 101; *F. v. G.* (2003) 1 W. P. C. 101; *F. v. G.* (2004) 1 W. P. C. 101; *F. v. G.* (2005) 1 W. P. C. 101; *F. v. G.* (2006) 1 W. P. C. 101; *F. v. G.* (2007) 1 W. P. C. 101; *F. v. G.* (2008) 1 W. P. C. 101; *F. v. G.* (2009) 1 W. P. C. 101; *F. v. G.* (2010) 1 W. P. C. 101; *F. v. G.* (2011) 1 W. P. C. 101; *F. v. G.* (2012) 1 W. P. C. 101; *F. v. G.* (2013) 1 W. P. C. 101; *F. v. G.* (2014) 1 W. P. C. 101; *F. v. G.* (2015) 1 W. P. C. 101; *F. v. G.* (2016) 1 W. P. C. 101; *F. v. G.* (2017) 1 W. P. C. 101; *F. v. G.* (2018) 1 W. P. C. 101; *F. v. G.* (2019) 1 W. P. C. 101; *F. v. G.* (2020) 1 W. P. C. 101; *F. v. G.* (2021) 1 W. P. C. 101; *F. v. G.* (2022) 1 W. P. C. 101; *F. v. G.* (2023) 1 W. P. C. 101; *F. v. G.* (2024) 1 W. P. C. 101; *F. v. G.* (2025) 1 W. P. C. 101.

giving the names of the ingredients, all of which were well known, viz., Rochelle salt, carbonate of soda, and tartaric acid, went on *ex abundante cautela*, to explain how to make all those ingredients. Held, that by so doing he had misled the public into thinking they could not make the powders out of the common commercial substances named. Patent held bad. A patent which described how to make a certain glaze of size and the "finest and purest chemical white lead," was held bad on the ground that the substance which would ordinarily be bought in London under that name would not answer: *Sturtz v. De la Rue*, 1828, 5 Russ. 327, 1 W. P. C. 83.

CHAP. VIII.
SECT. 22.

The specification must not contain any misleading or false statements or suggestions.

Where a patentee said that he used cloths "of any suitable material, but I prefer it to be made of linen warp, and woollen weft," and in evidence it was proved that he had tried other materials and failed with all except those; held, his expression above quoted was misleading, for he ought to have warned the public against the use of other materials which his specification was an invitation to try: *Crompton v. Johnson*, 1828, 1 Dan. & L. 313, 1 W. P. C. 233, 11 P. C. 402. It is misleading statement to put in, it is no answer to say that this was done innocently: *Stephens v. Hallett*, 1861, 20 Jurist, 1st Ser. 100.

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CHAP. VIII.
SECT. 23.

An error, obvious on the face of the specification, and which any workman would at once correct without further experiment, would not vitiate a patent.

Gandy v. Reddaway, 1883, 2 R. P. C. 52 (*per* Brett, M.R.). Where a specification directed the use of a "carbon gas or liquid," and it was shown that some carbon gases and liquids would not do, it was held no defect, because the specification sufficiently showed what were the particular sorts of carbon gases or liquids referred to: *Edison v. Woodhouse*, 1887, 4 R. P. C. at p. 107; compare this with *Stevens v. Keating*, 1848, 2 W. P. C. 194 (*post*, p. 209).

The doctrine is further exemplified in *Beard v. Egerton*, 1849, 8 C. B. 165, 13 Jur. 1004, 19 L. J. C. P. 36. The Court must have been desirous to sustain this patent, for it was for the daguerreotype process of photography, and exhibited great ingenuity and novelty. By inadvertence, however, in the specification it was said that you were to clean the silver plate with acid and pounce just before the moment of using the plates in the camera. This was obviously absurd, for it would have destroyed the iodised coating of silver upon which the light acted to take the picture. All that was really meant was that the plates were to be well cleaned before polishing, which was done just before putting the plate in the camera, and the Court held that anyone could so understand it. Patent supported by *see* "Construction of Specifications," Chap. XI., sect. 1. *See* also *Hopkinson v. St. James Electric Light Co.*, 1882, 10 R. P. C. 10, *Midway v. Beale*, 1883, 10 R. P. C. 106.

post, p. 209

CHAPTER IX.

THE CLAIMS.

1. The nature, functions, and objects of claims.—By the Patents Act, 1883, s. 5, s-s. 5, every specification should end with a distinct statement of claim or claims. This rule is, however, merely directory, and if the patent is passed by the officials, the absence of a distinct claim will not invalidate a patent: *Siddell v. Vickers*, 1887, 5 R. P. C. 432, L. R. 30 Ch. D. 92. It has been decided, that provided there is a claim or claims at the end of a patent, the question of disconformity with the provisional specification ought not to be raised by the officials at the Patent Office, provided that such claims are correct in form, and not a mere colourable evasion (as, for example, to say, "I claim what I have described"); *Smith's Patent*, 11 R. P. C. 203. The object of a claim is pointed out by Lord Cottonham in *Key v. Marshall*, 1833, 2 W. P. C. 30, 1 My. & Cr. 353, to be for the patentee's protection, to define and limit his invention. It is in reality a disclaimer (*per James, L.J.*) *Plimpton v. Bydler*, L. R. 6 Ch. D. 412. In practice the Patent Office officials do not interfere with claims, but leave the applicant to make them as he pleases and at his own risk. See a paper on "Claims," by J. J. J. J., Proceedings of the Institute of Patent Agents, vol. 11, 201.

CHAP. IX.
SECT. 1.

post, p. 442.

post, p. 213.

2. Everything not claimed must be considered as expressly disclaimed, and hence open to the public: *Harrison v. Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 581; *United Telephone Co. v. Harrison*, 1882, L. R. 21 Ch. D. 741; *Jackson v. Wolstenhulmes*, 1884, 1 R. P. C. 108; *Lucas v. Miller*, 1885, 2 R. P. C. 159; *Easterbrook v. G. W. Railway Co.*, 1885, 2 R. P. C. 208.

ante, p. 179.

3. Claims must be unambiguous and clear: *Tetley v. Easton*, 1853, M. P. C. 87; *Hinks v. Safety Lighting Co.*, 1876, 4 Ch. D. 612; and must state the limits and scope of the invention distinctly. Thus, it will not do to say: "What I claim is the general construction of the several parts . . . as herein set forth." This is not a "distinct" statement, and though it may not make the patent bad, it may greatly be prejudiced: *Siddell v. Vickers*, 1888, 5 R. P. C. 433, affirmed 7 R. P. C. 292. A claim is not intended to be a description, but only a marking out of the invention; hence, "expressions are permissible in claims which would be too general if they professed to be part of the description" (*per Cottenham, L.C.*): *Kay v. Marshall*, 1836, 2 W. P. C. 39. And a certain latitude is permissible, when the nature of the subject demands it. Thus, a patent for type-metal composed of seventy-five parts of tin and twenty-five of antimony was not held bad on account of its being stated in the claim "that these proportions might be to a certain extent varied": *Patent Type-founding Co. v. Richards*, 1859, 1 John. 381.

4. In interpreting the claims, the description in the specification must be looked at: *Heath v. Unwin*, 1855, 5 H. L. Cas. 510, 25 L. J. C. P. 20.

5. A claim of "every method by which a thing can be done" would not be sufficiently specific.—"To claim every method would be equivalent to claiming a principle" (*per* Alderson, B.): *Neilson v. Harford*, 1841, 1 W. P. C. 355. A patent related to a method of making gas from seeds. "We are also of opinion that the claim is too large, and cannot be supported. It is a claim to make gas direct from seeds, not in any mode pointed out in the specification, but generally . . . we think that the plaintiff's second patent was not for any particular mode of doing it, but for the doing it by any method; and we think that even if it had been new (which it turns out not to be), such a mode of specifying and claiming the invention cannot be sustained as a good specification" (*per* Pollock, C.B.): *Booth v. Kennard*, 1856, 1 H. & N. 527, 2 H. & N. 84. In *Wyeth v. Stone* an American patentee had said: "I claim every mode of cutting ice except by human power." Lord Hatherley called this "a preposterous claim": *Arnold v. Bradbury*, 1871, L. R. 6 Ch. 711, in which case the claim, though wide, was supported; see also *Tetley v. Easton*, 1852, M. P. C. 71 (*per* Pollock, C.B.). *see p. 18.*

6. When a claim is clear and distinct for a substantial object, or part of an invention, the patentee will be held to it, and not allowed to depart from it, either for the purpose of restricting it, so as to save his patent, nor, on the other hand, to expand it, so as to cover an infringement. This rule depends upon the principle that a patentee's claims define what he represents he has invented. We shall hereafter see that, in the case of a genuine invention, every effort will be made by the Courts to support it, where the language admits of it; but where

CHAP. IX.
SECT. 6.

When a claim is clear and distinct for a substantial object, or part of an invention, the patentee will be held to it.

post, p. 203.

a claim is distinct, it cannot be departed from. Of course the claim will be read so as to cover not only precisely what is specifically claimed, but also all that can fairly be described as coming within the scope of the invention. No patentee will be held so exactly to what he has claimed, as to protect him from nothing but exact imitations of his machine. For otherwise a patent would be useless. But he will not be allowed to play fast and loose with his claims, or to adopt that construction of them which happens at the moment to be convenient. And his patent must stand or fall, not by what he meant, but by what he has said: *Hill v. Thompson*, 1817, 1 W. P. C. 237; *Minter v. Mower*, 1835, 1 W. P. C. 142; *R. v. Else*, 1785, 1 W. P. C. 76; *Gibson v. Brand*, 1842, 1 W. P. C. 634; *Heath v. Unwin*, 1855, 25 L. J. C. P. 12, 5 H. L. C. 505, 16 C. B. 713; *Bloxam v. Elsee*, 1827, 6 B. & C. 169; *Jordan v. Moore*, 1866, L. R. 1 C. P. 624; see also *Cropper v. Smith*, 1884, 1 R. P. C. 87; *Clark v. Adie*, 1873, 2 App. Cas. 315; *Britain v. Hirsch*, 1888, 5 R. P. C. 229, cited in the next section.

post, p. 201.

7. Where, however, a claim may be read as merely auxiliary or subordinate, this will be done in order to save the patent.—This rule depends on the principle of beneficial construction (see Chap. XI., sect. 1). “If the claim to the material can be substantiated by the patent, the specification of a particular user of it comprehended in the general area claimed, cannot for a moment be accepted as a ground for vitiating the patent” (*per* Westbury, L.C.): *Betts v. Neilson*, 1871, 5 H. L. C. 21. In *Plimpton v. Spiller*, 1876, 6 Ch. D. 426, one of the claims was for “a mode of holding runners” by bolting them between pieces of wood. The

ante, p. 187.

idea of holding a thing by bolting it between pieces of wood is of course as old as the hills, but the patent was saved by treating the claim as merely subsidiary to the claims for the runners themselves.

In *Frearson v. Loe*, 1878, L. R. 9 Ch. D. 48, Jessel, M.R., held "that it is not because an inventor thinks that he has invented more than he really has, that his claims must be upset, *if they can be limited so as to save his invention.*" This view was in the next year carried further. An inventor had patented dynamite, which consists of dry clay soaked in nitro-glycerine. It was well known at the date of the patent that all explosives of the "fulminating" kind, in order to explode violently, must either be strongly confined, or else fired with a detonator. The patentee claimed, first, the manufacture of dynamite, secondly, the method of firing the same by special ignition (*i.e.*, by confinement or by a detonator). It was argued that as those modes of firing fulminating explosives were old, the patent was bad. Fry, J., however, supported it. His judgment was reversed by the Court of Appeal, but restored by the House of Lords, who considered that the means of using the new substance was really essential to it, and part of it, and that the claim might be regarded as "appendant" to the claim for the dynamite: *British Dynamite Co. v. Krebs*, 1879, 1 Good. P. C. 88; see also *Oxley v. Holden*, 1860, 8 C. B. (N.S.) 666, Judgment of Erle, C.J.

On the other hand, none of these cases can prevent a *clear* claim for a subordinate part of an invention being held, either for good or ill, to be binding on the patentee. He may claim the combination of A, B, C, and D, and in addition a sub-combination of A and B, and in addition he might claim C and D separately. If, however, he

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Where, however, a claim may be read as merely auxiliary or subordinate, this will be done in order to save the patent.

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Where, however, a claim may be read as merely auxiliary or subordinate, this will be done in order to save the patent.

does so clearly, and makes them into distinct claims, he will be bound by them, and they cannot be read as auxiliary: *Clark v. Adie*, 1877, 2 App. Cas. 320, and *Cropper v. Smith*, 1884, 1 R. P. C. 87. The cases of *Plimpton v. Spiller*, *Frearson v. Loe*, and the *British Dynamite Co. v. Krebs*, must, therefore, be considered as proceeding upon the principle of beneficial construction adopted where possible in order to save the patent. The distinction between such cases and *Clark v. Adie* was pointed out by Cotton, L.J., in *Britain v. Hirsch*, 1888, 5 R. P. C. 229. "If," said he, "in the *British Dynamite Co. v. Krebs*, the House of Lords had found the words 'What I claim is a *new cap* for the purposes of igniting,' I think they could not reasonably have come to the conclusion, to which, indeed, they did come, on the words of that specification." See also *Pether v. Shaw*, 1893, 10 R. P. C. 293.

CHAPTER X.

THE DRAWINGS.

1, Drawings are to be attached to specifications if required: Patents Act, 1883, s. 5, s-s. 4, s. 6; and if they have been attached to the provisional specification, they may be referred to in the complete: Patents Act, 1886, s. 2; P. Rules, 1890, r. 30-33. The rules regarding drawings are framed with a view of making them uniform in size and pattern, and of facilitating their reproduction by photolithography. They are sometimes very rough. It is, however, better to make them carefully, for in a patent action the Court may be apt to think slightly of a patent which the inventor has not troubled himself to draw with accuracy and neatness.

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SECT. 1.

post, p. 442.

post, pp. 477,
489.

2, Drawings are to be taken as part of the specification: *Morgan v. Seaward*, 1836, 1 W. P. C. 173; and examined in connection therewith: *Morton v. Middleton*, 1863, 1 Ct. Sess. 3rd ser. 722. They may be used to explain the specification, and a description consisting of a drawing alone might even be sufficient: *Poupard v. Fardell*, 1869, 18 W. R. 129, overruling *Ex parte Fox*, 1812, 1 V. & B. 67, 1 W. P. C. 431; see also *Foxwell v. Bostock*, 1864, 4 De Gex. J. & S. 303, 10 L. T. (N.S.) 146. In *Brunton v. Hawkes*, 1820, 1 C. P. C. 410, Abbot, C.J.,

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says: "If a drawing or figure enables a workman of ordinary skill to construct the improvement, it is as good as any description": see also *Bloxam v. Elsee*, 1825, 1 C. & P. 564. Drawings may also explain an ambiguity in the description: *Hastings v. Brown*, 1853, 1 E. & B. 454; *Daw v. Eley*, 1867, L. R. 3 Eq. 500 n., 14 W. R. 126; *Miller v. Scarle Barker & Co.*, 1893, 10 R. P. C. 106.

3. It is not sufficient for a patentee to shew an important part of his patent in a drawing if he does not call attention to it in the description: *Fairburn v. Household*, 1886, 3 R. P. C. 267; *Clark v. Adie*, 1877, 2 App. Cas. 315; and mere inference from the drawings cannot control the clear language of the specification: *Stewart v. Briggs*, 1883, 11 Ct. of Sess. Cas. 4th ser. 236.

4. The drawings need not be well executed if they satisfy the requirements of the Patents Acts and Rules.—It is enough if they enable a competent workman to understand them: *Bovill v. Moore*, 1816, D. P. C. 369. They ought to have a scale where needful to explain the invention: *Morton v. Middleton*, 1863, 1 Ct. Sess. Cas. 3rd ser. 724. A drawing which is obviously erroneous may be corrected by reference to the specification: *Otto v. Linford*, 1881, 46 L. T. (N.S.) 40.

5. Anticipation by drawings.—A drawing without a description may be an anticipation.

ante, p. 158.

6. If the provisional specification has a drawing, reference to it may be made in the complete specification, and no new drawing is needful: Patents Act, 1886, s. 2.

post, p. 242.

post, p. 477.

CHAPTER XI.

CONSTRUCTION OF SPECIFICATIONS.

1. **The beneficial construction.**—The construction of specifications has been the subject of many decisions, which, when examined, shew no contradiction of principle, though the mode in which the principle is expressed differs. The rules of construction are three: (1) That the ordinary meaning of words is to prevail; (2) Subject to expert evidence to explain technical terms, (3) That where it is possible to give two different constructions to a specification, then, if it can be done without a violation of the words, such a construction should be given as will support the patent. *see ante, p. 198.*

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Patents in old law were, like all grants, construed most strongly against the grantee, and upset upon the smallest suggestion that the full consideration for them had not been given, or that the Crown had been deceived. In order to try and avoid this harsh construction, it was usual to insert in the recitals the words, “Ex mero motu et certa scientia,” which were held in *R. v. Mussary*, *ante, p. 15.* 1738, Bull. N. P. 76 a., 1 W. P. C. 41, “to occasion the grant to be taken in its most liberal and beneficial sense.” In addition to this, a clause used to be (and still is) inserted, that “the patent should be considered to be *ante, p. 13.* most available” for the patentee: 1 W. P. C. 26 (*see post, p. 265,*

Chap. XVII., sect. 7). In accordance with these principles, a beneficial interpretation has always been given to patents, although at one time, viz., before 1830, the Courts were stricter in construing them: *Neilson v. Harford*, 1841, 1 W. P. C. 310 (*per Parke, B.*).

But though they were once very strictly applied, the general principles in favour of a beneficial construction have always been admitted, as appears from the following cases, which, however, are now of less importance, because more recent cases, to be presently cited, have amplified and explained them: *Boulton v. Bull*, 1795, D. P. C. 212; *Hullett v. Hague*, 1831, 2 B. & Ad. 377; *Haworth v. Hardcastle*, 1834, 1 W. P. C. 485; *Russell v. Cowley*, 1835, 1 W. P. C. 470; *Minter v. Mower*, 1835, 1 W. P. C. 141; *Bickford v. Skewes*, 1841, 1 Q. B. 950, 1 W. P. C. 219; *Neilson v. Harford*, 1841, 1 W. P. C. 372 (followed in *Edison v. Holland*, 1888, 5 R. P. C. 474); *Househill Co. v. Neilson*, 1843, 1 W. P. C. 679; *Elliot v. Turner*, 1845, 2 C. B. 416, 15 L. J. C. P. 49; *Newton v. Grand J. Rail Co.*, 1845, 5 Ex. 335, 20 L. J. Ex. 427 n.; *Stevens v. Keating*, 1848, 2 W. P. C. 187; *Sellers v. Dickinson*, 1850, 5 Ex. 324; *Tetley v. Easton*, 1852, M. P. C. 74; *Palmer v. Wagstaffe*, 1854, 9 Ex. 501.

The words "of our especial grace, certain knowledge, and mere motion" always remained, and still remain, in the form of the patent. In the form prior to 1852 a clause was inserted validating the patent, "notwithstanding the not full and certain describing the nature and quality of the said invention": Hindmarch, p. 628. After the Patents Act of 1852, however, that form was altered, and then stood, "shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the patentee": see forms at the

end of Patents Act, 1852. In form D, attached to the Patents Act of 1883, and which, with slight modification, is now in use, the words "of our especial grace, certain knowledge, and mere motion" are retained, as also "that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee."

The Courts have always endeavoured to give force to the words of favourable construction contained in the grant. This was at one time known as the benevolent construction, a term which is now in disfavour, and which has been replaced by the term "beneficial" construction. The following cases, from the year 1864 to the present time, exemplify this:—

Simpson v. Holliday, 1864, 20 Newton's Lond. Journal (N.S.) 107, 13 W. R. 578, 12 L. T. (N.S.) 99.—"The rules which govern the construction of specifications . . . are the ordinary rules for the interpretation of written documents. If the words, 'the most liberal construction,' are intended to denote some principle of interpretation different from the ordinary rules for the interpretation of written documents, I am not aware of any such authority" (*per* Westbury, L.C.): followed in *Edison v. Holland*, 1888, 5 R. C. P. 475.

Newton v. Halbard, 1872, John. 152.—"A specification should not be construed in any technical or captious spirit, but with a fair intention to give it effect, if it be reasonably intelligible."

Harrison v. Anderston Foundry Co., 1876, L. R. 1 App. Cas. 581.—"A specification ought not to be subjected to what has been called the benign interpretation, or to the strict one. The language should be construed according to the ordinary meaning."

Hinks v. Safety Lighting Co., 1876, 4 Ch. D. 612.—"I

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am anxious . . . to support honest bonâ fide inventors . . . and to prevent their patents being overturned on mere technical objections. . . . This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. Beyond that the benevolent mode of construction does not go" (*per* Jessel, M.R.).

Plimpton v. Spiller, 1877, 6 Ch. D. 422.—"It is the duty of a judge to construe a specification fairly with a judicial anxiety to support a really useful invention . . . it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible, rather than that which makes it utterly absurd" (*per* Jessel, M.R.).

Clark v. Adie, 1877, 2 App. Cas. 436.—"In construing the specification, we must construe it like all written documents. But when it is attempted . . . to say that inasmuch as these specifications shew matters . . . which were old when the patent was taken out . . . therefore the patent must be so construed as not to include them, that seems to me both contrary, so far as I know, to the course of decision, and contrary to principle (*per* Lord Blackburn).

Dudgeon v. Thompson, 1877, L. R. 3 App. Cas. 53.—"The duty of the Court is fairly and truly to construe the specification, neither favouring one side nor the other" (*per* Lord Blackburn).

Otto v. Linford, 1882, 46 L. T. (N.S.) 38.—"There should be a bias in favour of that construction which supports a patent" (*per* Jessel, M.R.).

Cropper v. Smith, 1884, 1 R. P. C. 89.—“We were pressed very earnestly to give this document that which has been called a benevolent construction. It seems to me that prayer for grace is very often addressed to Courts under circumstances which preclude the idea of their entertaining it for a moment. It is quite true that in old times a great many judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees must be fairly dealt with, as between themselves and the public; and as a canon of construction, accordingly, reference has been from time to time in various cases made to the idea that a benignant or benevolent construction was one that ought to be involved, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Shepherd’s Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign—‘Verba debent intelligi cum effectu ut res magis valeat quam pereat.’ Now that is only a caution against excessive formalism. It only means, that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by their deed, and you must not defeat it if effect can be given to their intention by a fair construction of the whole of the document” (*per* Bowen, L.J.).

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Needham v. Johnson, 1884, 1 R. P. C. 58.—“I do not like the expression ‘benevolent interpretation’; I do not believe in it. The question is, whether a given construction is the true construction; but of course if any patent is capable of more constructions than one, the general rule would be applied, that you would put upon it that construction which makes it a valid patent, rather than a construction which renders it invalid. There is no particular benevolence in that. It is a general principle of interpretation applicable to all documents, but of course those who talk about benevolent interpretation do not mean more than that” (*per* Lindley, L.J.).

Philpot v. Hanbury, 1884, 2 R. P. C. 38.—“I should read the specification liberally . . . is this such, that a fair man, willing and wishing to understand the specification, can reasonably gather from it what the patentee considers his invention?” (*per* Grove, J.).

Sugg v. Bray, 1885, 2 R. P. C. 231.—“The patent must be construed . . . by giving the ordinary and natural meaning to the words” (*per* North, J.).

Lister v. Norton, 1886, 3 R. P. C. 203.—“The specification ought to be construed like any other legal document, as a whole. It certainly ought not to be construed malevolently—I will not say it ought to be construed benevolently—I do say it ought to be construed fairly. It must be read by a mind willing to understand, not by a mind desirous of misunderstanding. Inventors and those who assist them are seldom skilled adepts in the use of language; faults of expression may be got over where there is no substantial doubt as to the meaning” (*per* Chitty, J.).

Automatic Weighing Machine Co. v. Knight, 1889, 6 R. P. C. 307.—“We are told by the statute that we are

to consider all patents in the most beneficial sense for the advantage of the patentee. Why this clause should have been put in I do not know . . . we must ascertain the real meaning, and must, in obedience not only to the command, but to common sense, construe it so as to uphold it, if it can be reasonably done" (*per* Lindley, L.J.).

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Leadbitter v. Kitchin, 1890, 7 R. P. C. 244.—“ A specification is to be construed neither in favour of the grantee nor against him, but precisely according to the rules applied to any other document ” (*per* Brett, L.J.). (The patentee had described a guard for toothed wheels and belted pulleys. To avoid anticipation, he wanted the Court beneficially to read it as though he had only claimed the guard for the belted pulleys. Held, it could not be done.)

A consequence of the principle that a patent is to be supported if the language reasonably admits of it is, that a patentee is not to be presumed to claim things that he must have known were in general use (see Chap. VIII., sect. 15); and where a claim in a patent is too widely stated, and would if isolated be bad, the beneficial construction is often applied to restrict it, and thus save the patent (see Chap. IX., sect. 7).

ante, p. 187.

ante, p. 198.

2. The title, specifications, and claims, may all be looked at, to explain one another.—“ You must always construe a claim with reference to the whole context of a specification ” (*per* James, L.J.): *Plimpton v. Spiller*, 1877, 6 Ch. D. 427. In *Edison v. Woodhouse*, 1887, 4 R. P. C. 106, where a claim was for the use of a “ carbon gas or liquid,” the words “ carbon gas ” were allowed to be explained as not meaning every sort of carbon gas

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The title, specifications, and claims may all be looked at, to explain one another.

(some of which, as a fact, would not succeed), but as meaning only certain sorts of carbon gas, the nature of which could be gathered from the specification. This case may be compared with *Stevens v. Keating*, 1847, 2 W. P. C. 194, where a claim to the use of "acids as hereinbefore described" was held to mean all sorts of acids, some of which would do, and some would not do, and the patent was held bad.

The specifications are to be read in connection with their titles (*per Parke, B.*): *Newton v. Vaucher*, 1851, 6 Ex. 859; *Hornblower v. Boulton*, 1799, D. P. C. 220, 8 T. R. 95; *Oxley v. Holden*, 1860, 8 C. B. (N.S.) 747, 30 L. J. C. P. 74, 8 W. R. 627; *Househill Co. v. Neilson*, 1843, 1 W. P. C. 679.

Although the provisional specification may be used to explain the final, it is not permissible to supplement it; *Mackelcan v. Rennie*, 1862, 13 C. B. (N.S.) 52; see also *ante*, p. 176. Chap. VII., sect. 4.

Compare *ante*, p. 77, Chap. III., s. 3.

Compare *post*, "ambit of an invention," p. 299.

3. Construction with reference to public knowledge at the time.—The specifications are to be construed with reference to public knowledge at the time they are sent in. For this purpose former specifications may be consulted, and evidence of experts taken: *Hocking v. Hocking*, 1886, 3 R. P. C. 293. "If the words of the specification are clear, of course these specifications cannot help in any way, nor could the public knowledge at the time help in any way, but if they are doubtful, then I think it may be legitimate and useful, in ascertaining the true construction of the terms of the specification, to look to all matters which could help the judge to determine what was the state of public knowledge at the time when this patent was granted" (*per Cotton, L.J.*);

see also *Couchman v. Greener*, 1884, 1 R. P. C. 199 (*per* Lord Esher, M.R.).

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Thus, in *The Badische Anilin Fabrik v. Levenstein*, 1887, the word "naphthylamine" was used. It was argued that there were two sorts, viz., alpha- and beta-naphthylamine, that only the former would do, and that the patent did not distinguish them. It was the fact that, at the date of the patent, both were known, but under the names "naphthylamine" and "new naphthylamine." Hence the patentee, in describing as "naphthylamine" what was afterwards termed "alpha-naphthylamine," had correctly used the language in vogue when it was sent in, and the patent was supported: 4 R. P. C. at p. 463; see also *Lewis v. Marling*, 1829, 1 W. P. C. at p. 496, 10 B. & C. 22. This principle was also affirmed by the House of Lords: *King Brown v. Anglo-American Brush Co.*, 1892, 9 R. P. C. 322; and see *Heath v. Unwin*, 1852, 2 W. P. C. 228, 12 C. B. 522, 5 H. L. C. 505 (*per* Alderson, B.); *Clark v. Adie*, 1877, 2 App. Cas. 436; *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. 98; *Ellington v. Clark*, 1888, 5 R. P. C. 325; *Crossley v. Beverley*, 1829, 1 W. P. C. 107; *Ashworth v. Roberts*, 1892, 9 R. P. C. 92.

Construction with reference to public knowledge at the time.

4. Lapse of time has some effect upon the construction of a patent, so that if a patent has stood inquiry and the test of time, this is evidence that the specification is intelligible: *Neilson v. Betts*, 1871, L. R. 5 H. L. C. 1, 40 L. J. Ch. 317, 19 W. R. 1121.

5. The use of particular words in patents.— Foreign words in a patent, such as "vis de pression" and "centimetres," will not vitiate it, if the meaning is

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comprehensible: *Bloxam v. Elsee*, 1825, 1 C. & P. 558, 6 B. & C. 169; see also *Cassella v. Levinstein*, 1891, 8 R. P. C. 473.

“**Manufacture.**”—This word is used in the widest sense: *Cornish v. Keene*, 1835, 1 W. P. C. 508, 2 C. P. C. 314; *Bush v. Fox*, 1852, M. P. C. 176, 23 L. J. Ex. 257; *Ralston v. Smith*, 1865, 11 H. L. C. 223, 20 C. B. (N.S.) 28, 35 L. J. C. P. 49.

“**As above described.**”—These words have a limiting effect: *Plating Co. v. Farquharson*, 1879, Griff. 191; *Barber v. Grace*, 1847, 1 Ex. 339, 17 L. J. Ex. 122.

“**Substantially as described.**”—These words, according to Grove, J., “come to nothing,” and the word “substantially” is mere verbiage: *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. 241.

“**Substantially as hereinbefore described,**” interpreted by North, J.: *Lawrence v. Perry*, 1885, 2 R. P. C. 183; *Easterbrook v. G. W. Rail. Co.*, 1885, 2 R. P. C. 208.

“**As above set forth.**”—In the sentence “provided with a shoulder . . . made from a piece of wire as above set forth” the word “as” was read as relating to “provided,” not to “made”: *Bray v. Gardner*, 1887, 4 R. P. C. 403.

“**Substantially as set forth,**” must refer to the description in the specification: *United Telephone Co. v. Bassano*, 1886, 3 R. P. C. 315 (*per* Cotton, L.J.).

“**As described and illustrated,**” refers to the drawings: *Fairburn v. Household*, 1886, 3 R. P. C. 267.

“**Other substances,**” is not too general, and means other substances ejusdem generis: *Crossley v. Beverley*, 1829, 9 B. & C. 63; *Bickford v. Skewes*, 1841, 1 Q. B. 948, 1 W. P. C. 218.

“**Any mechanical equivalent,**” are useless words.

They are implied, and need not be stated: *Curtis v. Platt*, 1863, 3 Ch. D. 137, n.

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SECT. 5.

“Analogous”: see *Brown’s Patent*, Griff. App. 1. “The inventor does not limit himself. . . .”; “It will be evident that the process may be varied,” are useless words: *Binney v. Feldtman*, H. L. (*per Cairns*), 1875, Griff. 52.

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ticular words.

“More or less,” means a substantial quantity: *Plating Co. v. Farquharson*, 1883, Griff. 192.

“Effect,” read as “beneficial effect”: *Neilson v. Harford*, 1841, 1 W. P. C. 372.

“A,” must be read in the singular. Thus, “a” machine to do various things, means that *one* machine must do them all, not that various machines of different sizes are required: *Hastings v. Brown*, 1853, 1 E. & B. 450, 22 L. J. Q. B. 161; *Bloxam v. Elsee*, 1827, 6 B. & C. 169, 9 D. & R. 215. *ante*, p. 186.

“And.”—“Metal fittings *and* the mode of applying them.” Held, a patent only for the fittings, in accordance with the rule of interpretation laid down in *Oxley v. Holden*, 1860, 8 C. B. (N.S.) 666; Chap. VI., sect. 1. *ante*, p. 166.

“Etc., etc.,” held to mean another name for the thing after which they were put, and not necessarily too vague: *Shaw v. Jones*, 1839, 6 R. P. C. 333.

“Or,” must be read disjunctively. Thus, where a patentee said, “I do A,” *or* “I accelerate it by B,” and it was shewn that B was indispensable to success, the patent was held bad: *Simpson v. Holliday*, 1864, 20 Newton’s Lond. Journal (N.S.) 108; see also *Elliot v. Turner*, 1845, 2 C. B. 446, 15 L. J. C. P. 49. In the case of *Hills v. London Gas Light Co.*, 1860, 5 H. & N. 312, 27 L. J. Ex. 60, 29 L. J. Ex. 409, “hydrated *or* precipitated oxide of iron” was allowed to be read as if the word *or* was omitted.

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use of par-
ticular words.

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“S.”—In a patent for improvements, one improvement was allowed to be enough, for every part of the new plan might be considered as an improvement: *Derosne v. Fairie*, 1835, 1 W. P. C. 162; see also *Nickels v. Haslam*, 1844, 8 Scott N. R. 97, 7 M. & G. 378, 8 Jur. 474, 13 L. J. C. P. 146. But where the patent said that “notes” were produced that never were before produced, held, that one new note would not satisfy the description: *Bainbridge v. Wigley*, 1810, Parl. Rep., 1820, 197, 1 C. P. C. 270.

CHAPTER XII.

AMENDMENT OF THE SPECIFICATION.

1. **Practice prior to the Patents Act, 1883.**—Formerly the patent was in the custody of the Chancellor, but the enrollment thereof and the specifications were under the custody of the Master of the Rolls, who allowed the amendment of clerical errors, but no others: 1 W. P. C. 641. By 5 & 6 Wm. IV., c. 83, disclaimers were first allowed, which, however, could only repudiate some matter claimed, and which could not amend errors in the specification. When made, the disclaimers were held to date back to the specification. By the Patents Act, 1852, 15 & 16 Vict., c. 83, s. 29, it was provided that no action should be brought for infringements prior to the disclaimer, except by leave of the law officer.

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SECT. I.

2. **Amendment of the Specification under Patents Act, 1883.**—As soon as a specification has been sent in the Comptroller may require it to be amended: Patents Act, 1883, ss. 7, 9. But if the applicant for the patent, or the patentee, after it has been granted, desire to amend a specification, he must do so under sect. 18 of the Act of 1883: *In re Jones*, Griff. 313. The word patentee means the "person" for the time being entitled to the patent, and thus includes assignees and

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Amendment
of the specifi-
cation under
Patent Act,
1883.

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post, p. 486.

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post, p. 494.

see also post,
p. 550.

personal representatives: 13 & 14 Vict., c. 21, s. 4; Patents Act, 1883, s. 46. Infants or lunatics would be represented, as provided in sect. 99. It may be doubtful whether a mortgagee would be entitled to amend a specification without the mortgagor: (see "Parties to an Action," Chap. XXVIII., sect. 2).

Amendments may, under sect. 18, be made at any time, and from time to time, except when an action for infringement, or proceeding for revocation, is pending: Patents Act, 1888, s. 5. See also Patent Rules, 1890, r. 16, 16A.

3. Amendment of specification when no action is pending, is governed by sect. 18, and the Patent Rules, 1890, 52-59, and Form F. When the amendment has been made and allowed it cannot be afterwards objected to, on the ground that the advertisements were not duly inserted, or that an action was pending, and hence, that the making of it was ultra vires. The order of the Comptroller would be conclusive upon these points: *Farben Fabrik v. Bowker*, 1891, 8 R. P. C. 396.

4. Amendment of specification when an action of infringement or petition for revocation is pending.—The method is first, under sect. 19, to obtain leave of the Court (Patents Act, 1883, s. 117), to apply to the Comptroller, and then to proceed as under sect. 18 (as amended by Patents Act, 1888, s. 5), and Patent Rules, 1890, 55-59, Form F, and see Rule 58 (*per Cave, J.*): *re Hall and Others*, 1888, 5 R. P. C. 312. It is, however, to be noticed, that in this case the amendment will have to be limited to a mere disclaimer. By this it is not meant that words may only be struck out, and none inserted, but that substantially, the essence of the amendment

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474.

must be a disclaimer, and not a correction: *Ralston v. Smith*, 1865, 11 H. L. C. 245; *Thomas v. Welch*, 1866, L. R. 1 C. P. 195. It is to be observed that the necessity for leave of the Court is not necessary when an action for threats is pending. Leave is not necessary after judgment, by which is meant not necessarily the judgment of a Court of Appeal, but the judgment of the Court below, so that after judgment, the fact that an appeal is pending is no objection to the patentee's right to apply to amend without leave: *Cropper v. Smith*, 1884, 1 R. P. C. 254; *Lawrence v. Perry*, 1885, 2 R. P. C. 188; *Haslam v. Hall*, 1887, 5 R. P. C. 24.

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SECT. 4.

Amendment of specification when an action of infringement or petition for revocation is pending.

The application for leave to apply to the Comptroller can be made at Chambers: *Singer v. Stassen*, 1884, 1 R. P. C. 122.

In granting the application, the Court has an absolute discretion as to the conditions which it will impose: *Allen v. Douulton*, 1887, 4 R. P. C. 383; *Lang v. Whitecross Co.*, 1889, 6 R. P. C. 574; *re Lang*, 1890, 7 R. P. C. 469.

In framing these conditions the Court will see that no one against whom the leave is granted is prejudiced: *Goulard v. Gibbs' Patent*, 1888, 5 R. P. C. 191; *Goulard v. Lindsay*, 1888, 5 R. P. C. 193; *Bray v. Gardner*, 1887, 4 R. P. C. 42. As a general rule the terms are that the amended specification shall not be given in evidence at the trial; that no damages shall be recovered for infringements prior to the date of the amendment, and some provision as to the costs in the action; but the terms vary in each case, and evidence of the amended specification has sometimes been allowed to be given, on the terms that no damages should be asked, nor injunction obtained, in respect of anything done before the disclaimer: *Lang v. Whitecross Co.*, 1889, 6 R. P. C. 570.

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tion when an
action of
infringement
or petition for
revocation is
pending.

Examples of the conditions imposed are to be found in *Singer v. Stassen*, 1884, 1 R. P. C. 122; *Winter v. Baybut*, 1884, 1 R. P. C. 76; *Codd v. Bratby*, 1884, 1 R. P. C. 209; and *Fusee Vesta Co. v. Bryant & May*, 1887, 4 R. P. C. 171, in which no conditions as to damages for prior infringement were imposed, and the amended specification was directed to be given in evidence, although those conditions were asked for by the defendant: see *Allen v. Douulton*, 1887, 4 R. P. C. 375; *Haslam Foundry v. Goodfellow*, 1888, 5 R. P. C. 30, where an order was made substantially on the same principle as in the *Fusee Vesta Co. v. Bryant & May*. The application to amend may be made at the hearing, after defendant has closed his case: *Meyer v. Sherwood*, 1890, 7 R. P. C. 283.

Where the Court imposes no conditions the law officer and the Comptroller ought not to do so: *Hearson's Patent*, 1884, 1 R. P. C. 213.

When more than one action for infringement or proceeding for revocation is pending, it is not necessary to get leave to apply to amend in all of them: *Re Hall*, 1888, 5 R. P. C. 310; *Goularū & Gibbs' Patent*, 1888, 5 R. P. C. 194. The practice was formerly different: *Codd's Patent*, Griff. 305.

post, pp. 449,
494.

ante, sect. 3,
p. 216.

5. **Opposition to the amendment** is governed by Patents Act, 1883, s. 18, and Patent Rules, 1890, 53-59, and Form G. Notice of opposition may be given within a month of the first advertisement of the application to amend. The opponent may then within fourteen days from the expiration of the month leave at the Patent Office statutory declarations in support of his opposition (Rule 55), and by Rule 56 the proceedings to the hearing

will go on according to Rules 38-41, as in the case of oppositions to grants of patents. The case is then heard by the Comptroller, from whom an appeal lies to the law officer: Patents Act, 1883, s. 18, s-s. 3. Where an applicant fails to appeal to the law officer, he cannot make a fresh application and then appeal: *Arnold's Patent*, Griff. App. 5. The appeal will be conducted according to the law officer's rules made under s. 38 of the Patent Act, 1883. No appeal lies from the law officer, nor is he "a Court" to which a prohibition can go, if he exceeds his authority: *Ex parte Simon*, 1888, 6 R. P. C. 22. The Comptroller, as well as the law officer, has power to determine whether an opposer has a locus to be heard: *Bell's Case*, 2 Griff. 10. A prior patentee, or a person working according to a patent which he has purchased, but which has expired, is entitled to oppose if the amendment might affect his rights: *Glossop's Patent*, Griff. 285; *Heath & Frost's Patent*, Griff. 288; *Hampton & Facer's Application*, 1885, Griff. App. 13; and compare further the observations on "Opposition to Grants of Letters Patent," Chap. XVI.

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SECT. 5.

Opposition to
the amend-
ment.

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post, p. 457.

post, p. 246.

6. The hearing of the application for leave to amend, and the conditions imposed.—If the application is by leave and an action is pending, as has been seen above, the conditions are fixed by the Court, and not by the Comptroller or law officer; but if no action is pending, both the law officer and also the Comptroller (*Hearson's Patent*, 1884, Griff. 309; *Re Pietschman*, 1884, Griff. 314) have power to impose conditions. One of them might, for example, be compensation to be paid to some opponent who had been put to expense incurred in the belief that the patent was invalid: *Re Pietschman*,

ante, p. 217

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SECT. 6.

The hearing of the application for leave to amend, and the conditions imposed.

1884, Griff. 315; but the Comptroller having no power over costs, could not impose the paying of costs to a partially successful opponent as a condition of being allowed to amend: *ibid.*, p. 314.

Formerly it used generally to be stipulated on the allowance of a disclaimer that no action should be brought in respect of infringements committed prior to the infringement: *Tranter's Patent*, John. Pat. Man., 5th ed. 91; *Smith's Patent*, 1855, M. P. C. 232; *Harrison's Patent*, 1853, M. P. C. 32. But this was not always the case: *Lucas' Patent*, 1854, M. P. C. 239. With regard to patents taken out prior to 1884, it is still generally required that no action should be taken on infringements prior to the amendment: *Re Hearson*, 1884, 1 R. P. C. 213; *Re Cheeseborough*, 1884, Griff. 303; *Re Westinghouse*, 1885, Griff. 315; *Re Ashworth*, 1886, Griff. App. 6. But with regard to patents taken out after 1883 under the new Act, this is not usually done. The reason is, that by the Patents Act, 1883, s. 20, the fact of amending a specification under sect. 18 deprives the patentee of damages for all breaches prior to the amendment, unless the Court is satisfied of the original good faith and reasonable skill and knowledge with which the original specification was framed: *Re Allen*, 1887, Griff. App. 3. But in special circumstances such a condition might still be imposed; *Re Ashworth*, 1886, Griff. App. 9; *Re Hadden*, 1886, Griff. App. 12.

post, p. 450.

A condition might be imposed of allowing an opponent to use machinery which he had in good faith erected, proper precautions being taken for marking and limiting him to the use of what he had already erected: *Edison's Patent*, 1887, Lawson, 64; *Westinghouse Patent*, 1874, Griff. 315; *Hadden's Patent*. Griff. App. 12.

A condition that no action is to be brought in respect of certain machines, means no action on the patent in respect of which the amendment is allowed, but does not prevent proceedings on another patent which those machines may have infringed: *United Telephone Co. v. Globe Telephone Co.*, 1884, 26 Ch. D. 766. When there is a condition that no action shall be brought for infringements prior to a certain date, this covers articles made before that date, even though they may be sold afterwards: *Cheeseborough's Patent*, 1878, Griff. 303.

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SECT. 6.

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The hearing of the application for leave to amend, and the conditions imposed.

7. The nature of the amendments allowed.—Formerly disclaimers only were allowed, but now the power of amendment is wider: Patents Act, 1883, ss. 7, 9, 18. It is to be remembered that the Comptroller can himself require alterations prior to the acceptance of the specifications; and in a proper case, where no harm to anyone can ensue, the Comptroller might, if he chose, spare the applicant the expense of proceeding under sect. 18, and make the corrections under sects. 7 and 9, and it has been laid down by Webster, A.G., that where a patentee desires to limit his invention in his complete specification, and for that purpose to restrict his title and provisional specification, this course ought to be pursued. Thus, where an application has been made for a *dynamo and motor*, and after the provisional specification had been accepted the applicant found the invention inapplicable to motors, the A.G. considered that the Comptroller ought to have accepted the complete specification without mention of motors, and then, under sects. 7 and 9, to have amended the title and the provisional specification accordingly: *Dart's Patent*, Griff. 308. This is a better plan for

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449.

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SECT. 7.

The nature
of the
amendments
allowed.

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the patentee, as it leaves him with a clean unamended patent.

Under the present Act, no limits are placed upon the amendments which the Comptroller may require under sects. 7 and 9; and in pursuance of a requisition to amend, an inventor might re-model and add as much as the Comptroller thought proper to allow. But when an applicant or patentee seeks to amend under sect. 18, he cannot be allowed any amendment which either substantially extends or alters his invention; and if such an amendment were allowed, it might afterwards be considered as vitiating his patent: *Van Gelder's Patent*, 1889, 6 R. P. C. 22; *Nairn's Patent*, 1891, 8 R. P. C. 444. In doubtful cases the amendment ought to be allowed, for it can do no harm; and if it makes the patent bad, that can always be questioned: see *Van Gelder's Patent, supra*; also, *Lake's Patent*, 1887, Griff. App. 16, *Bateman and Moore's Disclaimer*, 1854, M. P. C. 118; *Dudgeon v. Thompson*, 1877, L. R. 3 App. Cas. 34.

Under the old practice it was not allowed, under guise of restricting a specification, to turn it from a vague and general one into a good one by making it more precise, for that would not be restriction, but amendment: *Ralston v. Smith*, 1865, 11 H. L. C. 223; nor could, by disclaimer, a claim for one combination be turned into a claim for another: *Foxwell v. Bostock*, 1864, 4 De G. J. & S. 298. Moreover, disclaimers must be clear and definite, and a reason for a disclaimer is no part of the disclaimer: *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205; see also *Seed v. Higgins*, 1860, 8 H. L. C. 568; *R. v. Mill*, 1850, 10 C. B. 379. On the other hand, not only disclaimers are now allowed but amendments, so that a patentee may correct an error or want of clearness in his specification.

Thus, where a patentee had claimed pipes of "novel form," and it appeared from the specification that he meant not of novel *form* but arranged in a new way, he was allowed to amend: *Re Allen*, 1887, Griff. App. 3. A patentee who had stated that aluminium might be added to molten metal, "shortly before it was poured, or earlier," was allowed to take out those last words: *Re Nordenfeldt*, 1887, Griff. App. 20; but he was not allowed to insert an explanation of the principles of his invention. An alteration in the description was allowed without altering the claims: *Re Lake*, 1887, Griff. App. 16. Where a patentee had patented a blasting cartridge surrounded by a case full of water, substantially as described, and incidentally mentioned that with dynamite, or other water-resisting substances, the case of the cartridge might be dispensed with, and then wanted to amend by leaving out all his main claim, and simply claiming the use of dynamite in water without a case, it was held that he could not do so, as this would be to alter the invention: *Re Heath & Frost*, 1886, Griff. 312; see also *Re Walker*, Griff. App. 22. A patent for a method of re-inforcing electrical contacts, *i.e.*, making them more perfect, could not be altered into one for keeping the contact pieces clean, even though the machinery employed was not altered: *Re Serrell*, 1888, 6 R. P. C. 101; see also *Ryland's Patent*, 1888, 5 R. P. C. 665. One of the most extreme cases in which an amendment was allowed was *Kelly v. Heathman*, 1890, 7 R. P. C. 343. Here a patentee had claimed: (1) A telescopic ladder; (2) a cord to raise it; (3) a bracket lever to secure it. Having found these things to be old, Mr. Macrory very ingeniously struck out all his claims, and suggested an amendment, claiming them in com-

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allowed.

ination only, and then the plaintiff brought an action. North, J., held that this amendment did not vary or extend the invention, because though the plaintiff had originally claimed three things separately, yet it was clear that he had meant to claim only the combination of them. See a paper on this case by Mr. Lloyd Wise. Proceedings of the Institute of Patent Agents, vol. ix. p. 36. An imperfect description of a drawing was allowed to be amended: *Re Morgan*, 1886, Griff. App. 17. Knowledge subsequently acquired is not allowed to be introduced by way of amendment: *Re Beck & Justice*, 1877, Griff. App. 10. If a specification on the face of it admits of two meanings, it may be amended: *Re Ashworth*, 1886, Griff. App. 6; and this may be done though the ambiguity was not pointed out in the applicant's reasons.

No appeal lies from the decision of the law officer as to amendments, and no prohibition would be granted if he wrongly exercised his authority, for a prohibition can only be directed to a Court: *Van Gelder's Patent*, 1888, 6 R. P. C. 28.

8. The amendment when made dates back to and forms part of the original specification: Patents Act, s. 18, s-s. 9, 10.—When leave to amend has been obtained an action may be brought, although the amendment has not in fact been made, for the latter is merely a ministerial act: *Andrew v. Crossley Bros.*, 1892, 9 R. P. C. 165.

9. The title, the provisional (*Dart's Patent*, Griff. 307), and the complete specification may all be amended; so also may the drawings: Patents Act, 1883, s. 18, s-s. 1.

A new grantee may also be added by way of amendment: *Evans & Otway's Patent*, 1884, Griff. 279.

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SECT 9.

The title, the provisional and the complete specification may all be amended.

10. The effect of an amendment which widened the patent beyond its former scope, would not merely be to make the amendment void, but it would vitiate the patent: *Ralston v. Smith*, 1865, 11 H. L. C. 550; *Dudgeon v. Thompson*, 1877, L. R. 3 App. Cas. 55; *Re Goulard v. Gibbs' Patent*, 1888, 5 R. P. C. 189, 7 R. P. C. 367; *Moser v. Marsden*, 1893, 10 R. P. C. 215; *Farben Fabrik v. Bowker*, 1891, 8 R. P. C. 391; but see *Foxwell v. Bostock*, 1864, 4 De G. & S. 298. On the other hand, a disclaimed portion of an invention is open to the use of the public: *The Plating Co. v. Farquharson*, 1883, Griff. 187.

11. An amendment has the effect of depriving the patentee of all right to damages for infringements committed prior to it, unless he can satisfy the Court that his original claim was framed in good faith, and with reasonable care and skill (Patents Act, 1883, s. 20): *Wenham v. Carpenter*, 1887, 5 R. P. C. 68. In *Hopkinson v. St. James Electric Light Co.*, the specification was held to be in good faith, and an account granted as from the date of the patent: 1892, 10 R. P. C. 62. post, p. 450.

12. An amendment may be made out of caution; therefore, the mere fact of making it is not an admission that without it the patent is defective: *Stocker v. Waller*, 1845, 1 C. B. 148, 14 L. J. C. P. 90; but see dictum of Kay, J., *Fusee Vesta Co. v. Bryant & May*, 1886, 4 R. P. C. 72. Formerly a disclaimer was not allowed to assist in explaining the specification. *Tetley v. Easton*, 1857, 2 C. B. (N.S.) 706; but as amend-

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An amend-
ment may be
made out of
caution.

As to rectifi-
cation of the
register.

see post, p. 267.

ments are now allowed, that rule would probably no longer apply.

13. Amendment of clerical errors.—The Master of the Rolls had always power to correct clerical errors in documents enrolled under his care: 1 W. P. C. pp. 641-664; and the Patents Act, 1883, has not taken this power away: *Re Gare's Patent*, 1884, L. R. 26 Ch D. 105; *Re Johnson's Patent*, 1877, 5 Ch. D. 503. He could also even order the enrolment of a patent which had been sent in a day too late, owing to the error of an official: *Adam's Patent*, 1853, 21 L. T. (N.S.) 38; but this power exists only after the patent is sealed, for not till then is it in his custody.

Power also existed for the Master of the Rolls to take a disclaimer off the file which had been filed without the consent of the patentee: *Re Berdan's Patent*, 1875, L. R. 20 Eq. 346, 44 L. J. Ch. 544. Delay would, however, be a bar to such an application: *Re Blumoud's Patent*, 1860, 3 L. T. (N.S.) 800; and in future the usual course will probably be under ss. 18, 91, of the Patents Act, 1883, Form P. This gives the Comptroller power to correct any clerical error in an application, and any error in name, address, etc., of a registered proprietor.

post, pp. 448,
454.

14. Costs of amendments.—The Comptroller has no power over costs, nor can he allow an amendment conditionally on their being paid: *Pietschman's Patent*, 1884, Griff. 314; but the law officer has, and by sect. 38 his order may, on non-payment, be made a rule of Court. He may either fix the costs or else direct how they shall be ascertained: Law Officer's Rules, 11.

post, p. 501.

Costs are generally given against unsuccessful parties,

except that, where a patent is amended a second time, the applicant will rarely get his costs, "for second amendments are not to be encouraged": *Haddan's Patent*, 1885, Griff. App. 12. The Comptroller does not in general either give or receive costs: *Re Lake*, 1887, Griff. App. 16; but the return of the stamp on the notice might be asked for: *Re Morgan*, 1886, Griff. App. 17. The Court, in granting leave to apply to amend pending an action, might perhaps make it a condition that the defendant should have in any event his costs of opposing the amendment; but this is not the usual rule, and Kay, J., having made this condition, revoked it: *Fusee Vesta Co. v. Bryant & May*, 1887, 4 R. P. C. 73; see also *Re Bell*, 1887, Griff. App. 10.

CHAPTER XIII.

PATENTEES.

See also post, p. 541.

CHAP. XIII.
SECT. 1.

*post, pp. 441,
474, 497.*

Form G.

*ante, p. 158,
& P. Act, 1885,
sect. 5, post, p.
476.*

post, p. 274.

1. **Who may take out a patent.**—By the Act of 1883, s. 4, any person, whether a British subject or not (including a body corporate: s. 117, and Patent Rules, 1890, 73) may take out a patent. The patent may be granted to the inventor or inventors, or to the survivor of them, singly or jointly with other persons, who are not the first inventor or inventors. A body corporate, though not likely to be an inventor, might have a patent for an invention communicated from abroad, or else jointly with the true inventor. Questions may arise as to the rights of co-owners of patents, as to which see Chap. XXII., sect. 2.

A person who has obtained knowledge of an invention in a public capacity cannot take out a patent: *Patterson v. Gas Light & Coke Co.*, 1876, L. R. 2 Ch. D. 833, 3 App. Cas. 239.

2. **Infancy, lunacy, married women, and aliens.**—Patents may be granted to infants: Patents Act, 1883, s. 99; *Cheavin v. Walker*, 1877, L. R. 5 Ch. D. 858; married women, lunatics (sect. 99), and aliens, or, at all events, to friendly aliens: *Bloxam v. Elsee*, 1825, 6 B. & C. 178, 9 D. & R. 224; see 1 W. P. C. 418 n.

post, p. 466.

3. **Legal representatives.**—Within six months after the death of an inventor a patent may be applied for by his personal representatives: Patents Act, 1883, s. 34. And if a person who has applied for a patent dies within fifteen months of his application, then the patent may be granted to his legal representatives, and sealed within twelve months after his death: Patents Act, s. 12, sub-s. 3. The legal representatives must furnish an office copy of the will, or letters of administration: Patent Rules, 20. The form of the grant when made is varied to suit the case: see “Grant,” Chap. XVII., sect. 1.

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SECT. 3.

Legal representatives.

post, p. 456.

post, p. 276.

post, p. 446.

post, p. 487.

post, p. 258.

4. **International grants of patents for foreign inventions** are dealt with: Chap. XXXIII.

post, p. 432.

5. **The first and true inventor** must be one at least of the grantees, except where the patent is granted to his legal representatives after his death. The 6th sect. of the Statute of Monopolies, 21 Jac. 1, c. 3, provides for the giving of patents “to the first and true inventor or inventors of such manufactures.” The first and true inventor must be the person who has exercised the ingenuity which is required in every invention, and (subject to what is hereafter said as to servants and workmen), he must have made the invention *himself*, he must not have borrowed it from some other person in the United Kingdom, or from any book, or, it is submitted even from an unpublished manuscript in the United Kingdom. It is clear that if a patentee takes the invention from another person resident in the United Kingdom, he cannot be considered the inventor: *Marsden v. Saville Street Foundry*, 1878, L. R. 3 Ex. D. 203; *Barber v. Waldeck*, 1828, 1 C. P. C. 438. In *Tenant’s Case*, 1802,

ante, p. 228.

post, p. 247.

CHAP. XIII.
SECT. 5.

The first and
true inventor.

1 W. P. C. 125, a patent was held invalid on the ground (*inter alia*) that the patentee had received part of his invention from a chemist who communicated it to him.

It will be observed that the words of the statute refer not only to the true, but the first inventor. It might seem as though, if a prior inventor had used an invention in secret, a subsequent inventor could not be called the *first* inventor. This doubt has, however, been removed by decisions, and it is now clear that by the first inventor is meant, not the first in point of time, but the first who applies for the patent: *Dollond v. Champness*, 1766, 1 W. P. C. 43; see also *Bramah v. Hardcastle*, 1789, Holroyd, 81, 1 W. P. C. 44. "There may be several rivals starting at the same time; the first who comes and takes a patent, it not being generally known to the public, that man has the right to clothe himself with the authority of the patent, and enjoys the benefit of it" (*per* Tindal, C.J.): *Cornish v. Keene*, 1835, 1 W. P. C. 508, 2 Hodg. 294, 3 Bing. N. C. 588; *Lewis v. Marling*, 1829, 1 W. P. C. 496; and see further "Anticipation," Chap. V., sects. 2, 3, 7, which shews that secret user of the patent, or even abandoned user in public, of something which closely resembles the patent, will not avoid it, or prevent the patentee from being considered the first and true inventor.

ante, p. 142.

6. The assistance of servants and workmen.—As inventors naturally often have assistants, the question early arose how far their co-operation prevented a patentee from being the first and true inventor, and how far the results of the inventive power of a man, exercised when in the service of another, remained his own property.

In the first place, it is clear that if a servant in the

employ of his master makes an invention, the invention is the invention of the servant, and not of the master, and the servant is the proper patentee: *Bloxam v. Elsee*, 1825, 1 C. & P. 558; *Homan's Case*, 1889, 6 R. P. C. 104; *Heald's Patent*, 1891, 8 R. P. C. 429. This was assumed throughout in *Siddell v. Vickers*, 1888, 5 R. P. C. 93; see also *Saxby v. Gloucester Waggon Co.*, 1880, Griff. App. 56.

But an inventor may employ a servant to assist him, and in that case the question will be, Who really invented it? "If Sutton (the assistant) suggested the principle to Minter, then he would be the inventor. If, on the other hand, Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak. . . . Suppose two persons engaged on an invention of this description. They know perfectly well between themselves who is the real inventor of it, and who is the workman to carry into effect the conception; but they would destroy the value to both if they did not take it out in the name of the right person" (*per Alderson*): *Minter v. Wells*, 1834, 1 W. P. C. 132; compare *R. v. Arkwright*, 1785, D. P. C. 61; *Barker v. Shaw*, 1823, 1 W. P. C. 126, n. Valuable discoveries accessory to the main principle, and tending to carry it out in a better manner, if made by engineers, agents, and other persons to assist an inventor, will not make his patent bad: *Allen v. Rawson*, 1845, 1 C. B. 551; *Kurtz v. Spence*, 1888, 5 R. P. C. 181. In this case the improvements are those of the master, and the servant cannot patent them: *David & Woodley's Application*, 1888, Griff. App. 26.

But in some cases the master and servant will both be held interested in the patent, and on opposition by one of them to its being granted to the other, the Court may direct that it shall be vested in trust for both: *Russell's*

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ance of
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workmen.

Patent, 1857, 2 De G. & J. 130; *Healey's Application*, 1872, John. 165 (see further as to this subject, "Opposition to the Grant," Chap. XVI. *post*, p. 246).

7. Inventions imported or communicated from abroad.—In the earlier cases it was held that under the word "invent" might be included the "bringing in" from abroad. Thus, one Edisbury or Edgebury had described himself as "an inventor" of certain rollers for carriages. In the case of *Edgebury v. Stephens*, 1691, 1 W. P. C. 35, it was held that, whether learned by study or travel, it is the same thing. "A man has a right to a patent, not only for his own original invention, but . . . if he is the first person who brings into England an invention which is used abroad and not known in England" (*per Abinger, C.B.*): *Carpenter v. Smith*, 1841, 1 W. P. C. 536. In Lombes' Act of Parliament, the words, "his invention" are applied in a case in which it is clear that the invention was obtained from abroad: 1 W. P. C. 38; and see *Walton v. Bateman*, 1842, 1 W. P. C. 615; *Nickels v. Ross*, 1849, 8 C. B. 679. In *Beard v. Egerton*, 1846, 3 C. B. 97, it was expressly held that a patent might be granted to a British subject in his own name *as an inventor*, but really in trust for an *alien amy* resident abroad. Where, therefore, a man has derived an invention from abroad in his travels but from no particular person, it seems clear that he can describe himself as the first and true inventor, and take out the patent as for his own invention and in his own name. But where the patent has been expressly communicated by some person living abroad, then, inasmuch as under the Patent Rules of 1890, made by virtue of s. 101 of the Patents Act, 1883, a special form, A1, has been set out for applications

post, pp. 488,
510

ante, p. 192.

or patents communicated from abroad, it is better to adopt that form, though it does not seem to have been definitely decided whether it is absolutely necessary to do so. The point partly arose in *Avery's Patent*, 1887, 4 R. P. C. 152, 322; 36 Ch. D. 307. The patent had been taken out by one Lindsay in his own name as his invention, though in reality it was a communication from abroad, but upon which he had made certain improvements. On petition for revocation by the person who alleged he had communicated it, on the ground of fraud, Stirling, J., inclined to the opinion that, so far as the form went, it was good, for that the word "inventor" included an importer. The same point was raised but not decided in *Moser v. Marsden*, 1893, 10 R. P. C. 216. In *Milligan v. Marsh*, 1856, 2 Jur. (N.S.) 1083, the question also partly arose. Further examples of patents granted to importers even against the opposition of the foreign inventors will be found under "Opposition to the Grant," Chap. XVI., sect. 4.

CHAP. XIII.
SECT. 7.

Inventious
imported or
communi-
cated from
abroad.

post, p. 247.

In *Re Wirth's Patent*, 1879, L. R. 12 Ch. D. 303, it was decided that a patent might be granted to an alien resident abroad, for an invention communicated to him by another alien resident abroad. This decision followed logically the principles that an importer might be considered as an inventor, and that a patent could be granted to an alien resident abroad. But now, by notice April 21st, 1884, P. O. J. May 9th, 1884, the Patent Office has announced that no such patents will in future be granted, and the Form of Application A1, naming the "county" of the applicant, will prevent a foreigner from applying for a patent for a communication from some one else. It is to be noticed that Form A does not contain this word of description of the applicant's address. (As to "Extension," see p. 329.)

post, p. 510.

CHAP. XIII.
SECT. 8.
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post. p. 462.

post. p. 281.

8. Meaning of the word "patentee."—The word "patentee" means in the Act the person for the time being entitled to the patent, and includes executors, administrators, and assigns: 13 & 14 Vict. c. 21, s. 4, and Patents Act, 1883, s. 46. When a patent is mortgaged, the mortgagor is the "patentee." See also as to personal representatives, Chap. XXII., sect. 7, and as to assignees generally, Chap. XXII.

CHAPTER XIV.

PATENT AGENTS.

1. Patent agents, though employed before the Patents Act, 1888, were for the first time recognised by that Act:

s. 1. The only privilege a patent agent apparently has, is that no one else has a right so to call himself under a penalty of £20. By merely writing "Agent for X.," a man does not render himself liable to this penalty: *Graham v. Fanta*, 1892, 9 R. P. C. 164. Communications with a patent agent are not privileged like those with a solicitor: *Moseley v. Victoria Rubber Co.*, 1886, 3 R. P. C. 355; and he is liable to his principal for fraud or misconduct: *Lee v. Walker*, 1872, L. R. 7, C. P. 121. The relation of agent to a patentee creates the duty of exercising uberrima fides, so that an infringement by him is to be more strictly viewed than one by a rival manufacturer: *Wheatstone v. Wilde*, 1861, Griff. 247. In order to become a patent agent it is necessary to be placed on the Register of Patent Agents; and for this purpose a preliminary examination must be passed or else a university matriculation, or Civil Service examination, or else the candidate must have been for seven years pupil or assistant of a registered patent agent or agents. A final examination in patent law is in all cases necessary. The law regulating the admission of patent agents on the register is governed by the rules of the Board of Trade, made on June 11th, 1889. They are not officers

CHAP. XIV.
SECT. I.

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post, p. 479;
see also P. R.,
8, post, pp. 484,
533.

CHAP. XIV.
SECT. 1.

Patent agents.

post, p. 533.

post, p. 613.

of the High Court of Justice, but of the Board of Trade, by whom their names may be removed from the register for misconduct or other specified causes.

In August, 1891, the Institute of Patent Agents was re-incorporated by Royal Charter. Mere registration as a patent agent does not make the person so registered a member of the Chartered Institute of Patent Agents. (A description of the objects of the Institute is given in the President's address, November, 1891.) On November 18, 1891, a set of rules was made applying the rules of 1889 to the Chartered Institute.

The rights and privileges granted to patent agents do not seem to be commensurate with the duties and responsibilities imposed upon them. They have no lien on documents, such as a solicitor possesses, though no doubt they have the usual common law lien on any document which they themselves have prepared or procured, or in respect of which they have paid fees or other money.

post, p. 536.

The Patent Agents' rules provided for the payment of an annual fee. This rule has been held invalid and ultra vires by the Scotch courts: *Chartered Institute of Patent Agents v. Lockwood*, 1893, 10 R. P. C. 167. (An appeal has been lodged against this decision.)

post, p. 553.

Lists of patent agents can be purchased.

Elsewhere the very unsatisfactory state of the law relating to patent agents has been pointed out, and every day the number of unqualified persons who pretend to be patent agents is increasing. Ignorant inventors are being lured into taking out patents for inventions that are clearly old, and it is high time that a remedy should be applied to the evil. See the Presidential Address by Mr. Lloyd Wise to the Institute of Patent Agents, 1891. Proceedings, vol. x. p. 59; also a paper by A. V. Newton, *ibid.*

CHAPTER XV.

PROCEDURE TO OBTAIN A PATENT.

[N.B.—For further details of Procedure the circular of information published by the Patent Office may be usefully consulted. It is printed in the Appendix.] *post*, p. 541.

1. Whether to send in a provisional specification or a complete specification in the first instance.—There are two modes in which an inventor may proceed to take out a patent, viz., to file a provisional specification, and then, within nine months, to follow it with a complete specification, or else to file a complete specification at once. In considering which of these courses to pursue, it is to be remembered that the date of the patent, from which its life begins to run, is the date of the application: Patents Act, 1883, s. 13. The first date after which damages can be recovered is the date of the publication of the complete specification; but no legal proceedings can be commenced till the patent is sealed: sect. 15. A provisional specification, if abandoned, is not published, and hence does not prejudice a second or a third application for the same or another invention: Patents Act, 1885, s. 4. *post*, p. 447.

CHAP. XV.
SECT. I.
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From one point of view it is, of course, desirable to have an early date for the patent, for from the date of application no subsequent publication of the invention, or independent discovery of it by another, can vitiate it: Patents Act, 1883, s. 14. Hence, then, it may often be desirable to apply as early as possible, even before the *post*, p. 447.

CHAP. XV.
SECT. 1.

Whether to
send in a
provisional
specification
or a complete
specification
in the first
instance.

ante, p. 171.

invention is complete in detail. On the other hand, its life begins to run from the date of the application; and hence, if the inventor could be certain that his discovery would not leak out or be made independently, he would desire to commence the life of the patent only when he was completely ready to carry it out, and obtain the acceptance of the complete specification as soon as possible after his application. The reason why inventors usually commence with the provisional specification is, that after that date they can then shew the invention to capitalists; and hardly any invention is thus shewn without suggestions in detail being made to render it more likely to be a commercial success, which details can then be embodied in the complete specification. Besides, inventors often draw their provisional specifications very badly, and then, if they succeed in finding a capitalist, the matter is placed in the hands of some patent agent in whom the capitalist has confidence, and it is not too late either to draw a really good complete specification, or, if needful, to abandon the old provisional specification and commence *de novo*. If it is possible to file a complete specification at once, there is this further advantage, that the risk of disconformity is avoided: see "Provisional Specification," Chap. VII., sect. 3. On the other hand, however, there is a danger in filing the complete specification too soon. For when it becomes public, all those who have pending applications, that is to say, who have sent in their provisional specifications, but not yet sent in their complete specifications, would be able to take from the complete so sent in any parts that pleased them, and which they could include within the limits of their provisional specifications; and as their date of application

would be prior to that of the inventor whose case we are considering, they could pilfer from him with impunity. From these considerations we derive the result, that where an invention is very original, quite complete, and not the least likely to be the subject of contemporaneous patents, an inventor, having scanned all pending applications, and finding that there is none whose title could cover his patent, might send in a complete specification in the first instance. In all other cases his wisest course would be to apply provisionally, and wait the full nine months before sending in his complete specification. (This question is very skilfully discussed by Mr. Lloyd Wise, in *Engineering*, date Jan. 29th, 1886.)

CHAP. XV.
SECT. I.

Whether to send in a provisional specification or a complete specification in the first instance.

2. Procedure in sending in an application.— *post*, p. 542.
Having determined upon a title, and decided on the scope and nature of the invention, and fixed upon the parties who are to be the applicants (see “Who may be a Patentee,” Chap. XIII., s. 1.), the applicant procures from the Royal Courts of Justice, Strand, London, or else from any money order office in the United Kingdom, Form A or A1, as the case may be, for which he will pay £1. At the same time two copies of Form B will be given to him, which he must fill up carefully without erasure: Patents Act, 1883, s. 5. No stamp is required for them. (Paper suitable for continuations of Form B can be got at any law stationer’s, known as patent paper.) He then sends in the application and the provisional specification to the Comptroller: Patent Rules, 1890, 18. Where needful a drawing must accompany the provisional: Patents Act, 1883, s. 5, sub-s. 3. But this is not commonly done, for the object of the provisional is not to describe how to perform the invention, but to identify it: Chap. VII., s. 2. *ante*, p. 169.

ante, p. 228.

post, p. 508.

post, p. 497.

post, p. 441.

post, p. 484.

post, p. 487.

post, p. 326.

ante, p. 169.

CHAP. XV.
SECT. 2.

Procedure in
sending in an
application.

post, p. 456.

post, p. 463.

post, p. 442.

ante, p. 161.

These are then submitted to an examiner (Patents Act, 1883, s. 6), whose duty is to report upon whether the nature of the invention has been fairly described, whether the application and specification are in due form, whether the title sufficiently indicates the subject-matter, and whether the specification includes more than one invention: Patents Act, 1883, s. 33; or whether it contains anything contrary to law or morality: Patents Act, 1883, s. 86.

As to the provisional specification, see sect. 5, sub-s. 3, and as to title, see Chap. VI. The question what constitutes "one invention" was discussed in *Jones' Patent*, Griff, 265. Lord Herschell (then A.-G.), said: "If you have a particular general (*sic*) object of an invention to make rails rest more securely, and you describe one, or two, or three devices of an analogous nature, cognate devices for carrying it into effect, I should say it was one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' . . . it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention. But if you say, 'I have invented six different kinds of railway sleepers,' each of which has its own merits, and purposes, and objects, then those are six inventions." An application was made for a patent for "improvements in rapidly heating water, a part of which improvements is applicable to other purposes." The invention consisted in a means of interlocking taps, so that they could only be turned on or off in a certain order. It was stated that this plan was also useful for the cocks of oxy-hydrogen and other apparatus. It was pointed out by Davey, S.G., that he might either have a patent for his combination of cocks, or for its

application to geysers, or for its application to oxy-hydrogen apparatus, but that these were distinct inventions, and required separate patents: *Hearson's Patent*, 1886, Griff. 266. Again, another inventor who proposed to patent "improvements in the art of producing and utilising induced electrical currents *for telegraphic and other purposes*," was informed that he could either patent it for *all* purposes, or else take out separate patents for its application to telegraphy and for its application to other subjects. The inventor preferred the former alternative, and the words in italics were struck out; *Robinson's Patent*, Griff. 267. An inventor who has included more than one invention in his application may amend it so as to apply to one invention only, or may make application for separate patents for the different machines: still preserving the date of his application. Patent Rules, 1890, 19.

CHAP. XV.
SECT 2.
—
Procedure in sending in an application.

3. If the patent is contrary to law or morality it may be refused: Patents Act, 1883, s. 86. A patent for a lottery machine has been thus refused: Griff. 20.

4. The report of the examiner is private, but may in certain cases be produced: Patents Act, 1883, s. 9, sub-s. 5. If the report is against the applicant he will receive by letter an intimation of the fact, and be required to amend or correct his application or specification. But he may appeal if he please from the decision of the Comptroller to the law officer: Patents Act, 1888, s. 7; and see Law Officer's Rules made under sect. 38. The Comptroller is not bound to follow the examiner's report: *C's Application*, 1890, 7 R. P. C. 250.

5. Acceptance of the application and provisional

CHAP. XV.
SECT. 5.

Acceptance of
the applica-
tion and
provisional
specification.

*P. Act, 1883,
sect. 8, post,
p. 382, and
p. 371.*

*As to Sundays
and holidays,
see sect. 98,
post, p. 350.*

specification.—As soon as the Comptroller is satisfied with the application and provisional specification, he will intimate by letter that they have been accepted, and publish a notice of the acceptance in the official journal: Patent Rules, 1890, r. 21. The patentee has now got nine months from and exclusive of the day of application to send in his complete specification, which may be extended for one month more. The date of the application is the day on which it is received at the Patent Office, not the day on which it is dated. The last day of sending in the complete specification is the same day of the month nine months on. Thus, an application dated, say, March 20th, might be received at the office on March 21st. This would be the date of the application and of the patent. The complete would then have to be in the office on December 21st. Documents are received up to twelve midnight by the policeman on duty if the other officials have gone home.

6. Sending in the complete specification.—This is done on Form C, in duplicate, stamped with £3, and is accompanied by duplicate drawings (a specimen of which is to be found in the copies of the Patent Rules, 1890, which are supplied by the Patent Office, price 6*d.* It is also printed in Griffin's Patent Cases, p. 326.) If a drawing has been sent in with the provisional specification, it will be sufficient to refer to it if no further one is needed: Patents Act, 1886, s. 2. The drawings must be carefully prepared, according to Patent Rules, 1890, rr. 30–33. They should be clear, and black, to facilitate photo-lithographic reproduction. As to the complete specification, see Chap. VIII. It must conform to the provisional, and should end with claims: Patents Act, 1883, s. 5, sub-s. 5;

ante, p. 201.

post, p. 477.

*post, pp. 489,
544.*

ante, p. 178.

post, p. 442.

though this is not fatal to its validity if it have been passed by the Comptroller: see "Claims," Chap. IX. By a distinct claim is meant more than a merely colourable evasion of the requirements of the Act; but when once there is a clear claim, the Comptroller has no power to reject the application, because the claim goes beyond the description: *Smith's Patent*, 1884, Griff. 268.

CHAP. XV.
SECT. 6.
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Sending in
the complete
specification.
ante, p. 195.

For the purpose of seeing whether the complete specification is in due form, and whether it conforms to the provisional, it will be submitted to an examiner, who will report upon it: Patents Act, 1883, s. 9; and if his report is unsatisfactory, the applicant will, by letter, be required to amend it.

ante, pp. 215,
221.

If he please, the Comptroller who has required alterations to be made may postpone the date of the patent till his requirements are complied with: Patents Act, 1888, s. 2. The patentee can, if he please, appeal to the law officer: Patents Act, 1883, s. 9, sub-ss. 2, 3, and Law Officer's Rules; and see *e.g.*, *Re Everitt*, 1886, Griff. App. 27.

post, p. 444.

In the case of *Grenfell v. McEvoy's Patents*, the curious point was raised whether, when two persons had jointly applied for a patent, and jointly sent in a provisional specification, they could sever, and each send in a complete specification. This was not decided, but it was decided that one could proceed with the complete specification if he pleased, and that it need not be signed by both: 1890, 7 R. P. C. 151.

The fact that the complete specification is narrower than the provisional is no ground for the Comptroller refusing to accept it: *Re Everitt*, Griff. App. 27; but in that case he may, and ought to, require the applicant to amend the title and provisional if needful: *Dart's Patent*, Griff. 307.

ante, p. 221.

CHAP. XV.
SECT. 7.

post, p. 445.

post, p. 487.

post, p. 447.

post, p. 552.

7. Acceptance of the complete specification.—As soon as the complete specification is accepted, the acceptance of it is published in the official journal, and the application, specifications, and drawings are open for public inspection: Patents Act, 1883, s. 10. The Comptroller also gives notice to the applicant: Patents Act: s. 7. sub-s. 4; Patent Rules, 1890, rr. 21, 22. This is an important date, as from it the possibility of infringement begins: Patents Act, 1883, s. 13. The specifications appear in print for sale about three weeks afterwards, and abstracts of them are given in the Patent Office Journal.

post, p. 444.

If the complete specification is not accepted within twelve months from the date of the application, or within a further extended period of three months, then, except where an appeal against a refusal to accept is pending, the application is void: Patents Act, 1883, s. 9, sub-s. 4.

ante, p. 237.

8. Sending in the complete specification with the application: Patents Act, 1883, s. 5, sub-s. 4; as to the advisability of this, see Chap. XV., sect. 1.

post, p. 480.

9. Rival applications; interference.—If, after a patent had been applied for, but before it had been sealed, a second application came in bearing the same or a similar title, it was, under the Patents Act, 1883, customary to give an interference notice to the first applicant, and to let the two applicants dispute the question before the Comptroller, under s. 7, sub-ss. 5 and 6. But by the Patents Act, 1888, s. 2, this was changed: see Chap. XVI. No such notices are now sent, but the second applicant may at any time within two months of the grant of the patent on the first application abandon his application,

or surrender his patent if it have been granted: see Chap. XVI., sect. 2 (*post*, p. 246).

CHAP. XV.
SECT. 9.

Rival applications; interference.

10. Powers of the Comptroller.—The Comptroller may require any applicant to give a written or oral explanation of any matter: Patent Rules, 1890, 13; and in all these cases of discretionary power of the Comptroller he is required (Patents Act, 1883, s. 94; Patent Rules, 11, 13), before deciding, to give ten days' notice to the applicant that he may be personally heard. If the applicant desires to be heard, he should then, within five days, give notice on Form E (£1 stamp): Patent Rules, 1890, r. 12. The Comptroller always notifies his decisions to the applicant: Patent Rules, 1890, r. 14. He has no power to award costs.

post, p. 485.

post, p. 465.

11. An appeal lies to the law officer from any decision of the Comptroller: Patents Act, 1883, s. 9, sub-s. 3. The Comptroller neither asks nor gives costs: see further Chap. XVI., sect. 8.

post, p. 444.

post, p. 255.

12. Amendments of the specifications have been already dealt with in Chap. XII.

ante, p. 215.

13. Constitution of the Patent Office and powers of the Comptroller are dealt with in Patent Act, 1883, ss. 82, 83, 102; and it is provided that he cannot exercise a discretion adversely without affording the person affected an opportunity of being heard: sect. 94; Patent Rules, 11-14. He may also dispense with evidence: Patent Rules, 80; and may refer doubtful questions to the law officer.

post, p. 462.

post, pp. 465, 485, 499.

post, p. 465.

CHAPTER XVI.

OPPOSITION TO THE GRANT OF A PATENT.

CHAP. XVI.
SECT. 1.
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1. **Before the Patents Act, 1883**, opposition to patents was regulated by the Patents Act, 1852, ss. 12, 13, 14, and the rules thereunder, and objections were referred to the law officer, and also could be taken before the Lord Chancellor. As a general rule, the sealing of the patent was not refused, except in a very clear case, on the ground that the effect of the refusal would be irreparable: *Russell's Patent*, 1857, 2 De G. & J. 130; *Spence's Patent*, 1859, 3 De G. & J. 523; *Ex parte Sheffield*, 1872, L. R. 8 Ch. 237, 42 L. J. Ch. 356.

2. **Procedure under the Patents Act, 1883.**—The old procedure is now abolished, and oppositions may now be made within two months after the advertisement of the acceptance of the complete specification, on which date the applications, specifications, and drawings become open to public inspection: Patents Act, 1883, s. 10. The procedure is regulated according to Patents Act, 1883, s. 11, Patents Act, 1888, s. 4, Patent Rules, 34–44, and Form D. In *Brennaud's Patent*, 1861, 7 Jur. 690, an extension of time for opposing was granted. See a paper by Mr. Lloyd Wise, in the "Proceedings of the Institute of Patent Agents," vol. 8, p. 90.

post, pp. 445,
491.

3. **Grounds of opposition.**—The only grounds upon which an opposition may be made are those specified in s. 11 of Patents Act, 1883, as amended by Patents Act, 1888, s. 4. In substance they are: (a) That the applicant has derived the invention from the opponent or an invention of whom the opponent is the legal representative, or his legal representatives; (b) That the invention has already been patented on an application of prior date; (c) That the applicant, after lodging his provisional specification, has incorporated into his complete specification a different invention, for which the opponent has, in the interval, applied for a patent.

4. **Opposition on the ground that the invention has been obtained from the opponent.**—The obtaining must be within the United Kingdom, and not abroad. For an introducer is on the same footing as an inventor. Hence, no opponent can appear to say that the applicant has merely got the invention from him abroad: *Edmunds' Patent*, 1886, Griff. 281; *Bairstow's Patent*, 1888, 5 R. P. C. 287; *Lake's Patent*, 1888, 5 R. P. C. 415; *Spiels' Patent*, 1888, 5 R. P. C. 281; *Higgins' Patent*, 1892, 9 R. P. C. 74; see also Chap. XIII., sect. 7.

ante, p. 232.

But even when the applicant obtained the invention from the opponent with his consent in the United Kingdom, the patent was refused, as the applicant was not the first and true inventor: *Marshall's Patent*, 1888, 5 R. P. C. 661.

ante, p. 229.

It is to be observed, that only the person from whom the invention has been obtained, or his legal representative, can oppose under this section, and it has been held that an assignee of an assignee is not sufficiently a "legal representative": *Spiels' Patent*, 1888, 5 R. P. C. 281; and it has been queried whether a person holding a power of

CHAP. XVI.
SECT. 4.

Opposition on the ground that the invention has been obtained from the opponent.

attorney is a "legal representative": *Edmunds' Patent*, 1886, Griff. 280. Probably the words here have the same meaning as in Patents Act, 1883, s. 34.

An opposition was made on behalf of a workman to a grant to his employer, but it was considered that the workman in that case had only suggested improvements which belonged to his employer: *David's & Woodley's Patent*, 1886, Griff. App. 26; *Homan's Patent*, 1888, 6 R. P. C. 104; see further, Chap. XIII., sect. 6 (p. 230).

In the following cases the opposition was successful: *Paterson & Dundon's Patent*, 1886, Griff. 295; *Griffin's Patent*, 1888, 6 R. P. C. 296.

In order that a patent may be refused on the ground that the invention was obtained from the opponent, the evidence must be very strong indeed; for that ground of opposition could always be employed to overturn the patent in an action: *Stuart's Application*, 1892, 9 R. P. C. 452.

Cases, however, may arise in which the idea of the invention has been got from an opponent, and yet has been so improved upon as to change the character of the invention. In these instances it is not necessary that the patent should be absolutely refused. Conditions may be imposed. Thus, where Hoskins had obtained from Needham an idea of a cot, held, he might have a grant, but on condition of stating that it was an improvement on a cot for which Needham had taken out provisional protection: *Hoskins' Patent*, 1884, Griff. 291; followed in *Newman's Patent*, 1887, 5 R. P. C. 279. Cutting and Evans had been experimenting together, and Cutting took out a patent which Evans did not oppose. Subsequently, Evans and Otway (a capitalist) applied for a

patent, which Cutting opposed. Held, that a patent would be granted to Evans and Otway on condition that Cutting and Evans each assigned half his patent to the other. Otway subsequently disappeared and could not be found, so finally an order was made that a patent be *not* granted to Evans upon Cutting assigning to him half of his patent: *Evans' Patent*, 1885, Griff. 279. Tatham opposed Luke's application on the ground that Luke had obtained the invention from him. The law officer made them share the patent, and provided for the event of either of them refusing to carry out his order: see the form of order, *Luke's Patent*, 1886, Griff. 294. Where B. had communicated an idea to E., who improved upon it, and suggested a joint patent, on B.'s opposition the patent was directed to issue to B. and E. jointly: *Eadie's Patent*, 1885, Griff. 279. King and Garthwaite were joint inventors, and had each applied for a patent. On King's opposition to Garthwaite's patent, it was held, that they must either have a joint patent or else each take out a patent and assign one half to the other: *Garthwaite's Patent*, 1886, Griff. 284.

CHAP. XVI.
SECT. 4.

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Opposition on the ground that the invention has been obtained from the opponent.

5. **Opposition on the ground that the invention had been previously patented on an application of prior date.**—This was formerly a well known ground of opposition: see, *e.g.*, *Stoll's Patent*, 1853, 21 L. T. 233; *Tolson's Patent*, 1856, 6 De G. M. & G. 422; *Ex parte Yates*, 1869, L. R. 5 Ch. 1; *Manceaux's Patent*, 1870, L. R. 6 Ch. 272, 18 W. R. 1184; *In re Scott & Young*, 1871, 19 W. R. 425.

It is not open to anyone to oppose on the ground that a prior patent for the same invention exists: *Hookham's Patent*, 1886, Griff. App. 32. The opposer must be the

CHAP. XVI.
SECT. 5.

Opposition on the ground that the invention had been previously patented on an application of prior date.

prior patentee, or else a licensee of the prior patentee: *Hill's Application*, 1888, 5 R. P. C. 599; *Webster's Application*, 1888, 6 R. P. C. 165; or one who has purchased the prior patent, or worked under it, even though it has expired: *Glossop's Patent*, 1884, Griff. 285. But merely to have manufactured according to the prior patent is not sufficient: *MacEvoy's Application*, 1888, 5 R. P. C. 285; nor to be intending to use the prior patent: *Bairstow's Patent*, 1888, 5 R. P. C. 286; nor has the agent of a prior patentee a locus to oppose: *Heath & Frost's Patent*, 1886, Griff. 288.

post, p. 447.

An objection on the ground of a prior patent is equally good whether the prior patent has or has not expired: *Lancaster's Patent*, 1884, Griff. 293. An accepted prior complete specification is, for the purpose of opposition, sufficient, though the patent may not yet have been sealed, by virtue of s. 15, Patents Act, 1883: *L'Oiseau & Pierraud's Application*, 1886, Griff. App. 36. But a prior provisional specification for the same invention is not enough: *Bailey's Patent*, 1886, Griff. 269; nor, again, is a mere right to have a patent antedated under s. 103, Patents Act, 1883: *Everitt's Application*, 1888, Griff. App. 28.

post, sec. 6,
p. 253.

But it is no objection to the sufficiency of a prior patent as giving locus to oppose that the invention has been put in the complete specification, but is not contained in the provisional: *Green's Patent*, 1886, Griff. 286; *Haythornthwaite's Application*, 1890, 7 R. P. C. 70.

A prior invention that has been merely *described*, but not claimed, will not afford a ground of opposition: *Von Buch's Application*, 1887, Griff. App. 40.

The earlier view, that patents are not to be refused on mere suggestion of prior patents having been taken out

for the same invention, has been re-affirmed in the cases since 1883. "I am not here to stop patents, and certainly not at the instigation of an opponent because there is some general principle of patent law that has been infringed": *Newman's Patent*, 1887, 5 R. P. C. 277; *McHardy's Patent*, 1891, 8 R. P. C. 432; *Re Todd*, 1892, 9 R. P. C. 487. "By allowing a specification in any particular form no harm is done to persons who have a prior patent . . . but the law officer is bound to protect the public, so that they may not be misled" (*per Webster, A.G.*); opposition disallowed: *Lorrain's Patent*, 1888, 5 R. P. C. 143; *Hill's Application*, 1888, 5 R. P. C. 599. In *Tattersall's Patent* it appeared that the second patent for a blower was very similar to the first on which the opposition was based, except that it provided for a receiver into which the blown air was to be gathered before being used. Held, that this was a possible improvement, and the second patent (subject to the insertion of a disclaimer of the first), was allowed to go: 1892, 9 R. P. C. 150; *Atherton's Application*, 1889, 6 R. P. C. 547. A real dispute as to an anticipation will not be tried under guise of an opposition, nor for that purpose will evidence be taken before the law officer: *Lake's Application*, 1889, 6 R. P. C. 548. Examples of successful opposition on the ground of a prior patent are to be found in *Daniel's Patent*, 1888, 5 R. P. C. 413; *Aire & Calder's Patent*, 1888, 5 R. P. C. 345; *Wallis & Radcliffe's Patent*, 1888, 5 R. P. C. 347; *Webster's Patent*, 1888, 6 R. P. C. 163; *Re Bailey*, 1887, Good. Prac. Cas. 57; *Boult's Patent*, 1893, 10 R. P. C. 275. The alleged anticipation must be clear and definite, and not depend on the piecing together of a number of prior patents: *Re Ross*, 1891, 8 R. P. C. 477.

CHAP. XVI.
SECT. 5.

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Opposition on the ground that the invention had been previously patented on an application of prior date.

Unsuccessful oppositions—*Pitt's Patent*, 1888, 5 R. P. C.

CHAP. XVI.
SECT. 5.

Opposition on the ground that the invention had been previously patented on an application of prior date.

343; *Dundon's Patent*, 1885, Griff. 278; *Huth's Patent*, 1884, Griff. 292; *Fletcher's Patent*, 1889, Griff. App. 30; where the inventions were almost, but not quite, identical. See also *Cumming's Patent*, 1884, Griff. 277; *Stubbs' Patent*, 1884, Griff. 298; *Jones' Patent*, 1885, Griff. App. 33.

It is frequently usual, upon an opposition to a grant on the ground of a prior patent, to impose on the applicant the condition of disclaiming the prior invention: *Curtis v. André*, 1892, 9 R. P. C. 495. The disclaiming clause must disclaim not merely the invention as described, but as claimed: *Gozney's Application*, 1888, 5 R. P. C. 597. Sometimes a specific disclaimer naming the prior patent is required: *Hall & Hall's Patent*, 1888, 5 R. P. C. 283; *Welch's Patent*, 1885, Griff. 300; *Airey's Patent*, 5 R. P. C. 348; *Lynde's Patent*, 1888, 5 R. P. C. 663; and this specific disclaimer is especially enforced when the applicant's patent contains a specific reference to the prior patent: *Hookham's Patent*, Griff. App. 32; *Wallace's Patent*, 1888, 6 R. P. C. 134; or again, where the prior patent is a "master patent": *Hoffman's Patent*, 1890, 7 R. P. C. 92. But otherwise specific mention of previous patents in disclaimers is not generally desirable: *Andersen & Mackinnell's Patent*, 1887, Griff. App. 25, approved in *Sielaff's Application*, 1888, 5 R. P. C. 484; *Guest & Barrows' Patent*, 1888, 5 R. P. C. 312; *Stell's Patent*, 1891, 8 R. P. C. 235; *Kilner's Patent*, 1891, 8 R. P. C. 35; *Welch's Patent*, 1891, 8 R. P. C. 442; and where a disclaimer might prejudice the construction of a patent a similar reference to the prior patent may be sufficient: *Van Gelder's Patent*, 1892, 9 R. P. C. 325. A successful opponent is sometimes allowed to elect whether applicant's claim should be struck out or a disclaiming clause inserted: *Teague's Patent*, 1885, Griff. 298.

6. Opposition on the ground that the applicant is seeking to put into his complete specification an invention for which the opponent has applied for a patent in the interval between the applicant's provisional and complete specifications: *Ander- sen & Andersen's Patent*, 1890, 7 R. P. C. 323. In the older cases the person who by diligence could first get his patent sealed was allowed the patent: *Ex parte Dyer*, 1812, Holroyd, 59; *Re Sampson*, 1853, 21 L. T. 81; *Bates & Redgate's Application*, 1869, L. R. 4 Ch. 577; 38 L. J. Ch. 501; *Henry's Application*, 1872, L. R. 8 Ch. 167, 42 L. J. Ch. 363. This was called "racing for a patent," or "racing for the seal." But this procedure was dis- approved by Lord Cairns: *Re Dering*, 1880, 13 Ch. D. 393. Sometimes where the applications were concurrent, joint patents were granted: *Heath v. Smith*, 1854, 2 W. P. C. 271; or else if the inventions were different they were severed: *Macfarlane's Application*, 1883, Johns. 165. This racing for a patent was stopped to some extent by the Patents Act, 1883, which antedated the grant to the date of application. But a danger was still left, for if A. had (provisionally) applied, say, on January 1st, and B. on February 1st, then A., if he could discover B.'s invention, and if his provisional specification were sufficiently wide, might incorporate into his complete specification what was really B.'s invention, and retain it against B. On the other hand, B. was unable to do this as against A., whose priority of application always protected him. B. thus required protection against A. The Patents Act, 1883, s. 11, instead of giving this protection to B., only aggravated the evil by allowing A. to put what he pleased into his complete specification, to the detriment of B., even though by this disconformity was produced *post*, p. 445.

CHAP. XVI.
SECT. 6.

post, p. 445

in A.'s patent, and then when he had thus practically ruined B.'s patent, he was also allowed to oppose the grant of it: *Green's Patent*, 1886, Griff. 286. This glaring injustice was remedied by the Patents Act, 1888, s. 4.

7. Hearing before the Comptroller.—The notice of opposition must be accurately drawn, and as a rule oppositions will not be allowed on grounds which have not been given in the notice (Patent Rules, 1890, r. 42). In a notice of opposition on the ground that the invention has been patented before, the title, name, and date of the prior patent must be given. But a defect in this respect has been allowed to be amended at the hearing: *Airey's Patent*, 1888, 5 R. P. C. 349; and where a patent agent died after the notice, but before the hearing, the notice was allowed to be amended by inserting the opponent's name: *Lake's Application*, 1887, Griff. App. 35. The notice should not state that the invention is "substantially the same": *Jones' Patent*, 1886, Griff. App. 33; nor should it say that the invention, "or material parts thereof," are the same: *Fawcett's Application*, 1889, Good. P. P. 10; for this would be to raise the question of construction and of infringement, which could not be tried. It is only cases of substantial *identity* which are the grounds of opposition.

The Comptroller cannot take oral evidence; hence, when it is desired to try the case on examination and cross-examination of witnesses it is usual to take merely a formal order from the Comptroller, and then to appeal to the law officer, who has full powers in this respect: *Luke's Patent*, 1886, Griff. 294; *Hatfield's Patent*, 1884, Griff. 288. The Comptroller cannot give costs.

Where an opponent did not appear owing to not having

received the notice of the day fixed for hearing, and the Comptroller declined to re-hear, the law officer directed him to do so: *Warman's Application*, 1886, Griff. App. 43.

CHAP. XVI.
SECT. 7.

Hearing
before the
Comptroller.

8. Appeals to the law officer.—The time for appeal dates, not from the hearing, but from the time when the order or amendment is made after that hearing: *Chandler's Patent*, 1887, Griff. 270; *Cooper & Ford's Patent*, 1886, Griff. 275. Every appeal is a re-hearing: *Stubbs' Patent*, Griff. 298; but in general fresh evidence will not be allowed which might have been produced before the Comptroller: *Hampton & Facer's Patent*, 1887, Griff. App. 13. An appeal is allowable, though it does not ask that the grant should be refused, but only that terms should be imposed: *Brownhill's Patent*, 1889, 6 R. P. C. 135. The applicant usually begins, except where an opponent alleges fraud: *Luke's Patent*, 1886, Griff. 294. Notice of appeal need not be given to the applicant by an opposer, but is to be given by the Patent Office or official clerk: *Hill's Application*, 1888, 5 R. P. C. 599. On the non-appearance of a party costs can be given against him: *Dietz' Patent*, 1889, 6 R. P. C. 297; *Ainsworth's Patent*, 1886, Griff. 269; in which latter case a re-hearing was fixed on the respondent's explaining his absence. An appellant withdrawing his appeal may also be compelled to pay costs: *Knight's Application*, 1887, Griff. App. 35.

see *Law
Officers' Rules*,
post, p. 500.

As a rule the costs of the opposition will follow the event: *Anderton's Patent*, 1886, Griff. App. 25; except where an opponent who successfully demanded an alteration in certain terms ought to have asked the applicant to consent to it before appealing: *Woodhead's Application*, 1887, Griff. App. 44. As the Comptroller cannot take

CHAP. XVI.
SECT. 8.

Appeals to
the law
officer.

oral evidence, nor have a cross-examination conducted before him, it is important that the declaration should be in the fullest good faith, and, therefore, when the applicant's declaration did not give the whole truth he was not allowed the costs even when successful on an appeal: *Anderton's Application*, Griff. App. 25. On appeal, each party should hand in a statement of what fees have been paid by him, so as to enable the law officer to fix the costs at once (*per Webster, A.G.*): *Sielaff's Application*, 1888, 5 R. P. C. 487. A stamp of £3 on the appeal will be allowed as part of these costs: *Aire & Calder's Patent*, 1888, 5 R. P. C. 345.

post, p. 446. The law officer has power to order the assistance of an expert (Patents Act, 1883, s. 11, sub-s. 4), but this power is not often exercised. He has once looked at a model which had not been properly made an exhibit, but only to explain the drawings, not as evidence: *Lancaster's Patent*, 1884, Griff. 293.

ante, p. 219. The decision of the law officer is not reviewed on appeal by way of prohibition: *Van Gelder's Patent*, 1888, 6 R. P. C. 22.

post, p. 456. **9. Opposition on the ground of fraud.**—Prior to the Act of 1883 there was always a jurisdiction in the Court to prevent an inventor being robbed of his invention by a fraudulent application made by some other person: *Ex parte Scott v. Young*, 1871, L. R. 6 Ch. 274. The Act of 1883, s. 35, provided that "a patent granted to the first and true inventor shall not be invalidated by an application in fraud of him, nor by provisional protection obtained thereon, nor by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection:" see also

Edmunds' Patent, 1886, Griff. 283; *Anderson's Patent*, 1890, 7 R. P. C. 324; and *Fiechter's Patent*, Griff. 284; *re Hetherington*, 1889, 7 R. P. C. 419.

CHAP. XVI.
SECT. 9.

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Opposition on
the ground of
fraud.

(N.B.—Mr. Goodeve has published a useful abstract of cases decided by the Comptroller and law officers, 1893.)

CHAPTER XVII.

THE GRANT OF THE PATENT.

CHAP. XVII.
SECT. 1.

post, p. 463.

post, p. 446.

post, p. 456.

post, p. 467.

1. Form of the grant.—Under the Patents Act, 1883, s. 12, the patent is sealed with the Patent Office seal, which has the same effect as the Great Seal of the United Kingdom, and by sect. 84 is to be judicially noticed and given in evidence. The time for sealing is within fifteen months of the date of application, except where (1) the sealing is delayed by an appeal or opposition to the grant; (2) where the applicant dies within fifteen months; (3) where the time for leaving the complete specification has been extended: Patents Act, 1883, s. 12, sub-s. 3, and Patents Act, 1885, s. 3. The grant may be in the form in the first schedule to the Patents Act, 1883 (s. 33), which form may, however be altered or amended by the Board of Trade under sect. 101, sub-s. 2. There are now in use eight special forms of grant, the different forms being modified to suit the cases: (A) single inventor, (B) joint inventor, (C) importer, (D) joint applicants, some of whom are inventors, (E) legal representatives of a deceased applicant, (EE) legal representatives of a deceased inventor, (F) to a female applicant, (G) joint applicants where one of the original applicants is dead.

Form A of a grant to a single inventor is as follows, slightly altered from the Form given in the Schedule to the Act of 1883, by leaving out after the word "hath" * the words "by his solemn declaration," which, by virtue of Patents Act, 1885, s. 2, and Patent Rules, 1892, 5 (2), is now no longer required.

CHAP. XVII.
SECT. 1.

Form of the
grant.

post, p. 442.

FORM OF PATENT.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come, greeting:

Whereas *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, hath * represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee), our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, *make, use, exercise, and vend* the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner

Note (a)

Note (b)

Note (c)

Note (d).

CHAP. XVII.
SECT. 1.

Form of the
grant.

as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, we do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or com-

Note (e).

CHAP. XVII.
SECT. 2.

Note (a)

ante, p. 14.

9 Hen. VII., 2 a; but the two Chief Justices did deny that, for the King shall not be concluded to shew or to say the truth, but the law shall adjudge him rather to be deceived." On referring to the case in the year books, 9 Hen. VII., 2 a, we find a distinction drawn between patents which contain the words "ut informamur" and those which contain "ex certa scientia et mero motu," the Court being of opinion that the former words clearly gave the Crown a right to say that it had been wrongly informed, but the latter words (called an assertive clause), took that right away. This view, however, did not prevail in Coke's time, where it was held that the certain knowledge here spoken of was only "verity, which is the proper object of science, and not of falsity, which is a 'non-ens,' and thereof the King cannot have knowledge": see Coke's note, C. 3, p. 43 b. In other words, the certain knowledge must be knowledge of what is true and not what is false; and hence, when the King, in a recital, says he "knows" a thing, it must be taken that he knows it if it is true, but not otherwise. This after all is no more than a repetition of the doctrine that estoppels do not bind the King. For if he is not estopped by the recital of a fact, how can he be estopped by a recital "that he knows of certain knowledge that it is a fact?" If he may go behind one, he may go behind the other. In the case cited it was accordingly held that the words "ex gratia speciali certa scientia et mero motu" did no more than provide that the grant should be "favourably taken for the patentee," but created no estoppel of what was recited in the recitals: 46 b; see also as to recitals, 1 W. P. C. 41, and 2 Bl. Comm. Ch. 21, and Chap. XI., sect. 1. From this it follows that though the grant recite "the inventor hath, by and in his

ante, p. 203.

complete specifications, particularly described the nature of his invention," yet that if in fact he has not done so, the recital is false, the King deceived, and the patent void; and so with the other recitals.

CHAP. XVII.

SECT. 2

Note (a).

3. Note (b).—The word "patentee" means persons for the time being entitled to the benefit of the patent: Chap. XIII.; and by the prior recital in the patent includes executors, administrators, and assigns. This shews that the patent is a chattel, but of an incorporeal character. And were it not for the above words, would be personal to the patentee, and not assignable (*per* Littledale); *Duvergier v. Fellows*, 1830, 10 B. & C. 829.

4. Note (c).—The area of the patent includes the Isle of Man and used to include the Channel Islands, but this is no longer so. They are excluded from sect. 16 of the Act, but there is a process of registration by which an English patent may be extended to the Channel Islands. Note also sect. 117.

post, p. 448.*post*, p. 484.

5. Note (d).—Formerly the grant contained clauses enabling constables to enter and search dwellings for prohibited contraventions; but these clauses have been long disused.

6. Note (e).—The provision that the grant shall be void "if it be made to appear to us or six or more of our Privy Council, etc.," enables the Crown to revoke the patent if it be not new, or contrary to public policy. But, quite apart from this, any false suggestions or illegality in the grant would always have rendered it liable to revocation upon a *scire facias* being brought.

CHAP. XVII.

SECT. 6.

Note (e).

The word "us" means of course the Courts of Law, in which the King is always supposed to be present, and gives no power to the King to revoke a patent, except by regular process. The provision that the grant may be revoked if six or more of the Privy Council shall find it illegal, is very old, and appears in early patents. The first instance of its use is in a patent (No. 26, 1623) to Gormeldon. The clause then seems to have been disused. It reappears again in 1632, since which time it has been always, or almost always, inserted. It would not, however, give the Privy Council power to revoke a patent nor enable a petition to be presented there for its revocation. For by the second section of the Statute of Monopolies, it is expressly provided that all patents and charters for monopolies shall be examined, tried, and determined according to the Common Laws of the realm. And the Privy Council does not possess the requisite machinery for a regular common law trial of a patent. It is difficult to see why the words were originally introduced, and still more difficult to see why they are now retained. It is possible that they were inserted with a view of endeavouring to preserve the jurisdiction of the Star Chamber. For up to the time of the abolition of that Court, the number of councillors who sat to hear ordinary causes was six, and a portion of its regular work was to inquire into forestalling and repeating; and quite up to the end of the reign of Charles I. we find persons cited before it for breach of the laws affecting trade and commerce, and fined, or obliged publicly to stand in the streets with a paper attached to them specifying their offences. The Star Chamber also always claimed jurisdiction to inquire into and examine the validity of all Royal grants. The decrees of the Star Chamber have

unfortunately perished by fire, but the bills and pleadings exist, and specimens are to be found in Rushworth's collection.

CHAP. XVII.
SECT. 6.
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Note (e).

Both Clarendon and Coke bear witness to the fact that infringers of monopoly grants were summoned before it, but few instances will probably be found of Star Chamber patent cases after the date of the Statute of Monopolies. See Hudson's treatise on the Star Chamber.

7. Note (f).—As to the beneficial construction, see note (a) above, and "Construction of Specifications," Chap. XI., sect. 1.

ante, p. 203.

8. Duration of the grant.—A patent thus granted is for fourteen years from the date thereof. It is dated as of the same date as the day of the application. This period is computed inclusively of the day of application, so that a patent dated Feb. 26th, 1825, would expire at midnight, Feb. 25–6, 1839: *Russell v. Ledsam*, 1845, 14 M. & W. 574, 16 M. & W. 633, 14 L. J. Ex. 353, 1 H. L. C. 687 (*per* Parke, B., whose decision, though reversed, was affirmed so far as the computation of the time of expiry was concerned). The patent thus granted ceases, however, if the patentee fails to make the proper payments. The dates for making these payments are specified in the table of fees, and the time for making them is computed exclusively of the date of the patent: *Williams v. Nash*, 1859, 28 Beav. 93, 28 L. J. Ch. 886.

post, p. 448.

post, p. 447.

ante, p. 242.

post, p. 270.

Therefore, if a patent were dated May 1st, 1890, the first renewal fee would have to be paid on May 1st, 1894, but the patent would expire at midnight on April 30th, 1904.

No proceedings can be commenced for infringement

CHAP. XVII.
SECT. 8.

Duration of
the grant.

until the patent is sealed, and then only for infringements committed after the acceptance of the application: Patents Act, 1883, sect. 15.

post, p. 457.

9. Lost Patent.—If a patent is lost or destroyed or its non-production accounted for to the satisfaction of the Comptroller, a duplicate may be sealed: Patents Act, 1883, sect. 37.

post, p. 417.

10. Sealing of a patent in respect of an invention for which a prior patent has been obtained is permissible, provided the patent so sealed was on an earlier application: Patents Act, 1883, sec. 13.—For the intention of the Act is that patents shall date and take effect, not from the actual day on which the Great Seal is affixed to them, but from the date of their application.

CHAPTER XVIII.

THE REGISTER OF PATENTS.

The keeping of the register.—This is governed by Patents Act, 1883, ss. 23, 85, 87, 88, 89, 90, 91, 93, 101, 114, and Patent Rules, 1890, 67–79, which point out the procedure to be followed by any person applying to have any matter relating to the patent registered. The register contains a notice of the grant, any assignments, mortgages, licenses, extension, or revocation, together with a note of what fees have been paid. The register is open for inspection, and copies may be taken.

CHAP. XVIII.
 post, pp. 451,
 463, 496.

Trusts are not entered on the register: Patents Act, 1883, s. 85; but an equitable assignment of a share of a patent is more than a mere trust, and should be registered: *Stewart v. Casey*, 1891, 8 R. P. C. 259; contrary to the previous decision in *Haslett v. Hutchinson*, 1891, 8 R. P. C. 457. The register may be rectified by order of Court: sect. 90. Clerical errors may be altered by the Comptroller: sect. 91; and false entries punished: sect. 93.

post, p. 473.

post, p. 474.

ante, p. 226.

post, p. 431.

The Comptroller is not bound to enter on the register of any patent an assignment not specifically relating to that patent. Thus, an agreement relating

CHAP. XVIII.

The keeping
of the register.

generally to "future" patents would not be registered. Again, the Comptroller is not obliged to register, until the patent is taken out, an agreement which had been made previously: *Parnell's Patent*, 1888, 5 R. P. C. 126.

If a deed is made, either fraudulently: *Green's Patent*, 1857, 24 Beav. 145; *Morey's Patent*, 1858, 25 Beav. 581; or which is clearly ultra vires on the part of the grantor, as if it purported to assign a patent belonging to someone else, the register may be corrected by expunging it: *Horsley & Knighton's Patent*, 1869, L. R. 8 Eq. 475, 39 L. J. Ch. 157. There used formerly to be no appeal against the order of the Master of the Rolls for rectifying the register: *ibid.*; but now the rectification is done by the H. C. J.: Patents Act, 1883, s. 90; and see *Morgan's Patent*, 1876, 24 W. R. 245; *Myer's Patent*, 1882, W. N. 1882, 53; and an appeal would lie.

post, p. 464.

Registration is necessary to give third parties notice of an assignment, and used formerly to be necessary to enable an assignee to sue a third party: *Chollett v. Hoffman*, 1857, 7 Ell. & B. 686, 26 L. J. Q. B. 249; but not as between assignor and assignee. It may perhaps be doubted whether registration is now needful to enable a plaintiff to sue: see "Action of Infringement," Chap. XXVIII., sect. 2. When an assignment is registered (*semble*), that the registration dates back to the date of the assignment, so as, under the old law, to enable an assignee to sue, not as from the date of the registration, but as from the date of the assignment: *Hassall v. Wright*, 1870, L. R. 10 Eq. 509.

post, p. 357.

Registration is notice to the world of the ownership of a patent, but not necessarily of all the terms and conditions of the assignment, so that where a license had

been granted to a person for a particular district, purchasers who bought in good faith patented articles out of the district were not held to infringe by bringing them into the district: *Heap v. Hartley*, 1889, 42 Ch. D. 461, 6 R. P. C. 495. CHAP. XVIII.
The keeping
of the register.

The register is *primâ facie* evidence of any matters contained therein. post, p. 451.

The seal of the Patent Office is also to be judicially noticed: Patents Act, 1883, sects. 84, 89. post, p. 453.

As to enrolment in Scotland and Ireland, see Patents Act, 1883, sect. 100. post, p. 456.

CHAPTER XIX.

FEES.

CHAP. XIX.
SECT. 1.
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post, pp. 451,
493, 505.

post, p. 448.

post, p. 484.

ante, p. 265.

1. The fees to be taken under the Patents Acts are regulated by Patents Act, 1883, s. 24 ; Patent Rules, 1890, rr. 4, 75, 76. A new schedule of fees came out on October 1st, 1892.—These fees are very easy to recollect ; £1 is charged on application, £3 on sending in the complete, and then in respect of the fifth year of the patent £5 ; the sixth year £6 ; and so on for each year as many pounds as the years of the life of the patent. If the fees are not paid at the proper time the patent lapses. The Patent Office is open from 10 to 4 every day, except the public holidays : Patent Rules, 1890, r. 7 ; and the time for payment of the fees excludes the day of the date of the patent : *Williams v. Nash*, 1859, 28 Beav. 93.

Where a patentee contracts to complete the patent, he is not bound to go on and pay the fees to the end of its life ; he has done his duty if he files the complete specification and obtains the grant : *Sequelin v. Terrell*, 1867, 16 L. T. (N.S.) 539.

post, pp. 448,
551.

2. Enlargement of time for paying the renewal fees may be granted up to three months : Patents Act, 1883, s. 17, on payment of enlargement fees as prescribed in the schedule.

For form of application see Patent Rules, 1890, r. 49, and Form R. (*post*, p. 377).

After the time for enlargement has passed, a patentee's only remedy is to obtain a private Act of Parliament extending the time. In 1887 a Select Committee reported that Extension Acts ought not to be granted without serious illness or some other similar cause, and that clauses should be put in for the protection of those who may have infringed after the publication of the lapse of the patent in the official journal. For an example of an extending Act where the assignees had omitted to pay the fee through illness, see Potter's Patents Act, 50 & 51 Vict. c. cxxi., 1887. These Acts are usually obtained with the aid of parliamentary agents. For an example of the advertisement employed, see official journal, May 25, 1892, p. 1.

Formerly, notice of the impending expiration of the time for paying fees used to be given to patentees. This is now no longer done.

3. Stamps.—The fees, as in cases of judicial fees, are charged by means of stamps.

4. The Privy Council fees are given in a Table in the Appendix.

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SECT. 2.

Enlargement
of time for
paying the
renewal fees.

CHAPTER XX.

THE CROWN.

CHAP. XX.

post, p. 454.*post*, p. 459.*post*, p. 452.*post*, p. 458.*post*, p. 474.

Prior to the Act of 1883 the Crown was not restricted in using an invention by reason of the grant of letters patent: *Feather v. The Queen*, 1865, 6 B. & S. 257. But a mere contractor for the Crown was liable: *Dixon v. Small Arms Co.*, 1875, L. R. 10 Q. B. 130, 1 App. Cas. 632. But this is now altered by the Patents Act, 1883, s. 27, sub-s. 1, which provides that a patent shall have to all intents the like effect as against the Queen as it has against a subject, with, however, the proviso (sub-s. 2) that the Crown may use the invention upon terms to be settled by agreement, or in default of agreement, by the Treasury (see also sect. 44).

In granting extension of patents, it used to be customary to insert a clause in favour of the Crown: see "Extensions of Patents; Conditions," Chap. XXV., sect. 17); but this has not been done since the Act of 1883, though there is nothing to prevent its being inserted if the Judicial Committee thought fit: Patents Act, 1883, s. 25, sub-s. 5.

The Science and Art Department has a right to demand models of patented inventions on paying for them: Patents Act, 1883, sect. 42.

Subject as aforesaid the Crown's prerogative is expressly saved, sect. 116.

CHAPTER XXI.

FOREIGN GOVERNMENTS.

The rights of foreign governments not to be made amenable to the laws of Great Britain, have always been recognised. A patentee had obtained an injunction against the agent of a foreign government which had bought some shells in Germany and brought them to England to be put on board a ship of war. The patentee applied to have the shells delivered up to be destroyed. Held, that before making the order, the foreign government which owned the shells must be before the Court, and the foreign government having been made a defendant, was allowed to remove the shells, notwithstanding the injunction: *Vavasseur v. Krupp*, 1878, 9 Ch. D. 351. CHAP. XXI.

post, p. 404.

CHAPTER XXII.

ASSIGNMENT; DIVISION; MORTGAGE; AND DEVOLUTION
OF PATENTS BY DEATH OR BANKRUPTCY. CO-OWNERSHIP
AND PARTNERSHIP IN PATENTS.

CHAP. XXII.

I. Assignments.—An inventor has no property in his invention analogous to a copyright, for all monopolies are illegal unless allowed by a patent; and hence it is not the invention that he may assign, but the patent: *Duvergier v. Fellows*, 1830, 10 B. & C. 829. But breach of an agreement to keep an invention secret gives rise to damages: *Smith v. Dickinson*, 1804, 3 B. & P. 630; though an injunction to restrain a person from revealing a secret invention will not in general be granted unless it has been revealed for the purpose of taking out a patent.

The form of grant of a patent gives a right to the patentee to assign it, without which form it would be unassignable: see *Duvergier v. Fellows*, cited *supra*.
ante, p. 263.

An assignment may be made to any person, or number of persons, capable of holding a patent, including a corporation or public company: Patents Act, 1883, s. 117, sub-s. 1. The former law, that the patent became void if vested in more than a given number of persons, has been abolished.
post, p. 474.

An assignment must be by deed. This rests on two

grounds, first, that it is an incorporeal chattel: Co. Litt., 9 C.; and secondly, on the principle that that which cannot be created without deed cannot be assigned without deed: Coke's Rep., part 3, 63 a; Morris on Patent Conveyancing, p. 111; *Stewart v. Casey*, 1891, 8 R. P. C. 259.

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SECT. 1.
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Assignments.

Where there is an agreement to assign, it may in equity be treated as an assignment, and enforced as in the case of leases: Morris, "Patent Conveyancing, Form of Agreement for Sale of Patent," p. 70.

2. Division of a patent, and assignment of portions of it.—A patent may be divided up in three different ways to an indefinite extent, (a) by separating the parts of the invention, (b) by dividing the geographical area into districts, (c) by a number of persons each having concurrent rights to use it.

(a) The case of *Dunnicliff v. Mallet*, 1859, 7 C. B. (N.S.) 209, 29 L. J. C. P. 70. Two joint patentees of a patent containing two inventions for "warp fabrics" and "purles," split it up, Donnicliff to take the "warp fabrics," Bagley the "purles," and each assigned to the other accordingly. Donnicliff then assigned his share to Ball and others, who reassigned to Donnicliff, with the assent of Bagley, all the patent, "as far as it related to the 6th claim" (which really related both to warp fabrics and purles. This of course left a part of the patent still remaining in Ball, viz., all such parts of Donnicliff's share as had not been reassigned to him.) Donnicliff and Bagley then brought an action of infringement in respect of the 6th claim (as to which of course they were complete owners). Plea in abatement that Ball had not been joined was held bad, for that portion of the patent upon which they were suing was completely

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SECT. 2.

Division of a
patent, and
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portions of it.
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vested in them, and was severable from that which was not so vested.

(b) A patent may be geographically divided into districts. This power is expressly given by the Patents Act, 1883, Ch. 36. For a form of agreement for such a division, see Morris's Patent Conveyancing, p. 115, *et seq.*, and 139. In thus subdividing a patent, special care should be taken as to the rights of the patentees *inter se*. Thus, for instance, if a patent were divided between two counties, a purchaser who bought an article in good faith in one, without notice of the subdivision, might use it in the other: see *Heap v. Hartley*, 1889, 42 Ch. D. 461, 6 R. P. C. 495; for the registration of the division does not affect all the public with notice of the details of it. Hence, then, the agreement ought to provide that articles should be marked, "To be used only in such and such a district," unless it is intended to allow user in other districts.

(c) A patent may be owned jointly, in common, or in shares. This point first seems to have come before the Court in *Walton v. Lavater*, 1860, 8 C. B. (N.S.) 162, 29 L. J. C. P. 275, in which it was argued that a patent being a franchise, was indivisible. But the judges decided that the Patents Act, 1852, had, in sects. 35 & 36, clearly recognised "shares" in patents, and that they were quite common. At that time the form of the patent to joint patentees differed from the present form. For it used to be "to the patentees, their executors, administrators, and assigns, that they, *and every of them* . . . by themselves, their servants, and those with whom they shall agree, may use, exercise, and vend," etc. This certainly points to the subdivision of interest in shares. The modern form of patent to joint patentees

does not contain the words in italics: see further on this point under the heading, "Co-ownership in Patents," Chap. XXII., sect. 9; and see a paper by C. M. Owen in the "Proceedings of the Institute of Patent Agents," vol. 9, p. 157; see also a paper by W. Carpmael, vol. 3, p. 175.

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SECT. 2.

Division of a
patent, and
assignment of
portions of it.

3. Agreement to assign.—An agreement to assign may be by parol, and need not be in writing, under the Statute of Frauds, even though the assignee agrees to pay the fees which extend over a period of more than a year. For, in order that a contract may come within the 4th sect., the things to be done by *both* parties must be to be performed in a time greater than a year: *Smith v. Neale*, 1857, 2 C. B. (N.S.) 67, 26 L. J. C. P. 143. A covenant to assign on the happening of a future event is interpreted as constituting an assignment conditional on the happening of it, and hence, when it happens, the assignment is complete without further deed: *Cartwright v. Amatt*, 1799, 2 B. & P. 43, D. P. C. 240. An agreement to purchase a patent may of course be set aside on the ground of fraud: *Lovell v. Hicks*, 1836, 2 Y. & C. 46, 481; *Chevasse v. Stevens*, 1874, W. N. 193. Where a purchaser agreed to find £300 by a given day to enable the patentee to take out foreign patents, and did not perform it by that day, held, that this was of the essence of the contract, and that the patentee could rescind: *Payne v. Banner*, 1846, 15 L. J. Ch. 227.

There is nothing against public policy in an agreement by a patentee to give the benefit of all future inventions of like character to a purchaser: *Printing and Numerical Registering Co. v. Sampson*, 1875, L. R. 19, Eq. 462; 44, L. J. Ch. 705. It is a very common clause in assignments.

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SECT. 3.

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Agreement to
assign.

For an example shewing when a clause in an agreement will be construed as a condition, see *King v. Oliver*, 1884, 1 R. P. C. 23, 42.

4. Warranties and estoppels in assignments.—The warranties implied in the assignment of patents are the same as those usual in assignments of other things. Thus, just as the vendor of an article does not in general warrant its quality, so the assignor of a patent does not warrant its validity: *Hall v. Conder*, 1857, 2 C. B. (N.S.) 22, 53, 26 L. J. C. P. 138, 288; *Smith v. Neale*, 1857, 2 C. B. (N.S.) 67, 26 L. J. C. P. 143; *Smith v. Buckingham*, 1870, 18 W. R. 314, 21 L. T. (N.S.) 819; *Liardet v. Hammond Electric Light Co.*, W. N. 1883, 96, 31 W. R. 710. Hence, to an action by the assignee for the purchase money, it is no plea that the patent is bad. “What sensible being in this world who buys a patent buys it on the strength of the assertion made by the patentee in the petition that the patent is new. We all know that everybody who buys it as a rule takes it for what it is worth” (*per Bowen, L.J.*): *Cropper v. Smith*, 1884, 1 R. P. C. 94; *Stavert v. Passburg Grain Syndicate*, 1891, 8 R. P. C. 400.

The warranty of title given by the assignor is exactly that which occurs in ordinary sales of chattels, and if he expresses to sell “as beneficial owner,” of course a warranty of title to convey will be included.

There is no implied warranty by a patentee who assigns that he will refrain from communicating to others facts which might invalidate the patent: *London Hosiery Co. v. Griswold*, 1886, 3 R. P. C. 251.

On an assignment of a patent on terms of the assignor receiving payment upon each article manufactured, there

is no implied undertaking by the assignee to manufacture: *Re Railway Appliances Co.*, 1888, 38 Ch. D. 597.

Fraud of course would vitiate an assignment of a patent, and though neither the validity nor the actual goodness of the patent are warranted, yet a sale by one who knew or must have known that he had no title, or that the patent is invalid, would naturally not be enforced.

Estoppel arises where a litigant is not allowed to dispute a state of facts which he has agreed to take for granted, or on the faith of which he has induced others to act. It arises either by record; by recital in deeds; or in pais, that is to say by reason of conduct. If therefore there be a recital in a deed respecting the validity of a patent, it binds those who have signed the deed, none of whom can dispute it. *Bowman v. Taylor*, 1834, 2 A. & E. 278. But it only binds the actual signatories and not even their partners.

Again a judgment between two parties as to the validity of a patent would estop either from raising the question.

Estoppels on the assignment of patents may also arise by reason of conduct. Thus, for example, an assignor of a patent is estopped from alleging its invalidity against the assignee by his conduct in receiving the price of it: *Walton v. Lavater*, 1860, 29 L. J. C. P. 275; *Oldham v. Langmead*, 1789, 3 T. R. 439; *Chambers v. Crichley*, 1864, 33 Beav. 374; *Hocking v. Hocking*, 1889, 6 R. P. C. 72. But in case of fraudulent representations, such estoppels would not be allowed to prevail. For no estoppel can be of effect in a case of fraud. So that where an assignee sued for the recovery of money paid for a patent which was a mere bubble and the nature of which had been misrepresented, the deed was set aside and the money ordered to be refunded: *Hayne v. Maltby*,

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ments.

1789, 3 T. R. 439. *Lovell v. Hicks*, 1836, 2 Y. & C. 46; and mutual mistake would also, like fraud, invalidate any agreement or deed: *Ashworth v. Law*, 1890, 7 R. P. C. 234.

But where no such fraud existed a person who had worked a patent could not recover back the payments he had made before the patent was declared invalid: *Hare v. Taylor*, 1803, 1 W. P. C. 292.

The true ground of the estoppel which arises on the sale of the patent, therefore, either is, the recitals in a deed, or else the conduct of the parties. Hence, then, in a sale where neither of these grounds exists there is no estoppel. Thus, where the owner of a patent who had purchased from a trustee in bankruptcy sued the bankrupt for infringement, it was held that the bankrupt was not estopped from alleging that the patent was bad. For there was no estoppel by conduct, as he had not taken the purchase money, nor by recitals, for there were none which he had signed, nor was there any estoppel of record against him by reason of the statements in his petition saying that "he was the true inventor": *Cropper v. Smith*, 1884, 1 R. P. C. 92. On the question of estoppels, see further under the head of "Licenses," for many of the cases apply mutatis mutandis to Assignments, Chap. XXIII., sect. 2.

post, p. 288.

5. An assignee with notice of prior covenants takes subject to them, so that if a patentee assigns, reserving a right to an account against his assignee, a second assignee who takes knowing of this right is bound to render an account to the original assignee: *Werderman v. Société Générale d'Electricité*, 1881, L. R. 19 Ch. D. 246.

6. Mortgage of a patent.—A patent may be mortgaged and the mortgage registered, but the mortgagee

is not in the position of an assignee. On the contrary, the mortgagor in possession remains the "person entitled to the benefit of the patent," and hence is the "patentee," under the Patents Act, 1883, s. 87. It, hence, follows that he can sue alone, as a mortgagor in possession is entitled to do, without joining the mortgagee: *Van Gelder v. Sowerby Bridge Flour Society*, 1890, 7 R. P. C. 211.

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SECT. 6.

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Mortgage of
a patent.

7. Death and devolution of the patent to personal representatives.—By the form of the grant executors and administrators acquire the patent on the death of the patentee: Chap. XVII., sect. 1; and under the Patents Act they have further time to complete the taking out of a patent applied for by the patentee during his life, or to apply in respect of an invention of which he died possessed: Chap. XIII., sect. 3.

ante, p. 263.

The executor may validly assign a patent before obtaining registration of the probate: *Ellwood v. Christy*, 1864, 17 C. B. (N.S.) 757, 34 L. J. C. P. 130.

ante, p. 229.

Where, however, by agreement two persons had taken an assignment as tenants in common, and not as joint tenants, and the patent was infringed, and one of them died, and the other sued alone, it was held that the right of action survived, and that the plaintiff might recover the whole damages: *Smith v. London & N. W. Rail. Co.*, 1853, 2 E. & B. 69.

In the absence, however, of such express agreement, the rights of a co-owner of a patent would descend by the terms of the grant to his personal legal representatives: Form B of grant, Chap. XVII., sect. 1.

ante, p. 258.

8. Bankruptcy of patentee.—In *Hesse v. Stevenson*, 1803, 3 B. & P. 577, it was contended that a patent, being the fruit of invention, is not such property as