

tell the public clearly, by his specification, what he claims, and what they may do or not do without risk of an action for infringing his patent.” for infringement.

In the specification of a patent for an *improved* instrument or invention, the improvement must be distinctly pointed out. Specification must point out improvements.

The earliest authority for this proposition is *Williams v. Brodie* (x). Illustrative cases.

The plaintiff's invention, which was admitted to be ingenious and useful, consisted in the insertion of a pipe into an old stove for conveying the air into it, but the letters patent and the specification embraced the whole apparatus, and did not confine the invention to the application or addition of the pipe to an old stove, the patent was held void. *Williams v. Brodie*.

In *Harmar v. Playne* (y), it was held that a specification describing a whole machine, the subject of two patents, but not referring to the former specification, or pointing out the particular improvement, the subject of the latter patent, was a sufficient compliance with the proviso of the second letters patent, which recited the former letters patent. The principle of this decision appears to have been that, inasmuch as in the second patent the plaintiff had recited the first patent, and the specification under it, the recital, being in immediate comparison with the new specification, furnished *in gremio* of the new patent the means of distinguishing the new from the old (z). *Harmar v. Playne*.

Macfarlane v. Price (a) was an action for the infringement of the plaintiff's patent for “certain improvements in the making of umbrellas and parasols.” The specification and accompanying drawings contained a minute detail of the mode of constructing the improved umbrellas and parasols, but no distinction was made between what was new and what was old. One of the annexed *Macfarlane v. Price*.

C. 349. “It is necessary that the patentee should show that he has accurately explained the nature of his invention in his specification, separating that which is new from that which is old, so as to enable a person of tolerable skill to make the thing by means of his specification.”

(x) Before 1785, 1 Web. P. C. 75; Higgins's Dig. 210; Dav. P. C. 96; cp. *Hornblower v. Boulton*, 1799, 8 T. R. 103; *Hill v. Thompson*, 1818, 1 Web. P. C. 247.

(y) 1809, 1 Web. P. C. 75; 11 East, 101.

(z) Per Lord Westbury, L. C., in

Foxwell v. Bostock, 1864, 4 De G. J. & S. at p. 311.

(a) 1816. “This case,” says Mr. Webster, “has been occasionally cited as an authority against a drawing accompanying the specification being considered as part of the specification, but it is no authority for such a doctrine; and Lord Lyndhurst, C. B., on one occasion remarked ‘that the above was a complicated case, and that the rule was to be applied with certain limits, not where the thing is quite obvious and apparent.’ It is now perfectly settled that a drawing alone may be a sufficient specification.” 1 Web. P. C. 75.

drawings showed the particular part which had been pirated, and which was the substance of the invention. Lord Ellenborough, C. J., non-suited the plaintiff, on the ground that it would exceed the wit of man, unless he were previously acquainted with the construction of the instrument, to collect, from the whole of the figures, in what the improvement consisted (*b*).

*Fozwell v.
Bostock.*

Here (*c*) the patent was for "improvements in machinery or apparatus for sewing or stitching," and the specification described the invention as consisting in "an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle." The drawings and the description exhibited and described an entire machine, and the composition and working of its several constituent parts, without in any manner indicating where the improvement lay, or in what it consisted. Westbury, L. C., held that the specification was insufficient.

"It must follow," said his Lordship in giving judgment, "that an accurate knowledge of all needle and shuttle machines which were known and used in England at the date of this patent is necessary in order to discover the differences and novelties that existed in this improved combination. The law requires that the specification should be intelligible to a workman of ordinary skill and information upon the subject. A new combination or improved arrangement of machinery, therefore, should be so described as that a person of ordinary knowledge on the subject may be able at once, on reading the specification, to perceive the invention and the manner in which it is to be performed. It is not sufficient to say that a person possessed of all the knowledge existing at the time of the patent on the subject of sewing machines will discern the improvement. . . ."

"I must, therefore, lay down the rule which is consistent with and in reality a mere sequence from the decided cases, 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; it must, to use a logical phrase, assign the *differentia* of the new combination. This obligation flows directly from the condition of the patent."

(*b*) Cp. *Bovill v. Moore*, 1816, Dav. P. C. 361; *Saunders v. Aston*, 1832, per Littledale, J., 3 B. & Ad. 881; *Kay v. Marshall*, 1836, 1 Web. P. C. 75.

(*c*) 1864, 4 De G. J. & S. 298, 309, 313; cp. *Parke v. Stevens*, 1869, L. R. 8 Eq. 358; *Rowcliffe v. Morris*, 1886, 3 P. O. R. at p. 23.

Sir W. M. James, V.-C., expressed himself to the same effect in *Parques v. Stevens* (d).

“It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new, and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and commonplace—all that was the subject of other patents or of other improvements—bringing to the subject not only the knowledge of an ordinary skilled artisan, but of a patent lawyer or agent.”

To the rule that a specification must distinguish the new elements in an invention from the old there are several exceptions or limitations.

A patentee need not disclaim matters which manifestly form no part of the invention (e).

“The rule may perhaps admit of some modification in favour of the patentee in respect of things incidentally mentioned which are old and universally known to be so; for if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new” (f).

If, taking the whole specification together, and giving its words a fair and reasonable interpretation, the Court can see that the specification only claims an improvement on an old machine, it will be sufficient (g).

When a patentee takes out a fresh patent for improvements on his original invention, it is sufficient if an ordinary skilled artisan, reading the second specification with the first, would have no substantial difficulty in ascertaining what is claimed (h).

In *Shaw v. Jones* (i), a specification alleged not to particularly describe and ascertain the nature of an invention, and the manner in which it was to be performed, was held sufficient, on the evidence of witnesses who had done the very thing indicated in the specification, without other instructions than the specification itself.

Where a patentee claims a new combination only, and not the subordinate elements included in that combination, if the

Parques v. Stevens.

Limitations to rule.

Immaterial elements.

Elements known to be old.

Specification sufficient if Court can see that only improvement claimed.

Specification sufficient if intelligible to ordinary skilled artisan.

In patent for new combination only,

(d) *Supra.*

(e) *Lister v. Leather*, 1858, 8 E. & B. 1031; *Watling v. Stevens*, 1886, 3 P. O. R. 153.

(f) *Tetley v. Easton*, 1853, per Coleridge, J., *Maer. P. O.* 87.

(g) *McAlpine v. Mangnall*, 1846, 15 L. J. C. P. 298; 3 C. B. 518.

(h) *Parques v. Stevens*, 1869, per James, V.-C., 8 Eq. at p. 365.

(i) 1889, 6 P. O. R. 335.

specification need not distinguish subordinate elements.

Novel elements distinguished by implication.

Specification must distinguish useful elements.

combination and the mode of working it are properly described, it is not necessary to specify which of the subordinate elements are new (*k*).

Again, if it appears from the reading of the specification that, although the patentee does not in so many words say, "I limit my claim to so and so," yet, if it plainly enough appears that he actually does only claim so and so, that is enough (*l*).

In *Easterbrook v. G. W. Rail. Co.* (*m*), an action for the infringement of a patent for "improvements in machinery or apparatus for actuating and controlling railway points or signals," it was proved at the trial that the plaintiff's apparatus could be so worked as to give conflicting signals, or signals conflicting with the points. It was strongly urged, however, on behalf of the plaintiff, that, inasmuch as the apparatus, when applied to very simple constructions of points and signals at Leigh, had performed its work for three or four years without accident, and was shown to have some utility, and that as a very small degree of utility was enough to support a patent, it was not bad on the ground of inutility. In disposing of this contention, Wills, J., said, "The specification here points to its universal application for railway signalling, including its use at the most complicated junctions and sidings. If it be useful for one very small and insignificant section of its proposed work, and for the rest is, as in my opinion it is proved to be, fraught with danger and death, the specification is bad as not distinguishing between its useful and its useless application (*n*). It is as consonant with good sense as I believe it to be with good law, that an inventor who invites the indiscriminate use of apparatus sure to bring about disaster in the long run, if generally applied according to his invitation, cannot maintain a patent for his invention because it will do some useful work at places and under circumstances where mechanical appliances for preventing conflict of signals are scarcely necessary at all, whilst elsewhere it is full of danger to the public."

To whom complete

The following proposition is submitted to be an accurate state-

(*k*) *Moore v. Bennett*, 1884, 1 P. O. R. 129. Where a specification claims a combination, of which part is new, the new part may be pointed out either in the body of the specification or in one of the claims. *Nordenfelt v. Gardner*, 1884, 1 P. O. R. 74; *Watling v. Stevens*, 1886, 3 P. O. R. p. 41; *Kaye v. Chubb*, 1888, 5 P. O. R. at p. 649; per Lord Watson in argument, "if you claim a

combination you need not say which of the parts are old."

(*l*) *Morton v. Middleton*, 1863, 1 Court of Sess. 3rd series, 722.

(*m*) 1885-6, 2 P. O. R. 201; 3 P. O. R. 94.

(*n*) *Cp. Badische Anilin Fabrik v. Levinstein*, 1885, L. R. 29 Ch. D. 366; 2 P. O. R. pp. 115, 116.

ment of what may be called "the ordinary workman test" of the sufficiency of a complete specification :—

specification must be intelligible.

A complete specification is, and the Courts must declare it to be (o), sufficient in law, where the directions contained in it will enable the processes described to be successfully followed out, without the exercise of further inquiry, experiment, or invention by any careful workman, having a competent degree of knowledge upon the subject-matter to which the patent relates (p).

"The ordinary workman test" stated.

From the proposition above stated, the following rules are logically deducible :—

The person upon whose ability to understand a specification its sufficiency depends, is neither, upon the one hand, simply an uninstructed member of the general public (q), nor, upon the other hand, an eminent specialist or scientific workman, but to the workman of ordinary skill and information upon the subject (r).

Definition of ordinary workman.

"It is plain," said Jessel, M. R., in *Plimpton v. Malcolmson* (s), "that the specification of a patent is not addressed to people who are ignorant of the subject-matter. If it is a mechanical invention, you have, first of all, scientific mechanics of the first 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 . . . 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 and still more 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. . . . 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

Specification not addressed to persons ignorant of subject-matter.

Test of sufficiency.

(o) *Edison and Swan, &c. Co. v. Woodhouse*, 1887, per Lindley, L. J., 4 P. O. R. at p. 108.

(p) *Bray v. Gardner*, 1887, 4 P. O. R. at p. 406; cp. *Wallington v. Dale*, 1851-52, per Alderson, B., 7 Ex. R. 888; *Edison Co. v. Holland*, 1889, 6 P. O. R. 243.

(q) *Arkwright v. Nightingale*, 1785, 1 Web. P. C. 60; *Harmar v. Playne*, 1809, Dav. P. C. 316, 318; *Neilson v. Harford*, 1841, 1 Web. P. C. 314.

(r) See cases cited under last note, and *R. v. Arkwright*, 1785, 1 Web. P. C. 66; *Hornblower v. Boulton*, 1799, Dav.

P. C. 228; *Manton v. Manton*, 1815, Dav. P. C. 349; *Sturtz v. De la Rue*, 1828, 5 Russ. 327; *Morgan v. Scaward*, 1836, 1 Web. P. C. 176; *Galloway v. Bleadon*, 1839, 1 Web. P. C. 524; *Elliott v. Aston*, 1841, 1 Q. B. 938; *Gibson v. Brand*, 1842, 1 Web. P. C. 629; *Houshill Co. v. Neilson*, 1842, 1 Web. P. C. 676, 692; *Heath v. Unwin*, 1852, 2 Web. P. C. 245; *Foxwell v. Bostock*, 1864, 10 L. T. N. S. 147.

(s) 1875, L. R. 4 Ch. D. at p. 568; cp. *Bray v. Gardner*, 1887, 4 P. O. R. at p. 406.

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. . . . It will be a bad specification if the first two classes only understand it, and if the third class do not."

Workman must bring his knowledge to bear on specification.

The ordinary workman, as above defined, must not only possess competent knowledge, but must bring it to bear on the specification before him (*t*), and a specification need not explain any facts with which an ordinary workman must necessarily be acquainted (*u*).

Thus, in *Crossley v. Beverley* (*x*), an action for the infringement of a patent for an "improved gas apparatus." An objection that the gas-making apparatus was incomplete, because the specification gave no directions respecting a condenser, was overruled. "A workman," said Lord Tenterden, C. J., "who was capable of making a gas apparatus would know that he must put in a condenser. The specification does not tell you to leave it out."

Workman not bound to exercise invention or ingenuity.

But while a workman is bound to exercise all the actual existing knowledge common to the trade, he cannot be called upon to exercise anything more. He cannot be called upon to tax his ingenuity or invention (*y*), and if experiments are necessary in order to produce any beneficial effect from an invention at all, the specification will be bad (*z*).

In *Macnamara v. Hulse* (*a*), an action for the infringement of a patent for "certain improvements in paving, pitching, or covering streets, roads, and other ways," the specification stated, "My invention consists in an improved mode of cutting or forming stone, or other suitable material for paving or covering roads or other places," and directed the blocks to be used for paving to be bevelled both inwards and outwards, but said nothing as to the angle at which the bevels were to be made.

Lord Abinger, C. B., said, "It will be for the jury to say whether any particular angle is essential, or whether any angle whatever is useful and beneficial. . . . *If the specification leaves it to*

(*t*) "A specification," said Maule, J., during the argument in *Beard v. Egerton*, 1849, 19 L. J. C. P. 36, "is not to compel a person who is determined to misunderstand to learn, but to direct one who is willing to understand."

(*u*) *Badische Anilin Fabrik v. Levinstein*, 1887, per Lord Herschell, 4 P. O. R. at p. 469.

(*x*) 1829, 3 C. & P. 513; *Morgan v. Seaward*, 1836, 1 Web. P. C. 176.

(*y*) *Morgan v. Seaward*, 1836, per Alderson, B., 1 Web. P. C. 174; cp. *R. v. Arkwright*, 1785, 1 Web. P. C. 67; *R. v. Wheeler*, 1819, per Abbott, C. J., 2 B. & Ald. 354; *Macnamara v. Hulse*, 1842, 1 C. & M. 477; *Muntz v. Foster*, 1844, 2 Web. P. C. 109.

(*z*) *Neilson v. Harford*, 1841, per Parke, B., 1 Web. P. C. 371.

(*a*) 1842, 2 Web. P. C. 128, 129.

experiment to determine what is the proper angle, it is not good, but if any angle is a benefit, it will do."

And so, where in his specification a patentee said that a bowl might be filled or partially filled with a liquid to produce a certain effect, and it appeared that the effect was best procured when the bowl was partially filled, but that there was some effect when it was completely filled, it was held that the specification was sufficient (b).

Patent actions are now tried without a jury unless the Court otherwise directs (c). In a jury trial, the construction of the specification would be for the judge, its sufficiency would be for the jury, to determine (d).

The law as to the respective functions of judge and jury in regard to the comparison of specifications was very clearly stated by Wilde, B., in his answers to the questions put to the judges by the House of Lords in *Betts v. Menzies* (e):—"If the terms of the two specifications are identical, and if it is not disputed that the terms of art used in the one have the same meaning as the same terms used in the other, which, from the lapse of time between the dates of the two patents may not always be the case, the Court ought to determine that the first publication anticipated the second, without evidence, and without any proof that either the first or second was practicable. If, though not identical, the language used in the two, when construed by the Court, describes identically the same process, machine, or manufacture, the Court may, subject to the same remark as to the terms of art, decide at once upon the question of anticipation. But if after construction, and after the meaning of the parties in the two documents has been ascertained by the Court, there be any difference between the two things described, which may be essential or material to the invention, and which is contended by either of the parties to be essential or material to the invention, the Court cannot decide such a controversy; it has neither materials nor means for so doing, and it

Questions of law and fact in regard to comparison of specifications.

(b) *Thomson v. Batty*, 1889, 6 P. O. R. 84, 97.

(c) Act of 1883, s. 28, sub-s. (1).

(d) *Hill v. Thompson*, 1817, 1 Web. P. C. 235; *Bickford v. Skewes*, 1841, 1 Web. P. C. 214; *Neilson v. Harford*, 1841, 1 Web. P. C. 295; *Walton v. Bateman*, 1842, 1 Web. P. C. 621; *Beard v. Egerton*, 1848, 19 L. J. C. P. 38; *Wallington v. Dale*, 1852, 7 Ex. 888; *Morton v. Middleton*, 1863, 1 Ct. of Sess., 3rd ser. 721; *Purkes v. Stevens*, 1869,

L. R. 8 Eq. 353.

(e) 1862, 10 H. L. C. 134; cp. *Muntz v. Foster*, 1842, per Tindal, C. J., 2 Web. P. C. 105; *Allen v. Rawson*, 1845, 1 C. B. 571; *Tetley v. Easton*, 1852, Macr. P. C. 68; *Bush v. Fox*, 1856, Macr. P. C. 178; *Booth v. Kennard*, 1857, 2 H. & N. 84; *Thomas v. Foxwell*, 1858, 5 Jur. N. S. 38; 8 Jur. N. S. 271; *Hills v. London Gas Light Co.*, 1860, 5 H. & N. 363; *Hills v. Evans*, 1862, 31 L. J. Ch. 457.

must go to a jury. In a word, the Court can pronounce two identical descriptions to portray two identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence."

3. Construction of Complete Specification.

Various ideas of construction.

Various ideas have prevailed, in the development of our patent law, as to the principles on which the specification of an invention ought to be construed.

Strict interpretation.

In early times, it was the fashion of the Courts of justice to lean in favour of the public against the patentee, under the notions that a patent was a monopoly, that all monopolies were odious, and that the specification could not, therefore, be too critically scanned (*f*).

Benevolent interpretation.

About the year 1830 (*g*), the theory of strict interpretation was abandoned: the Courts seemed rather to lean in favour of the patentee against the public, and expressions were used which encouraged the idea that a peculiarly favourable construction was to be placed upon the language of specifications, so as, if possible, to support the patents to which they related (*h*).

With regard to this doctrine of "benevolent interpretation," it must be observed that the evidence for its existence rests chiefly on isolated dicta (*i*), and that a strong counter-current of authorities supports the modern theory of construction which will be dealt with later on.

Thus, in *Harworth v. Harcastle* (*k*), Tindal, C. J., said: "There can be no rule of law which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts would warrant; on the

(*f*) *Hullett v. Hague*, 1831, 2 B. & Ad. 377; *Neilson v. Harford*, 1841, 1 Web. P. C. 310; *Stevens v. Keating*, 1847, per Pollock, C. B., 2 Web. P. C. 187; *Cropper v. Smith*, 1884, per Bowen, L. J., 1 P. O. R. pp. 90, 91.

(*g*) Cp. *Neilson v. Harford*, 1841, per Parke, B., 1 Web. P. C. at p. 310. "Within the last ten years or more the Courts have not been so strict in taking objections to the specification, and they have endeavoured to hold a fair hand between the patentee and the public, being willing to give to the patentee on his part the reward of a valuable patent, but taking care to secure to the public on the other hand the benefit of that proviso which is introduced into the patent for their advantage."

(*h*) *Stevens v. Keating*, *ubi supra*.

(*i*) Thus in *Sellers v. Dickinson*, 1850, 20 L. J. Ex. 417; 5 Ex. 324, Pollock, C. B., observed: "The specification should be met with candour and indulgence," and in *Palmer v. Wagstaffe*, 1854, 9 Exch. 501, 23 L. J. Ex. 217, his lordship said: "I think that every patent should be expounded favourably to the patentee." But in each case the scope of the dictum is limited by the context, and the modern theory of construction, which will be noticed immediately, was very clearly foreshadowed by the same learned judge. Cp. *Stevens v. Keating*, 1847, 2 Web. P. C. 187; *Tetley v. Easton*, 1852, Macr. P. C. 74, 76.

(*k*) 1834, 1 Web. P. C. 485.

contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent."

Again, in *Russell v. Cowley* (l), Alderson, B., said: "The specification ought to be taken as a whole, and fairly and candidly construed, without astuteness to pick holes in it"; and in *Elliott v. Turner* (m), Parke, B., told the jury that the language of a specification ought to be construed according to its ordinary and proper sense, unless it be shown by something in the context (which may be explained by evidence) that a different construction ought to be adopted.

A new definition of the benevolent interpretation theory was given by the late Master of the Rolls.

In *Hinks v. Safety Lighting Co.* (n), his lordship said: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections, or on mere cavillings with the language of the specification, so as to deprive the inventor of the benefit of his invention.

"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, and it can be supported on a reasonable construction of the patent. Beyond that the benevolent mode of construction does not go. It was never intended to make use of ambiguous expressions with a view of protecting that which was not intended to be so protected by law, whether or not it was an invention unknown to himself."

In *Plimpton v. Spiller* (o), Sir George Jessel, said: "When the judge sees that there is a real substantial invention of great merit, and the description is fairly made, so that a competent workman can make the invention, it is not his duty to endeavour to construe the patent so as to make it claim that which it is utterly absurd to

Jessel, M.R., on the "benevolent interpretation" of specifications.

"Judicial anxiety" to support a useful invention.

Substantial invention of merit.

(l) 1834, 1 Web. P. C. 470. In the same case Parke, B., observed: "In the construction of a patent, the Court is bound to read the specification so as to support it, if it can fairly be done."

(m) 1845, 15 L. J. C. P. 49; 2 C. B. 461; *cp. Househill Co. v. Neilson*, 1843, 1 Web. P. C. 679; *Beard v. Egerton*,

1848, 8 C. B. 165; *Trotman v. Wood*, 1864, per Willes, J., 16 C. B. at p. 503; *Simpson v. Holliday*, 1866, 13 W. R. 578; *Adie v. Clark*, 1876, per James, L. J., L. R. 3 C. D. at p. 142.

(n) 1876, L. R. 4 C. D. at p. 412.

(o) 1876-77, L. R. 4 C. D. at p. 422.

suppose would be claimed because it is so well known as a matter of public notoriety that nobody would think of claiming such a thing.”

These passages should be compared with the language of the same learned judge in *Otto v. Linford* (*p*).

“I have heard judges say, and I have read that other judges have said, that there should be a benevolent interpretation of specifications. What does this mean? I think, as I have explained elsewhere, it means this: when the judges are convinced that there is a genuine great and important invention, which, as in some cases, one might almost say produces a revolution in a given art or manufacture, the judges are not to be astute to find defects in the specification (*q*), but, on the contrary, if it is possible consistently with the ordinary rules of construction, to put such a construction on the patent as will support it. They are to prefer that construction to another which might possibly commend itself to their minds if the patent was of little worth and of very little importance. That has been carried out over and over again, not only by the Lord Chancellor on appeal, but by the House of Lords. There is, if I may say so, and I think there ought to be, a bias, as between two different constructions, in favour of the real improvement and genuine invention, to adopt that construction which supports an invention. Beyond that I think the rule ought not to go.”

Cropper v. Smith.

Bowen, L. J., on “benevolent construction.”

In *Cropper v. Smith* (*r*) the doctrine of benevolent interpretation was reduced to its proper proportions. “We were pressed very earnestly,” said Bowen, L. J., “to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety 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 invoked, that is to say, reference has been made to an old principle of construction, which is not at all special

(*p*) 1881-82, 46 L. T. at p. 39.

(*q*) Cp. *Bickford v. Skewes*, 1841, 1 Web. P. C. 219.

(*r*) 1884, 1 P. O. R. at pp. 89, 90;

Sugg v. Bray, 1885, per North, J., 2 P. O. R. at pp. 230, 231.

to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Sheppard'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*' (s). 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. It is almost always coupled with another maxim which seems to me really to be the same thing in another shape. '*Verba intentioni debent inservire.*' You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it, when the validity of a patent is in question, it certainly never can be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document; it is not an excuse to justify you in misconstruing a document" (t).

The leading principles applicable to the construction of a specification have now been clearly settled.

Present theory of construction.

"It ought to be construed like any other legal document as a whole," said Chitty, J., in *Lister v. Norton* (u), "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

(s) Cp. *Boulton and Watt v. Bull*, 1793-99, per Eyre, C. J., Dav. P. C. at p. 212; *Thomas v. Foxwell*, 1858-59, per Pollock, C. B., 6 Jur. at p. 272.

(t) In *Newton v. Grand Junction Rail. Co.*, 1845-46, 5 Ex. at p. 335, Rolfe, B., said: "The defendant's counsel discussed and scanned the language of the specification in the same sort of spirit as if it were a plea or replication specially demurred. That is not the

spirit in which a specification should be inspected. The proper mode is to construe it, and see what is the good sense of it, and whether that which the patentee claims as his invention is there distinctly and clearly explained." See 20 L. J. Ex. 427, n. Cp. *Automatic Weighing Co. v. Knight*, 1889, per Lindley, L. J., 6 P. O. R., at p. 307.

(u) 1886, 3 P. O. R. at p. 203.

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. The persons to whom a specification is particularly addressed are those who are conversant with the business to which the invention relates. The specification is sufficient if a person of ordinary skill and intelligence in the business can understand the directions and work upon them without experiments. The specification must define in reasonable terms the ambit of the invention, and thus give fair warning to the public what the invention is for which the monopoly is claimed."

Needham v. Johnson.

In *Needham v. Johnson* (x), Lindley, L. J., said: "I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but, of course, if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid. 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 the benevolent interpretation do not mean more than that. They do not mean you are to put upon a specification a benevolent interpretation which will turn that into an infringement which is not an infringement. Benevolent interpretation has nothing to do with infringement: it has to do with the validity of specifications."

Perhaps the most terse statement of the present law is that given by Lord Chelmsford in *Harrison v. Anderston Foundry Co.* (y).

"In the construction of a specification it appears to me that it ought not to be subjected to what has been called a benign interpretation or to a strict one. The language should be construed according to its ordinary meaning—the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention—and if the specification is thus sufficiently intelligible it performs all that is required of it."

Construction
in particular
cases.

The construction of particular specifications cannot profitably be considered here. Each case is dealt with upon its own merits (z).

(x) 1884, 1 P. O. R. at p. 58.
(y) 1876, 1 App. Cas. at p. 579; cp. *Adie v. Clark*, 1876, per James, L. J., 3 Ch. D. at p. 142; S. C., per Lord Hatherley, 2 App. Cas. at p. 433; S. C., per Lord Blackburn, 2 App. Cas. at p.

436; *Dudgeon v. Thomson*, 1877, per Lord Blackburn, 3 App. Cas. at p. 53; *Roberts v. Heywood*, 1879, 27 W. R. 454.
(z) See *Forsyth v. Riviere*, 1819, 1 Web. P. C. 97; *Minter v. Wells*, 1834, 1 Web. P. C. 134; *Russell v. Cowley*, 1835,

4. *The Claims.*

A claim is a short clause inserted in a specification, whereby the patentee particularly points out what he claims as his invention. Definition of claim.

Regarded from the point of view of the specification, "a claim is," in the language of Mr. Justice Kay in *Lucas v. Miller (a)*, "in point of fact a disclaimer; it shows what parts, and what parts only, of the whole invention you mean to protect by your patent." Function of claim.

"The claim," said Lord Cottenham, L. C., in *Kay v. Marshall (b)*, "is introduced lest, in describing and ascertaining the nature of his invention, and by what means the same is to be performed . . . the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new."

Prior to the Patents Act, 1883, although usual, it was unnecessary to insert claiming clauses in the specification of inventions. Origin of claims. Thus, in *Lister v. Leather (c)*, Williams, J., said, "Neither a claim nor a disclaimer is essential to a specification; that which appears to be the invention or part of it will be protected, though there be no claim."

The Act of 1883, s. 5, sub-s. 5, however, provides that a complete specification "must end with a distinct statement of the invention claimed." Act of 1883, s. 5, sub-s. 5.

Several points of importance have been decided under this subsection.

Provided the specification ends with a statement of the invention

1 Web. P. C. 463; *Gibson v. Brand*, 1842, 1 Web. P. C. 631; *Muntz v. Foster*, 1844, 2 Web. P. C. 104; *Elliott v. Turner*, 1845, 2 C. B. 446; *McAlpine v. Mangnall*, 1846, 3 C. B. 496; *Barker v. Grace*, 1847, 17 L. J. Ex. 122; 1 Ex. 339, 344; *Stevens v. Keating*, 1848, 2 Exch. 772; *Beard v. Egerton*, 1849, 8 C. B. 165; *Holmes v. L. & N. W. Rail. Co.*, 1852, Macr. P. C. 27; *Hills v. London Gas Light Co.*, 1857, 27 L. J. Ex. 60, and 1860, 29 L. J. Ex. 409; *Thomas v. Foxwell*, 1859, 5 H. & N. 368; *Ozley v. Holden*, 1860, 8 C. B. N. S. 666; *Ralston v. Smith*, 1865, 11 H. L. C. 223; *Thomas v. Welch*, 1866, L. R. 1 C. P. 192; *Jordan v. Moore*, 1866, L. R. 1 C. P. 624; *Binney v. Feldt*, 1871-75,

Griffin, P. C. 49; *Spencer v. Ancoats, &c., Co.*, 1889, 6 P. O. R. 46; *Automatic Weighing Co. v. Knight*, 1889, *ubi sup.*, at p. 297; *Boyd v. Horrocks*, 1889, 6 P. O. R. 159; *Hocking Co. v. Hocking*, 1889, 6 P. O. R. 69; *Thomson v. American Braided Wire Co.*, 1889, 6 P. O. R. 525.

(a) 1885, 2 P. O. R. at p. 159; *cp. Plimpton v. Spiller*, 1876-77, per James, L. J., 6 Ch. D. at p. 426.

(b) 1836, 2 Web. P. C. 39; *Jackson v. Wolstenhulmes*, 1884, 1 P. O. R. at p. 108; *Easterbrook v. G. W. Rail. Co.*, per Wills, J., 1885, 2 P. O. R. at p. 208.

(c) 1858, 1 E. & B. at p. 1033.

claimed distinct from the description of the invention contained in the specification, sub-sect. 5 of sect. 5 is complied with, and there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given (*d*). There must, however, be a real statement of the invention claimed, and not merely a colourable compliance with the terms of the statute, as by reference to the previous description, *e. g.*, "I claim the invention described in the specification," would not be regarded as sufficient (*e*).

"A distinct statement" means something more than a separate paragraph. The Legislature contemplated a distinct summary of the main features of the invention, something to which the reader might readily refer and learn therefrom, without referring to the body of the invention, what the characteristic features of the invention claimed were (*f*).

Although a complete specification does not conclude with "a distinct statement" as above defined, that is a matter purely directory; it is not made a ground of avoidance under the 26th section of the Act, and cannot be urged as an objection to the validity of a patent (*g*).

General rules. A few general rules may be laid down as to the requisites and characteristics of a valid claiming clause.

Claim must not go beyond invention.

1. The claim must not go beyond the invention.

Thus, a patentee must not claim what someone else has invented.

In *Minter v. Mower* (*h*), the patent was taken out for "an improvement in the construction, making, or manufacturing of chairs." The specification concluded, "what I claim as my in-

(*d*) *Aliter* in America and Germany. The official interference with claims which in England is practically non-existent, is in America often very minute and harassing. In Germany patent claims are drawn by the official examiners themselves.

(*e*) *Re Smith*, per Herschell, S.-G., Griffin, P. C. 268.

(*f*) *Siddell v. Vickers*, 1888, per Lopes, L. J., 5 P. O. R. at p. 433. In this case a majority of the Court of Appeal held a claim for "the general construction, adaptation, or application, and the combination and use of the several parts in the whole constituting improved, more simple and efficient appliances, or means for working or operating on iron or steel forgings substantially as hereinbefore set forth, and as illustrated in the ac-

companying drawings," not to be "a distinct statement" within this subsection.

(*g*) *S. C.*, *ubi supra*, per Fry, L. J.

(*h*) 1837, 1 Web. P. C. 142; *R. v. Else*, 1785, 1 Web. P. C. 76; *Huddard v. Grimshaw*, 1803, 1 Web. P. C. 86; *Bovill v. Moore*, 1816, Dav. P. C. 404. If the patentee has claimed too much it is immaterial whether he has done so fraudulently, or inadvertently: *Ibid.* 414; *Hill v. Thompson*, 1817, 1 Web. P. C. 237; *Bloxam v. Elsee*, 1827, 6 B. & C. 169; *Gibson v. Brand*, 1842, 1 Web. P. C. 613, 634; *Muntz v. Foster*, 1844, 2 Web. P. C. 110; *Gamble v. Kurtz*, 1846, 3 C. B. 425; *Thomas v. Foxwell*, 1858, 5 Jur. N. S. 37, affirmed 6 Jur. N. S. 271; *Rushton v. Crawley*, 1870, L. R. 10 Eq. 527.

vention is, the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as above described." It was clear upon the evidence that the description applied to a chair (acting on the same principle as that which the patentee claimed) which had been constructed and sold by a person of the name of Brown, before the date of the patent: this chair had, however, been encumbered by additional machinery. It was held that the specification was bad.

"The specification," said Denman, C. J., "claimed more than the plaintiff had invented, and would have actually precluded Brown from continuing to make the same chair that he had made before the patentee's discovery. We are far from thinking that the patentee might not have established his title by showing that a part of Brown's chair could have effected that for which the whole was designed. But his claim is not for an improvement upon Brown's leverage, but for a leverage so described that the description comprehended Brown's."

Again, the patentee must not claim more than he has himself invented.

In *Bloxam v. Elsee* (i), the patent was for a machine for "making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length." It was held by the Court of King's Bench that the meaning of this was that paper of various widths might be obtained from one and the same machine, and that as the evidence showed that the patentee was not, at the time of taking out the patent, possessed of any machine capable of accomplishing this object, the claim was bad.

2. A patent was formerly held not to be void because the patentee claimed as part of his invention something which was not described as essential, and which proved to be useless (k). But this is now not the law.

In *Reg. v. Cutler* (l), the case of *Lewis v. Marling* (k) was quoted *Reg. v. Cutler*. as establishing the doctrine that if the specification of a patent described two modes of performing one part of the invention, if either of those methods were proved to be satisfactory, the patent might be good, notwithstanding the imperfection of the other; and

(i) 1827, 6 B. & C. 169.

(k) *Lewis v. Marling*, 1829, per Lord Tenterden, C. J., 10 B. & C. at p. 25.

(l) 1849, 14 Q. B. 372, n.; *Beard v. Egerton*, 1849, per Maule, J., 19 L. J. C. P. 40.

Denman, C. J., had directed the jury that this was the law. The Court of Queen's Bench, however, held that this was a misdirection.

"The Court," said Denman, C. J., referring to *Lewis v. Marling* (l), "there only said that the claim of some part of the machine which turned out to be useless did not vitiate the patent. This is certainly a very different thing from describing a part of the machine as capable of co-operating in the work, when in fact it is incapable, even though at the same time other means are described which might be effectually employed. The reader of the specification relying upon it might attempt to use the former mode in constructing the machinery, which would fail of its purpose from being too accurately made according to the patentee's instructions."

Simpson v. Holliday (m) is a conclusive authority in favour of the law laid down by the Court of King's Bench in *Reg. v. Cutler*. This was a suit to restrain the infringement of a patent for "improvements in the preparation of red and purple dyes." The specification stated: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour." It was proved in evidence, and admitted by the plaintiff, that the latter process would not succeed. It was held that the patent was invalid.

"If the true construction of the specification," said Lord Westbury, L. C., "be that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is therefore invalid and bad at law."

Claim must
not be too
wide—

3. A claim must not be too wide, either in itself or upon the evidence.

either apart
from the
evidence,

In *Wyeth v. Stone*, an American case mentioned by Mr. Justice Curtis in his work on *Patents* (n), a person, who had invented some mode of cutting ice, stated in his claim, "I claim every mode of cutting ice, except by human power." "If a man," said Lord Hatherley, L. C., in *Arnold v. Bradbury* (o), "chooses to put forward his claim in so preposterous a form as that, of course he

(l) 1829, per Lord Tenterden, C. J., 10 B. & C. at p. 25.

(m) 1866, 5 N. R. 340.

(n) Sect. 148, and 1 Story, 273.

(o) 1871, L. R. 6 Ch. at p. 711. A claim for a principle to be carried into effect any way you will would be bad: per Alderson, B., in *Neilson v. Harford*, 1841, 1 Web. P. C. at p. 355.

must take the consequences." . . . "A claim," added his lordship, "must be very large and very vague indeed to justify any Court in saying that it is impossible to sustain a patent based upon it."

Jordan v. Moore (*p*) is the nearest case in the English law books of a claim being held too large, independently of the external evidence, but it falls short of being a precedent, and comes under the second part of the rule. There the patentee claimed in one part of the claim "an iron frame for vessels, in combination with a certain arrangement of wood, forming a lining either without or within this iron frame," and in another part of the claim he spoke of "the iron frame as herein described." It was held that by using the two forms of claim he showed that he intended the first to be more general than the second, and that his object was in the first to make a general claim to every ship constructed with an iron frame, and which was lined within or without with wood. Therefore the Court, having evidence before it that there had existed ships with iron framings similar to that which the plaintiff had claimed, held that the claim was too large. or upon the evidence.

In *Patterson v. The Gas Light and Coke Co.* (*q*)—a suit to restrain the infringement of a patent for "improvements in the purification of coal gas"—the patentee's second claim was for "a method or system of employing lime purifiers in the manner hereinbefore described, whereby the contents of all the said purifiers, or any required number of them, can be converted into sulphides of calcium, and also (if required) be maintained in that condition." It was held by the Court of Appeal that this claim was too general. Claim too general. "There is (here)," said James, L. J., "no suggestion of any new apparatus, of any new process. There is no device or scheme of any kind. Lime purifiers in succession were in general, almost universal, use, wherever lime could be freely used. The gas entered one, passed from that to another, and then generally or sometimes to a third; the gas, partly purified in the washers and scrubbers, passed through the series of lime purifiers into an oxide of iron purifier. That was the process before, and that is to remain the process after and under the plaintiff's patent. What he claims to have discovered is, that if the carbonic acid which is the first thing taken up by the lime, is not wholly taken up at the beginning, and is allowed to enter the last purifier or purifiers, it in fact poisons the latter, decomposes the sulphide of calcium

(*p*) 1866, L. R. 1 C. P. 624; and per Lord Hatherley, *ubi supra*.

(*q*) 1875-76, L. R. 2 Ch. D. 812, 834.

already formed, disengages the other sulphur absorbed by the sulphide, and of course fills the gas again with the sulphur impurities which had been removed. . . . This may be a direction and instruction of the greatest possible value and utility, but it is utterly impossible to make such a direction and instruction, however valuable the subject of a patent. How could an infringement of such a patent be predicated? Could the Court say in words (if not in words, could it in effect say), 'We restrain you from working your lime purifying process in any such way as will not allow the carbonic acid to enter the last purifier in sufficient quantity to do substantial mischief, or in less quantity on an average than it used to do in former times on an average'? No one has a right to prevent a workman from using care to keep his tools in the most efficient state. No one has a right to prevent a manufacturer from cleansing his vessels and throwing away the useless contents whenever he likes, or to ask him his motives or intentions in doing so" (r).

Construction
of claim.

A claim must always be construed with reference to the whole context of a specification (s). The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. If, therefore, the specification, as containing the description, be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they professed to be part of the description (t).

General
claim may be
modified by
specification,

In *Arnold v. Bradbury* (u), the patentee by his specification described an improved ruffle or frill, and the machinery by which he proposed to make such ruffle, and to fasten it to a plain fabric by a single series of stitches, and claimed "the production by machinery of ruffles, and the simultaneous attachment of them to a plain fabric by a single series of stitches"; it was held that the claim was not, on the face of it, too large.

In *Edison and Swan, &c. Co. v. Woodhouse* (v), the patentee claimed "the herein described method of preparing the illuminating part of an electric lamp, consisting of electrically heating the

(r) *Bailey v. Robertson*, 1878, 3 App. Cas. 1055; *Gandy v. Reddaway*, 1885, 2 P. O. R. 49, 52.

(s) *Plimpton v. Spiller*, 1876-77, per James, L. J., L. R. 6 Ch. D. at p. 426.

(t) *Kay v. Marshall*, 1836, per Lord Cottenham, L. C., 2 Web. P. C. 39; *Walton v. Bateman*, 1842, per Cresswell, J., 1 Web. P. C. at p. 622; cp. *Heath v. Unwin*, 1855, per Pollock, C. B., 5

H. L. C. 540.

(u) 1871, L. R. 6 Ch. D. 706.

(v) 1887, 4 P. O. R. 99, 107. In *Newton v. Vaucher*, 1851, 6 Exch. at p. 864, it was said that a patentee's claim, which would otherwise have avoided the patent as being too wide, might be limited by the title read in conjunction with the specification.

same while it is surrounded by a carbon gas or fluid." It was objected that the expression *carbon gas* would include "carbonic acid gas" and "carbonic oxide," which were proved to be utterly unsuitable materials. The Court of Appeal, however, repelled this objection.

"Every claim in every patent," said Lindley, L. J., "must be read and construed with reference to the specification, and not as if the claim was an isolated sentence having no connection with or reference to what precedes it. To see what is meant by carbon gas or liquid, we must turn to the specification, and when we do so we cannot conceive that anyone reading this specification fairly with a view to understanding it, would ever dream for a moment that 'carbonic oxide' or 'carbonic acid' would answer the purpose, or could be meant by carbon gas."

In *Gandy v. Reddaway* (x), the patentee claimed "an invention for constructing belts or bands, for driving machinery, of cotton canvas, or duck, woven hard." The Court of Appeal held this claim to mean "that if you take any of that class of cotton canvas known in the market as *hard woven canvas*, to make belting for machinery in the ordinary way for an ordinary machine, that will do." or by evidence.

Then Lord Esher, M. R., adds:—

"If that is the construction on the face of it, could that construction be altered or modified by evidence? I think it might. If it could be shown that although those words 'cotton canvas, woven hard,' do, on the face and surface of them, claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, why then I should say that the effect would be that this would be a claim not for that part which no ordinary workman would ever take, because that would be absurd and make it bad at once, but it would bring the true construction of the specification and claim, with that knowledge, to be only for that part which an ordinary workman might take."

Patentees frequently make use of the words "substantially as hereinbefore described," in claiming a particular arrangement set out in the body of the specification. The words "substantially as hereinbefore described."

Mr. Justice Grove, in a comparatively recent case (y), commented adversely upon the use of "substantially."

(x) 1883-85, 2 P. O. R. 52.

(y) *Young v. Rosenthal*, 1884, 1 P. O.

R. at p. 33; *Westinghouse v. L. & Y. Rail. Co.*, 1884, 1 P. O. R. at p. 241.

“That word to my mind is an utterly and entirely useless word, because the law gives it to (the patentee) without (his) using it. The law says, if a man, although not literally infringing the letter of the patent, yet substantially infringes it, it is an infringement.”

The words
“or some
mechanical
equivalent.”

In a large majority of cases the words “or any mechanical equivalent,” are wholly useless, and, being useless, regard being had to the strictness with which in some senses patents are construed, ought to be left out. They amount simply to this—that if anything is claimed which is a mechanical equivalent in the largest sense, then the claim must be too large; and in favour of the patentee the Court could only construe them so as to give him the benefit that he would have had without inserting them (s).

What can be
claimed.

A principle, coupled with some mode of carrying it into effect, may be the subject of a claim (a).

A principle
applied.

“If you have a new principle,” said Jessel, M. R., in *Otto v. Linford* (b), “or a new idea as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new.

Comments on
Neilson v.
Harford.

“One of the strongest illustrations that I know of is the patent for the hot blast (*Neilson v. Harford* (c)), where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel would produce most remarkable results in the shape of economy in the manufacture of iron. The inventor or discoverer could not patent that, but what he did was this, he said, ‘I will patent that idea in combination with the mode of carrying it out; that is, I tell you you may heat your air in a closed vessel next your furnace, and then that will effect the object.’ It was held that that would do.”

Otto v.
Linford.

In *Otto v. Linford* (d), an action for the infringement of a patent for “improvements in gas motor engines,” the claim was—“admitting to the cylinder a mixture of combustible gas or vapour

(s) *Curtis v. Platt*, 1863, per Wood, V.-C., 3 Ch. D. at p. 137, n. In *Shaw v. Jones* (1889, 6 P. O. R. 333), a claim for “the production of printing surfaces, &c., &c.,” was held not to be vague, the ‘&c.’s’ having been put in not for the purpose of misleading, but *ex abundantia cautela*.”

(a) *Boulton v. Bull*, 1793-99, per Buller, J., Dav. P. C. at p. 198; *Jupe v. Pratt*, 1837, per Alderson, B., 1 Web.

P. C. 145; *Houshill Co. v. Neilson*, 1843, per Lord Justice Clerk Hope, 1 Web. P. O. 686; *Easterbrook v. G. W. Rail. Co.*, 1885, 2 P. O. R. 207. See a full discussion of the cases relating to this branch of the law under subject-matter of letters patent, *ante*, p. 21.

(b) 1881-82, 46 L. T. 39.

(c) 1841, 1 Web. P. O. 370.

(d) *Ubi supra*; *Minter v. Wells*, 1834, 1 Web. P. O. 134.

with air, separate from a charge of air or incombustible gas, so that the development of heat and the expansion or increase of pressure produced by the combustion are rendered gradual, substantially as and for the purposes set forth." It was objected that this was not the subject-matter of a patent, being merely a claim for a principle. "It is said," observed Jessel, M. R., "that what is claimed is the idea of putting a cushion of air between the explosive mixture and the piston of the gas motor engine, so as to regulate, detain, or make gradual what would otherwise be a sudden explosion. Of course that could not be patented. I do not read the patent so. I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out, but he also describes other kinds of machines which will carry it out; and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent." Then, after referring to *Neilson v. Harford (e)*, his lordship adds: "Now that is a much stronger illustration than this of the validity of a patent as regards the subject-matter. . . . In the case of the hot blast the man did not pretend to invent anything; he said, a machine of any shape in which you can heat air is sufficient. Mr. Otto does allege he has invented a machine. It appears that he did, although a machine which *per se* was not of sufficient novelty probably to support a patent. It comes, therefore, to this—that we have a principle and a mode of carrying it out, and, I will assume for this purpose, sufficiently described, and that is a good subject-matter for a patent."

A combination is not a mere collection of independent groups, nor is it simply "a putting together" of two or more things in the sense of juxtaposition; it involves also connection of some kind, so that the group, in consequence of the connection of its members, has properties or effects different from those possessed by its members separately.

The kinds of things that may properly be combined are only three in number—material, machinery, and method. "There may be a combination of materials chemically combined, or mechanically mingled or united, or compounded partly by chemical composition, partly by mechanical mixture. But there can be no combination of material with machinery, nor of material with method of operat-

Claim for combinations.

Combination defined.

Incommensurable combinations.

(e) *Ubi supra.*

ing; nor can there be a combination of machinery with method. The three kinds are incommensurable" (g).

Classes of combinations.

The combinations which form so large a part of the subject-matter of patent claims may be roughly grouped in five classes.

New compounds.

1. New compounds resulting from the chemical combination of two or more substances, *e.g.*, aniline dyes or nitro-glycerine.

What the patentee generally claims in such cases is the product.

New mixtures.

2. New mixtures without actual chemical combination.

"Thus, an alloy of two or more metals producing a compound metal presenting particular qualities may be fairly considered an invention, provided that there is some particular rule as to proportions, temperatures, or modes of fusion, which is not obvious, but must have required experiment and observation for its determination. It would not do for a patentee to say, 'I melt together lead and tin, and so produce pewter, which I claim'; because if lead and tin were put together in a ladle and sufficiently heated, they would melt and mingle independently of any invention whatever. But if a person found that by melting lead and tin together in certain proportions, or by melting them in a particular way, he could produce an alloy having some special character, he might fairly claim that special product" (h).

Mechanical union of materials.

3. A mechanical union of two or more materials—*e.g.*, macintosh cloth, made by a film of caoutchouc put on fabric, so as to render it waterproof.

Here not only the special process necessary to effect the union, but the product itself, if new and useful, might be claimed.

Machines.

4. Machines.

Processes.

5. Processes.

A process is a combination of operations pursued in regular sequence which may be either chemical (*e.g.*, soap making), or mechanical (*e.g.*, printing), or both (*e.g.*, paper-making).

Here the process, and if it is special in character, the apparatus by which it is carried on, may be claimed.

(g) See an interesting paper "On Combinations as Subjects of Patent Claims," by J. Inray, in Transactions I. P. A., vol. i. p. 135. Many years ago, in a case against the Bank of England for infringing, by the use of certain numbering machines, Chief Baron Pollock said, "You cannot have a valid claim for combination of 2½d. with a pound

of butter." See also paper on "Patent Claims," by the same writer, in Trans. I. P. A., vol. vi. p. 203; *cp. Clark v. Adie*, 1873-75, per James, L. J., L. R. 10 Ch. at p. 676, and *S. O.*, per Lord Cairns, L. C., 2 App. Cas. at p. 326.

(h) Inray on "Combination," *ubi supra*, Trans. Inst. P. A., vol. i.

A combination which is new and useful is good subject-matter for a patent although each principle, process, or material part in it is old (i).

The law as to claims for combinations must now be stated.

In *Foxwell v. Bostock* (k), Lord Westbury, L. C., said :

“The term *combination of machinery*, which has become a favourite form of words with patentees, is nothing but an extended expression of the word *machine*. It is the word *machine* writ large ; and as a patent for an improved machine, in the specification of which the improvement was not particularly stated and described, would hardly be attempted to be supported, so neither, in my judgment, can the patent for an improved arrangement or combination be supported, in the specification of which there is nothing to distinguish the new from the old. . . . I must therefore lay down the rule, which is consistent with and in reality a mere sequence from the decided cases, 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 ; it must, to use a logical phrase, assign the *differentia* of the new combination.”

Law as to
claims for
combinations.

Foxwell v.
Bostock.

Foxwell v. Bostock was discussed and explained in two later cases.

In *Harrison v. Anderston Foundry Co.* (l), Lord Cairns, L. C., said :—

“It is said to have been determined in that case that where there is a patent for a combination, there must be a discovery or explanation of the novelty, and the specification must show what is the novelty, and what the merit of the invention. I cannot think that, as applied to a patent for a combination, that is or was meant to be the effect of the decision in *Foxwell v. Bostock*. If there is a patent for a combination, the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence.”

In *Moore v. Bennett* (m), a positive interpretation of *Foxwell v. Bostock* was given.

(i) *Crane v. Price*, 1840-42 ; per Tindal, C. J., 1 Web. P. C. at p. 408 ; *Cannington v. Nuttal*, 1871, 5 H. L. 205 ; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 114, affirmed 5 Times R. 359.

(k) 1864, 4 De G. J. & S. 298, 311, 313.

(l) 1876, L. R. 1 A. C. at pp. 577, 583 ; cp. *Parke v. Stevens*, 1869-70 ; per James, V.-C., L. R. 8 Eq. at p. 365.

(m) 1884, 1 P. O. R. at p. 143 ;

Meaning of
Forwell v.
Bostock.

"It appears to me," said the Earl of Selborne, L. C., "to amount to no more than this, that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved. For example, if . . . some particular improvement, say in the arrangement of a cog, or in the arrangement, it may be, of some other portion of an old combination, which was new and useful, had been made, the general combination remaining the same, then, according to the decision in *Forwell v. Bostock*, by describing it as a new combination, you would be misdescribing it, because, indeed, the thing discovered would be a particular improvement upon a particular part or element of that combination."

"For example (*n*), supposing that a compensation pendulum was now for the first time invented, it would not do to patent improvements in clocks in general terms, and give a specification of the whole machinery of a clock, introducing somewhere, in the course of the description, the mode of making a compensation pendulum, and then end by claiming the arrangement and combination aforesaid. He must say expressly, 'I claim the invention of a compensation pendulum, and make it thus'" (*o*).

But "where the claim is for a combination (*p*), and not for particular subordinate things included in that combination, if the combination is a new one in substance and in truth, and if the manner of arriving at it and working it and the purpose for which it is useful, are all properly, sufficiently and correctly described in the specification, so that any one acquainted with the subject will know in what respect it differs from the things which have gone before, then it would be contrary to the whole policy which allows such combinations, though no part of them is new, to be the subject of a patent, to say that, besides describing clearly and

Cartsburn Sugar, &c. Co. v. Sharp, 1884, per Lord Kinnear, 1 P. O. R. at p. 185, cp.

(*n*) Per James, V.-C., in *Parkes v. Stevens*, 1869-70, L. R. 8 Eq. at p. 305; and cp. *Harrison v. The Anderston Foundry Co.*, 1876, per Lord Hatherley, 1 A. C. at p. 583.

(*o*) In *Nordenflett v. Gardner*, 1884, 1 P. O. R. at pp. 69, 74, a case decided before the present Act came into opera-

tion, it was held that the new improvement might be pointed out either in the body of the specification or in one of the claims. Under sect. 5, sub-sect. 5 of the Act of 1883, it seems that an improvement must be specified in the claim. Cp. *Siddell v. Vickers*, 1888, 5 P. O. R. at p. 432.

(*p*) Per Lord Selborne, L. C., in *Moore v. Bennett*, *ubi supra*.

sufficiently the manner of doing it, which would show every one acquainted with the subject what was the novelty in the thing, you are to go on, and though you do not want to claim subordinate parts of the combination as distinct from the entire combination, nevertheless you must specify the subordinate parts of it as constituting new elements and a new thing."

Stated shortly, therefore, the meaning of *Howell v. Bostock* is that "where you have a claim for a patent resting upon a combination, you must have that so clearly made out upon the specification that the public can know that what you claim is in truth the combination, not the specified things which make up the combination but the combination itself" (q). Combination must be claimed qua combination.

In *Rowcliffe v. Morris* (q), accordingly, a claim for "the construction of frame work for spring mattresses, substantially as hereinbefore described, and illustrated on the accompanying drawing, or any mere modification of the same," was held to be insufficient as a claim to a combination.

But in *Murray v. Clayton* (r), the following claim was held to be good:—

Claim.—"The arrangement and construction of parts herein set forth for cutting clay into bricks. I claim particularly cutting the clay into the form of bricks by forcing the clay forwards by means of a pushing board against a series of fixed wires, so arranged that the clay is forced past the wires on to a moveable board provided with handles, so that twelve or any convenient number of bricks may be removed at the same time."

"I am of opinion," said James, L. J., "that the plain meaning of the specification is that the plaintiff claims the machine. The claim is not to any particular part. It is a claim for the entire machine, produced by the arrangement and construction of the parts set forth" (s).

The law as to "subordinate integers" was very clearly put by Lord Cairns, L. C., in *Clark v. Adie* (t). Claim for subordinate integers.

"Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step or a number of steps

(q) *Rowcliffe v. Morris*, 1886, per Bristowe, V.-C., 3 P. O. R. at p. 24.

(r) 1872-73, L. R. 7 Ch. 570, 578.

(s) *Op. Westinghouse v. L. & Y. Rail. Co.*, 1884, 1 P. O. R. 229, 241; *Watling*

v. Stevens, 1886, 3 P. O. R. 39.

(t) 1873-75, 2 App. Cas. at p. 320; followed by Cotton, L. J., in *Cropper v. Smith*, 1884, 1 P. O. R. at p. 87.

in the whole, which is or are perfectly new; or the subordinate integer may not consist of new steps, but may consist of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term 'combination.' Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A., B., C., D., he may at the same time claim that as to one of those parts, D., it is itself a new thing; and that as to another of those parts, C., it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind, the monopoly would or might be held to be granted not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind, and has intended to claim protection for, those subordinate integers, and moreover he is at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

A subordinate integer may be claimed either *in gross* as a separate invention, or as appendant to the entire combination.

Claim for
subordinate
integer *in
gross.*

"When one does find in a claim," said Cotton, L. J., in *Cropper v. Smith* (u), "particular subdivisions, viz., first, second, and third, I am of opinion that it would not be right to say that when the first is as to general combination, the second and third are only to be considered as pointing out, though they are put by way of claim, that which the patentee considers material. Undoubtedly in his description he may do that as he pleases; but when we do find that he claims first of all the general combination, with a previous declaration, 'I declare that I claim, first, so and so; second, so and so; and third, so and so,' in my opinion, according to the fair construction of the language, and having regard to the use of the claim, it would be wrong to say that he is not intending to claim, as that which he protects, one, two, and three; that is to say, he treats his claim not only as a claim for the entire combination, but also as a claim to those subordinate combinations

(u) L. R. 18 C. D. 423.

which are introduced into it, and help, together with other things, to make the entire combination.”

Plimpton v. Spiller (v) is an apparent exception to the principle here laid down. In that case the subordinate claim formed and was numbered as a distinct and substantive invention. The plaintiff was the patentee of an invention for “improvements in the construction of skates.” The patent related to an improvement in roller-skates, whereby the lateral tilting of the foot-stock to the right or left caused the roller axles to converge on the side towards which the skate was inclining, and the skate ran in a curve. Thus the various evolutions practised with an ordinary skate could be readily accomplished with a skate running like a carriage upon four wheels. The plaintiff’s second claim was for “the mode of securing the runners, and making them reversible as above described.” It was held by the Court of Appeal that this claim was so stated as to be confined to the runners of the particular skate of the patentee in the same patent.

Plimpton v. Spiller explained.

“It is too absurd,” said James, L. J., “for any one to suppose that a man was claiming in the year 1865 (the date of the plaintiff’s patent), as a distinct and substantive invention, the putting of a piece of metal between two pieces of wood, and tightening them so as to hold that piece of metal fixed.”

So Brett, L. J., said (x): “If you can say that the subsidiary claim in the patent cannot under any circumstances increase the monopoly of the patent itself . . . it seems to me that the subsidiary claim is unimportant, is futile, has no effect, and, therefore, does not raise any objection to the patent.”

“*Plimpton’s Case*,” said Bowen, L. J., in *Cropper v. Smith* (y), “seems to me . . . only to be an authority upon the construction to be placed upon Plimpton’s specification. It may be used as instructive to show to what length the Court will go in allowing the general spirit of a specification to govern and prevail over the clumsy use of particular language; but except for that instructive purpose, it seems to me no more than an authority upon the true construction of *Plimpton’s Patent*.”

(v) 1876-77, L. R. 6 Ch. D. at p. 426.

(x) S. C., L. R. 6 Ch. D. at p. 433; *op. Betts v. Neilson*, 1868-71, 5 H. L. at p. 21. The specification of a patent described a process and a material, claimed the material as the result of the process, and concluded with a claim for a particular manufacture out of the material.

“If a claim to the material,” said Lord Westbury, “can be substantiated by the patent, the specification of a particular user of it, comprehended in the general user claimed, cannot for a moment be accepted as a ground for vitiating the patent.”

(y) 1884, 1 P. O. R. at p. 90.

If a claim can be read in two ways, one claiming something that has the merit of novelty, and the other claiming something which would show the man to be ignorant of all the ordinary appliances used in every workshop in the world, it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible rather than that construction which makes the patent utterly absurd (z).

Claims for subordinate integers as appendant.

When a subordinate integer is part and parcel of the invention, which a patentee is bound to give to the public as a means of working his patent, a claim for that integer will not be construed as a claim for a separate and independent invention (a).

Thus in *The British Dynamite Co. v. Krebs* (a), the patentee had claimed in his specification the mode of manufacturing dynamite, and also the modes of firing the same by special ignition therein set forth. It was held by the House of Lords that he claimed the means of explosion not in gross, but only as appendant to dynamite.

Claim for specific improvement.

If a specific mechanical improvement is claimed, the inventor must be held strictly to that particular mechanical device which he has claimed for effecting the object he had in view; and if he says it is to be done in one precise and particular way, to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed (b).

Seed v. Higgins.

Thus, in *Seed v. Higgins* (c), the patentee had claimed by his specification "the application of the principle of centrifugal force to the flyers employed in certain machinery for roving cotton and other fibrous substances," although his drawings and the specification represented only "one particular and practicable mode of applying his invention." He afterwards disclaimed all application of the law or principle of centrifugal force, except by the

(z) *Plimpton v. Spiller*, 1876, per Jessel, M. R., 6 Ch. D. at p. 423; *Westinghouse v. L. & N. Rail. Co.*, 1884, 1 P. O. R. 161; *Edison v. Woodhouse*, 1887, 4 P. O. R. 96.

(a) *British Dynamite Co. v. Krebs*, 1876-79; Goodeve's P. O. 93, 94; cp. *Britain v. Hirsch*, 1888, per Kay, J., 5 P. O. R. at p. 76.

(b) *Curtis v. Platt*, 1863 (per Wood, V.-C., commenting on *Seed v. Higgins, infra*), L. R. 3 C. D. at p. 136, n.; and see also p. 139; cp. *Palmer v. Wagstaffe*,

1853, 8 Ex. R. 840; 9 Ex. R. 601, 502; *Proctor v. Bennis*, 1888, L. R. 36 C. D. 740; *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 437, 453.

(c) 1860, 27 L. J. Q. B. 145, 411; 8 H. L. C. 550; cp. *Daw v. Eley*, 1865, 3 Eq. at p. 512. When a specification has been the subject of a disclaimer, the specification and disclaimer are to be construed fairly and not strictly. *Hocking and Co. v. Hocking*, 1888, per Cotton, L. J., 4 P. O. R. at p. 432.

particular means described in the specification. It was held that the claim was strictly limited thereto.

Everything which is not claimed is disclaimed (*d*).

Everything not claimed is disclaimed.

“If a man has described in his specification a dozen new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven; and he has no right to be protected as regards any one of the other eleven if he wishes to recall that gift which he has made by publishing the specification” (*e*).

In *Harrison v. Anderston Foundry Co.* (*f*), where the patentees claimed for a combination under their first claim, and in their second, third, and fourth claims specified the subordinate or subsidiary parts which they claimed as novel, it was held that the specification of these parts excluded the possibility of a claim for any other parts as novel.

In *Lister v. Leather* (*g*) it was laid down by Lord Campbell, C. J. (*h*), that “a valid patent for an entire combination for a process gives protection to each part thereof that is new and material to that process without any express claim of particular parts, and notwithstanding that parts of the combination are old.”

Lister v. Leather explained,

“This is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man’s invention, and the question in every case is a question of fact—Is it really and substantially a part of the invention? Supposing that a clock was now for the first time invented and patented as a machine for measuring and indicating time, a man could not evade the patentee’s right by substituting a spring for a weight, or by leaving out the whole of the striking apparatus” (*i*).

in *Parkes v. Stevens*,

“A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles as every other patent. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form; and that invention may be pirated by a

and *Clark v. Adie*.

(*d*) *Harrison v. Anderston Foundry Co.*, 1870, per Lord Chelmsford, 1 App. Cas. at p. 580; cp. *Jackson v. Wolstenhulmes*, 1884, 1 P. O. R. 105.

(*e*) *Hinks v. Safety Lighting Co.*, 1876, per Jessel, M. R., L. R. 4 C. D. at p. 612; cp. *United Telephone Co. v. Harrison*, 1882-83, per Fry, J., L. R. 21 C. D. at p. 741.

(*f*) *Ubi supra*, at p. 577, per Lord Cairns, L. C.

(*g*) 1858, 8 E. & B. 1018, 1023.

(*h*) On the authority of *Newton v. Grand Junction Rail. Co.*, 1845-46, 5 Ex. R. 331; *Sellers v. Dickinson*, 1850, 5 Ex. R. 312; *Smith v. L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69.

(*i*) *Parkes v. Stevens*, 1869, per James, V.-C., 8 Eq. at p. 367.

theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination" (j).

SECT. 5.—AMENDMENT OF SPECIFICATION.

1. *Former Law as to Amendments, Disclaimers, and Clerical Errors.*

Early law as to amendments.

Alteration of patent.

A patent was originally a record of the Court of Chancery containing the Queen's grant, made by the Court in pursuance of the writ of Privy Seal. That writ was directed to the Lord Chancellor alone, and conferred authority upon no other person: the letters patent which he made in pursuance of such a writ never passed into the custody of the Master of the Rolls; and therefore the Master of the Rolls had no jurisdiction whatever over the patent whenever a patent itself had to be altered or amended in any respect, the alteration or amendment could only be made by the Lord Chancellor, and he gave effect to it by the same means that he had made the patent, viz., by affixing to it, as altered, the Great Seal, which was in his custody (k).

Alteration of enrolment.

Clerical errors in the enrolment of letters patent or specifications were alterable by the Master of the Rolls. "It would seem," said Lord Langdale, M. R., in *Re Sharp's Patent* (l), "that it

(j) *Clark v. Adie*, 1873-75, per James, L. J., 10 Ch. at p. 676; cp. *Lawrence v. Perry*, 1855, per North, J., 2 P. O. R. at p. 184. "There might well be an infringement of a patent for an infringement of A. and B., although the infringer adopted a different mode of combination to that of the patentee."

(k) *Hindmarch*, 214 *et seq.*; cp. *Ex parte Beck*, 1784, 1 Web. P. C. 430; 1 Bro. C. C. 573.

(l) 1840, 1 Web. P. C. at p. 647; 10 L. J. Ch. 86. Though the Master of the Rolls had no jurisdiction to do more by a memorandum of alteration than to amend clerical errors, yet where a disclaimer had been filed without the consent of the patentee, it was held that the Master of the Rolls had jurisdiction, without bill filed, to order it to be taken off the file: *Re Berdan*, 1875, L. R. 20 Eq. 346.

The following are a few of the earlier cases of amendment of enrolments, a complete list of which is given by Webster, *ubi sup.*, n. (l):—

1. Pat. 2 Hen. VII. p. 1, n. 5. This

is a warrant, attached to the enrolment under the king's hand, and addressed to John, Archbishop of Canterbury, his Chancellor, reciting a grant of the office of ranger of a forest, and that in the bill and letters patent the name was mistaken and called "Kyngere" instead of "Kingesbere," and directing "the said name to be reformed, as well in our bill assigned as in our letters patent and enrolment of the same." The amendment not made.

2. Pat. 8 Hen. VIII. p. 2, n. 4. Warrant under the king's hand, attached to the enrolment, "to Cuthbert Tunstall, clerk, Master and Keeper of our Rolls and Records in our Chancery, and, in his absence, to his depute there for the time being," reciting the grant of the office of attorney in the town of "Hereffordwest," the which word was misnamed and miswritten for "Haverfordwest," and directing the former word to be erased and the latter inserted, "as well in our said letters patent and the enrolment of the same, as in our Privy Seal, whereby our said letters patent were made."

has always been usual to amend clerical errors. When errors have been made in grants, as was said, *per incuriam et ex inani inadvertentia scriptoris*, they have been amended by the Master of the Rolls, sometimes under the authority of a warrant from the

3. Pat. 35 Hen. VIII. p. 1. Date of the grant amended in the enrolment by order of Julius Cæsar, M. R., in the presence of Sir Robert Heath, Attorney-General, and others. The roll is signed by the Master of the Rolls and the Attorney-General. The date is stated to have been omitted *per incuriam*, and the enrolment made to correspond with the Privy Seal and letters patent.

4. Pat. 36 Hen. VIII. p. 4. The enrolment amended by order of Sir Thomas Egerton, Lord Keeper and Master of the Rolls, in the presence of himself and Sir Edw. Coke, Attorney-General. The roll signed by both. A word omitted *per incuriam scriptoris*, supplied so as to make the enrolment correspond with the Privy Seal and letters patent.

5. Pat. 36 Hen. VIII. p. 12. Several words, omitted in the enrolment, but contained in the Privy Seal bill, inserted by order of Lord Bruce, Chancellor and Master of the Rolls, in the presence of himself and a Master in Chaucery, and signed by both, so as to make the enrolment correspond with the Privy Seal and letters patent.

6. Pat. 37 Hen. VIII. p. 3, n. 24. The name of a county amended by order of Lord Bruce, so as to make the enrolment correspond with the Privy Seal and letters patent.

7. Pat. 2 Edw. VI. p. 4. Several words omitted *per incuriam* inserted in the presence of Lord Bruce and the Six Clerks. Roll signed by Lord Bruce, so as to make the enrolment correspond with the Privy Seal and letters patent.

8. Pat. 2 Edw. VI. p. 5. Roll amended (by the insertion of words omitted *per incuriam*), in the presence of the Lord Bruce and two of the Six Clerks, and another person, all of whom inspected the king's bill and the letters patent, and signed the roll.

9. Pat. 1 & 2 Ph. & M. p. 3. Enrolment amended in a date, upon petition to Lord Keeper Guildford, who referred it (9th of May, 1684) to the Master of the Rolls. In the margin of the enrolment is a memorandum signed by Sir H. Grimston, M. R., stating the amendment to be made by his order and in his presence.

The above petition by the Governors and Fellowship of English Merchants, for the discovery of new trades, stated

the grant of letters patent, 26th of February, 1 & 2 Ph. & M., incorporating the company; that by Act of Parliament, 8 El., the privileges by the said letters patent granted were confirmed; that the said letters patent were destroyed in the fire of London, and the petitioners having occasion to make use of the enrolment thereof, discovered the date to be written the "6th" instead of the "26th;" that it appears by the Privy Seal or warrant of the enrolment, that the *recepti* thereof is dated the 26th, and by the recital in the Act of Parliament remaining in the Rolls' Chapel. The petition was accompanied by an affidavit of the Secretary of the Company, stating that he had perused several ancient entries of the said letters patent, describing them as dated the 26th of February.

10. Pat. 1 El. p. 9. The original enrolment, on a comparison with the warrant of the queen's bill and the letters patent, being found full of gross errors, was cancelled, and the new enrolment placed in front of it by order of Sir Edward Phelps, M. R., and the memorandum signed by him.

In the margin of the second enrolment is the following: "Memorandum. The first enrolment of these letters patent being examined both with the warrant of the queen's bill signed, and the letters patent themselves under the great seal of England, the same was found full of many very gross errors and mistakings, differing both from the said warrant and letters patent. Whereupon it was prayed, that a new enrolment might be made agreeable to the letters patent under the great seal, and to the said warrant."

11. Pat. 5 El. p. 7. A single letter in the enrolment of letters patent amended, "R" instead of "L" having been written as the first letter in the name of a place. The petition to King James, setting forth the error, was referred to Sir H. Yelverton, Attorney-General, who reported that the amendment might be safely made, and that the course to have this effected was by warrant under the Signet or Privy Seal, to be directed to the Master of the Rolls to amend the same. The warrant was made out and the enrolment amended accordingly.

Amendments
of specifica-
tions.

Crown, sometimes with the consent of the Attorney-General, sometimes in consequence of a reference to him by the Lord Chancellor, and there is an instance of an amendment being made by an order of the Lord Chancellor, pursuant to an order of the King. The errors have been proved and rectified by comparison with the writ of Privy Seal, or with the signed bill, or with the original grant. . . . In a case before Lord Gifford in 1824 (*m*), the word 'wire' had been written instead of 'fire,' and he ordered the specification to be amended. In the case of *Redmund* (*n*), an erroneous transposition of numbers was amended by order of Sir John Leach, M. R., who, in a subsequent case, ordered to be amended two errors, by one of which the word 'which' was written instead of 'wheel,' and by the other of which the word 'increase' had been written instead of 'inverse.' I have had similar cases before me in which there have been errors more or less numerous, but all of the same kind. And in every case which has occurred, it has plainly been intended to do no more than amend mere slips or clerical errors made by the parties, or the agents of the parties, who, intending to make an accurate enrolment, have, by mere inadvertence, made an enrolment which was not what it purported to be, a true statement of that which the party intended at the time; and not only has strict evidence of error been required, but in order to enable any third party to dispute the validity of the amendment, and of the order, it has been directed that the order itself should be endorsed on the enrolment (*o*). It does not appear that the Master of the Rolls, as Keeper of the Records in Chancery, has ever exercised any greater authority than I have stated in matters of this kind."

Disclaimers.

According to common law, letters patent were wholly void for

(*m*) *Whitehouse's Patent*, 1830, 1 Web. P. C. 455.

(*n*) July 25th, 1828, Letters Patent, 9th November, 1821, to David Redmund, "for an improvement in the construction or manufacture of hinges for doors." The patentee stated in his petition that within the last month he had discovered that the copying clerk, in engrossing the specification and the plan annexed to it, had by mistake transposed the numbers by which, in the specification, reference was made to the plan, and that no office copy of the specification had been taken. The petition prayed that this clerical error in the enrolment might be amended. Ordered as prayed, 5 Russ. 44; cp. *In re Rubery's Patent*, 1837, 1 Web. P. C. 649, n. (*x*); *Nickel's Patent*, 1841, 1 Web.

P. C. 650; *Dismore's Patent*, 1853, 18 Beav. 538; *Adam's Patent*, 1853, 21 L. T. 38. In *Re Blamond*, 1860 (3 J. T. N. S. 800), an application for amendment of a patent, granted in 1856, by rectifying an error in the spelling of the name of the patentee, was refused by Lord Campbell, L. C., on the ground of culpable delay.

(*o*) Evidence was required by the Master of the Rolls that the error was "clerical." The practice was to produce, where possible, the original draft of the specification, and to explain how the mistake in the filed copy had arisen: *Re Dixon*, 1881, Eng. Rep. Jan. to Mar. xvi.; *Re Johnson*, 1888, ib. April to June, xiii.; *Lawson*, 69.

any defect in part, not being a mere clerical error which the Master of the Rolls had authority to amend, and the patentee was liable to be deprived of his patent from the failure of some condition, such as want of novelty in a very small part of the invention, insufficient description, ambiguous terms, uselessness of parts, inadequacy of means, indefinite claims, surplusage, no proper distinction between new and old, or some objection to the specification as not being a true, full, clear, and faithful account of the invention (*p*). The necessity of providing some mode of escape from the defects which inevitably arose from the secret and hurried manner in which experiments were formerly conducted, and the technical difficulties surrounding the correction of the public records in this department (*q*), were so impressed upon the Legislature by the evidence contained in the Report of the Select Committee of 1829, that, mainly by the exertions of Lord Brougham, an Act was passed to relieve patentees from the hardships of the common law (*r*). It is known as Lord Brougham's Act (5 & 6 Will. IV. c. 83), and will be further referred to in connection with the prolongation and confirmation of letters patent (*s*). By sect. 1 of that statute the patentee was enabled to enter with the clerk of patents, by permission of the Crown, signified by the *fiat* of the law officer (*t*), a disclaimer of any part of the title or a memorandum of any alteration therein, which, upon being filed (*u*) by the clerk of patents and enrolled with the specification, was deemed and taken to be part of the letters patent or specification in all Courts whatever.

Lord
Brougham's
Act, 1835.

Permission to enter such disclaimer or memorandum of altera-

Discretion of
law officer in

(*p*) Web. Letts. Pat., p. 17.

(*q*) The cost of altering the word "pressing" into "dressing" is mentioned as having amounted to 30*l*. Coryton, p. 181.

(*r*) The Report of the Committee of the House of Commons was ordered to be printed June 12th, 1829. The Act in question, introduced by Lord Brougham, received the Royal Assent September 10th, 1835.

(*s*) See Chapters XVIII. and XIX., *infra*, pp. 373, 404.

(*t*) The original Act provided for the signification of the Royal Assent by the fiat and signature of the Attorney or Solicitor-General in the case of an English, of the Lord Advocate or Solicitor-General of Scotland in the case of a Scotch, and of the Attorney or Solicitor-General of Ireland in that of an Irish, patent. Under the Patent Law Amend-

ment Act, 1852, patents were granted for the United Kingdom, and the assent of the Attorney or Solicitor-General alone was required for patents granted under that Act. Disclaimers, however, required the assent of the same law officers as before: sect. 39.

(*u*) This was the construction put upon the Act in *Perry v. Skinner*, 1837, 1 Web. P. C., at p. 253; and *Stocker v. Waller*, 1843, 14 L. J. C. P. 148; 9 Jur. 138 (reported as *Stocker v. Warner*, in 1 C. B. 148). Cp. *Clark v. Kenrick*, 1843, 13 L. J. Ex. 6; 12 M. & W. 221. *Perry v. Skinner* was questioned, however, in *R. v. Mill*, 1850—1851, 10 C. B., p. 389, per Jervis, C. J., in which it was held that the disclaimer must be read as part of the specification as from the date of the letters patent. See 15 & 16 Vict. c. 83, s. 39.

allowing dis-
claimers, &c.

tion was left in the discretion of the law officer of the Crown, who considered its effect and consequent legality, and the propriety of advertising to warn other persons of the intentions of the patentee. This formed a check upon the enrolment of specifications with illegal claims, in the hope of being able at any time to file a disclaimer, should it be necessary. Whenever the law officers of the Crown had reason to presume want of fairness on the part of the patentee in this respect they had power of refusing the prayer of the petition altogether, or ordering suitable advertisements, that the public might be fully apprised of the patentee's intentions (x).

Further
statutes.
Changes in
law.

The practice relating to disclaimers and memoranda of alterations was further regulated by the following statutes: 7 & 8 Vict. c. 94, 12 & 13 Vict. c. 109, 15 & 16 Vict. c. 83, 16 & 17 Vict. c. 115. The chief points of difference introduced by these enactments were: (1) In *Spilsbury v. Clough* (y), where it was decided that the grantee of letters patent, though having entirely parted with his interest, might enter a disclaimer, the judges were understood to express their opinion that, irrespective of his interest in the patent, the patentee was the proper party to disclaim. 7 & 8 Vict. c. 69, s. 5, resolving the doubt raised by that case, enacted that a disclaimer or memorandum of alteration might be made by an assignee either alone or jointly with the patentee where the latter had assigned only part of his interest. (2) By 11 & 12 Vict. c. 94, and 12 & 13 Vict. c. 109, disclaimers and memoranda of alterations were directed to be enrolled in the Enrolment Office of the Court of Chancery, whether the specifications of the invention to which such disclaimer or memorandum of alteration related had been enrolled there or not. (3) The general changes introduced by the Patent Law Amendment Act, 1852, affected the practice to the extent of substituting filing in the office appointed for filing specifications in Chancery for the filing and enrolling required by preceding Acts. The Patent Law Amendment Act provided also (sect. 39), that no action should be brought upon any letters patent in which, or on the specification of which, any disclaimer or memorandum of alteration had been filed in respect of any infringement committed prior thereto, without the leave of the law officer certified in his fiat (z). In

7 & 8 Vict.
c. 69.

11 & 12 Vict.
c. 94.

12 & 13 Vict.
c. 109.

(x) Web. Letts. Pat., p. 55, n. (m).
(y) 1842, 11 L. J. Q. B. 109; 1 Web. P. C. 255; *Wallington v. Dale*, 1852, 7 Ex. 88C.

(z) The defects of the old law as to

disclaimers were these: 1. A disclaimer was merely the renunciation of some previous claim actually or apparently made, or supposed to be made. The patentee had no power to add to or en-

Re Lucas (a), Sir A. E. Cockburn, A.-G., said that there were exceptional cases in which a disclaimer should be made retrospective, as where a person having obtained his information from the patentee presumed upon a defect in his specification, and infringed the valuable part of his patent. (4) 16 & 17 Vict. c. 115, provided for the production as evidence of certified and sealed copies of disclaimers and memoranda, without further proof or production of the originals. 5 & 6 Will. IV. c. 83, s. 1, prohibited the allowance of any disclaimer or alteration which would extend the exclusive right granted by the letters patent, which, or the specification relating to which, it was sought to amend.

16 & 17 Vict.
c. 115.

It lay, however, upon the party applying for a certificate that would make his disclaimer retrospective to satisfy the law officer that this course should be followed.

In spite of Lord Brougham's Act, the emendation of clerical errors by the Master of the Rolls continued (b). How far the power to make such corrections was affected by that statute is discussed by Lord Langdale, M. R., in *Re Sharp's Patent (c)*. "If it were alleged that the enrolled memorandum of alteration, by mistake of the writer, contained verbal or clerical errors, by means of which something was enrolled contrary to the true intent

Clerical errors
still corrected
by Master of
Rolls

large the terms of his specification: *Ralston v. Smith*, 1865, 11 H. L. C. 223, per Lord Chelmsford; *Forcell v. Bostock*, 1864, 4 De G. F. & J. 298, 306. The object of the disclaimer was merely to relieve him of insignificant, immaterial, or useless parts of his patent: *In re Derosne*, 1835, 1 Carp. P. C. 698; *Morgan v. Seaward*, 1838, 2 Carp. P. C. 104; *Reg. v. Wheeler*, 1850, per Maule, J., 10 C. B. 395; *Reg. v. Mill*, 1851, per Romilly, M. R., 14 Beav. 315; *Bate-man's Patent*, 1854, Macr. P. C. 116; *In re Lucas*, 1854, Macr. P. C. 235; *Lister v. Leather*, 1858, 8 El. & B. 1034; *Thomas v. Welch*, 1866, L. R. 1 C. P. 192.

2. The disclaimer could not be read as explanatory of the remainder of the specification; *Tetley v. Easton*, 1857, 2 C. B. N. S. 706.

3. Except with the leave of the law officer the amendment was not retrospective, 16 & 16 Vict. c. 83, s. 39; *In re Harrison*, 1853, Macr. P. C. 32; *In re Lucas*, *ubi supra*; *In re Smith*, 1855, Macr. P. C. 232; *Lister v. Leather*, 1857, 3 Jur. N. S. 433; *Seed v. Higgins*, 1860, 27 L. J. Q. B. 145, 411; 8 H. L. C. 550; *In re Medlock*, 1865, Newton's Lon. Jour. N. S. vol. 22, p. 69; *Cannington v. Nut-*

tall, 1871, L. R. 5 H. L. 205, 227.

It may be convenient to refer here to the present law by way of contrast:—

(1) The power of amendment is not restricted to mere rejection, but the amended specification must not claim an invention substantially larger than, or different from, that which was included in the original specification: Act of 1883, s. 18, sub-s. 8. (2) The amendment, in all Courts and for all purposes, is deemed to be part of the specification: *ibid.* sub-s. 9. (3) The amended specification has now a retrospective effect, subject to such conditions as may be imposed on the applicant or patentee on his obtaining leave to amend: *ibid.* sub-ss. 4, 5, 7. (4) A restriction on the right to recover damages is now substituted (sect. 20) for the leave of the law officer required by 16 & 16 Vict. c. 83, s. 39. (5) Every amendment of a specification is advertised.

(a) 1854, Macr. P. C. 235.

(b) Cf. *Rubery's Patent*, 1837, 1 Web. P. C. 649, n.; *In re Nickel's Patent*, 1841, 1 Web. P. C. 650; *Re Adams' Patent*, 1853, 21 L. T. 38.

(c) 1840, 1 Web. P. C. at p. 646.

of the party, and if sufficient evidence were given of the fact, I should think myself authorized by precedent to correct the error, and make the enrolment accord with the proved intention of the party at the time of enrolment. But it has never been supposed that the Master of the Rolls, as Keeper of the Records, had power to permit or to order an erroneous claim to be expunged or amended. The party may have claimed too much, and thereby made his patent good for nothing, or may have omitted to claim something which he was justly entitled to: but on such grounds the Keeper of the Records could not interfere on his behalf or at his instance; and I apprehend that no attempt has ever been made to induce the Keeper of the Records to expunge by his authority some claim which the patentee desired to sustain, and was willing to defend in the course of law. Under the late statute the disclaimer is not to be such as shall extend the exclusive right granted by the letters patent. But the Keeper of the Records, as such, has no authority to decide whether there is any extension; nor has he, in that character, any means of investigating the truth and justice of the case. It is no part of his duty, when he receives the enrolment into his custody, to consider whether the Attorney or Solicitor-General has improperly given leave to file the memorandum, nor can he afterwards determine any such question."

2. Existing Law.

(a) Amendment generally.

Present jurisdiction of Master of Rolls.

Sect. 18 of the Patents Act, 1883, did not affect the power of the Master of the Rolls to allow amendments of the character above described (*d*); nor was that power transferred by the Judicature Act to the High Court of Justice (*e*).

So long, however, as the specification is in the Patent Office, and before the patent is sealed, the proceedings under sect. 18 should be the only proceedings taken by anyone asking for amendment within that section (*d*).

In *Re Dixon's Patent* (*f*), where the errors which it was sought

(*d*) *Re Gara*, 1884, per Brett, M. R. 26 Ch. D. 105. Cp. *Re Johnson*, 1877, per Jessel, M. R., L. R. 5 Ch. D. 503. In this case notice of the order was given to the Commissioners of Patents, so that the specification might be reprinted. See also *Sharp's Patent*, 1840, 1 Web.

P. C. 640; *Re Dixon*, 1881, Eng. Rep. January to March, 1881, vol. xvi.; Lawson, p. 59.

(*e*) Jud. Act, 1873, s. 17, sub-s. 6; *Re Morgan*, 24 W. R. 246.

(*f*) *Ubi sup.*

to correct were alleged to be material, an order was only made upon the petitioner giving an undertaking not to sue any person in respect of infringements committed before the date of the order. In the later case, *Johnson's Patent (g)*, however, such an undertaking was not required.

In the case of *Abel's Specification (h)*, 1876, No. 2081, where it was proved, on the trial of *Otto v. Linford (i)*, that the drawing filed with the specification contained draughtsman's errors, and that in the parts where these errors occurred the drawing was not in conformity with the description, but that a competent workman following the description could easily find out the errors and put them right; Sir George Jessel, M. R., on the petition of the agents for the patentee, praying that they might be permitted to substitute for the drawing filed with the specification a new drawing in which the errors were corrected, allowed the new drawing to be filed in addition to the original one. (6 March, 1883.)

The following are the chief provisions as to amendments (*j*) and disclaimers under the existing law:—

(1) An applicant or a patentee may, from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of *disclaimer, correction, or explanation*, showing the nature of such amendment and his reasons for the same (*k*).

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

(3) Where an amendment by way of *disclaimer, correction, or explanation* has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the *disclaimer, correction, or explanation*, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge (*m*).

Present law as to amendments and disclaimers.

Amendment by disclaimer, correction, or explanation.

Amendment by disclaimer pending proceedings.

Restriction on recovery of damages.

(g) 1831, Eng. Rep. April to June, vol. xiii.

(h) Cited by Lawson, p. 59.

(i) 1881-82, 46 L. T. N. S. 35.

(j) Amendments of titles are fully dealt with at p. 93.

(k) Sect. 18, sub-sect. 1.

(l) Sect. 19.

(m) Sect. 20.

Amendment
by comptroller
of clerical
error.

(4) The comptroller may, on request in writing, accompanied by the prescribed fee, correct any clerical error in or in connexion with an application for a patent (*n*).

Amendment
of other
documents.

(5) Any document for the amending of which no special provision is made by the Acts, may be amended, if and on such terms as the comptroller may think fit (*o*).

Request for
leave to
amend.

A request for leave to amend a specification is required to be signed by the applicant or patentee, and accompanied by a copy of the duly certified printed original specification and drawings, showing in red ink the proposed amendment, and to be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct (*p*).

Sect. 18, to
what amend-
ments applic-
able.

Sect. 18 of the Act of 1883, applies to the amendment of specifications after they have become public property; any other amendment must be dealt with under sects. 7 and 9 (*q*).

The construction of this section was considered in *Jones's Patent* (*q*). There a complete specification had been filed after a provisional, the full time (9 months) allowed by the Act for so doing being taken by the applicant. Ten weeks subsequent to the filing of the complete and prior to its acceptance, the applicant asked leave to amend under sect. 18. The comptroller did not require the application for leave to amend and the nature of the proposed amendment to be advertised, on the ground that the complete had not yet been accepted, and was therefore not open to public inspection at the date of the application for leave to amend. Webster, A.-G., held that the fact of the office not having signified its acceptance of the complete specification as lodged was immaterial, and that any proceedings for amendment must be taken in pursuance of sect. 18.

Grounds of
application to
amend.

The most usual grounds (*r*) on which application is made under

(*n*) Act of 1883, sect. 91 (*a*).

(*o*) P. R. 1890, r. 16. This was rule 18 in the P. R. 1883.

(*p*) P. R. 1890, r. 52, and Form F, p. 742. Applications may be sent to the Patent Office by prepaid letter. P. R. 1890, r. 16 *a*.

(*q*) *Jones's Patent*, Griffin, P. C. 313.

(*r*) It may be interesting to extract a few of the actual advertisements of applications to amend from the Illustrated Official Journal (Patents) for 1889. Each list of applications has the following heading:—*Notice is hereby given that*

any person or persons intending to oppose any of the under-mentioned applications must leave at the Patent Office, within one month from the date of this journal, notice (on Form G.) of his or their objections thereto. N.B.—The paging referred to is that of the printed specifications. Then follow the advertisements.

E.g. (1) "No. —, 15th July, 1889. Improved grids or supporting frames of electric accumulators.

E—C—, has applied for leave to amend the specification above referred to, alleging as his reasons: 'That my

sect. 18 for the amendment of specifications are that it is desired to correct sundry errors, clerical and otherwise, which interfere with the due comprehension of the specification, that it is doubted whether the subject-matter of one of the claims is good and novel, that the claims might be construed as covering subject-matter which was of doubtful novelty at the date of the patent, that the applicant desires to make the specification more clear, and to limit the scope of the claims which as they stand are too wide, that the applicant has since discovered that his specification claims more than he desired, that it is proposed to insert in the original application the name of a joint applicant, that reference to prior patents was omitted in the former specification.

That a patentee desires the principle upon which his invention is based to be fully understood is not a sufficient reason for an amendment. It is the duty of a patentee to fulfil the condition of his patent and to file a proper and sufficient specification (s). Duty of patentee.

An amendment will not be disallowed merely because the reasons given for it are insufficient (t).

The plain language of the operative part of a disclaimer is not

instructions were misunderstood by the draughtsman, and the draughtsman's error has been to some extent followed by the writer of the specification in order to make it agree with the drawing. Also that I am not acquainted with the English language.'

The proposed amendments are as follows:—

On page 1

Line 7. To strike out ' '

Line 38. To insert ' ' &c.

(2) "No. —, 26th January, 1888. Improvements in matchboxes.

J. B. and A. A. B. have applied for leave to amend the specification of letters patent above referred to, alleging as their reasons: 'That we have ascertained that the specification of a foreign patent, which was open to inspection in the United Kingdom before the date of our said patent, referred to an invention having some of the features contained in the modification described under Figures 2 and 3 of the original mode of carrying out our invention described under Figure 1, and that the aforesaid foreign patent might be considered as an anticipation of such parts,' &c.

(Amendments set out as before.)

(3) "No. —, 26th August, 1884. Improvements in machines for producing stereotype matrices, and for printing.

J. B. (assignee) has applied for leave to amend the specification of letters patent granted to O. M. above referred to, alleging as his reasons; 'That I am advised that there are certain clerical errors and inaccuracies in the language of the specification, which interfere with its real meaning, that parts of the specification and claims may receive an erroneous interpretation, and that all the reference letters in the specification do not appear throughout the figures,' &c.

(Amendments set out as before.)

(4) "No. —, 5th March, 1889. Improvements in and connected with watch bows and pendants.

F. G. F. has applied for leave to amend the specification of letters patent above referred to, alleging as his reasons: 'That I desire to better explain and define the scope of the invention, to exclude a part of the invention claimed, and to correct an omission on the drawings,' &c.

(Amendments set out as before.)

(s) *Re Nordenfelt*, 1887, per Webster, A.-G., Griffin, A. P. C. at pp. 20, 21. Here the law officer's decision was influenced by the fact that a complete specification had been filed in the first instance.

(t) *Re Ashworth*, 1886, per Davey, S.-G., Griffin, A. P. C. p. 7.

to be controlled or modified by any introductory sentences with which the patentee may think fit to preface such disclaimer. The reason for a disclaimer is no part of the disclaimer itself (*u*).

Who may
apply for
amendment
under sect. 18.

The persons who may apply for the amendment of a specification under this section are (1) an applicant who has filed his complete specification; and (2) a patentee, *i.e.*, "the person for the time being entitled to the benefit of a patent" (*x*).

Under this definition of patentee, it is clear that an assignee and a mortgagee may be applicants for leave to amend. It was formerly held that a patentee could disclaim even after wholly (*y*), or partially (*z*), assigning his interest in a patent.

Second
disclaimers.

Second disclaimers are clearly permissible (*a*), but are not to be encouraged if they can possibly be avoided. And the Law Officer on appeal may refuse to make an order as to costs in favour of a successful applicant (*b*).

In *Re Arnold* (*c*), an application for leave to amend had been made in 1885, had been refused by the comptroller, and had not been appealed against. Two years later a second application, for substantially the same amendment, was made by the same applicant. The comptroller refused to allow it, and an appeal was taken to the Law Officer. Webster, A.-G., said that he thought the proposed amendments were such as he would allow to be made, but required an explanation of there having been no appeal against the former decision of the comptroller. The case was accordingly adjourned and declarations were put in alleging that the applicant was ignorant of patent law, and that he was not aware until after the comptroller had rejected his second application that he could have appealed on the former occasion. The Attorney-General held that this was not a sufficient explanation, and dismissed the appeal.

Amendment
by explana-
tion.

The function of an "explanation" within sect. 18 is to permit a man to amend, correct, and explain the enunciation of his invention as he intended originally to give it. It was not intended that he should put in subsequently ascertained knowledge (*d*).

(*u*) *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205, 227, 228.

(*x*) Act of 1883, s. 46.

(*y*) *Wallington v. Dale*, 1851-52, 7 Ex. R. at p. 910.

(*z*) *Spilsbury v. Clough*, 1842, 1 Web. P. C. 255.

(*a*) Act of 1883, s. 18, sub-s. 1.

(*b*) *Re Haddan*, 1885, Griffin, A. P. C. 13.

(*c*) 1887, Griffin, A. P. C. 5.

(*d*) *In re Beck and Justice's Patent*, 1886, Griffin, A. P. C. 10. But an explanation will be allowed, which is necessary to remove an ambiguity which prevents the real meaning of a patentee from being understood. *Re Ashworth*, 1886, Griffin, A. P. C. 6. So if a specification is on the face of it clearly capable

In *Re Beck and Justice's Patent* (e), an unopposed application to amend the specification of a patent for "improvements in nozzles for the escape of steam or gases under pressure," one proposed amendment was a rider giving detailed measurements relating to gas engines. There was no mention of gas engines in the original; and the applicant admitted that a good deal of the information given was necessitated by the development of the discovery of the gas engines, or by gas engines being more largely used and developed. This amendment was refused.

Must not give subsequently ascertained knowledge.

The defect which is to be cured by an explanation must be one which is consistent with the patentee intending to fulfil the condition of his patent by properly describing his invention (f).

Must be consistent with fulfilment of condition of patent.

Re Nordenfelt (f), was an application for leave to amend the specification of a patent for improvements in the manufacture of castings for wrought iron and steel. The invention consisted in the admixture of metallic aluminium or aluminium alloy with molten iron or steel before casting the same into moulds. The applicant proposed to add a long explanatory statement of the proportions required, and of the character of an alloy in which the aluminium might be introduced, if not introduced pure. Both amendments were rejected. "Before the patentee," said Webster, A.-G., "can insert anything into a description which if the invention were new was sufficient, and if not was open to serious objection, I think he must show that there is a real reason for requiring it. The principle of his invention was in my opinion amply described in his original complete specification."

A statement in an amendment imputing faults to all formerly used or patented methods will not be allowed (g).

In any question of doubt it is not the duty of the law officer to disallow an amendment, because his decision, being final, might thereby deprive a patentee of valuable rights, whereas the patentee takes the amendment at his peril (h).

of two constructions, it is open to the person applying to satisfy the law officer or the comptroller, on the face of the specification, that he desires to limit the claim to one or more of them. *Re Ryland*, 1888, per Webster, A.-G., 5 P. O. R. at p. 668. In *Bateman's Patent*, 1854, Macr. P. O. 116, where there was some evidence upon the face of a specification that the patentees intended their invention to comprise an entire apparatus, but at the end of the specification they claimed the several

parts of the apparatus, Bethell, S.-G., allowed a disclaimer, the effect of which was to convert the claim into one for the combination. Higgins's Dig. p. 251.

(e) 1886, Griffin, A. P. C. 10.

(f) *Re Nordenfelt*, 1887, Griffin, A. P. C. 18.

(g) *Re Hampton and Facer*, 1887, per Clarke, S.-G., Griffin, A. P. C. at p. 15.

(h) *Re Lake*, 1887, per Webster, A.-G., Griffin, A. P. C. 16; cp. *Bateman's Patent*, 1854, Macr. P. O. 116.

Opposition to amendments.

Notice of opposition to a proposed amendment may be given at any time within one month from the first advertisement above referred to (*h*).

Grounds of opposition.

The notice of opposition must state the ground or grounds on which the person giving notice intends to oppose, and must be signed by him, state his address for service, and be accompanied by an unstamped copy (*i*).

Statutory declarations.

This copy is forwarded by the comptroller to the applicant (*k*). Within fourteen days after the expiration of one month from the first advertisement of the proposed amendment the opponent may leave at the Patent Office, and on so doing shall deliver to the applicant a list of statutory declarations in support of his opposition (*l*). The applicant has fourteen days thereafter to lodge at the Patent Office and deliver to the opponent statutory declarations in answer, and within fourteen days from such delivery the opponent may lodge statutory declarations in reply, which must be confined to matters strictly in reply. The evidence is then closed on either side except by leave of the comptroller on the written consent of the parties or on special application to him. Ten days notice, at least, of the date of hearing is given by the comptroller to the parties (*m*), and the comptroller then hears and decides upon the case subject to an appeal to the law officer (*n*), whose decision is final.

Conditions imposed.

As the decision of a case does not necessarily involve an absolute refusal or an absolute allowance, the comptroller is at liberty to impose conditions (*o*), and he has the same power in this respect as the law officer on appeal (*p*). The comptroller has, however, no power to make the payment of costs a condition of allowing an amendment (*q*). Only a person "being in the opinion of the law officer entitled to be heard," can oppose the amendment of a specification before the law officer (*r*). It is doubtful whether this limitation of opposition applies to proceedings before the comptroller;

Persons entitled to be heard.

(*h*) Act of 1883, s. 18, sub-s. 2.
 (*i*) P. R. 1890, r. 63.
 (*k*) *Ibid.* r. 54.
 (*l*) *Ibid.* r. 55.
 (*m*) *Ibid.* r. 53, and r. 41.
 (*n*) Act of 1883, s. 18, sub-s. 3. The law officer is not a court, and no prohibition lies to prevent him allowing an amendment forbidden by sect. 18 of the Act of 1883. *Re Van Gelder*, 1889, 6 P. O. R. 22; reported as *Ex parte Simon*, 4 Times Rep. 764. A prior patentee may oppose on the ground that an amendment if allowed would have a

prejudicial effect upon his rights under a patent. *Re Hampton and Facer*, 1887, Griffin, A. P. C. 13.

(*o*) *Hearson's Patent*, 1884, Griffin, P. C. 309.

(*p*) *Re Pietschmann*, 1884, Griffin, P. C. 314.

(*q*) *Re Pietschmann*, 1884, Griffin, P. C. 314, impliedly overruling *Re Codd*, 1884, Griffin, P. C. 303.

(*r*) Act of 1883, s. 18, sub-s. 4. See Chapter LX., pp. 175—178, where the question of who is "entitled to be heard" before the law officer is considered.

but in the case of *Re Bell* (s), the comptroller went into the question of the opponent's interest, although it was not directly raised.

In *Re Cochrane* (t), subsequent to notice of opposition to a grant, and prior to the hearing of such opposition, the applicant applied under sect. 18 for leave to amend. The two oppositions were fixed for hearing on the same day, and the question arose as to which should be heard first. The applicant urged that the amendment should be heard first, on the ground that probably if the amendment were allowed the sting would be taken out of the opposition to the grant of the patent. The comptroller took this view, and the amendment case was taken first.

Amendment and opposition contemporaneous.

Where no notice of opposition is given, or the opponent does not appear, an applicant or patentee may nevertheless appeal to the law officer against the comptroller's decision refusing leave to amend (u).

Appeal in unopposed cases.

In such cases, unless under very special circumstances, the Comptroller-General neither gives nor receives costs (x).

Comptroller's costs.

In *Re Morgan* (y), an unopposed application for leave to amend the specification of a patent ten years old, rejected by the comptroller, was allowed by the law officer. The applicant then asked for an order for a return of the stamp on the notice of appeal, but this was refused. "This was a case," said Webster, A.-G., "in which the Comptroller-General was quite right in declining to allow it in the first instance and to leave it to the law officer. There was quite sufficient difficulty about it. It is a ten year old patent, and therefore I should not be disposed to make a special order."

The evidence brought before the law officer on appeal must be the same as that brought before the comptroller, and no further evidence may be given except with the law officer's leave, save as to matters which have occurred or come to the knowledge of either party since the date of the decision appealed against (z).

Evidence before the law officer.

Thus, in *Re Cheesebrough* (a), it appeared that certain words were objected to by the opponents before the comptroller, and were struck out. On appeal, the opponents objected that the original notice as advertised did not request that these words should be struck out, and that they could not now be excised. Herschell, S.-G., held, however, that as the retention of these words had been objected

(s) 1887, Griffin, A. P. C. 11.

(t) 1885, Griffin, P. C. 304.

(u) Act of 1883, s. 18, sub-ss. 5-7.

(x) *Re Lake*, 1887, per Webster, A.-G., Griffin, A. P. C. at p. 17.

(y) 1886, Griffin, A. P. C. 17.

(z) L. O. R. r. 8; *Re Hampton and Facer*, 1887, Griffin, A. P. C. 13.

(a) 1884, Griffin, P. C. 303.

to by the opponents before the comptroller and he had struck them out, the opponents could not now object to their omission.

Costs before
law officer.

Under sect. 38 of the Act of 1883, the law officer may order payment of costs (*b*). The comptroller has no power to award costs.

In *Re Ashworth* (*c*), where the specification was loosely framed, Davey, S.-G., although allowing an amendment, refused to give any costs of the appeal.

Conditions of
amendment.

In the case of patents granted under the old law,—as a general rule and apart from special circumstances, which any party is at liberty to bring forward (*d*),—a condition when desired will be imposed that no action shall be brought or other proceeding taken for any infringement prior to 1st January, 1884 (*e*).

Such a condition protects the continued user of articles made by the opponents prior to 1st January, 1884, subsequent to that date, and also the sale of articles in stock and unsold prior to 1st January, 1884 (*f*).

Special cir-
cumstances.

The nearest approach to a definition of "special circumstances" is that given by Davey, S.-G., in *Re Ashworth* (*g*): "If I saw, or if there was any evidence before me that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons, and endeavouring to prevent persons from making or selling (the subject-matter of the patent in question, viz.,) wire hardened and tempered in a mode different from that which was claimed, I should consider that a special circumstance, and under those circumstances, as far as I am personally concerned,

(*b*) *Aliter* under the Act of 1835; *Kynoch v. National Small Arms Co.*, 1877, 37 L. T. N. S. 31.

(*c*) 1886, Griffin, A. P. C. at p. 9.

(*d*) *Re Haddan*, 1885, per Webster, A.-G., Griffin, A. P. C. at p. 13.

(*e*) *Re Hearson*, 1884, 1 P. O. R. 213; cp. *Re Cheesebrough*, 1884, Griffin, P. C. 303; *Re Westinghouse*, 1885, Griffin, P. C. 315; *Re Ashworth*, 1886, Griffin, A. P. C. 6.

(*f*) *Re Cheesebrough*, *ubi supra*, per Herschell, S.-G.: "If the opponents, however, had been making the (articles) after notice that the patentee was going to disclaim, there would be a good deal to be said for not protecting them." S. C.; cp. *Re Harrison*, 1853, Macr. P. C.

31; *Re Medlock*, 1865, Newt. Lond. Jour. N. S. vol. 22, p. 69. In *Re Smith*, 1855. Cockburn, A.-G., said, that the undertaking not to sue in respect of past infringements must be wide enough to include not only opponents but everyone. He refused, however, to protect persons who had contracted to supply the patented articles, and claimed immunity up to the time of the termination of their contracts. Macr. P. C. 232, 234; *Re Tranter*, 1873, John. Pat. Man. 191; *Re Jones*, 1881, *ibid.* 192; *Re Crabtree*, 1881, Eng. Rep. Jan. to Mar. 1881; *Re Westinghouse*, 1886, Griffin, P. C. 315.

(*g*) 1886, Griffin, P. C. at p. 9.

I should impose the condition that no action should be brought for anything done at any time before the amendment."

"I do not think," said Webster, A.-G., in *Re Haddan (h)*, "any law officer or Comptroller-General can put down what are the most convenient means of identifying machines. . . . What would be sufficient in one case would be wholly inapplicable in another. It would be much better that the parties should agree upon a form which will be applicable to their special business, and submit that to the Comptroller-General, rather than to leave the language to be settled by him, especially as it is not desirable to have appeals upon the question of terms. The agreed words should be sent to the patent clerk to be embodied in the order."

Identification
of protected
articles.

In *Re Edison (i)* the instruments allowed to be used were ordered to be marked with identifying marks.

In *Re Westinghouse (k)*, an application for leave to amend the specification of a patent for "improvements in apparatus for working brakes and communicating signals on railway trains," James, A.-G., imposed a condition that no action should be brought in respect of certain specified apparatus made in alleged accordance with the said specification, and fitted to rolling stock prior to 1st January, 1884, and ordered each opponent to furnish the patentee with a full statement of the locomotives and other vehicles belonging to them respectively, and fitted with the protected apparatus, with numbers and other distinguishing marks, and to give notice, from time to time during the subsistence of the patent, of any change in any apparatus so fitted, except mere renewals of parts.

In the case of patents issued since the passing of the Act of 1883, no condition will be imposed as to the bringing of actions for infringement prior to the date of the amendment, but the matter will be dealt with by the Court under sect. 20 (*l*).

The Act of 1835 (*m*) provided that no disclaimer or alteration should be allowed which *extended* the exclusive right granted by the letters patent.

Act of 1835.
No amend-
ment must
extend grant.

The meaning of the word "extend" was considered in *Ralston v. Smith (n)*. R. took out a patent for "improvements in embossing and finishing woven fabrics, and in the machinery and apparatus

(h) 1885, Griffin, A. P. C. 12.

(i) Lawson, p. 64.

(k) 1885, Griffin, P. C. 315.

(l) *Re Allen*, 1887, per Clarke, S.-G., Griffin, A. P. C. 3.

(m) 5 & 6 Will. IV. c. 83, s. 1.

(n) 1865, 11 H. L. C. 293.

No amend-
ment must
extend grant.

employed therein." In his specification, he stated: "I employ a roller of metal, *wood*, or other suitable material, and groove, flute, engrave, mill, or otherwise indent upon it any desired design." R. afterwards entered a disclaimer, in which he disclaimed from the title and from the description of the roller the words in italics, and restricted the grooves or flutes on the roller to those of a circular kind. It appeared that R. had discovered that any other grooves would not only not produce the desired effect on the fabric, but would destroy it. It was held by the House of Lords that the disclaimer extended the exclusive right, and consequently was bad.

Meaning of
"extend."

"The word 'extend,'" said Lord Chelmsford, "in 5 & 6 Will. IV. c. 83, cannot be used only in its ordinary sense of 'adding to' or 'enlarging,' because the exact meaning of the term 'disclaimer,' to which it is applied, is the renunciation of some previous claim actually or apparently made or supposed to be made (o). It must, therefore, be intended to comprehend a case where the disclaimer would give the patentee a right which he could not have enjoyed under the specification as originally formed. Here the specification was conceived in general terms, embracing an infinite variety of modes of indenting upon all descriptions of rollers any desired design. The plaintiff afterwards discovered that no other rollers but those which had circular grooves, flutings, or indentations around their surfaces would answer, and he therefore, by his disclaimer, limited his invention to this description of rollers only. Now, as these were not specifically described in the original specification, but were merely involved in the general terms which were used, the plaintiff had not complied with the condition of the letters patent in particularly describing and ascertaining the nature of his invention. When, therefore, by his disclaimer he confines his claim to circular grooved rollers as his sole invention, though in one sense he may be said to narrow a right, yet he really extends it, because he thereby describes his alleged invention sufficiently to enable him now to assert a right under the patent which he never could have successfully maintained upon the patent alone."

Where, however, the patentee of "improvements in machinery

(o) But the mere fact of a disclaimer being made by a party to whom a grant has been made, does not necessarily import that the original patent was void.

Stocker v. Waller, 1845, per Tindal, C. J., 9 Jur. 138, reported as *Stocker v. Warner*, in 1 C. B. 148.

for preparing, slubbing, and roving fibrous substances," described in his specification a particular method for the application of centrifugal force, and claimed (1) the method so described, and (2) every other application of centrifugal force to the purpose set forth, it was held that a subsequent disclaimer of every application of the law or principle of centrifugal force, except that only described in the specification, did not extend the right granted by the patent (*p*).

Under the present Act (*q*) it is provided that no amendment will be allowed that would make the specification as amended claim an invention substantially larger than or different from the invention claimed by the specification as it stood before amendment (*q*). Act of 1883.
No amendment may make invention larger.

Although these words are apparently wider than the corresponding proviso in the Act of 1835, the practice does not seem to have been materially altered under the new law, and any amendment or disclaimer will in general be allowed, which merely (1) removes an ambiguity rather than a defect in the original claim; (2) restricts or does not enlarge the original claim, or (3) alters part of the description without affecting the claim. Present practice substantially the same.

Reference to a few cases will make the modern practice clear. Cases.

In *Re Allen* (*r*) a patentee who had claimed "the use of pipes of novel form, constructed of earthenware, to form, as herein above stated and described, a direct connection . . . with the main drain," asked leave to omit from the title the words "of novel form"; to insert before claim, "I do not claim as novel pipes one, two, and three respectively," and to alter the claim to "the use of pipes of the above form constructed of earthenware." The patentee contended that he had worded his original specification in perfect good faith and with such skill and knowledge as he possessed, but as he had not had professional assistance in the matter, he, without meaning to do so, claimed the *form* of the pipes as novel, as well as claiming the use and application of them, which was all he intended and wished to claim. Clarke, S.-G., allowed the proposed amendments. "I think," he said, "that my business in this case is to look at the specification, to take into consideration the declaration which has been made by the patentee as to the way in which he drew it up, and as to his intention, and to exercise my judgment as to what I should fairly have considered, upon reading the speci- *Re Allen*.

(*p*) *Seed v. Higgins*, 1858, per Lord Chelmsford, 8 H. L. C. at p. 668; cp. *Reg. v. Mill*, 1850-51, 10 C. B. 379.

(*q*) Act of 1883, s. 18, sub-s. 8.
(*r*) 1887, *Griffin*, A. P. C. 3.

fication, he intended to claim. . . . However clumsily the specification was expressed, I think that substantially it claimed the arrangement of the pipes, and not the form of the particular pipes, and I therefore think that the amendment will not enlarge the claim, and will not make it a claim for a different invention, but will remove ambiguity rather than defect in the original claim "(s).

Re Cochrane.

In *Re Cochrane (t)*, where the original specification, describing an invention for an improvement in moulds for cooling and discharging slag, claimed all angular or wedge-shaped slag boxes, an amendment was allowed confining the claim to a particular class of slag box, which was included with a number of other slag boxes in the previous claim.

"If you have got a claim," said Davey, S.-G., "for A, B, C, D, E, and F, and you confine it to F, that is a narrower claim than the original, and it is not different because it is included in the old claim."

Re Nordenfellt.

In *Re Nordenfellt (u)*, the original specification directed the addition of aluminium, or alloy of aluminium, to metal when molten, shortly before it was to be poured, and then stated that *the addition might, however, be made earlier*. The patentee was allowed to disclaim the words in italics. "It is clear," said Webster, A.-G., "that that could not extend the claim, whereas now it stands as a claim to put in the aluminium at the melting point or earlier; the striking out of those words would limit it to the time indicated—the melting point."

Re Lake.

In *Re Lake (x)* it was proposed to amend the specification of a patent for "improvements in and relating to the manufacture of colouring matter," by altering part of the description of the process without amending the claim. Webster, A.-G., allowed the amendment, on the ground that on the information before him he was unable to see that it extended the grant.

Re Morgan.

In *Re Morgan (y)* an application was made to amend the specification of a patent for "improved watch-keys." In the original description the applicant had misdescribed one of the figures, No. 3, in the sheet of drawings. He proposed to insert a correct

(s) The Solicitor-General added, however, "Inasmuch as these proceedings have been rendered necessary by the misfortune (to say the least of it) of the patentee in preparing his specification in the way he did, of course I shall say nothing about costs."

(t) 1885, Griffin, P. O. 304, 305; *Re Ashicorth*, 1886, Griffin, A. P. C. 6; *Re Rylands*, 1888, 5 P. O. R. 665.

(u) 1887, Griffin, A. P. C. 20.

(x) 1887, Griffin, A. P. C. 16.

(y) 1886, Griffin, A. P. C. 17.

description of it, and to add at the end of his claim the words *and as illustrated in the accompanying drawings*. Figure 3 was included in the provisional and also in the claim of the complete specification. Webster, A.-G., held that the amendment should be allowed, as it was included in the original claim.

But the applicant will not be allowed to amend his specification by disclaiming the main part of the original invention, even if he merely claims an obvious alternative resting on the part which he proposes to omit (*z*).

Again, the insertion of a single word, which introduces, however, an entirely new feature into the original specification, will not be permitted (*a*), and when there is a distinct and specific claim, without any claim being made to a minor arrangement of parts, a patentee cannot strike out the whole of his claim and insert an independent claim to a subordinate part (*b*).

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

In the previous Acts, and down to the present Act, the leave of the law officer did not give validity to a disclaimer which extended the scope of the invention, or altered it substantially. That was decided in the case of *Dudgeon v. Thomson* (*d*), by the judgment of Lord Blackburn, and also by the language of the then Attorney-General, Sir Richard Bethell, in *Bateman's Patent* (*e*). In the present Act the language of the old statutes is to some extent recast; but no *prohibition* will issue against the law officer on the ground that he has allowed an amendment improperly, and if an amendment be allowed contrary to the terms of sub-sect. 8 of sect. 18 of the Patents Act, 1883, the amendment can be questioned in any subsequent proceedings. This was laid down in the well-known case of *Van Gelder's Patent* (*f*).

In this case, V. having applied at the Patent Office for leave to amend his patent, S. opposed. The comptroller allowed the proposed amendment. S. appealed to the law officer, and the Attorney-General then intimated that the amendment should be allowed. S. applied to the Court of Queen's Bench for a prohibition to pro- No prohibition to law officer for improper amendment.

(*z*) *Re Heath and Frost*, 1886, per Clarke, S.-G., Griffin, P. C. 312.

(*a*) *Re Walker*, Griffin, A. P. C. 22.

(*b*) *Re Serrell*, 1889, 6 P. O. R. 101.

(*c*) Act of 1883, s. 18, sub-s. 9.

(*d*) 1874, L. R. 3 A. C. 34.

(*e*) 1854, Macr. P. C. 116.

(*f*) 1889, 6 P. O. R. p. 22.

hibit the Attorney-General from allowing the amendment, on the grounds (1) that the amendment, if allowed, would make the specification claim a larger invention than that originally patented; (2) that the amendment proposed to be allowed had not been advertised. Held, by the Divisional Court, that a rule nisi for a prohibition ought to be granted on the second ground, but not on the first. S. appealed to the Court of Appeal, who intimated that the owners of the patent and the Attorney-General ought to be heard on the matter, and directed them to be served with notice of motion. This having been done, and the matter argued—held (1), that no prohibition would issue against the Attorney-General in the matter; (2), that if an amendment of the specification were allowed, which was contrary to sub-sect. 8 of sect. 18 of the Patents, &c. Act, 1883, it could be questioned in a subsequent action (*f*).

(b) *Disclaimer pending Action.*

Disclaimer
pending
action.

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

Practice under
sect. 19.

Liberty to apply to amend (*i*) will not be given to one party

(*f*) It would seem that in any case where on the hearing an amendment is proposed to be allowed, which has not been advertised, it should be forthwith advertised, to give other parties an opportunity of opposing.

(*g*) Act of 1883, s. 18, sub-s. 10; Act of 1888, s. 5; *Singer v. Stassen*, 1884, 1 P. O. R. 121, 124; *Cropper v. Smith* (No. 2), 1886, 28 Ch. D. 148, 151; *Re Hall*, 1888, 21 Q. B. D. 137. "Pending" means "before final judgment." *Cropper v. Smith*, *ubi supra*; *cp. Singer v. Stassen*, *ubi supra*; *Lawrence v. Perry*, 1885, 2 P. O. R. 188; *Haslam Co. v. Hall*, 1888, 5 P. O. R. 1, 24.

(*h*) Act of 1883, s. 19. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order must be left with the request at the Patent Office. P. R. 1890, r. 58.

Where two actions for infringement, or an action for infringement, and a

proceeding for revocation, are going on at the same time, the comptroller cannot refuse leave to amend on the ground that liberty to apply has been obtained in one of them only. *Re Hall*, *ubi supra*, overruling impliedly *Re Codd*, 1884, Griffin, P. O. 305; *Goulard v. Gibbs*, 1888, 5 P. O. R. 196. In *Re Codd*, where it was held that leave must be obtained in each of two such actions as aforesaid, the original office copy of the order previously made in the first action was admitted at the second hearing. The comptroller decided that such order was not exhausted, the application for amendment having been refused not on its own merits, but upon a technical point.

(*i*) The application may be made in chambers. *Singer v. Stassen*, 1884, W. N. 1884, p. 83. Only a disclaimer appears to be allowable under this section.

without the Court or the judge (*k*) seeing that no injustice is done to the other thereby (*l*).

It is, therefore, usually made a condition of leave being granted that (a) the costs of and occasioned by the application for leave to disclaim (*m*); (b) the costs also of the action up to the time of leave being obtained (*n*), should be paid in any event by the applicant. Conditions imposed.

Apart from the practice as to imposing costs (*o*), no hard and fast rule has been laid down as to the manner in which the discretion given by the 19th section should be exercised (*p*).

A condition that the amended specification should not be given in evidence at the trial is a reasonable one, and is often imposed, unless special circumstances are made out in order to justify such an indulgence (*p*).

Whenever the Court or a judge exercises discretion upon the particular facts of the case, the Court of Appeal will not interfere with the exercise of that discretion unless in their view it was absolutely wrong (*p*).

The judge has an absolute discretion in imposing terms under sect. 19. In *Lang v. Whitecross Co.* (*q*), the owners of a patent for wire ropes brought an action for infringement. After the delivery of the defence, they applied for liberty to apply at the Patent Office to amend their specification by way of disclaimer. The judge in chambers gave them liberty to apply, and to use the amended specification as evidence on condition that no damages be recovered, or claim for injunction founded on anything done before disclaimer, and that the costs of the action up to the time

(*k*) See sect. 117. *Semble*, the House of Lords has no jurisdiction to entertain such an application. *Cropper v. Smith*, 1883-84, 28 Ch. D. 148.

(*l*) *Goulard v. Lindsay*, 1888, per Cotton, L. J., 38 Ch. D. at p. 41; op. *Bray v. Gardner*, 1887, 34 Ch. D. 668.

(*m*) *Winter v. Baybut*, 1884, 1 P. O. R. 76; *Singer v. Stassen*, 1884, *ib.* 121; *Codd v. Bratby*, 1884, *ib.* 211.

(*n*) *Fusee Vesta Co. v. Bryant and May*, 1887-88, 34 Ch. D. 458; 37 Ch. D. 120; 4 P. O. R. 73; *Haslam, & Co. v. Goodfellow*, 1888, 37 Ch. D. 118, 123. In this case the applicant was required to pay costs of the action only in so far as the previous proceedings could not be used in the amended action. See *Goulard v. Lindsay*, *ubi supra*, 38; 5 P. O. R. 194. Here the Court of Appeal refused to give costs on the

higher scale. *Ubi supra*, at p. 197. In the case of *Fusee Vesta Co. v. Bryant and May*, *ubi supra*, at p. 461, Kay, J., refused to give any direction as to costs of obtaining the disclaimer before the comptroller.

(*o*) Sometimes no terms, except as to costs, are imposed. *Winter v. Baybut*, *ubi supra*; *Re Hearson*, 1884, 1 P. O. R. 213; *Fusee Vesta Co. v. Bryant and May*, *ubi supra*.

(*p*) *Allen v. Doulton*, 1887, per Lord Esher, M. R., 4 P. O. R. 383, explaining *Singer v. Stassen*, 1884, 1 P. O. R. 121; and *Bray v. Gardner*, 1887, 34 Ch. D. 668; op. *Re Hearson*, 1884, per Herschell, S.-G., Griffin, F. C. at p. 310. See also special terms in *Haslam, & Co. v. Goodfellow*, 1888, 5 P. O. R. 38; *Re Goulard and Gibbs*, 1888, *ib.* 189.

(*q*) 1889, 6 P. O. R. 570.

(if disclaimer used) be the defendants' costs in the cause. The judge also ordered that the costs of the application and the costs caused in the action by disclaimer be defendants' in any event, and that proceedings be stayed pending the disclaimer. The plaintiffs appealed from this order, and contended that the conditions imposed would prevent them from deriving any advantage from continuing the present action, and that the condition as to damages was not within the jurisdiction of the judge at chambers. Held, that the judge had absolute discretion under sect. 19 to impose terms, and that the order ought not to be interfered with.

Restriction on recovery of damages.

Where an amendment by way of disclaimer, correction, or explanation has been allowed, no damages will be given in respect of the use of the invention before the disclaimer, correction, or explanation unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge (*r*).

Where leave to amend is given, the applicant must, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawing as amended (*s*).

Every amendment of a specification is forthwith advertised by the comptroller in the Official Journal of the Patent Office, and in such other manner, if any, as the comptroller may direct (*t*).

Power of comptroller to correct clerical errors.

The comptroller may, on request in writing (*u*), accompanied by the prescribed fee (*x*), correct any clerical error in, or in connection with, an application for a patent, or in the name, style, or address of the registered proprietor of a patent (*y*).

(*r*) Act of 1883, s. 20.
 (*s*) P. R. 1890, r. 57.
 (*t*) P. R. 1890, r. 59.

(*u*) P. R. 1890, Form P., p. 747.
 (*x*) See p. 687.
 (*y*) Act of 1883, s. 91.

CHAPTER IX.

OPPOSITION TO GRANT (*a*).

THERE may be opposition either to the grant of a patent, or to the amendment of a specification. It is here proposed to consider the first of these subjects. The amendment of the specification and oppositions thereto are considered elsewhere (*b*).

The law and procedure in oppositions to the grant are regulated by sect. 11 of the Patents Act, 1883; by the Patents Rules, 1890, rr. 34 to 44 (*c*); and in case of an appeal to the law officer, by the Law Officer's Rules (*d*). An outline of the subject has already been given in Chapter VI. (*e*), to which the reader is referred.

On the acceptance of the complete specification, the comptroller advertises the acceptance in the Illustrated Official Journal, and the application and specifications with the drawings (if any) are open to public inspection (*f*). The specifications and drawings being left in duplicate, one set goes to the printers and the other set is open to inspection. So soon as the specifications are printed and the drawings reproduced, they can be purchased (*g*). When specifications, &c., may be inspected.

The application and the original specifications and drawings remain permanently on view at the Patent Office. These documents, and others subsequently affecting the patent, are kept together in a packet, called "the file," and may be inspected on payment of the prescribed fee. The file.

At any time within two months (*h*) from the date of the advertisement of the acceptance of a complete specification, notice of Time within which notice of opposition may be given.

(*a*) Opposition to the extension of letters patent is fully dealt with at pp. 386 *et seq.* The oppositions under the old law are treated in the notes to the Act of 1852, sect. 12, n. (*b*), pp. 650—651.

(*b*) Chapter VIII., pp. 145 *et seq.*

(*c*) Pp. 573—575.

(*d*) Pp. 559—596.

(*e*) Pp. 57 *et seq.*

(*f*) Act 1883, s. 10.

(*g*) At the Patent Office (Sale Branch).

(*h*) It is frequently the practice for the opponent to delay the giving of notice of opposition until nearly the end of the two months, as by this means less time elapses between the date of the notice and date of hearing the opposition.

opposition to the grant of the patent may be given at the Patent Office. The notice must set out the grounds of opposition (i).

Grounds of opposition.

The *only* grounds of opposition are those given in sect. 11 of Act of 1883 (k), as amended by Act of 1888, s. 4, viz. :—

Invention obtained from opponent.

1. That the applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.

Patent of prior date.

2. That the invention has been patented in this country on an application of prior date.

Complete specification intended to cover opponent's application in interval.

3. That (l) the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.

Third ground of opposition under Act of 1883, now repealed.

Under the Act of 1883, the third ground of opposition was that the examiner had reported to the comptroller that the applicant's specification appeared to him to comprise the same invention as was comprised in a specification bearing the same or a similar title and accompanying a previous application.

This provision gave rise to, and was probably altered in consequence of, cases of hardship, such as the following :

Green's Patent.

Green's Patent (m). An application by G. for a patent for "improvements in and connected with fuel economisers," was opposed by L. and S., on the ground that a prior patent had been granted to them for parts of the invention claimed by the applicant.

It was admitted by G. that the parts in his specification to which L. and S. took exception were included in their complete specification ; but he contended that as these parts were not specially described in their provisional specification, the opponents had included in their complete, subject-matter which was not in their provisional.

The Comptroller-General refused to seal a patent to the applicant until the claims to and description of those parts had been excised from his specification. This order was confirmed by Webster, A.-G., on appeal. "It is said that the opponents have included in their complete, subject-matter which was not in their provisional. If that

(i) Act of 1883, s. 11, sub-s. 1. See also Form D., Patents Rules, 1890, p. 741.

(k) *Ibid.*

(l) Act of 1888, s. 4, sub-s. 1.

(m) 1885, Griffin, P. C. 286.

is so, that is an objection to the validity of the opponent's patent, which will be available to the applicant or to anybody else in the event of any proceedings being taken; but it is wholly impossible for me on the present application to alter, deal with, or interfere with the specification of the opponent's patent as allowed. It may be a misfortune, but the opponent is unfortunately in the position in which other applicants have been."

Sufficiency of notice of opposition.—A notice of opposition to the grant of a patent must state the ground or grounds on which the opponent intends to oppose the grant, and must be signed by him. Such notice must also state his address for service in the United Kingdom, and be accompanied by an unstamped copy (*u*). Sufficiency of notice.

Where the grounds or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the title, number and date of the patent granted in such prior application is required to be specified in the notice (*o*).

Insufficiency in the notice of opposition is not, however, generally a fatal defect. Insufficiency not a fatal defect.

The Patents Rules provide (*p*) that any document for the amending of which no provision is made by the Acts, may be amended; and any irregularity in procedure, which, in the opinion of the comptroller, may be obviated without detriment to the interests of any person may be corrected, if and on such terms as the comptroller may think fit. Amendment by comptroller of documents.

A few cases will serve to illustrate the circumstances under which this power has been exercised.

In *Re Airey* (*q*) an application for a patent was opposed by S. on the ground that the applicant's "claims Nos. 1 and 2 are the same as my claims in Patent No. 4726—86, for a machine for measuring the height of human beings automatically." It was objected that the notice was not drawn in conformity with the rules, neither the date nor the title of the patent being distinctly given. The applicant had, however, before him the means of referring to the opponent's specification. The comptroller gave leave to amend at the hearing. Cases.

(*u*) P. R., 1890, r. 34.

(*o*) P. R., 1890, r. 36.

(*p*) P. R., 1890, r. 16.

(*q*) 1888, 5 P. O. R. 348; cp. *In re Daniel*, 1888, 5 P. O. R. 413. In this case the examiner had reported interference. The comptroller gave leave to amend an informal notice of opposition on the ground

that, under s. 7, sub-s. 6 of the Act of 1883, and rules 11, 12, 13, and 15 of the P. R. 1883, he had power to hear and determine the point raised by the opponent as to whether the inventions were the same, irrespective of any opposition: *Re Welch*, 1889, Goodeve, F. P. 10.

In *Re Lake* (r) an application for a patent was opposed by *Wrigley*, as agent for *Black*, the real opponent, on the grounds of (1) prior patents; (2) report by examiner of interference. The notice of opposition began, "I, *Thomas Wrigley*," and was signed "*Thomas Wrigley*, . . . agent to opponent." At the hearing it transpired that *Wrigley* had died, and *Black* applied for leave to amend the notice of opposition. Notwithstanding objection on the part of the applicant, the comptroller allowed the notice to be amended by the substitution of *Black's* name for *Wrigley's*—*Black* signing the notice.

In *Re Fawcett* (s) an application for a patent was opposed on the ground "that the invention, or *material parts thereof*, had been patented in this country on applications of prior date." The notice was objected to on account of the insertion of the words in italics. The comptroller gave leave to strike them out, and the case proceeded.

In *Re Warman* (t) an interesting point arose as to the practice where an opponent does not appear owing to the miscarriage in the post of the comptroller's letter giving notice of hearing. An application for a patent was opposed on the ground of a prior patent for the same invention. At the hearing the opponent failed to appear, and the comptroller decided to seal the patent. Subsequently the opponent's agent informed the Comptroller-General that he had not received any notice of the appointment for hearing, and filed a declaration to that effect. The Comptroller-General refused to re-open the case, but suggested that if the opponent appealed the law officer might, under the circumstances, send the case back to him for re-hearing. On appeal, Webster, A.-G., gave a direction to this effect.

On receipt of the notice of opposition, a copy of the same is transmitted by the comptroller to the applicant (u). Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations

Opposition proceedings before comptroller. Delivery of declarations: in support of opposition;

(r) 1886, Griffin, A. P. C. 35.

(s) 1889, Guodere, P. P. 10, 11; *sp. Re Jones*, 1885, Griffin, A. P. C. 33, 34. Here the opponent stated that the applicant's invention was "the same, or substantially the same," as his own. Davey, S.-G., said that the notice of opposition was wrong in inserting the words in italics which raised the question of in-

fringement, and added: "I am not entitled to express an opinion as to whether Mr. Jones's patent is novel, or even whether it is an infringement of yours, unless you show me that it is the same invention—I mean identical"; *Re Cumming*, 1884, Griffin, P. C. 277.

(t) 1885, Griffin, A. P. C. 43.

(u) P. R., 1890, r. 35.

in support of his opposition, and on so leaving shall deliver to the applicant a list thereof (x).

Within fourteen days thereafter the applicant must lodge declarations in answer, and must at the same time deliver a list of such declarations to the opponent. Within seven days from the delivery of the last-named list, the opponent must lodge declarations in reply, and such declarations must be confined *strictly* to matters in reply (y). If the opponent fail to deliver declarations, the comptroller will decide the case on a comparison of the documents before him, and if these are insufficient to support the objections taken, the opposition will fail (z).

in support of application ;

in reply.

Thus, opposition based on the ground that the applicant had obtained the invention from the opponent requires evidence to be filed in support of it. When, however, the opposition is based on the existence of a prior patented invention of which the opponent is patentee, statutory declarations are sometimes dispensed with (a).

Where declaration necessary.

In cases where the ground of an opposition is that the applicants have obtained the invention from the opponent or a person of whom he is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by the rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith (b).

In cases of fraud there must be declarations in support.

Anything which is relied on by a party, as showing the state of public knowledge prior to the date of the application, ought to, and any prior specification which it is desired to put in evidence must, be made an exhibit in order that it may be referred to.

Exhibits.

In *Re Lancaster* (c)—an application for a patent for “improvements in pistons and plungers,” opposed by B., as grantee of a prior expired patent for the same invention—the applicant produced specimens of his packing which had not been made exhibits.

Gorst, S.-G., said that the specimens, not being exhibits, could not be admitted in evidence, but that he would look at them for the purpose of enabling him the better to understand the drawings. It assisted him very much to see the specimens, but he did not go by them. When he came to determine whether the two inventions were the same, he would go by the drawings and specifications.

(x) P. R. 1890, r. 37. As to the form of such statutory declarations, see r. 17a.

(y) *Ibid.*, r. 36. Copies of the declaration mentioned in this and the last preceding rule may be obtained either from the Patent Office or from the opposite party. If the declarations in reply

do not conform to the conditions above set forth, they may be ordered to be removed from the file.

(z) See Goodeve, P. P. 20.

(a) *Re Dundon*, 1885, Griffin, P. C. 278.

(b) P. R., 1890, r. 43.

(c) 1884, Griffin, P. C. 293, 294.

In *Re Jones (c)*—an application for a patent for “the more efficiently fastening the frames of writing-slates,” opposed by D. on the ground that the invention was substantially identical with that comprised in a prior patent of his own—certain specifications of prior date to D.’s were referred to in the declarations, but D. objected to their being admitted in evidence.

Davey, S.-G., said, “You must first find out what D.’s invention is, and for the purpose of finding out what D.’s invention is, of course I can read his specification, and understand it; but for the purpose of ascertaining what his invention is, it is extremely material to know the state of knowledge upon the question of securing the frames of slates prior to and at the date of his patent.”

No further evidence shall be left on either side except by leave of the comptroller, upon the written consent of the parties duly notified to him, or by special leave of the comptroller, on application in writing made to him for that purpose (*d*). Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application (*e*). Further evidence by leave will not in general be admitted, unless the comptroller is satisfied that it was not within the knowledge of, or reasonably obtainable by, the applicant within the times previously mentioned.

On the completion of the evidence, the comptroller shall appoint a time for the hearing of the case, and give to the parties ten days’ notice, at least, of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E. (*f*). If neither party applies to be heard the comptroller will decide the case (*g*).

On an opposition before the comptroller, the applicant begins, but where fraud is alleged as a ground of opposition, the *onus probandi* rests on the opponent (*h*).

On the hearing of the case, no opposition shall be allowed in respect of any ground not stated in the notice of opposition; and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground, unless the title,

(*c*) 1885, Griffin, A. P. C. 34.

(*d*) P. R., 1890, r. 39.

(*e*) *Ibid.*, r. 40.

(*f*) Sec p. 741.

(*g*) P. R., 1890, r. 41. Formerly in practice it generally rested with the applicant to apply for a hearing, as

so long as the patent was not sealed the opponent’s object is generally obtained. In some recent cases the law officer had commented strongly on delay by the applicant in applying for a hearing.

(*h*) *Luke’s Patent*, 1886, Griffin, P. C. 294.

No evidence after reply except by leave.

Appointment for hearing.

Right to begin.

number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition (*i*).

The decision of the comptroller in the case shall be notified by him to the parties (*k*), and may be appealed against to the law officer (*l*).

Decision of
comptroller
communi-
cated to
parties.

The comptroller has no power to award costs.

Costs.

Any person intending to appeal to the law officer from a decision of the comptroller must file in the Patent Office, within fourteen days from the date of the decision appealed against, a notice of such intention (*m*), stating the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so what part of such decision (*n*).

Appeals to
law officer.

A copy of such notice of intention to appeal must be sent by the appellant to the law officer's clerk, at room 549, Royal Courts of Justice, London, and to the opponent or opponents (*o*).

Notice of appeal signed by an authorized agent is sufficient (*p*).

In *Re Anderson and McKinnell* (*p*), Clarke, S.-G., held that this rule (rule 3) did not require any notice of appeal to be sent to an applicant.

This decision was discussed in *Re Hill* (*q*). "My attention," said Webster, A.-G., "has been drawn to this rule (L. O. R., No. III.), which, although there is no date to it, appears to have been issued by the law officers shortly after the passing of the Act. My attention has also been called to the decision (*p*) of the Solicitor-General, Sir Edward Clarke, that notice need not be given to the respondent in the appeal, if he was the applicant before the comptroller. . . . I agree with the construction put upon the rule in terms by the learned Solicitor-General; but I cannot but think that the late law officers overlooked the fact that the appellants might very frequently be one or more of the opponents, and it is equally necessary, if they (*i.e.*, the applicants) are to defend their contention, that they should be summoned before the law officer. With regard to that I will either give a direction to the Patent Office or to the official clerk that notice be sent, or I will consider with the Solicitor-General the necessity of issuing a supplemental rule."

Notice of
appeal to
applicant
where oppo-
nent appeals.

In cases where by his decision the comptroller requires an amendment to be made, and does not in his decision specify the

Where comp-
troller re-
quires amend-
ment.

(*i*) P. R. 1890, r. 42.

(*o*) *Ibid.*, r. 3.

(*k*) P. R. 1890, r. 44.

(*p*) *Re Anderson and McKinnell*, 1886,
Griffin, A. P. C. 23.

(*l*) Act of 1883, s. 11, sub-s. (2).

(*q*) 1888, 5 P. O. R. 599, 601.

(*m*) L. O. R., r. 1.

(*n*) *Ibid.*, r. 2.

terms thereof, the time for appealing is regarded as dating from the day of forwarding to the opponent a copy of the amendment approved by the comptroller (*r*).

Appeal limited to terms of notice or counter-notice.

The effect of the Law Officer's Rules, 1 and 2, is to limit the hearing before the law officers to points specifically raised by the notice of appeal; and where a notice of appeal is given as to part only of the comptroller's decision, the person receiving such notice and desiring to question other parts of the comptroller's decision must give a counter-notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter-notice may be extended under rule 5 (*s*).

Upon notice of appeal being given, the comptroller transmits to the law officer's clerk all the papers relating to the matter of the application in respect of which such appeal is made (*t*).

Notice of hearing.

Seven days' notice at least (*u*) of the time and place appointed for the hearing of the appeal is given by the law officer's clerk to the comptroller, the appellant and the opponent (*x*).

Evidence on appeal.

The evidence used on appeal to the law officer is required to be the same as that used at the hearing before the comptroller, and no further evidence will be admitted, save as to matters which have occurred or come to the knowledge of either party after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose (*y*).

In *Re Bailey* (*z*) the appellant asked leave under this rule (rule 8) to put in a specification which had come to his knowledge since the hearing before the comptroller, but Davey, S.-G., refused to admit it, inasmuch as the rule related to evidence, and the specification was not evidence, but an additional ground of opposition.

Assistance of expert.

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

(*r*) *Re Chandler*, 1886, Griffin, P. C. 273.

(*s*) *Re Birstow*, 1888, per Clarke, S.-G., 5 P. O. R. at p. 289. Rule 5 provides that no appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave, upon application to the law officer. See p. 591.

(*t*) L. O. R., r. 4.

(*u*) Unless special leave for shorter notice be given by the law officer;

L. O. R., r. 6.

(*x*) *Ibid.*, rr. 6, 7.

(*y*) *Ibid.*, r. 8. In *Re Siclaff*, 1888, 5 P. O. R. 484, Webster, A.-G., stated that it was desirable that each party should hand in to the official desk a statement of the fees which had been paid before the law officer.

(*z*) 1884, Griffin, P. C. 269. Rules 9 and 10 relate to the attendance, cross-examination, and expenses of witnesses; see p. 592.

(*a*) Act of 1893, s. 11, sub-s. 4.

In *Lake's Patent (b)*, which was an opposition on the ground that the invention had been patented on an application of prior date, strongly controverted questions of anticipation, involving many highly technical chemical questions, the desirability of calling in the assistance of an expert to assist the law officer was considered; Clarke, S.-G., said, "This is a very interesting case; it involves a good deal of difficulty. The first question for me to decide is, whether I am to exercise my power of having an expert to advise me with regard to the matters which are here in discussion and dispute. Whatever advice the expert gave me upon the matter, it would have to be my judgment, and the responsibility of that judgment is a considerable one in a question of this character, and I do not think that, even if advised by an expert, I should consider it right, in view of a strongly controverted question of scientific anticipation, to decide that in a way which would put a stop to the patent now asked for. I think such a question, if it is to be discussed at all, should be discussed elsewhere, where the evidence can be more thoroughly dealt with."

The law officer will not enter into difficult and controverted questions of fact.

In the same case, it was suggested that one chemist should be called on each side, but Clarke, S.-G., refused to go into evidence of that kind, but offered to allow the opponents to make an application to cross-examine the witnesses who had made declarations. This, however, they did not press for.

In *Pitt's Patent (c)*, Clarke, S.-G., expressed the opinion that the law officer, in dealing as it were with a preliminary stage of the matter, ought not to decide difficult questions of anticipation.

Any person may oppose the grant of a patent before the controller, but on appeal to the law officer only such persons as in his opinion are entitled to be heard will be granted a hearing (*d*).

Who may oppose before law officer.

"I shall hesitate very much," said Herschell, S.-G., in *Re Glossop (e)*, "before I say that any member of the public can come in and oppose a patent, and raise an inquiry, and cause an appeal of this sort, who has no interest in it, and who simply says, 'Do not ask me what my interest is, because I have none, except that I am going to show you that this patent is the same as that.'"

In a later case (*f*), Clarke, S.-G., observed, "It seems to me

(b) 1869, 6 F. C. R. p. 548.

(c) 1888, 5 P. O. R. 343.

(d) Act of 1883, s. 11, sub-s. 3. The same rule holds good in applications for the amendment of specifications. See sect. 18, sub-sect. 4; and *Re Bell*, 1885,

Griffin, A. P. C. 10.

(e) 1884, Griffin, P. C. 285.

(f) *Re Heath and Frost*, 1886, Griffin, P. C. 288; cp. *Re Hookham*, 1886, per Webster, A.-G., Griffin, A. P. C. 32.

perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. . . . The only class of persons who are entitled to be heard in opposition before the law officer are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."

The following persons have accordingly been held (a) entitled, and (b) not entitled, respectively:—

Persons held entitled to oppose before law officer.

(a) The licensee under a prior patent (*g*); the grantee of a prior expired patent (*h*); the assignee and manufacturer under a lapsed patent (*i*).

Not entitled.

(b) An agent for the real opponent (*k*); a manufacturer under one of the patents relied on (*l*); and a person who was about to work the invention for which the prior patent had been granted (*m*).

In *Re Maccroy* (*n*), the opposition was on the ground of a prior patented invention by a person having no interest in such patents, except that he had manufactured under them. The controller heard the case, and ordered the patent to be sealed. On appeal to the law officer, Clarke, S.-G., allowed the preliminary objection, that the opponent could not be heard before the law officer, upholding *Re Glossop* (*i*), and *Re Heath and Frost* (*o*).

When an invention is a prior patented invention.

The right of opposition on the ground of a prior patented invention comes into operation immediately after the acceptance of the complete specification of that invention. An accepted complete specification is, for this purpose, a patented invention (*p*). As to the meaning of "application of prior date," where an application has been ante-dated under international and colonial arrangements, see *Everitt's Patent* (*q*), and *infra*, p. 184.

L'Oiseau and Pierrard's Patent.

This point was decided in *Re L'Oiseau and Pierrard* (*r*). In that case an application for a patent was opposed by the grantee

(*g*) *Re Hill*, 1888, 5 P. O. R. 599.

(*h*) *Re Lancaster*, 1884, Griffin, P. C. 293. "It makes no difference," said Gorst, S.-G., "whether the patent has expired or not. The Act allows an application for a patent to be opposed on the ground that the invention has been previously patented, and so long as the opponent's invention has been patented—if it were 100 years ago—it would not make any difference."

(*i*) *Re Glossop*, *ubi supra*.

(*k*) *Re Heath and Frost*, *ubi supra*. In this case leave to amend by inserting in the notice of opposition the name of the real opponent was refused.

(*l*) *Re Maccroy*, 1888, 5 P. O. R. 235.

(*m*) *Re Baird*, 1888, 5 P. O. R. 286.

(*n*) 1888, 5 P. O. R. 285.

(*o*) *Ubi supra*.

(*p*) Act of 1883, s. 15.

(*q*) 1888, Griffin, A. P. C. p. 28.

(*r*) 1887, Griffin, A. P. C. 36.

of a prior patent, which had not been sealed, but the complete specification of which had been accepted. Webster, A.-G., affirming the decision of the comptroller, held that the opponent had *locus standi*.

“I am satisfied,” he said, “that in order to give effect to sect. 15, where a person has had a complete specification accepted, he is entitled to be in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose. In fact, the proviso preventing him from taking proceedings for infringement accentuates and makes clear that position, because a limit has been put upon his rights of bringing actions for infringement, which limit would only be necessary if he were in the *quasi*-position of a patentee.”

No person is entitled to oppose on the ground that an applicant's invention is comprised in a prior provisional specification published by the Patent Office before the Act of 1883 (s).

The mere description of an applicant's invention in a prior specification is not enough (t) : it must be claimed.

“Section 11,” said Clarke, S.-G., in *Re Von Buch* (u), “sets out the grounds, and the only grounds, upon which an opposition to the grant can be made. One of those grounds . . . is ‘that the invention has been patented in this country upon an application of prior date.’ Now, it is a rule long established, and of obvious justice and importance, that only that is patented which the inventor claims.” *Von Buch's Patent.*

Again, it is no answer to a *bonâ fide* applicant for a patent to allege that experiments, or even drawings, were being made by another person. If he is the true inventor, the circumstance of something having taken place somewhere else, which was not disclosed to the world, and as to which no prior application was made, will be no answer to him, even if it were shown that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time (x).

(s) *Re Bailey*, 1884, Griffin, P. C. 269. *Seemle*, however, that if the law officer should find that there was a distinct reference in a provisional specification to an invention, or a device, which was within the specification of an opponent properly construed, he would hold the opponent entitled to a disclaimer on the face of the specification: per Webster, A.-G., in *Hookham's Patent*, 1886, Griffin, A. P. C. 33.

(t) In order to ascertain what an opponent's invention is, it is extremely material to know the state of knowledge upon the subject-matter prior to and at the date of his patent. For this purpose prior specifications may be admitted in evidence. *Jones's Patent*, 1885, per Davey, S.-G., Griffin, A. P. C. 34.

(u) 1886, Griffin, A. P. C. 41.

(x) *In re Henry's Patent*, 1872, per Lord Selborne, L. C., L. R. 8 Ch. 167.

In *Brownhill's Patent* (*y*), which was an opposition on the ground of a prior patent, it was objected before the law officer that the opponents to the grant only appealed from the comptroller's decision so far as it refused to require a reference to their patent. Clarke, S.-G., held that he could entertain the appeal.

Costs before
law officer.

In opposition appeals the law officer generally makes costs follow the event (*z*), and it appears that this rule will be followed, even if the law officer vary the comptroller's decision, as, *e.g.*, by altering the insertion in a specification, which the comptroller had permitted to pass, of a small verbal alteration not going to the substance of the claim (*a*).

In *Re Ainsworth* (*b*) the respondent failed to appear on appeal. The law officer's clerk duly issued and posted the notices of hearing required by rr. 6 and 7. Webster, A.-G., heard the appellant's case and reserved his decision. Prior to any decision being given, the respondent applied *ex parte* to the Attorney-General for leave to be heard, and satisfactorily accounted for his previous non-attendance. The Attorney-General ordered the respondent to pay the appellant's costs of the adjournment, and on this being done, another day was fixed for the hearing.

Where, however, notice of appeal, duly given, was withdrawn two days before the hearing, and no sufficient reason for the step could be assigned, the law officer ordered the appellant to pay costs (*c*).

In *Re Dietz* (*d*) the opponent, who was appellant, failed to appear at the hearing. The agent for the opponent had written to the applicant asking his consent to an adjournment, but this had been refused. Clarke, S.-G., dismissed the appeal with costs.

The several grounds of opposition must now be considered in detail.

First ground
of opposition.

1. "That the applicant obtained the invention from the person

(*y*) 1889, 6 P. O. R. p. 136.

(*z*) Per Webster, A.-G., *In re Anderson*, 1886, Griffin, A. P. C. 25; and see *In re Stubbs*, 1884, Griffin, P. C. 298, per Webster, A.-G.: "I regard these appeals as re-hearings. . . . In cases before me, where there is no fresh evidence, or where, on the merits, either the opponent succeeds, or the applicant succeeds, I shall, as a general rule, allow costs to follow the event, because I think it only right that, apart from special circumstances, costs should follow the

event; but I wish it to be understood that that will not apply to cases where there may be further evidence brought forward, or special matter which ought to influence the judgment of the law officer."

(*a*) *Re Fletcher*, 1888, Griffin, A. P. C. 31.

(*b*) 1885, Griffin, P. C. 269.

(*c*) *Re Knight*, 1886, Griffin, A. P. C. 35.

(*d*) 1889, 6 P. O. R. 297.

giving notice of opposition, or from a person of whom he is the legal representative."

Sect. 11 was intended to apply to communications between persons in the United Kingdom and the Isle of Man, and not to communications made abroad. Not available in case of imported inventions.

Where, therefore, an invention is in whole (*e*), or in part (*f*), a communication, the first ground of opposition is not available to the person from whom it has been obtained.

"Prior to the passing of the Act of 1883," said Webster, A.-G., in *Re Edmunds* (*f*), "the law was well settled that a person importing into the realm an invention, was the true and first inventor within the meaning of the statute of James, and it mattered not under what circumstances he had obtained the invention abroad. In my judgment, the Act of 1883 has made no alteration of the law in this respect. In the case of an imported invention, the merit of the invention is the importation—the communication to the public in the United Kingdom and the Isle of Man, and I think, therefore, the comptroller has no jurisdiction to inquire as to the circumstances under which the invention was obtained by the importer. Of course, there may be cases in which the relations between the parties are such that the person who has first imported the invention may be guilty of some breach of contract, or breach of duty, towards the person from whom he has obtained the invention abroad, and the importer may be liable to proceedings in respect of the breach of any such contract or duty, but in my opinion those are matters which the comptroller-general and the law officer cannot inquire into, but must form the subject of independent proceedings between the parties either in this country or abroad, as the case may be."

A person availing himself of information from abroad, is an inventor within the meaning of 21 Jac. I. c. 3, s. 6, and is therefore entitled to a patent, and it is not for the comptroller to inquire into the source of his information (*g*). Importer is inventor.

This principle does not, however, apply to a case where an applicant based his right to a patent upon the ground that he had been instructed to obtain letters patent on behalf of the original inventor,

(*e*) *Re Lake*, 1888, 5 P. O. R. 415.

(*f*) *Re Edmunds*, 1886, Griffin, P. C. 281.

(*g*) *Cp. Abel's Application*, 1876, John.

Pat. Man. p. 178; *Adolph Spiel's Patent*, 1888, 5 P. O. R. at p. 282; *Bairstone's Patent*, 1888, 5 P. O. R. at p. 287; and *Re Edmunds*, *supra*.

resident abroad, and where it was clear from the declarations filed that there was no foundation for the applicant's allegation (*h*).

In re Marshall (*i*) is a case in which the comptroller refused to seal a patent on the ground that the applicant M. had obtained his invention from S., and on appeal to law officer the decision was upheld.

In *Griffin's Applications* (*k*), the comptroller refused to stop a patent on the ground that the applicant had obtained the invention from the opponent; but on appeal Clarke, S.-G., said, that if he had any doubt about the facts he should not interfere, but that as with the evidence before him he had no doubt, he must decide that the patents should not be sealed.

Again, in *Re Homan* (*l*), an application by H. for a patent for "improvements in the construction of fireproof floors," was opposed by A., on the ground that the invention had been obtained from him. It appeared that nearly two months before the date of H.'s application, A. had registered as a design a brick of the same form as that of H. The comptroller decided that either a patent should be granted to the applicant and opponent jointly, or that a patent should be sealed on condition that the applicant disclaimed the form of brick registered by A. On appeal, Clarke, S.-G., held that Homan was entitled to claim originality in the matter, and directed the patent to be sealed unconditionally.

Practice in case of overlapping inventions.

Usually, however, the cases which arise under this head are complicated by the fact that the applicant's and the opponent's inventions overlap each other, or by the existence of some contract or relation between the parties (*m*).

In *Re Russell* (*n*), it appeared that the applicant *Russell*, and the opponent *Muntz*, had either contributed to the invention, or had arrived independently at the same result.

(*h*) *Re Fiechter*, 1882, Griffin, P. C. 284, per James, A.-G.; and see the comments of Webster, A.-G., upon this case in *Re Edmunds*, *ibid.* 283.

(*i*) 1888, 5 P. O. R. 661; cp. *Hadden's Application*, 1853, Johns. Pat. Man. 177.

(*k*) 1889, 6 P. O. R. p. 296.

(*l*) 1889, Goodove, P. C. 33; 6 P. O. R. 104.

(*m*) In such cases the comptroller sometimes decides to seal the patent in order that an appeal may be taken, when the witnesses can be cross-examined. Cp. *Re Luke*, 1885, Griffin, P. C. 294; *Re Hatfield*, 1884, Griffin, P. C. 288. The old practice was dif-

ferent. It was the duty of the law officer to hear and determine which of two rival applicants for letters patent had the better title, and not to remit the question to the Lord Chancellor by directing warrants for both patents. *Ex parte Henry*, 1872, L. R. 9 Ch. 167; *Re Evans and Otway*, 1884, L. R. 9 Ch. 279. "It is exceedingly important, especially before the comptroller, who cannot cross-examine witnesses, that there should be the fullest good faith in the statements made": per Webster, A.-G., in *Re Anderton*, 1885, Griffin, A. P. C. 25.

(*n*) 1857, 2 De G. & J. 130.

Lord Cranworth, L. C., said: "There have been many cases of the sort before me, and the principle on which I have generally acted has been that where a matter is much in doubt, it is better to run the risk of putting the party opposing the grant to the cost of making out his case in some ulterior proceedings than to withhold the Great Seal from the letters patent in the first instance, for the obvious reason, that the one course would create a remediable, the other an irremediable, injury. The question here, is whether there is sufficient doubt in the present case as to who was the inventor of this improvement to render it right to take the course to which I have adverted. Having regard to the affidavits, there appears enough to satisfy my mind of this, not that Mr. *Russell* was the inventor, not that Mr. *Muntz* was the inventor, but that they were both the inventors" (o).

When applicant and opponent are practically joint inventors.

The patent was sealed on the following terms:—

"That the letters patent should be granted to two trustees, one to be named by each party. Each party to have a free license to himself and partners (if any). All costs of both sides properly incurred in the matter of the patent to be borne and paid equally by both, and the costs also of Mr. *Muntz's* application for the patent. A deed to be prepared accordingly, and to be settled, if the parties differed, by the conveyancing counsel of the Court."

Terms on which patent sealed.

The precedent set by Lord Cranworth in *Russell's Patent* was followed with modifications by Gorst, S.-G., in *Re Luke* (p). This was a case of opposition by *Tatham* to an application by *Luke* for a patent for "improvements in or applicable to machines for slubbing, roving, spinning, doubling or winding fibrous materials."

Russell's Patent followed by Gorst, S.-G.

"It has not been proved to my satisfaction," said the Solicitor-General, "that *Luke* obtained the whole of the invention which he seeks to patent from *Tatham*, but I am at the same time convinced that the applicant is not the sole inventor, but that part at least of the merit of the invention is due to *Tatham*."

"I think that *Luke* and *Tatham* should enter into an agreement by which the former should undertake to do all such acts as may be necessary for leaving to the latter the full rights of a joint

(o) Cp. *Re Fox*, 1812, 1 Web. P. C. 431; *Re Cutler*, 1839, 1 Web. P. C. 426; *Tolson's Patent*, 1856, 6 Do G. M. & G. 422; *Russell's Patent*, 1857, 2 Do G. & J. 130; *Spence's Patent*, 1859, 3 Do G. & J. 523; *Tolhausen's Patent*, 1866, 14 W. R. 551; *Vincent's Patent*, 1867, L. R. 2 Ch. 341; *Mancaux's Patent*, 1870,

L. R. 2 Ch. 272. See the cases on opposition at the Great Seal dealt with at pp. 650, 651.

(p) 1885, Griffin, P. C. 294; *Re Eadie*, 1885, Griffin, P. C. 279. Here a material part only of the applicant's invention had been obtained from the opponents.

Terms on
which patent
sealed.

patentee in the invention in question, and the latter should undertake to take no proceedings for revocation of the patent when granted. On the filing of such agreement at the patent office I determine that the grant shall be made and that each party shall pay his own costs of the appeal" (q).

In *Re Garthwaite* (r), an application for a patent for "fish biscuits for dogs and food for poultry and game" was opposed by *King*. It was proved that *King* had made a prior application for a patent which appeared to be identical with that described by *Garthwaite*, and that an examiner had reported interference. The comptroller held that the parties were joint inventors, and were therefore entitled to equal shares of any benefit which might accrue from the invention. On their declining to accept a joint patent the comptroller granted separate patents upon their respective applications, subject, however, to the following conditions: that each party agreed to assign to the other one half share of and in the respective patents, and to pay one half the necessary fees for maintaining the same in force; and in default of either party paying his half share of the fees, the other party to be at liberty to pay the whole of such fees, in which event the whole interest of the patent was to become the property of the party so paying the whole of the fees.

In *Re Evans and Otway* (s) an application for a patent for "improvements in steam engines" by E. and O. was opposed by C. on the ground that the applicants had obtained the invention from him. It appeared that C. had already obtained a patent for an invention which was substantially the same as that of E. and O., and that E. and C. had known each other for some time, and had been jointly experimenting on the subject-matter of the invention. Webster, A.-G., directed the patent to be sealed on terms that E. and O. assigned one half share of the patent to C., and that C. assigned one half share of his patent to E. and O. It subsequently transpired that O., whose name was included in E.'s application, and who was therefore a necessary party to any assignment, could not be found. Thereupon Webster, A.-G., cancelled his previous order, and now directed that a patent be *not* sealed to the

(q) If the applicant refused these terms the patent was not to be granted, and he was to pay the costs of both parties in the appeal. If the opponent refused them the grant was to be made,

and the costs of both parties in the appeal were to be paid by him.

(r) 1886, *Griffin*, P. C. 284.

(s) 1884, *Griffin*, P. C. 279.

applicants E. and O., on the condition that C. executed an assignment to E. of one half the interest in his patent (t).

The mere existence of the relation of master and servant does not prevent the servant from patenting an invention of his own, or, *ipso jure*, give the master a right to the servant's inventions.

Where confidential relation subsists between applicant and opponent.

Thus, in *Re Russell (u)*, where a master applied for letters patent for an invention upon which both he and his foreman had made improvements, a grant was only made on condition that the master and foreman should be joint grantees (x).

But if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in details which are adopted in the machine or model as completed: those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them (y).

The same principle applies where an applicant's invention probably resulted from investigations or experiments made by an employé and directed or paid for by the employer (z).

Where a man is trying experiments for the purpose of himself taking out a patent for an invention, all that he and his do together is confidential, and if, when he has made his invention complete, he goes and takes out a patent, all that he has done confidentially in that way does not affect him in the slightest degree (a).

The confidence of the servants, however, is a confidence only as regards the secrets of the master, not as regards the secrets of the fellow servants (b).

Thus, in *Sarby v. The Gloucester Waggon Co. (b)*, it appeared that *Edwards*, a superintendent in the signalling department of the London and North Western Railway Company, had invented, but had not patented, a new signalling apparatus, working drawings of which were openly prepared, under his directions, in the company's offices, and were submitted to, and inspected by, their mechanical engineer and locomotive committee. The plaintiffs, who had subsequently taken out a patent for the same invention, maintained, as a matter of law, that the circumstances above set forth did not

(t) The order contained a direction as to the payment of the renewal fees similar to that in *Re Garthwaite*, cited above.

(u) 1857, 2 De G. & J. 130.

(x) The order in this case is set out above, at p. 181.

(y) Per *Davey, S.-G.*, in *Re David and Woodley*, 1886, *Griffin, A. P. C.* 26.

(z) *Healey's Application*, 1872, *Johns. Pat. Man.* 174; *Conniff's Application*, 1872, *Ibid.*; *Macfarlane's Patent*, 1883, *Ibid.*; *Kurtz v. Spence*, 1888, per *Keke-wich, J.*, 5 P. O. R. at p. 181.

(a) *Sarby v. Gloucester Waggon Co.*, 1883, per *Lord Blackburn, Griffin, A. P. C.* 57.

(b) *Ubi supra.*

constitute a publication of the invention, on the ground of the confidentiality existing among the officers and servants of the London and North Western Railway Company.

“There is nothing,” said Jessel, M. R., whose judgment was affirmed by the House of Lords, “in the point of law. There is no question that the right of *Edwards* to the invention was his own personal right, the mere fact of his being the superintendent of the signalling department did not prevent him inventing and patenting a new signalling apparatus. If he obtained a patent, it would not belong to the company, but to himself, and if he chose to publish it to all the other 10,000 employés of the London and North Western Railway Company, of course that would have been a complete publication. He did publish it, in fact, to twenty-two or twenty-three of them, and in my opinion there is no pretence for saying that the publication of a secret which was his own to his fellow-servants was less than a publication to the same individuals if they had not been his fellow-servants . . . I should be of opinion that it was not only discovered, but sufficiently published, by *Edwards* before the date of the patent” (c).

Meaning of
“legal repre-
sentative.”

The words “legal representative” in sect. 11 must be construed in their ordinary sense, as meaning an executor or administrator of a deceased person. They do not include a person holding a power of attorney (d), nor a person who claimed to be entitled under an assignment of prior patents and improvements thereon to the particular improvement which the applicant was seeking to patent (e).

Second ground
of opposition.

2. “That the invention has been patented (f) in this country on an application of prior date.”

Who may
oppose before
law officer.

As to who is entitled to be heard before the law officer in opposition to a grant, see *supra*, pp. 175 *et seq.*

Application
ante-dated
under Act of
1883, s. 103.

E. applied on 20th August, 1886, for a patent for “automatic apparatus for subjecting the person to the action of electric currents.” Notice of opposition was given by L. and P., two foreigners in *France*, on the ground that the invention had been patented by them on an application of prior date, under sect. 103 of the Patents Act, 1883, and the International Convention.

(c) The question whether a confidential relation existed between the parties, must be decided by reference to all the circumstances of the case: *Humpherson v. Syer*, 1887, per Bowen, L. J., 4 P. O. R. at p. 313.

(d) *Re Edmunds*, 1886, per Webster,

A.-G., Griffin, P. O. 281.

(e) *Adolph Spici's Patent*, 1888, 5 P. O. R. 281.

(f) As to the meaning of “patented” in this connection, see *ante*, pp. 176 *et seq.*, where the cases bearing upon the subject are fully considered.

It was held that this foreign application was not "an application of prior date" to E.'s (*g*), within the meaning of the Act of 1883, s. 11, sub-s. 1.

The cases relating to this ground of opposition may be classified according to the result of the opposition. Sometimes the application is refused; sometimes it is granted. At other times conditions are imposed. Classification of cases under this heading.

An application for a patent will be refused when the invention to which it refers is absolutely or substantially identical with some other invention previously patented (*h*). Application, when refused.

Thus, in *Re Webster* (*i*), a claim for making "wire ropes compound," by laying some of the wires in a strand in one direction, and some in the other direction, was ordered to be excised on proof that, in a prior patent, there was a claim for making wire ropes with ordinary strands laid to the right and left hand alternately.

Again, in *Re Heath and Frost* (*k*), it was held that there was no difference between charging a case with an explosive, and then surrounding such charged case with water, and dispensing with the case, and surrounding the explosive itself with water.

In a later case (*l*), an application by the A. and C. Co. for a patent for "an improved screw stopper," was opposed by B. It appeared that both stoppers contemplated the use of a screw thread, which was to be screwed into a bottle, and of an indiarubber ring which was to be fixed into a groove: the only point of difference between them was the position of a washer in the groove in the stopper. The application was refused.

In *Re Bailey* (*m*), the two interfering inventions had the same object, viz.: expressing milk from a mass of butter and forming the butter into measured pats without any handling. The only differences in the construction and operation of the two contrivances were, that the vessel containing the butter was cylindrical in one case and rectangular in the other, and that the screw com-

(*g*) *Re Everett*, 1886, Griffin, A. P. C. 28.

(*h*) "Stopping a patent," said Webster, A.-G., in *Re Stubbs*, 1884, Griffin, P. C. 298, "is a very serious step, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent, unless I am satisfied that the inventions are identical." Cp. *Cumming's Patent*, 1884, per James, A.-G., Griffin, P. C. 277; *Jones's Patent*,

1885, Griffin, A. P. C. 34; *Newman's Patent*, 1888, 5 P. O. R. 271. Substantial identity will, however, be sufficient.

(*i*) 1889, 6 P. O. R. 163; *Re Hall and Hall*, 1888, 5 P. O. R. 283.

(*k*) 1885, Griffin, P. C. 310.

(*l*) *Re Aire and Calder Glass Bottle Works, and Walker's Application*, 1888, 5 P. O. R. 345; *Re Wallis and Ratchiff*, 1888, 5 P. O. R. 347; *Re Daniel*, 1888, 5 P. O. R. 413.

(*m*) 1887, Goodeve, P. P. 57.

pressing the butter was worked, in one case, directly by hand, and in the other, by the intervention of a pinion and wheel giving increased power. The comptroller refused to seal a patent.

Application,
when granted.

When an opposition to an application for a patent merely raises a question of infringement (*n*), where the differences between the interfering inventions are such that they cannot be considered as substantially identical (*o*), or where there is nothing in the later specification, which on the face of it might be held to have a wider scope, or include a wider kind of invention than that to which the patentee is on the evidence entitled (*p*), the application will be granted.

When an opposition has been before the comptroller, and the comptroller has allowed the grant, the law officer will not interfere with his decision unless it is clearly wrong (*q*).

Application
granted on
terms.

Where an applicant's invention covers to some extent the ground embraced in a prior patented invention, the application may be granted subject to the insertion by the patentee in his specification of a general disclaiming clause referring to the existing state of knowledge.

A patent will not be stopped where there is a strongly controverted question of anticipation involving difficult questions of fact (*r*).

Claims may
be struck out.

In *Hall and Hall's Patent* (*s*), which was opposed upon the ground that the invention had been previously patented, the comptroller ordered a claim to be struck out; and on appeal by the opponent to the law officer a second claim was struck out.

Form of
general dis-
claiming
clause.

Reference to
existing
knowledge.

Thus in *Re Guest and Barrow* (*t*), an application for a patent for "an improvement in velocipedes or cycles," the following disclaiming clause was required to be inserted: "We are aware that various arrangements of cycles have been heretofore proposed, having either a jointed backbone or the frame divided into portions joined together with one or more joints. . . ."

(*n*) *Jones's Patent*, 1885, Griffin, A. P. C. 34; *Sielaff's Application*, 1886, 5 P. O. R. at p. 487.

(*o*) *Re Cumming*, 1884, per James, A.-G., Griffin, P. C. 277; *Re Stubbs*, 1884, per Webster, A.-G., Griffin, P. C. 298; *Anderson and McKinnell's Patent*, 1886, Griffin, A. P. C. 23.

(*p*) *Re Lorrain*, 1883, 5 P. O. R. 142. The patentee of the later patent frames his specification at his peril, *Ibid.*; *Re Brownhill*, 1889, 6 P. O. R. 135.

(*q*) Per Herschell, S.-G., in *Re Glossop*, 1884, Griffin, P. C. at p. 286; *Re Cumming, ubi supra*; *Re Pitt*, 1888, per Clarke, S.-G., 5 P. O. R. 343; *Re Brownhill, ubi supra*.

(*r*) *Lake's Patent*, 1889, 6 P. O. R. p. 548.

(*s*) 1888, 5 P. O. R. 283.

(*t*) 1888, 5 P. O. R. 313; *Re Cooper and Ford*, 1885, Griffin, P. C. 275; *Re Hill*, 1888, 5 P. O. R. 599.

“Such arrangements have been defective, owing to the nature of the joint or joints used, and its or their position in relation to the various portions of the cycle (*u*); but we wish it to be understood that we make no general claim to the principle of preventing vibration in cycles by the introduction of joints or springs into the backbone.”

General allegation of defect.

General disclaimer.

The insertion of these disclaimers do not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interest, in order that his specification may not be considered as being too wide, and in the interests of the public, who are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (*v*).

Purpose of general disclaimer.

In *Atherton's Patent* (*x*), Webster, A.-G., ordered a claim to be struck out, considering it unnecessary, and practically the same as another claim.

In the same case it was held that a patentee may insert in his specification his own statement of the prior knowledge, and refer to any number of specifications in support of his statement, but he must not put on the public what he believes to be the construction of a written document.

The law officers have always recognized that where there is an existing patent and they can see fair ground for supposing that the construction of the later specification would interfere with the rights of the existing patent, the existing patentee is entitled to be protected (*y*). This protection may take the form of the insertion in the later specification, whereby the applicant disclaims, referring by number, date, and name of patentee to the prior patented invention everything that is described and claimed therein (*z*).

Special disclaiming clause.

Thus in *Re Hoskins* (*a*), an application by H. for a patent for

Forms of special

(*u*) With reference to the general allegation of defect in this case, Webster, A.-G., said: “As the specification only contains a statement of general knowledge, there cannot be said to be anything in the patent law to prevent a patentee, on the face of his specification, referring to the general defects which rightly or wrongly he alleges to exist. The earlier patentees are not bound by this description.”

(*v*) 1888, 5 P. O. R. 313; *Re Cooper and Ford*, 1885, Griffin, P. C. 275; *Re Hill*, 1888, 5 P. O. R. 599.

(*x*) 1889, 6 P. O. R. p. 547.

(*y*) *Re Newman*, 1888, per Webster, A.-G., 5 P. O. R. 271.

(*z*) In *Re Teague*, 1884, Griffin, P. C. 298, where the applicant had for the purpose of explanation described and illustrated, but had not claimed, certain parts of a rock drill which were protected by an opponent's patent, an order was made either for a special disclaimer or for the omission of those parts from the specification.

(*a*) 1884, Griffin, P. C. 291.

disclaiming
clauses.

“improvements in folding cots and hammock frames,” opposed by N., the following order was made:—

“This invention refers to improvements (*b*) in the description of cots invented by N., for which invention a patent, No.—, of 1883, has been granted to him, and it consists, &c.”

In *Re Newman* (*c*), an application by N., opposed by A., for a patent for “improvements in springs for self-closing doors and in checks for preventing slamming, and in the methods of adjusting the same,” the following special disclaimer was ordered:—

“I am aware of the prior patent granted to A., dated March 30th, 1886, No. , and I do not claim anything described and claimed (*d*) in the specification of that patent, and in particular I do not claim the apparatus as shown and described with reference to fig. 35.”

In *Lynde's Patent* (*e*), Clarke, S.-G., ordered the following clause to be inserted in the applicant's specification: “That I am aware of Everitt's patent (No. 16,433 of 1884), and that I do not claim anything claimed and described therein.”

Opponent
with broad
claim.

It is not because a particular patentee or a prior inventor has made a broad claim that he is entitled to have limiting words inserted unless he can show, upon the fair view of the evidence, that such words are really necessary to protect him (*f*).

Third ground
of opposition.

3. “That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.”

(*b*) A patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention during the existence of the former patent without licence, would be an infringement: per Campbell, C. J., in *Lister v. Leather*, 1858, 8 E. & B. 1017; cp. *Crane v. Price*, 1840-42, 4 M. & G. 580; *Fox v. Dellestable*, 1866, 15 W. R. 195; *Ex parte Fox*, 1 Web. P. C. 431.

(*c*) 1888, 5 P. O. R. 279.

(*d*) What a disclaiming clause is intended to guard against is the claiming in a new patent of something included in the claim of the old patent, not of something mentioned in the old patent, but of something which has not only been described in the old patent, but has

been claimed as a part of the previous invention: per Clarke, S.-G., in *Re Gozney*, 1888, 5 P. O. R. 597. In *Re Welch*, 1884, Griffin, P. C. 300, the word “claimed” was omitted. See, however, *Re Newman*, *ubi supra*; *Re Airey*, 1888, 5 P. O. R. 348; *Re Lynde*, 1888, *Ibid.* 661; *Re Wallace*, 1889, 6 P. O. R. 134.

(*e*) 1888, 5 P. O. R. 663, also see *Re Wallace*, 1889, 6 P. O. R. p. 135; *Re Hoffman*, 1890, 7 P. O. R. 92.

(*f*) *Re Guest and Barrow*, 1888, 5 P. O. R. 312. In this case, Webster, A.-G., said: “I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned.”

Disconformity in itself was not, under the Act of 1883 (*g*), and is not now under the Act of 1888,—by sect. 4, sub-sect. 1, of which this third ground of opposition was introduced,—an objection which will justify the law officer in stopping a patent at the instigation of an opponent. The condition specified in the latter part of the sub-section must concur with the fact of disconformity in order to make it a valid ground of opposition.

It is to be observed that the law officers and the comptroller prefer to allow the patent rather than refuse it, because their decision is final, and the applicant has no further remedy; whereas it is open to the opponent to petition for revocation, or to bring an action for infringement, when the validity of the patent will come in question before the Courts.

General rule
of law officer.

(*g*) *Newman's Patent*, 1888, per Webster, A.-G., 5 P. O. R. at p. 277.

CHAPTER X.

THE GRANT AND ITS EFFECT.

SECT. 1. THE GRANT.

SECT. 2. THE EFFECT OF THE GRANT.

SECT. 1.—THE GRANT.

Sealing of patent.

IF there is no opposition to the grant of a patent, or, in case of opposition, if the determination is in favour of the patentee, the comptroller causes the patent to be sealed (*a*).

Before 1878, all letters patent for inventions as well as for other matters (*b*), were issued under the Great Seal. The Crown Office Act, 1877, sect. 5 (*c*), however, empowered a committee of the Privy Council, consisting of the Lord Chancellor, the Lord Privy Seal, and one of the principal Secretaries of State, to direct a *wafer* Great Seal, instead of the Great Seal, to be attached to or embossed upon certain documents prescribed by them; and by rules made in pursuance of this section (*d*), the *wafer* Great Seal was directed to be attached to, among other documents, letters patent for inventions, which was accordingly the practice between the 1st March, 1878, and the 31st December, 1883. Under the present Act, letters patent are sealed with the seal of the Patent Office, and every patent so sealed has the same effect as if it were sealed with the Great Seal of the United Kingdom (*e*).

Time within which patent must be sealed.

A patent is sealed as soon as may be, and not after the expiration of fifteen months (*f*) from the date of application, except where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent; or the applicant dies

(*a*) Act of 1883, s. 12, sub-s. 1.

(*b*) As to these "other matters," see note, pp. 1 & 2.

(*c*) 40 & 41 Vict. c. 41.

(*d*) These rules came into operation on March 1, 1878, and are published in the

"London Gazette" for March 5, 1878.

(*e*) Act of 1883, s. 12, sub-s. 1 and 2.

(*f*) The Act of 1885, s. 3, empowers the comptroller to grant an extension of four months.

before the expiration of the fifteen months aforesaid. In the former case the patent may be sealed at such time as the law officer may direct. In the latter, a patent may be granted to his legal representative, and sealed at any time within twelve months after the applicant's death (*g*).

The grant is for fourteen years, subject to the payment of the renewal fees (*h*). Term of patent.

Letters patent dated the 26th February, 1855, were, under the Act of 1852, to cease at the expiration of three years from the date thereof, unless there were paid before the expiration of the three years an additional stamp duty of 50%. The stamp duty was paid on the 26th of February, 1858:—held, that the payment had been made within the time, and that the patent was subsisting (*i*). How term reckoned.

The form of letters patent for inventions has varied from time to time. Forms of patent.

The Statute of Monopolies, the Act of 1852, and the Act of 1883, each made certain alterations in the form in use at the date of its enactment (*j*); and, moreover, other alterations took place in the provisoes and other parts of the patent from time to time. The Board of Trade has power to alter or amend the present form given in the schedule to the Act of 1883, by rules made as provided by sect. 101 of that Act.

The form prescribed by the Act of 1883 (*k*) undergoes slight modifications when the patentee is a communicator or a woman, or the legal representative of a deceased person, or where two or more persons are the applicants, and according as all or only some of them are inventors (*l*). In the case of new letters patent granted after prolongation, the form is considerably varied (*ll*). The Channel Islands are still included in such a grant, although the Act of 1883 does not extend to them. This is a consequence of the decision in *Brandon's Patent* (*m*) as to the saving effect of sect. 113 of rights existing before the Act of 1883. Variations in form under Act of 1883.

(*g*) Act of 1883, s. 12, sub-s. 3.

(*h*) Act of 1883, s. 17.

(*i*) *Williams v. Nash*, 1859, 28 L. J. Ch. 886. See also Act, 1883, s. 98.

(*j*) The following forms of grant are to be found in this work:—

(1.) Form of grant, A.D. 1617, before the Statute of Monopolies. Appendix, p. 848.

(2.) Form of grant, about 1846. Appendix, p. 850.

(3.) Form of grant under Patent Law Amendment Act, 1852. Appen-

dix, pp. 667 *et seq.*

(4.) Form of grant now in use, with variations according to applicant or applicants, at pp. 530 *et seq.*

(5.) Form of new letters patent issued on Order in Council, for prolongation. Appendix, p. 839.

(*k*) Pages 528 *et seq.*

(*l*) See forms of such patents at pp. 533 *et seq.*

(*ll*) See p. 839.

(*m*) 1884, 1 P. O. R. p. 154. See also Chap. XV. pp. 378, 379.

Effect of various parts of grant.

The form in the schedule to the Act of 1883 is annotated at considerable length at pp. 533—549, where the effect of the various parts of the grant is fully considered.

The variations which may occur are chiefly in the recitals; the alteration in the operative part and in the provisoes consists purely in the formal changes of masculine into feminine, or singular into plural.

SECT. 2.—THE EFFECT OF THE GRANT.

Privilege has existence only by force of grant.

The privilege which a patent confers upon an inventor has existence merely by force of the patent, which in fact creates the right as well as grants it to the patentee. Patent right may be defined as an incorporeal chattel which the patent impresses with all the characters of personal estate by limiting it to the grantee, his executors, administrators, and assigns (*n*).

Must look to patent to discover rights of patentees.

If we wish, therefore, to determine what the patentee's rights are, it is in his patent that we must look for them. The patent fixes the date, the term, and the extent of the privilege. It confers upon the patentee the sole and exclusive right of manufacturing, using, and selling his invention, and by the clause of limitation provides at once for the assignment of the privilege and its devolution on death, or by operation of law. The construction of the various clauses in the grant of a patent will be fully considered hereafter (*o*).

The position of co-grantees of a patent requires some consideration (*p*).

Co-owners of patents.

The law as to the rights of co-owners of a patent which does not provide otherwise, is laid down in Lindley on the Law of Partnership (*q*). It is pointed out that the chattel interest in letters patent for an invention is such that each co-owner can, in fact, enjoy his rights to the full extent without the concurrence of the other owners. Also that—

(*n*) Hindmarch, 233.

(*o*) See pp. 533—549.

(*p*) "When a partnership is formed for working some secret and unpatented invention, the articles should specify to whom exclusively the right of working such invention shall belong in the event of dissolution. For if there be no agreement on the subject, all the parties will have a right to work it in opposition to each other, there being no ground upon which any of them can be prevented

from so doing. If, however, it can be proved by the inventor that his secret was to be kept from his co-partners, or that they, if they discovered it, were not to make use of their discovery, they will not be allowed to violate their agreement or the trust reposed in them, and the circumstance that the invention has not been patented will not be material": Lindley on Partnership, p 416.

(*q*) 5th ed., p. 62.

“In the case of a patent belonging to several persons in common, each co-owner can assign his share and sue for an infringement (r), and can also work the patent himself and give licences to work it, and sue for royalties payable to him for its use (s); and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, though it is still perhaps open to question whether he is not liable to account for what he receives in respect of the licences” (t).

Legal position
of co-owners.

In *Kenny's Button-holing Co. v. Somerville* (u), it was held that where a partnership was formed for the purpose of working an invention patented by one of the partners, the patent became part of the assets of the partnership, and that neither party could assign without the concurrence of the other; but that each partner acquired a licence to work the invention, and could work it accordingly on his own account on dissolution of partnership.

Where a patentee has assigned a share of the profits the assignee is entitled to an account from any licensee of the assignor, but must make patentee and other interested persons parties; and must place himself in the position of the assignor, by offering to pay any moneys which may be due from the assignor to the accounting licensee (v).

The inability of one of several joint patentees profitably to use the invention without the consent of his co-patentees as owners of a prior patent, does not entitle him to share with his co-patentees in the profits made by them from the use of the patent; there being no principle of law, in the absence of contract, to prevent any

(r) *Dunnicliff v. Mallett*, 1859, 29 L. J. C. P. 70; 7 C. B. N. S. 209; *Walter v. Lavater*, 1860, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

(s) *Sheehan v. G. E. Rail. Co.*, 1880, 16 Ch. D. 59.

(t) *Mathers v. Green*, 1865, L. R. 1 Ch. 29, reversing S. C. 34 Beav. 170; 34 L. J. Ch. 298; *Re Russell's Patent*, 1857, 2 De G. & J. 130; *op. Hancock v. Bowley*, 1860, 1 Johns. 601; *Re Horsley and Knighton*, 1869, L. R. 8 Eq. 475; *Lovell v. Hicks*, 1836, 1837, 6 L. J. (N. S.) Ex. Eq. 85; 5 *id.* 101. In *Mathers v. Green*, it was held by Lord Cranworth, C., that where a patent is granted in the usual form, each one of three co-grantees might, without the concurrence of the others, use the invention and not be obliged to account for the profits made thereby, and might also grant licences under the patent. This decision turned on the words of the

grant, which was to the grantees, their executors, administrators, and assigns, “that they and every one of them, by themselves, their servants and agents, and such others as they may agree with, and no others, may use the invention.” It should be observed that the clause in italics does not occur in the present form. The question as to the liability of a co-patentee to account for any royalties received by him under licences granted by him, was not considered in the House of Lords, as Lord Cranworth held that there was no evidence that such royalties had become due. In the Court below, however, Lord Romilly, M. R., whose judgment on this point has never been overruled, had decided that the co-patentee was so liable.

(u) 1878, 26 W. R. 787.

(v) *Bergmann v. Macmillan*, 1881, L. R. 17 Ch. D. 427.

person, not prohibited by statute, from using any invention whatever, and no implied contract where several persons jointly obtain letters patent, that no one of them shall use the invention without the consent of the others, or that he shall use it for their joint benefit (*x*).

Agreement
advisable.

It seems that in all cases where the application is made by several persons jointly, an agreement should be entered into between the applicants to define their mutual positions clearly. Such agreement should provide for the payment of renewal fees, the expenses of applying for disclaimers of oppositions to similar grants, of litigation on petitions to revoke, proceedings against infringers, &c. Also for the granting of licences, and the working of the invention by the patentees themselves (*y*).

(*x*) *Mathers v. Green, supra.*

(*y*) See *Trans. Inst. P. A.* vol. viii.,

a paper "on certain features of joint proprietorship in patents." C. M. Owen.

CHAPTER XI.

ASSIGNMENTS, LICENCES, ETC.

SECT. 1. SALES AND ASSIGNMENTS.

SECT. 2. LICENCES.

It is not here proposed to deal with the position of assignees and licensees in legal proceedings affecting letters patent, or with the application of the doctrine of estoppel in such cases, both of which matters are fully considered elsewhere (*a*). Scope of chapter.

The question of Compulsory Licences is treated of at pp. 461—463. Compulsory licences.

The registration of documents affecting the proprietorship of patents is dealt with in the next chapter. Registration.

The Register of Patents should be inspected before any agreement, assignment or licence is entered into, in order to see in whom the registered title is. Inspection of register.

All deeds affecting the ownership of patents should be registered at once at the Patent Office. No document will, however, be registered until the patent is sealed (*b*). Registration.

SECT. 1.—SALES AND ASSIGNMENTS.

The privilege granted by a patent cannot be assigned unless it is made assignable by the patent itself. And it seems that the same rule is applicable to a licence granted under the authority of the patent. For a licence merely grants a power, or dispenses with a right or remedy, and therefore confers a mere personal right upon the licensee which cannot be transferred to any other person, unless the grantor in the instrument itself makes the privilege which he grants assignable. Power to assign.

Licences are, however, frequently granted to licensees, their executors, administrators, and assigns, and then they become of Licences to licensees, their executors, &c., assignable.

(*a*) See "Parties to an Action of Infringement," pp. 254 *et seq.*

(*b*) See Chapter XII.

course assignable and transmissible in the same way as a patent privilege. And it would seem that the assignment of a licence, like the assignment of a patent, ought to be made by deed under hand and seal.

No restriction as to the consideration for a licence.

There does not appear to be any restriction with respect to the consideration for which a licence to use a patent privilege may be granted. A deed in itself imports a consideration (*c*), and as a licence must be granted by deed, it seems that no consideration is necessary to render it valid (*d*).

Origin of power to assign.

An inventor has by law no property in his invention, and no interest in it recognizable by law, except under a patent (*e*); the right or privilege granted by a patent is of a personal nature, and, but for an express provision in the patent by which it is granted, would be inalienable (*f*).

Assignment for particular places under Act of 1883.

By the Act of 1883, s. 36, however, it is provided that a patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man as effectually as if the patent were originally granted to extend to that place or part only.

Words of grant under Act of 1852;

Under the Act of 1852 the grant was "unto the said ———, his executors, administrators, and assigns, our especial licence, full power, sole privilege and authority that he the said ———, his executors, &c., and every of them, *by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said ———, his executors, &c., shall at any time agree with, and no others,*" &c.

under Act of 1883.

Under the Act of 1883, the grant is "unto the said patentee our especial licence, &c., that the said *patentee by himself, his agents or licensees, and no others,*" &c.; "the patentee" by a recital in the patent, meaning the patentee, his executors, administrators, and assigns.

It appears that the power of assignment of interests in patents under the Act of 1883 is strictly limited by the words of the grant and the provisions of sect. 36.

As to the position of co-owners of patents, see *ante*, pp. 192 *et seq.*

Extent of assignment.

The assignment may be either absolute or by way of mortgage, and may extend to any part or share of the invention (*g*), or to the

(*c*) See Plowd. 308.

(*d*) The proviso in a patent declares that nothing in the patent contained shall prevent the granting of licences in such manner, *and for such considerations as they may by law be granted.*

(*e*) Hindmarch, 233. An inventor may, however, maintain an action for breach of an agreement respecting an invention which he proposes to patent:

Smith v. Dickenson, 1804, 3 B. & P. 630.

(*f*) Hindmarch, 234; and *cp.* Little-dale, J., in *Durergier v. Fellows*, 1828, 10 B. & C. 829; and Dompier, J., in *Power v. Walker* (a copyright case), 1814, 3 M. & S. 9.

(*g*) *Walton v. Lavater*, 1860, 8 C. B. N. S. 162; *Dunnicliff v. Mallet*, 1859, 7 C. B. N. S. 209.

entirety of the patent so far as it relates to a separate and distinct part of the invention (*h*). One of several co-owners can assign his share, and can also work the patent and give licences, though he is probably liable to account for any profits received in respect of licences (*i*).

The assignment of a patent must be by deed.

Deed necessary.

Two explanations of this rule have been offered. The patent, it is said, requires that licences granted by the patentee shall be under his hand and seal, and "if the licence, which is the lesser thing, must be in writing, *à fortiori*, the assignment, which is the greater thing, must also be" (*j*).

Reasons.

Again, the privilege of a patent cannot be granted without deed (*k*); and the rule of law is that things which can only be granted or created by deed can only be assigned by deed (*l*). Also an assignment of a patent is a grant of an incorporeal right (*m*).

An instrument not under seal, purporting to be an assignment of a patent, may be treated merely as an agreement to assign, and is enforceable in equity (*n*).

No particular form is necessary to a valid assignment, and the ordinary rule of law respecting the construction of deeds will be applied, viz.: "that the construction be favourable, and as near to the minds and apparent intents of the parties as possible it may be and law will permit" (*o*).

Form of assignment.

Thus, a covenant to assign a patent upon the happening of a given event, will, as soon as the event happens, amount to an actual assignment of the patent (*p*).

The executors of a patentee having obtained probate of their testator's will, assigned his patent to another person, but the probate was not registered till after the assignment (*q*).

Executors.

The interest of a bankrupt in a patent passes to his trustee (*r*).

Bankrupt.

By a private Act of Parliament the sole making of a newly

(*h*) *Dunnicliff v. Mallet*, 1859, 7 C. B. N. S. 209.

(*i*) See p. 193, and cases there quoted.

(*j*) *Powis v. Walker*, *ubi supra*, per Lord Ellenborough, C. J. But see *Chanter v. Dewhurst*, 1844, 13 L. J. Ex. 198; 12 M. & W. 823.

(*k*) Co. Litt. 9 b, 172 a; Shep. Touch. 229—231.

(*l*) 3 Co. Rep. 63 a, *Lincoln College case*.

(*m*) Co. Lit. 9 C.

(*n*) *Parker v. Taawell*, 1858, 2 De G. & J. 559; *Bond v. Rosling*, 1861, 1 B. & S. 371;

Tidey v. Mollett, 1864, 33 L. J. C. P. 235. For the conditions on which specific performance of such a contract would be granted, see Morris, p. 42.

(*o*) Shep. Touch. 83, 86. For forms of assignment, see Appendix, pp. 778 *et seq.*

(*p*) *Cartwright v. Amatt*, 1799, 2 B. & P. 43.

(*q*) *Ellwood v. Christy*, 1864, 1865, 34 L. J. C. P. 130; 17 C. B. N. S. 754.

(*r*) *Hesse v. Stevenson*, 1868, 3 B. & P. 565.

invented machine was vested in certain persons, with a proviso that it should be forfeited in case it should become "vested in, or in trust for, more than five persons or their representatives otherwise than by devise or succession (reckoning executors and administrators only as the single persons they represent)": it was held, that one of the persons becoming bankrupt the right passed to his assignees; although there were more than five creditors, yet the assignees did not hold it in trust for "more than five persons, otherwise than by devise or succession," within the meaning of the Act (*p*).

Proviso,
before 1852,
avoiding
patent if more
than twelve
persons part-
ners therein.

Prior to the Act of 1852 a patent for an invention contained a proviso to the effect that the patent should be void if more than twelve persons became interested in it as partners. But there is now no limit upon the number of persons who may be interested in a patented invention. A considerable number of private Acts were obtained to enable companies or corporations to have patents for inventions assigned to them without their being rendered void. The form of patent given in the schedule to the Act of 1852 contained no such proviso (*q*); and, moreover, that Act provided that notwithstanding any proviso which might exist in former letters patent, it shall be lawful for a larger number than twelve persons hereafter to have a legal and beneficial interest in such letters patent (*r*).

An agreement by the vendor of a patent to assign to the purchaser all future patent rights which the vendor may hereafter acquire of a like nature to the patent sold, is not contrary to public policy (*s*).

One of two joint patentees cannot assign the whole interest in the patent without the consent of the other joint patentee. He can only assign his interest (*t*).

In *Hall v. Conder* (*u*), it was held to be no answer to an action on an agreement for the purchase of a patent, to plead that the invention was wholly worthless and of no public utility, and not new, and that the plaintiff was not the true and first inventor.

(*p*) *Bloxam v. Elsee*, 1827, 1 C. & P. 558. See also *Yate-Lee and Wace's Bankruptcy*; *McAlpine v. Mangnall*, 1846, 15 L. J. C. P. 298; *Hesse v. Stevenson*, 1868, 3 B. & P. 565.

(*q*) See pp. 667 *et seq.*

(*r*) Act, 1852, s. 36, and see note thereto.

(*s*) *Printing and Numerical Registering Co. v. Sampson*, 1875, L. R. 19 Eq. 462.

(*t*) *Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*u*) 1857, 26 L. J. C. P. 138, 288; 2 C. B. N. S. 22. See also *Smith v. Scott*, 1859, 28 L. J. C. P. 325; 6 C. B. N. S. 771.

British patents do not now fall with the expiration of a foreign patent granted before the date of the British patent, so that it is not necessary for the assignee to have a covenant providing that the foreign patents shall be kept in force. But in taking an assignment of a patent granted under the Act of 1852, it is still advisable to inquire if any foreign patents had expired before the Act of 1883 came into force.

British patents do not now fall with foreign patents.

Contents of an ordinary Deed of Assignment :

The Recitals.—There are ordinarily three recitals, one of the origin of the invention, another of the patent grant, a third of the devolution of title (if any). A recital that the assignor, or the person through whom he claims, was true and first inventor, while not amounting to an implied warranty of title (*r*), will estop the assignor, and also, if he execute the deed (*x*), the assignee, from afterwards disputing the validity of the grant (*y*).

Recitals.

The Testatum.—This is the operative part of the deed. It contains an assignment not only of the patent, but usually, although not, it would seem, necessarily (*z*), of the invention, and of the rights and powers of the patentee in respect thereof.

Testatum.

The Covenants.—The usual and proper covenants are:—A covenant for title, which will now be implied if the assignor is expressed to assign as “beneficial owner” or “trustee” (*a*); a qualified covenant for the validity of the patent so far as the acts and omissions of the assignor are concerned; an express covenant as to improvements or extensions of the patent; a covenant binding the assignor not to seek leave to amend the specification or drawings without the written consent of the assignee.

Covenants.

An assignment of a patent for a district should, in addition to the above, contain a covenant by the assignor to pay the renewal fees well within the prescribed times, and give due notice to his

Assignment for district.

(*v*) *Hall v. Conder*, 1857, 26 L. J. C. P. 138, 298; 2 C. B. N. S. 22; affirmed on appeal, 2 C. B. N. S. 53; *Smith v. Neale*, 1857, 26 L. J. C. P. 143; 2 C. B. N. S. 67; *Liardet v. Hammond Electric Light and Power Co.*, 1883, 31 W. R. 710.

(*x*) *Cp. Doe and Shelton v. Shelton*, 1835, 4 L. J. (N. S.) K. B. 167; 3 Ad. & El. 265. According to Morris, it is advisable to insert in the deed as parties “every person who shall become an

assignee of a share in the trust property and execute the deed, or otherwise assent to be bound by it”: see *Patents Conveyancing*, p. 125.

(*y*) *Oldham v. Longmead*, 1789, 3 T. R. 439, 441.

(*z*) *Morris*, 113.

(*a*) *Conveyancing Act*, 1881, s. 7. This covenant relates simply to the ownership and devolution of the title.

co-owner or co-owners of every such payment when made, or permit him or them to pay the same, and to repay the sums so paid on demand, and until repayment to charge them, together with interest, on his interest in the patent (*b*).

Assignment
of unequal
shares.

An assignment of a part share in a patent ought, in order to meet the decision in *Mathers v. Green* (*c*), to contain a special provision binding not only the parties themselves, but all future owners to account to each other for the profits made by them respectively, and to grant, or concur with the others in granting, licences in a manner which should be prescribed (*d*).

An assignment of a share in a patent usually contains a covenant by the assignee to perform and observe the stipulations, if any, which bind the assignor, and to indemnify him from future breaches thereof (*e*).

Where it is intended that a patent shall be divided into shares, and that each owner shall work his share separately, without the intervention of trustees, the deed of assignment should contain the following covenants, viz., that each owner shall pay his proper proportion of the renewal fees, that licences shall be granted only by all the owners jointly, and that each owner shall pay a royalty on articles manufactured by him (*f*).

Sub-assignee
with notice.

In *Werderman v. Société Générale d'Electricité* (*g*), the plaintiff assigned to D. and M. his patent in consideration of a share in the profits, &c., and it was part of the agreement that the patent should be worked and the profits disposed of in a particular way. It was held that the assignee of D. and M., taking with notice of the agreement, was bound by the covenants in the agreement.

Assignment
where part-
nership not
intended.

Where it is not intended that co-owners of a patent should be partners, the patent should be assigned to trustees for the owners, the trustees being authorized to grant licences to the owners or to strangers, or to sell the patent at the request of the owners, and being bound to provide for the current costs and expenses in respect of the trusts, and to take or defend proceedings in relation to the patent. Provisions are also inserted securing the remuneration of the trustees, and for the appointment of new trustees if necessary (*h*).

Covenant to

A covenant to assign future patents is not against public policy.

(*b*) *Morris*, at p. 116.
(*c*) 1865, L. R. 1 Ch. 29; see this case discussed at p. 193.
(*d*) *Morris*, p. 120.

(*e*) *Morris*, p. 121.
(*f*) *Morris*, pp. 122, 123.
(*g*) 1881, L. R. 19 C. D. 246.
(*h*) *Morris*, p. 126.

“ A man who is a needy and struggling inventor may well agree, either for a present payment in money down, or for an annual payment, to put his intellectual gifts at the service of a purchaser. I see, therefore, not only no rule of public policy against it, but a rule of public policy for it, because it may enable such a man in comparative ease and affluence to devote his attention to scientific research, whereas, if such a contract were prohibited, he would be compelled to apply himself to some menial, or mechanical, or lower calling, in order to gain a livelihood ” (i).

assign future patents legal.

As to the construction of a covenant for purchase of all patent rights of a like nature, see *Printing and Numerical Registering Co. v. Sampson* (k).

A patentee frequently covenants with his assignees to communicate and render available for the benefit of the assignees all further improvements in the patented inventions assigned by him.

Covenant to communicate improvements.

In the case of *London and Leicester Hosiery Co. v. Griswold* (l), G. took out two patents for improvements in the manufacture of stockings, to the benefit of which the H. Company became entitled. G. and the H. Company by deed assigned the patents to the L. Company. The deed contained a covenant by G. and the H. Company to communicate to the L. Company and render available for their benefit all further improvements of the patented inventions invented by them or either of them. The L. Company brought an action against G., claiming an injunction to restrain him from selling, disposing, and communicating to any person other than the plaintiffs any invention for or relating to improvements in the manufacture of stockings, and from assisting as a scientific witness or otherwise the defendants in two actions which the L. Company had commenced. On a motion for an interlocutory injunction until trial or further order, it was held, that G. was not entitled to infringe the patents, but that there was no evidence that he had done so; that he could not be restrained from giving evidence in the actions if subpoenaed; and that he could not be restrained from disclosing any information in his possession which might tend to show that the patents were invalid; and that specific performance of the covenant could not be ordered on an interlocutory application.

A body corporate may be registered as the proprietor of a patent in its corporate name (m), and may therefore take an assignment.

Assignment to body corporate.

(i) *Printing and Registering Co. v. Sampson*, 1875, L. R. 19 Eq. 462.

(k) 1875, L. R. 19 Eq. 462; and see also *Bewley v. Hancock*, 1856, 6 De G. M. & G. 391.

(l) 1886, 3 P. O. R. 251.

(m) P. R. 1883, r. 70. *Railway and Electrical Appliances Co., In re*, 1888, L. R. 38 Ch. D. 597.

The position of assignees, &c., in actions of infringement, will be considered hereafter, in Chapter XIV.

SECT. 2.—LICENCES.

Definition of licence.

A licence to use an invention is, in fact, a grant of a right by the patentee to the licensee; and during the time it is in force it exempts the licensee either from the whole or some portion of the prohibition contained in the patent, and enables him to exercise the whole or some particular part of the privilege granted by the patent (*n*).

Kinds of licences.

A licence does not, like an assignment, pass the whole interest.

Licences are of various kinds. Where the patentee, either by express covenant, or by a grant of "the full sole exclusive licence," to use an invention, excludes himself and his assigns from the use of it during the stipulated term, either generally or for a district, the licence is said to be *exclusive*, or the licence may be *general*, in which case the licensee can merely use the invention in common with other licensees of the patentee.

Exclusive or general licence.

Again, a licence may extend over all parts of the realm comprised in the patent, or may be restricted to some particular district or districts; or the purpose for which the licensee is permitted to use the invention may be limited; or the licence may amount to a grant of all the rights covered by the patent, in which case it will be construed as an assignment.

District. Purpose.

A licence to A. to manufacture a patent article is an authority to his vendees to sell it without the consent of the licensor (*o*).

Origin of right to grant licence.

It is doubted by Hindmarch (*p*) whether a patentee has any implied right under his privilege to grant licences any more than to assign.

Proviso for power to licence.

Letters patent, however, do invariably contain a clause expressly conferring such a right.

The origin of this clause is as follows:—"Under the old form (*q*) of condition against an assignment to more than five persons, it was considered doubtful whether a grant of a licence to more than five persons was not such an assignment within the meaning of the condition as would avoid the patent (*r*). In order

(*n*) Hindmarch, 239.

(*o*) *Thomas v. Hunt*, 1864, 17 C. B. N. S. 183.

(*p*) P. 238.

(*q*) See p. 198.

(*r*) 6 Jarm. & Byth. Conv. 188, n. (*a*).

to obviate this doubt, a clause is now inserted in all patents, whereby it is provided that nothing therein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted" (s).

A licence merely confers a personal right upon the licensee, which cannot be transferred to any other person, unless the grantor, in the instrument itself, makes the privilege assignable (t).

In *Bower v. Hodges* (u), Jervis, C. J., said that a licence is not really assignable, but the assignment acts only as an estoppel between the parties.

Licensing a person and his assigns is, unless the context clearly forbid such an interpretation, licensing him and all whom he shall licence (x).

Formerly, a licence without covenants was not required to be under seal (y), nor did it require a stamp, if it did not purport to be sealed and delivered as a deed (z). Is deed necessary?

The present form of letters patent requires a licence to be in writing under the hand and seal of the patentee. The words of the prohibition being a command not to "practise the said invention, &c., without the consent, licence, or agreement of the said patentee in writing under his hand and seal."

As between a licensor and his licensee, however, a verbal agreement for a licence may be good if acted on by the parties for a time, and especially where royalties have been paid on the patent articles manufactured by the licensee in accordance with the licence (a). Agreement for a licence.

An agreement for a licence is equivalent to a formal deed of licence (b).

The consideration for the grant of a licence is usually either an immediate money payment, or a periodical payment of an amount fixed or dependent on the extent to which the licensee uses the invention. Failure of consideration.

An agreement upon the basis last mentioned will not, of itself, create a partnership between the licensor and his licensee (c).

(s) Hindmarch, 239.

(t) Hindmarch, 242.

(u) 1853, 22 L. J. C. P. 194.

(x) *S.C.*, per Maule, J.

(y) *Chanter v. Dewhurst*, 1844, 13 L. J. Ex. 198; 12 M. & W. 823.

(z) *Chanter v. Johnson*, 1845, 14 L. J. Ex. 289; 14 M. & W. 411.

(a) *Crossley v. Dixon*, 1863, 10 H. L. C. 293; *Morris*, 184.

(b) *Postcard Automatic Supply Co. v. Samuel*, 1889, 6 P. O. R. 560; and see cases, *ante*, p. 197.

(c) *Ridgway v. Philip*, 1834, 1 C. M. & R. 415; *Elgie v. Webster*, 1839, 5 M. & W. 518.

A licensee cannot be compelled to give inspection in an action against his licensor (*d*).

Where the consideration for a licence totally fails, the licensee may recover any money paid by him (*e*).

Where the failure is only partial, and the consideration is not apportionable; thus, if the patent turns out to be invalid after the licensee has worked the invention to some extent according to the licence, the licensee cannot recover the royalties or annuities paid to patentee (*f*), except in the case of fraud (*g*).

In *Betts v. Willmott* (*h*), it was held, that where the owner of a patent manufactures and sells the patented article in a foreign country as well as in England, the sale of the article in one country implies a licence to use it in the other. But if he has assigned his patent in either country, the article cannot be sold so as to defeat the rights of the assignee.

In *Clark v. Adie* (*i*), it was held, that a patentee granting a licence cannot, without derogating from his grant, publish advertisements and circulars which have the effect of deterring usual customers or the public from dealing with his licensee.

In *Mathers v. Green* (*j*), it was held, by Romilly, M. R., and this part of the judgment was not reversed on appeal, that where one of several joint patentees grants a licence he is bound to account for the profits to his co-patentees.

In *Ward v. Livesey* (*k*), the owners of a patent granted a licence under seal for the use and manufacture of their invention upon certain terms and conditions, no express power of revocation being reserved by the deed. Some of the terms and conditions were not complied with. The plaintiffs thereupon gave notice to the licensees by letter that the licence was determined: this was, however, not assented to by the defendants, and the plaintiffs brought an action claiming a declaration that the licence had been

Determina-
tion of
licence on
breach of
conditions.

(*d*) *Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. p. 14.

(*e*) *Knowles v. Bovill*, 1870, 22 L. T. N. S. 70; *Baseman v. Wright*, 1858, 6 W. R. 719. See also *Chanter v. Leese*, 1839, 4 M. & W. 295; and on appeal, 9 L. J. Ex. 327; 5 M. & W. 698; and *Smith v. Neale*, 1857, 26 L. J. C. P. 143; 2 C. B. N. S. 67. "This rule, however, equally applies where the consideration is apportionable, so that on the total failure of any apportioned part of the consideration the moneys paid for such part will be returnable": *Morris*, 191.

(*f*) *Taylor v. Harc*, 1805, 1 Bos. & P. N. R. 260; and see *Laices v. Pursar*, 1856, 26 L. J. Q. B. 25; 6 El. & Bl. 930; and *Hebbie v. Phosphate Sewage Co.*, 1875, L. R. 10 Q. B. 491. Affirmed L. R. 1 Q. B. D. 679.

(*g*) *Lovell v. Hicks*, 1836, 6 L. J. (N. S.) Ex. 101; and see *Hall v. Jarvis*, 1822, 1 Web. P. C. 103.

(*h*) 1871, L. R. 6 Ch. 239.

(*i*) 1873, 21 W. R. 456.

(*j*) 1865, L. R. 1 Ch. 29.

(*k*) 1888, 5 P. O. R. 102.

determined and an injunction and accounts, and alleging fraudulent dealing on the part of the defendants. The defendants denied that they had wilfully or in fact broken any of the terms and conditions of the deed, and alleged in the alternative knowledge of and acquiescence in the breaches, if any, on the part of the plaintiffs, and also denied that the licence had been determined. Bristowe, V.-C., held (1) That the licence was one coupled with an interest, and, therefore, not revocable at will, but that it was liable to forfeiture in the event of the terms and conditions contained in the deed being broken. (2) That there had, in fact, been breaches of the terms and conditions of the licence, and that the plaintiffs thereupon became entitled to treat the licence as forfeited, and to determine it. (3) That the plaintiffs had not by their conduct or otherwise deprived themselves of their right to treat the licence as forfeited and determined. (4) That the letter sufficiently indicated the plaintiffs' intention to treat the licence as determined, and that an instrument under seal was not necessary for this purpose.

The consideration for the grant of a licence may consist of one or any of the following:—a sum down on execution of the licence; a fixed periodical payment; a royalty dependent on the use made of the invention; a royalty on the profits. Consideration for licence.

A licence usually contains stipulations for the payment of the royalty or other consideration which the licensee covenants to do, and if desirable a condition should be inserted empowering the licensor to have full inspection of all books, stock, &c., and full accounts rendered from time to time. The licensee is generally to have the benefit of any subsequent improvements, which are to be communicated to him. Licensee's covenants.

It is also advisable that the licensor should be empowered to revoke the licence on nonpayment of the royalties, &c., or breach of any of the covenants. Power to revoke.

The licensor will enter into the usual qualified covenant that the patent is valid, and that he has power to grant the licence. Licensor's covenants.

A licence is not assignable without express power given by the licence, so that power should be given to assign if it be desired to do so (1). Power to assign.

As to the estoppel created by the recitals and covenants, see Chapter XIV.

(1) *Bower v. Hodges*, 1853, 22 L. J. C. P. 194.

Construction of licence.

In *Bown v. Humber* (l), a licence to persons carrying on a particular business to use an invention, was held to authorize the use of the invention at all places of business of the defendants who were carrying on the original business.

Covenant by licensee not to dispute validity of patent.

As recitals in a licence merely act as estoppels up to the date of execution of the deed, it may be advisable for the licensor to make the licensee covenant not to dispute the validity of the patent or the sufficiency of the specification. On the other hand, it may frequently be advisable for the licensee to have a clause inserted in the licence specially reserving to him the right to dispute the validity of the patent.

Stamp duty on licences.

When a licence is, or purports to be, by deed, it must bear a 10s. deed stamp.

When a premium or fixed sum is paid for a licence, whether by deed or otherwise, an *ad valorem* stamp for the amount is necessary.

Where a licence contains a covenant for the payment of a minimum royalty, the Stamp Office insists upon payment of an *ad valorem* duty upon the gross minimum royalty reserved, and this although the licence contains power for licensor or licensee to determine the licence (m).

(l) 1889, 6 P. O. R. 9. Cp. *Henderson v. Mostyn Copper Co.*, 1868, L. R. 3 C. P. 202; *Otto v. Singer*, 1890, 7 P. O.

R. 7.

(m) *Johnson*, 233, 234.

CHAPTER XII.

THE REGISTER OF PATENTS (*a*).

SECT. 1. GENERAL.

SECT. 2. THE REGISTERS OF PATENTS AND PROPRIETORS UNDER THE ACT OF 1852.

SECT. 3. THE REGISTER OF PATENTS UNDER THE ACT OF 1883.

SECT. 1.—GENERAL.

SINCE the Patent Law Amendment Act, 1852, every patent is, upon sealing, registered, and all subsequent dealings with the patent, or other matters which affect its proprietorship, ought also to be registered. Registration.

By searching the subject-matter indexes of patented inventions, the patents granted in any particular manufacture or industry will be found, with the names of patentees and the number and dates of the patents. On looking in the name index, the patents, with their date and number, and the subject-matter thereof, granted to any person, can be seen. Upon inspection of the Registers of Patents, when the year and number of a patent are known, assignments, licences, prolongations, amendments of specification, payment of renewal fees, and other matters affecting the proprietorship or validity of the patent, will be found, and copies of the documents seen. There is always a registered owner or owners of a patent, in the same way as there are registered holders of shares in a company registered under the Companies Acts. Registered owners.

Between the Act of 1852 and Act of 1883, the Register of Patents and the Register of Proprietors were separate series of volumes. The Register of Patents contained a series of entries, of which an

(*a*) The author desires to acknowledge his indebtedness to Mr. E. Towers, for information in connection with this Chapter.

example is given in the foot-note (*b*), and also a notification of assignments, licences, &c. But the actual assignments, licences, &c., were entered in full, in the order in which they happened to be presented at the Great Seal Patent Office, in a series of volumes, called the Register of Proprietors. Thus, to see the assignments, licences, &c., relating to any given patent, it was often necessary to look at several volumes.

Register of
patents under
Act of 1883.

The file.

The reference to these volumes was obtained from the Register of Patents. Under the Act of 1883 the Register of Patents is very much the same as it was before, except that all the stages of progress up to sealing are not now entered, and, moreover, these stages have been much altered. The Register of Proprietors, now non-existent in name, for entries subsequent to 1st January, 1854, is replaced by a *file* or bundle, which is kept separate for each patent. The original specifications and other papers connected therewith, as also copies of all subsequent documents registered, and formerly entered on the Register of Proprietors, are kept together in this bundle or *file*, so that, on seeing the page of the Register of Patents

(*b*) *An Extract from the Register of Patents under the Act of 1852.*

10th September, 1874.	Petition, declaration, and provisional specification of ——— of ——— in the county of ——— for grant of letters patent for an invention for improvements in ———
3103 (Stamp 1s. 8d.)	Sealed with the commissioners' seal and referred to Attorney-General.
14th September.....	Petition, declaration, and provisional specification left with Attorney-General for allowances.
15th September.....	Certificate of Attorney-General allowing provisional protection received and filed, and certificate thereof given.
18th September.....	Provisional protection advertised in gazette.
2nd October	Notice to proceed received and filed, and certificate thereof given.
6th October	Notice to proceed advertised in gazette.
29th October.....	Petition, declaration, and provisional protection again referred to Attorney-General.
30th October.....	Fiat for warrant received.
24th February, 1875.	Warrant left with Attorney-General for signature.
26th February.....	Warrant received, sealed and filed.
2nd March	Letters patent prepared, sealed and dated the 10th September, 1874.
9th March.....	Specification filed in pursuance of letters patent.
6th September, 1877.	Letters patent stamped with 50l. stamp produced at Office of Commissioners of Patents, and certificate thereof endorsed thereon.
3rd September, 1881.	Letters patent stamped with 100l. stamp produced at Office of Commissioners of Patents, and certificate thereof endorsed thereon.

When a complete specification was filed in the first instance, the entry commenced, "Petition, declaration, and complete specification of ———" and the reception of the "notice to proceed" was the next entry on the register. The subsequent entries were substantially the same as those above set forth. This extract given here does not contain anything beyond the formal entries, but notifications of assignments, licences, &c., were also entered in the Register of Patents.

on which a patent is registered, and referring to the file, all the information is at once before the inquirer. It should be mentioned that with the file are kept a certain number of private documents, such as the reports of the examiners, &c., but these are not open to public inspection, and are removed before the file is inspected.

By the Act of 1883 the former Register of Patents and the Register of Proprietors are to be deemed part of the Register of Patents kept under that Act (*c*).

SECT. 2.—THE REGISTERS OF PATENTS AND PROPRIETORS UNDER THE ACT OF 1852.

The Patent Law Amendment Act, 1852, provided for the registration of patents, and the proprietorship therein, as follows:—

15 & 16 Vict.
c. 83, s. 35.

By sect. 34 (*d*), there was to be kept at the office appointed for filing specifications, a book or books to be called "The Register of Patents," wherein were to be entered and recorded in chronological order all letters patent granted under the Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the *validity* of such letters patent as the commissioners should direct, and such register, or a copy thereof, was to be open at all convenient times to the inspection of the public, subject to such regulations made by the commissioners.

Register of
patents.

And by sect. 35 (*e*), there was also to be kept at the office for filing specifications, a "Register of Proprietors," wherein were to be entered, in such manner as the commissioners might direct, the assignment of any letters patent, or of any share or interest therein, any licence under letters patent, and the district to which such licence relates, with the name or names of any person or persons having any share or interest in such letters patent or licence, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the *proprietor-*

Register of
proprietors.

(*c*) Sect. 114.

(*d*) Appendix, p. 658.

(*e*) Appendix, pp. 658, 659.

ship in such letters patent or licence; and a copy of any entry in such book properly certified was to be received in evidence in all Courts and proceedings, and was to be *prima facie* proof of the assignment of such letters patent, or share, or interest therein, or of the licence or proprietorship as therein expressed; and until such entry, the grantee was to be deemed the sole and exclusive proprietor of the letters patent, and of all the licences and privileges thereby given and granted.

Falsification or forgery of entries on register.

The falsification or forgery of any entry on the Register of Proprietors was a misdemeanour and punishable by fine and imprisonment (*e*).

Rectification of the register.

Any person deeming himself aggrieved by any entry made under colour of the Act in the Register of Proprietors, might apply by motion to the Master of the Rolls, or to any of the Courts of Common Law at Westminster, in term time, or by summons to a judge of any of the said courts in vacation for an order to have such entry expunged, vacated, or waived; and on production of any such order, the officer having the care and custody of such register was bound to comply with its requisitions (*f*).

Cases under Act of 1852.

The following cases were decided under the Act of 1852.

In 1853, one G., the grantee of a patent, assigned the same to W. and H., who omitted to register it. Afterwards, in 1855, G. assigned it to another person, who registered the assignment on the same day. The first assignees registered their assignment a week afterwards. On the motion of the first assignees, W. and H., Romilly, M. R., in 1857, ordered the entry of the second assignment to be expunged from the register, and with costs, on the ground that it had been executed for a fraudulent and improper purpose (*g*).

An assignee cannot bring an action for an infringement of his patent *against third parties* until his assignment had been registered (*h*).

Action before registration.

But the assignee of a patent may maintain a suit against the assignor, and subsequent licensees from the assignor *with notice* of the assignment, to restrain them from using the patent, although at the time of the institution of the suit the assignment had not been registered. It is to be observed, that in this case the omission to register the first deed arose out of the negligence of the

(*e*) Act of 1852, sect. 37, Appendix, p. 659.

(*f*) Act of 1852, sect. 38. Appendix p. 660.

(*g*) *Re Green's Patent*, 1857, 24 Beav. 145.

(*h*) *Chollett v. Hoffman*, 1857, 26 L. J. Q. B. 249; 7 E. & B. 686.

assignor's solicitor. Also the subsequent licence was not registered (*i*).

Apparently the registration of an assignment of a patent relates back to the date of the assignment, so as to entitle the assignee to maintain a suit to restrain an infringement instituted between the dates of the assignment and the registration (*i*). Relation back of registration to date of assignment.

The Court could, on motion, expunge an entry fraudulently made in the Register of Proprietors: it could direct any facts relating to the proprietorship to be inserted, but not the legal inferences to be drawn from them (*k*): it could also correct any entry which purported to affect the rights of persons not parties to the document registered (*l*). Fraudulent entries.

Where the executors of a patentee having obtained probate of their testator's will, had assigned his patent to another person, but the probate was not registered till after the assignment, it was held that the assignment was valid (*m*).

In *Speckhart v. Campbell*, it was held by the Court of Appeal that a person (who, in this case, was a foreigner) may bring an action in his own name for an infringement, when the patent is registered in the name of another person, if that other person is a trustee for the plaintiff (*n*).

There was no right of appeal against an order made by the Master of the Rolls to expunge an entry in the register (*o*). No appeal from Master of the Rolls.

SECT. 3.—THE REGISTER OF PATENTS UNDER THE ACT OF 1883 (*p*).

Under the Act of 1883, there is kept at the Patent Office a book called the Register of Patents (*q*), wherein are entered the names and addresses of grantees, notifications of assignments, and of transmissions of patents, of licences under patents, and of amend- Register of patents under the Act of 1883.

(*i*) *Hassall v. Wright*, 1870, L. R. 10 Eq. 509; 40 L. J. Ch. 146.

(*k*) *Re Morey's Patent*, 1858, 25 Beav. 581.

(*l*) *Re Horsley and Knighton's Patent*, 1869, L. R. 8 Eq. 475.

(*m*) *Ellwood v. Christy*, 1864, 34 L. J. C. P. 130; 10 Jur. N. S. 1079.

(*n*) 1884, Johns. Pat. Man. 239.

(*o*) *In re Horsley and Knighton's Patent*, *supra*; L. R. 4 Ch. 784; *In re Morgan's Patent*, 24 W. R. 245; *Re Myers*, 1882, W. N. 53, 56.

(*p*) The sections relating to the Register of Patents are: sect. 23, providing

for the keeping of the register; sect. 85, forbidding the entry of trusts on the register; sect. 87, providing for registration of assignments on request and proof of title to his satisfaction; sects. 88 and 89, providing for inspection of register and extracts therefrom; sect. 90, providing for the rectification of register by the Court; sect. 91, providing for correction of clerical errors by comptroller; sect. 93 makes it a misdemeanour to falsify entries in the register. There are also the Patents Rules, 1890, rr. 67—79.

(*q*) Sect. 23.

ments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be from time to time prescribed (*r*). The Register of Patents is to be *prima facie* evidence of any matters directed to be inserted therein.

Matters recorded in register.

Amongst "the other matters affecting the validity or proprietorship of patents," notifications of which are recorded in the register, are certificates of enlargement of time for payment of renewal fees, requests, applications for amendments, advertisements of these applications, notices of opposition, notices of abandonment of applications to amend, decisions of the comptroller on hearing notices of appeal, judgments of the law officer, requests for entry of assignments, &c., requests for entry of orders in council, orders in council extending the term of letters patent, and new letters patent granted thereunder. An entry of "patent expired" is also put against all patents which have ceased by non-payment of renewal fees.

How it differs from the old registers.

The modern register of patents differs from its predecessors in the following points:—There is now no distinct register of proprietors. Assignments and other deeds are no longer set forth *in extenso*, as in the volumes of the Register of Proprietors, but copies are filed. No notice of any trust will now be entered (*s*), although it appears that any deed of assignment, &c. which also contains trusts is not refused; and, indeed, it would give rise to endless trouble if any attempt were made to do so. All the documents relating to each patent are now kept together in separate bundles or files, instead of merely forming part of a chronological series as before.

With these exceptions, and due allowance being made for the changes in procedure which have taken place, the Register of Patents under the Act of 1883 continues to be kept on the same lines as the Registers prescribed by the Act of 1852.

When documents will be registered.

Documents dated before the grant of letters patent will not be entered on the register until the patent is actually issued (*t*).

The patent is not registered until after sealing, and until that time no property is recognized by the comptroller in an invention.

It is not the practice of the Patent Office to register, even after sealing, dealings with inventions prior to the application; the reason

(*r*) Sect. 23, sub-sect. 1; P. R. 1890, rr. 68—80, deal with the register of patents; cp. sect. 87. There is nothing in sect. 23 to make registration notice of the documents registered: *Heap v. Hartley*, 1888, 5 P. O. R. 603.

(*s*) Sect. 85. As to the former practice, see Johns. Pat. Man., 4th ed., p. 221.

(*t*) *Parnell's Patent*, 1888, per North, J., 5 P. O. R. 126.

apparently being the difficulty of identifying the application with the invention dealt with.

In *Parnell's Patent (u)*, an agreement was entered into on 9th July, 1883, by A. with B. for the purpose of certain dealings with an invention. Previous to this date applications had been made for patent rights in Victoria and Queensland. On the 16th March, 1886, application was made for a patent in England, which was subsequently granted and dated, as usual, the 16th March, 1886, the date of application. In September, 1887, B. requested the comptroller to register this agreement. The comptroller refused to comply with the request, on the ground that the document was dated before the date of application. B. then moved the Court, under sect. 90, to rectify the register and order the registration of the agreement. North, J., while refusing the motion, declined to lay down as an absolute rule that no document executed before the date of the grant (*i.e.*, date of application) can be entered on the register, though there might be very forcible objections to the registration of such documents, which might often be insuperable. There were documents to which the objections might not apply. There might be a document executed immediately before the date of the grant, so clear and precise as to leave no doubt whatever as to the proposed patent referred to in it.

*Parnell's
patent.*

Under rules made in pursuance of the Public Record Act, 1877, sect. 1, the volumes of the Register of Patents are kept for twenty-one years from the date of the earliest patent recorded in each. Any volume in which there is an entry of a patent of which extension is granted, is specially retained for seven years after the expiry of the period of prolongation.

*How long
volumes
of register
preserved.*

A large number of the pages in the Register of Patents contain no entry except a memorandum of the grant. Many patents lapse at the end of the fourth year through non-payment of the renewal fee, and there are frequently no dealings with a patent during its continuance which require to be registered.

It may be convenient to give here a summary of the practice under the Act of 1883, and the Rules made thereunder (*v*), in relation to the entry of various matters on the register.

*Practice
under the Act
of 1883.*

Upon the sealing of a patent the comptroller causes to be entered on the Register of Patents the name, address, and description of

*Entry of
grant.*

(*u*) 1888, per North, J., 5 F. O. R. 126. (*v*) P. R. 1890, rr. 67—79.

the grantee, and the title of the invention (*y*). A patent granted under the international and colonial arrangements is entered in the register as of the date of the first foreign application (*z*).

Entry of subsequent proprietorship.

A request for the entry of subsequent matters requiring registration must be addressed to the comptroller and left at the Patent Office (*a*).

Every such request must state the name, address, and description of the person claiming to be entitled to the patent, and the particulars of the assignment, transmission, or other operation of law in virtue of which proprietorship of the patent is alleged (*b*).

A body corporate may be registered as proprietor in its corporate name (*c*).

The applicant must produce to the comptroller, together with the request above mentioned, his documents of title, not being matters of record (*d*), and such other proof of title as may be required, and also an official, certified, or attested copy of the documents aforesaid (*e*).

Entry of license.

Substantially the same procedure is necessary in order to obtain the registration of a license (*f*).

Entry of orders.

Where an order has been made for the extension or revocation of a patent, or for the rectification of the register, the register will be altered accordingly upon an office copy of such order being left at the Patent Office (*g*).

Entry of payment of renewal fees.

Upon the issue of a certificate of payment under rule 48, the comptroller causes to be entered in the Register of Patents, a record of the amount and date of payment of the fee on such certificate (*h*).

Entry of failure to pay renewal fees.

The failure of a patentee to make any prescribed payment is duly entered in the register (*i*).

Restrictions on registration.

There will not be entered on the Register of Patents any notice of any trust, express, implied, or constructive (*k*).

Inspection of and extracts from the register.

The Register of Patents is open to the inspection of the public on every week day from ten a.m. to four p.m., with certain exceptions (*l*).

Certified copies.

Certified copies of every entry in the register may be furnished by the comptroller on payment of the prescribed fee (*m*).

(*y*) P. R. 1890, r. 67.

(*z*) *Ibid.* r. 29.

(*a*) See sect. 87; P. R. 1890, r. 68. Forms L or M, p. 746.

(*b*) P. R. 1890, r. 70.

(*c*) *Ibid.*, r. 73.

(*d*) An official or certified copy of such documents is sufficient: r. 71.

(*e*) Rules 71, 72.

(*f*) Rule 77.

(*g*) Rule 74.

(*h*) Rule 75.

(*i*) Rule 76.

(*k*) Sect. 85.

(*l*) See Rule 78.

(*m*) P. R. 1890, r. 79; sects. 88 and 89. For the fee, see No. 33, p. 587.

The comptroller may, on request in writing accompanied by the prescribed fee, correct any clerical error in, or in connection with, an application for a patent, or in the name, style, or address of the registered proprietor of a patent (*n*).

Rectification
of clerical
error in
register by
comptroller.

The Court (*o*), also, may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars (*p*), from the register of patents, or by any entry made without sufficient cause in such register, order the register to be rectified, and may make such order as may seem fit with respect to costs.

Rectification
of register by
the Court.

The Court may in any such proceeding itself decide or direct an issue to be tried for the decision of any question of fact, and may award damages to the person aggrieved (*q*).

Issue of fact.
Damages.

An order of the Court rectifying a register, directs due notice of the rectification to be given to the comptroller (*r*).

Notice of
rectification
to comp-
troller.

(*n*) Act of 1883, s. 91.

(*o*) Sect. 90, sub-sect. 1.

(*p*) Act of 1888, s. 23.

(*q*) Act of 1883, s. 90, sub-s. 2.

(*r*) *Ibid.*, sub-s. 3. These provisions are based on the Act of 1852, the cases on which are noticed at pp. 210, 211.

CHAPTER XIII.

THE INFRINGEMENT OF LETTERS PATENT.

SECT. 1. GENERAL.

SECT. 2. PRINCIPLES IN PRACTICAL OPERATION.

SECT. 3. COMBINATIONS.

SECT. 4. CHEMICAL PROCESSES AND PRODUCTS.

SECT. 1.—GENERAL.

Scope of this chapter.

It is proposed to give in this chapter a general account of the way in which the inventor's privilege under his patent may be infringed without entering upon the consideration of the means which the patentee may make use of to secure his rights. The *action of infringement*, and the various questions which may be raised therein, will be treated of in Chapter XIV. (a).

Prohibitory clause in letters patent.

The form of letters patent now in use (b), which does not, in this respect, differ materially from those which have preceded it, contains the following clause:—"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 the 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 any wise imitate the name, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof,* without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal Com-

(a) Pages 245 *et seq.*(b) See Form of Patent, pp. 630 *et seq.*

mand, and of being answerable to the patentee according to law for his damages thereby occasioned.”

Moreover, the grant is to the “patentee, &c., of our especial licence, full power, sole privilege and authority that the said patentee by himself, his agents and licensees, and *no others*, may, &c., make, use, exercise, and vend the said invention.”

The grant is of exclusive privilege to patentee.

A breach of the monopoly granted and of the prohibitory clause is an infringement of the patentee’s privilege for which an action may be brought, and an injunction and damages obtained (*c*).

Infringement a breach of the prohibition.

The ways in which a patent may be infringed are very clearly anticipated by the prohibitory words of the grant, printed in italics, and a consideration of them raises the questions which arise in the infringement of patents.

Ways of infringing.

An infringement may be defined as any act, not by the patentee or with his consent, which comes within the terms of the prohibition.

Definition of infringement.

The patentee, by his specification and claims, allots to himself a certain field of invention, and the letters patent grant him certain rights in connection with that field. Provided his patent be valid, and with that question we are not in this chapter concerned, any act which trespasses upon the patentee’s field of invention is an infringement.

A patent privilege may be infringed :—

Modes of infringing.

(1) By manufacturing articles by means of the invention or any imitation thereof, or by using or putting the invention or any imitation thereof in practice in any other way, and whether the same be by way of actual use of the invention or by an imitation thereof ;

(2) By using or selling, or otherwise dealing in articles made in violation of the patent privilege ;

(3) By making for use or sale, or vending articles which counterfeit, imitate, or resemble articles made in pursuance of the invention, or by counterfeiting or imitating the invention in any other way (*d*).

The issue of infringement leads to very difficult questions of fact in many cases. In the various classes of inventions, more or less definite general propositions of law have been, however, laid down, which assist in determining what is an infringement in questions of infringement arising out of the overlapping of patented inventions or other manufactures.

Difficult questions of fact often arise.

Overlapping manufactures.

(*c*) See next Chapter.

(*d*) See also Hindmarch, p. 487.

There are, however, several questions connected with infringement in which this overlapping is not in issue.

Infringement mixed question of law and fact.

What are questions of fact and what of law.

The question of infringement is a mixed question of law and fact. Where everything is admitted on either side, and the decision depends merely on the construction of the specification, it is for the Court to determine whether or not an infringement has taken place (*d*). Again, "there may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool" (*e*). But when the decision will depend on disputed questions of fact such as the degree of difference or similitude between two machines, or the operation of two or more chemical substances placed together, infringement becomes a question of fact mixed with law, which the judge is bound to submit to the jury. What the jurymen find to have been done is the matter of fact, but the judge must apply that fact according to the rules of law, and is entitled and bound to say whether what has been done amounts to an infringement (*f*).

General considerations.

Before proceeding to the cases on infringement in detail, there are some general points to be considered.

Must clearly ascertain subject-matter.

It is always necessary to ascertain precisely what the subject-matter of a patent is, in order to determine whether or not there has been an infringement of the privilege, and it must be shown that the act complained of constitutes an interference, to the prejudice of the patentee, with the subject-matter, or some new and essential part of the subject-matter, of the letters patent.

Cases.

This point, of which the importance can hardly be over-estimated, will be best explained by a reference to a few decided cases.

(a) The complainers being patentees of an invention for "improvements in the manufacture of knitted fabrics and in machinery therefor," brought an action against the respondent for infringing their patent. The respondents denied infringement. The machines of both parties produced radial knitting with

(*d*) *Seed v. Higgins*, 1860, 30 L. J., Q. B. 314; 8 H. L. C. 550; *Curtis v. Platt*, 1866, 35 L. J. Ch. 852.

(*e*) *De la Rue v. Dickinson*, 1857, per Campbell, C. J., 7 F. & B. at p. 755; *Westinghouse v. The L. & Y. Rail. Co.*, 1884, per Grove, J., 1 P. O. R. 237, 238.

(*f*) *Seed v. Higgins*, *ubi supra*; cp. *Walton v. Potter*, 1841, 1 Web. P. C. 586; *Macnamara v. Hulse*, 1842, Car. & M. 471; *Newton v. Grand Junction Rail. Co.*, 1846, 20 L. J. Ex. 427, n.; 5 Exch. 331; *Stevens v. Keating*, 1847, 2 Web. P. C. 191; *Sellers v. Dickinson*, 1850, 20 L. J. Ex. 417; Exch. 323.

courses of unequal lengths. In the complainers' machine, the needles were latched needles and were securable by means of a raising bar, while in the respondents they were barbed and stationary. It was held that as the specification did not claim the process of radial knitting apart from the mechanism described, and as the respondents' machine was substantially different from the complainers', although producing the same results, there had been no infringement (*g*).

Same result obtained by different means.

(b) The owner of a patent for improvements in stretchers for trousers brought an action for alleged infringement. The defendants denied the infringement. It was held that the defendants' stretchers, although obtaining the same result, obtained it by different means, and were a development beyond what was to be found in the plaintiff's specification (*h*).

(c) A patentee in his specification claimed as his invention "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair." Any combination by which that principle is applied to the same subject, and nothing short of that, is an infringement of the patent (*i*).

In the case of *Heath v. Unwin* (*k*), Parke, B., held that a defendant could not be considered guilty, at least, of an indirect infringement, unless he had intended to commit it.

Intention of infringer immaterial.

This doctrine was, however, disapproved of in *Steat v. Anderson* (*l*), where Wilde, C. J., said, "We think it clear that the action is maintainable in respect of what the defendant (the infringer) does, not of what he intends," as well as in the subsequent stages of *Heath v. Unwin* (*m*), and is now clearly overruled (*n*). In a later stage of *Heath v. Unwin* (*o*), Parke, B., said, "In delivering the judgment of the Court of Exchequer, in a former stage of this case, I stated the opinion of the Court to be that there

(*g*) *Mackie v. Berry*, 1885, 2 P. O. R. 146.

(*h*) *Gosnell v. Bishop*, 1888, 5 P. O. R. 41.

(*i*) *Minter v. Wells*, 1834, 1 Web. P. C. 134; cp. *Couchman v. Greener*, 1884, 1 P. O. R. 197; *Nordenfellt v. Gardner*, 1884, *ibid.* 61; *Walker v. Hydro-Carbon Syndicate*, 1885, 2 P. O. R. 8; *Sugg v. Bray*, 1885, *ibid.* 233—239; *Richardson v. Castrey*, 1887, 4 P. O. R. 265; *Ellington v. Clark*, 1888, 5 P. O. R. 319; *Garrard v. Edge*, 1889, 6 P. O. R. 563; *Boyd v. Horrocks*, 1889, *ibid.* 152;

Automatic Weighing Co. v. Combined Co., 1889, 6 P. O. R. 367.

(*k*) 1845, 2 Web. P. C. 227.

(*l*) 1847, 16 L. J. C. P. 250; 2 Web. P. C. 156.

(*m*) 1847-55, 15 Sim. 552, 553; 25 L. J. C. P. 19.

(*n*) *Stevens v. Keating*, 1848, 1 Mac. & G. 659; *Walton v. Lavator*, 1860, 29 L. J. C. P. 279; *McCormick v. Gray*, 1861, 7 H. & N. 25; *Newall v. Elliott*, 1864, 10 Jur. N. S. 954; *Curtis v. Platt*, 1864, 11 L. T. N. S. 245.

(*o*) 1850, 2 Webs. R. 228.

Ignorance of existence of patent immaterial.

would be no indirect infringement if the defendant did not mean to imitate at all. No doubt we were in error in that respect. There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself" (k).

Knowledge immaterial.

In *Nobel's Explosives Co. v. Jones* (l), Lord Blackburn said, "I do not think it would be material, in order to support an action for infringement of their (the plaintiffs') property, to show that it was knowingly infringed; whether it was done knowingly or not it would be equally an infringement of their property."

Intention no part of infringement.

In *Young v. Rosenthal* (m), Grove, J., said, "Intention is not part of an infringement. A man may infringe a patent although he does not know he has infringed it, as a patentee may claim as a novelty that which is not a novelty. But then if it is not a novelty he must suffer, and if a man infringes he must suffer, whether he intentionally infringes or whether he does not intentionally infringe."

"Evidence of intention to imitate may be material for the attention of the jury, but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, the infringement is just the same" (n).

Mere intention cannot make any act done an infringement, which, without that intention, would not be an infringement (o).

By servants or agents.

As to the responsibility of employers for the acts of infringement of their servants or agents, see next Chapter (p).

Importation

The *importation* into this country and sale here (q), or to a foreign customer (r), of goods manufactured abroad by a process patented in this country, is an infringement of the patent.

The rationale of this rule is very clearly explained by James, L. J., in *Von Heyden v. Neustadt* (s):—

(k) See also *Curtis v. Platt*, *supra*.

(l) 1880-82, L. R. 17 Ch. D. 721.

(m) 1884, 1 P. O. R. at p. 39.

(n) 1845, 2 Web. P. C. 227, n. (d).

(o) *Newall v. Elliott*, 1864, 10 Jur. N. S. 954.

(p) Pages 258 *et seq.*

(q) *Walton v. Lavater*, 1860, 29 L. J. C. P. 279, 280; *Filmie v. Boursier*, 1869, L. R. 9 Eq. 217; *Wright v. Hitchcock*, 1870, 39 L. J. Ch. 103, 101, 106; *Cartsburn Sugar Refining Co. v. Sharp*, 1884, per Lord Kinncar, 1 P. O.

R. at p. 186. Though the manufacture in this country of the several parts of a patented machine, and the exportation of those parts, may not be an infringement of a patent for a new combination of machinery, when the parts exported are old, it is otherwise where the part exported is itself the patented invention: *Goucher v. Clayton*, 1865, 34 L. J. Ch. 239; 11 Jur. N. S. 462.

(r) *United Telephone Co. v. Sharples*, 1885, per Kay, J., 2 P. O. R. at p. 31.

(s) 1880, L. R. 14 Ch. D. at p. 233.

“We see no reason to doubt the conclusion arrived at in *Importation. Elmslie v. Boursier* (t), that the sole right granted by the Crown ‘to make, use, exercise, and vend the invention within the United Kingdom,’ and the right to ‘have and enjoy the whole profit, benefit, commodity and advantage accruing and arising by reason of the said invention,’ includes a monopoly of the sale in this country of products made according to the patented process, whether made in the realm or elsewhere. It may be added that the patent in another part expressly forbids any person directly or indirectly to make, use or put in practice the invention. A person who makes, or procures to be made, abroad for sale in this country, and sells the product here, is surely indirectly making, using, and putting in practice the patented invention. Any other construction would, in fact, in the case of any really valuable invention of a process, render the whole privilege granted by the Crown futile.”

In *Neilson v. Betts* (u), B. held an English patent for the manufacture of a combined metal to be (among other purposes) applied as capsules to put on bottles. T. (who resided and carried on the business of a brewer in *Scotland*) purchased capsules made according to the process described in B.’s patent from a foreign manufacturer, and in *Scotland* put these capsules upon his beer bottles, which he then sent to his agents in *England* for transshipment and exportation. There was no evidence that the beer was sold in England for consumption here. It was held that though the capsules were put on in *Scotland*, their user, while the beer remained here, was a continued user of them, which amounted to an infringement of the patent.

In *Varasseur v. Krupp* (x), a foreign sovereign bought in *Germany* shells made there, but said to be an infringement of an English patent. They were brought to this country in order to be put on board a ship of war belonging to a foreign sovereign, and the patentee obtained an injunction against the agents of the foreign sovereign, and the persons in whose custody the shells were, restraining them from moving the shells. The sovereign then applied to be and was made a defendant to the suit. An order was then made by the Master of the Rolls, and affirmed on appeal, that notwithstanding the injunction he should be at liberty to remove the shells.

Transshipment.

Rights of foreign sovereigns.

In *Nobel’s Explosives Co. v. Jones* (y), a patent having been

(t) 1869, L. R. 9 Eq. 217.
(u) 1870, L. R. 5 H. L. 1.

(x) 1870, L. R. 9 Ch. D. 351.
(y) 1880-82, L. R. 17 C. D. 721.

granted in this country for making the handling of nitro-glycerine less dangerous, by causing it to be absorbed in porous unexplosive substances, a material manufactured abroad by the patent process was imported into British waters. It was held, that such importation, though for the purpose only of transshipment for exportation, and not for the purpose of having the material landed and stored in this country, was a continuing user in this country of the invention, and therefore an infringement.

Custom House agents.

In the same case it was held, that the acting as Custom House agents for an importing firm was not an infringement of an English patent, although the importation might have been an infringement.

Foreign vessels in British waters.

The Act of 1883 (*a*) declares that a patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the British territorial waters; nor the use of such an invention on board the ship, where it is not used for, or in connection with, any intended importation into, or exportation from, the United Kingdom or Isle of Man. This provision, however, is not to apply to the vessels of any foreign state where similar privileges are not accorded to British vessels.

Rights of the Crown.

Prior to the Act of 1883 the Crown and its servants or agents had the right to use a patented invention without any payment of compensation to the patentee (*b*). It was decided, in *Feather v. Regina* (*c*), that a grant of letters patent to a subject for an invention does not exclude the Crown from using the invention without a licence of the patentee.

This right of the Crown is not because the Crown is impliedly excepted from the effect of letters patent, but because the privilege thereby granted is granted against the subjects only, and not against the Crown (*d*).

Crown contractors.

In *Dixon v. London Small Arms Co.* (*e*), persons who had contracted with the government for the supply of a patented article were held liable in damages. As the defendants were contractors and not servants or agents, they could not shelter themselves

(*a*) Sect. 43. This is a re-enactment of Act of 1852, s. 26, and was necessitated by the decision in *Caldwell v. Vanlissigen*, 1861, 21 L. J. (N. S.) Ch. 97. In that case an injunction was granted against subjects of the King of Holland to restrain them from using on board their ships within the dominions of England, without the licence of the plaintiffs, an invention to the benefit of which the

plaintiffs were exclusively entitled under the Queen's patent.

(*b*) *Dixon v. London Small Arms Co.*, 1875, R. 1 App. Cas. 632; *Feather v. Regina*, 1865, 35 L. J. Q. B. 200; 12 L. T. N. S. 184.

(*c*) *Supra*.

(*d*) *Dixon v. London Small Arms Co.*, 1875, L. R. 1 App. Cas. 632.

(*e*) *Supra*.

behind the rights of the Crown, even though manufacturing for the Crown (*f*).

The above cases still apply to patents granted prior to the Act of 1883, but now it is provided by that Act, s. 27, that a patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject. But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested. Patent to bind Crown.

In *Frearson v. Loe (g)*, Jessel, M. R., said, "No doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made, for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition." Experimental user.

In the case of *Jones v. Pearce (h)*, an action for the infringement of a patent for an improved method of making carriage wheels on the principle of suspension, Mr. Justice Patteson, in summing up the case to the jury, intimated that there would be no infringement of the patent if the defendant merely made the patented articles for his own amusement or as a model.

In a later case, *Muntz v. Foster (i)*—an action for the infringe-

(*f*) As to the insertion of conditions in favour of the Crown and its contractors on grant of new letters patent on prolongation, see *Napier's Patent*, L. R. 6 App. Cas. 174; *Lancaster's Patent*, 1864, 2 Moo. P. C. N. S. 189; and *Hughes' Patent*, L. R. 4 App. Cas. 174; also *Petit Smith's Patent*, 7 Moo. P. C. 133. See also Prolongation, Chapter

XVII.

(*g*) 1878, L. R. 9 C. D. at p. 67. See also *Higgs v. Goodwin*, 1858, 27 L. J. Q. B. 145; affirmed, p. 411; *Brereton v. Richardson*, 1883-84, Griffin, P. C. 54; 1 P. O. R. 165; *Guilbert-Martin v. Kerr*, 1887, 4 P. O. R. 18.

(*h*) 1832, 1 Web. P. C. 124.

(*i*) 1844, 2 Web. P. C. 101.

Experimental
user.

ment of a patent for “an improved manufacture of metal plates for sheathing the bottom of ships”—the patentee’s invention consisted in making the said plates of an “alloy of foreign zinc” and of “best selected copper,” the metals being melted together in certain stated proportions. Chief Justice Tindal told the jury that if the defendant had “actually made any small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent.”

User for
instruction.

But user of a pirated article for the purpose of experiment and instruction, is user for advantage, and an infringement of the patent (*l*).

In that case, a company, being the proprietors of two patents for improvements, brought two actions against S., one for the infringement of each patent; S. denied infringement, and the actions were consolidated. It was admitted at the trial that S. had imported from abroad certain magnets, telephones, and transmitters, which were substantially identical with the articles made under the patent. S.’s story was that he did not really buy the instruments for exportation, but for use by his pupils, so as to avoid the use by them of the patent articles which were much more expensive.

“Imagine,” said Mr. Justice Kay, “that I am to believe all this extraordinary story, and that these were not bought (for exportation). . . . what is the alternative story? The alternative story is this: The witness S. says, “We used them for the purpose of experiment; the cost of them was so small that we could afford to allow our pupils to pull them to pieces, or experiment with them.” Now they had, as he says, a number of the so-called royalty paid instruments; they were more costly, and he says, again and again: “We could not afford to let our pupils use those: we could not afford to allow them to be pulled to pieces or experimented with, and therefore it was that we bought those which were very much cheaper, in order that our pupils might experiment with and use those instead of using the more expensive instruments.” And I am asked to say that that was not a user in this country. What does a pupil mean. They say that the pupils are persons who do not pay anything for being taught, but, on the contrary, that after they have been a certain while in the business, they, or certain classes of them, receive some payment; but the very word pupil—and this evidence which is given shows me plainly that they are young persons who are ad-

(*l*) *United Telephone Co. v. Sharples*, 1885, L. R. 29 C. D. 164; 54 L. J. Ch. 633.

mitted into this business for the purpose of learning the business—and whether they pay or not, it is obvious enough that they are paid very much less than an ordinary assistant would be paid who did not want to learn the business. They are admitted upon the terms that part of the remuneration they shall get for their services shall be instruction in the business. . . . To say that to buy a telephone, which is an infringement of the patent in this country, for the purpose of instructing your pupils, is not a user in their country, is a thing which I cannot accede to. . . . I asked (whether) there could be no user of a patent unless it produced a direct pecuniary advantage to the person who used it. . . . I put the very obvious case of a man buying what he knew to be a pirated Singer Sewing Machine; for example, suppose, the real thing being protected by a patent, that he buys a cheaper instrument which he knows is made in infringement of the patent, and buys it for some member of his household, who uses it in the household—let us say for amusement simply—would that be a user or not? Of course it could not be denied, because, although it did not produce to him one farthing, or save him the expense of one farthing, there would be no doubt whatever it would be a user in this country.

It appears, therefore, that direct pecuniary advantage to the infringer of patented articles is not a condition precedent to his liability, and that it is sufficient if the act complained of is, or may reasonably become, prejudicial to the patentee.

Direct pecuniary advantage not condition precedent to liability.

In the case of *Higgs v. Goodwin* (m), the use by the defendant of a patented process for “treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes,” not with the object of making a saleable mercantile article, but merely to purify the water, was not an infringement of the plaintiff’s patent.

In *Proctor v. Bayley* (n), the plaintiff, the owner of a patent, the validity of which had been established in a previous action, brought an action in the Palatine Court against the defendant, claiming an injunction and damages in respect of a previous user by the defendant of certain infringing machines in his works.

(m) 1858, 27 L. J. Q. B. 145; affirmed at p. 411.

(n) *Proctor v. Bayley*, 1889, 6 P. O. R. 106, 538. It was also held by the Court of Appeal, that as the Palatine Court had, under Lord Cairns’ Act, only jurisdiction to grant damages in a case where

it was proper to grant an injunction, there was no jurisdiction in the present case, and the action must be dismissed. The Court refused to give any opinion as to whether the dismissal of this action would be prejudicial to a subsequent action at law for damages.

The machines had been put up on trial, and proving unsuccessful, had been taken down five years, and removed from the defendant's premises three years before the commencement of the action. The defendant denied purchase or user of infringing machines, and, in the alternative, pleaded that his user of them was experimental, that it had long been discontinued, and that no threat or intention on his part to use infringing machines had been alleged or proved. It was held, by Bristowe, V.-C., that the defendant had used machines which were an infringement of the plaintiff's invention and to an extent amounting to more than an experimental user; and that though the act was discontinued, and there was no threat to continue it, the plaintiff was entitled to an injunction in aid of his legal right. The defendants appealed. It was held, on appeal, that in order to invoke the extraordinary jurisdiction to grant an injunction there must be some probability of the act being continued, and that assuming the defendants had infringed, as they were only users and not manufacturers, and the only infringement was put an end to in 1883, there was no evidence of any intention on their part to continue the wrongful act, and, therefore, an injunction ought not to be granted.

What is user? In the case of *Minter v. Williams* (o), it was held by the Court of King's Bench that the mere exposing for sale an article manufactured by a patent process is not an infringement of the letters patent, because the word "vend" which occurs in the granting, is not used in the prohibitory part of the patent; and because, even if it ought to be imported into the prohibitory clause of a patent, to "vend" does not mean to "expose for sale"; also because a mere exposure to sale is not necessarily prejudicial to the patentee.

Exposure for sale.

In *Osley v. Holden* (p), however, an action for the infringement of a patent for "improvements in the doors and sashes of carriages," it appeared that the defendant had made about half-a-dozen of the patented articles, and that his traveller had offered them for sale to divers persons, but had not sold any. Justice Byles directed the jury that this was, in point of law, as much a user of the patent as if there had been an actual sale of the articles.

Where certain patented articles were given to a tradesman for the purpose of being repaired, and were lent by his wife to a third

(o) 1835, 5 L. J. K. B. 60; 1 Web. P. C. 135.

(p) 1860, 8 C. B. N. S. 666.

party, without any intention to sell them or to evade the patent, it was held that there had been no infringement (*q*).

It is sufficient to constitute user of a patented article that the same sort of benefit, however temporary and indirect, has been in fact derived from it in its ordinary use. It is immaterial whether the use of the article is active or passive (*r*).

The user in this country of a patented article made abroad is an infringement of the patent (*s*). Possession.

Possession of a patented article may amount to an infringement if it be shown that it was intended to be used, although there may have been no actual user.

In *Adair v. Young* (*t*) an action was brought against the master of a ship to restrain him from using pumps, which were an infringement of the plaintiff's patent. It was shown that the ship was fitted up exclusively with infringing pumps, but had been so fitted up before the defendant, who was not a part-owner, had taken possession of her. He had nothing to do with putting them on board, and they had never been worked in British waters.

On appeal from an injunction granted by Bacon, V.-C., it was held that the injunction was rightly granted, on the ground that the defendant, being in command of a ship exclusively fitted up with pumps, which were an infringement of letters patent, was intending to use the patented invention.

In *The United Telephone Co. v. London and Globe Telephone Co.* (*u*), the plaintiffs brought their action on the ground that certain instruments were infringements of their Patent B. These instruments had been manufactured for the defendants under a contract dated before the 27th of July, 1882, and were in their possession, but they had never used or sold any of them. The defendants contended that no injunction could be awarded against them, as they had not used or sold the instruments complained of. It was held that an injunction must be granted on the terms asked for by the plaintiffs, because possession without actual use of infringing articles is a sufficient ground for an injunction to restrain actual use.

The user of an invention after the patent has expired, and before new letters patent are granted on prolongation, is not an infringement (*x*).

(*q*) *United Telephone Co. v. Henry & Co.*, 1885, 2 P. O. R. 11.

(*r*) *Betts v. Neilson*, 1868-71, 34 L. J. Ch. 537.

(*s*) *Ibid.*

(*t*) 1879, L. R. 10 Ch. D. 13.

(*u*) 1884, 1 P. O. R. 117.

(*x*) *Russell v. Ledlam*, 1845, 14 M. & W. 574; 14 L. J. Ex. 353; affirmed, 16 L. J. Ex. 145; 16 M. & W. 641.

The user of an invention for a different purpose from that of the patent is an infringement (*t*).

Infringement
by sale.

In *Townsend v. Haworth* (*u*), it was laid down by Jessel, M. R., that the sale of articles which, to the knowledge of the vendor, would be used by the purchaser in infringing a patent, was not an infringement of the patent so far as the vendor was concerned; and this principle was approved of by Fry, L. J., in *Sykes v. Howarth* (*x*). It is a necessary deduction from the proposition, which is clearly good law, that in cases of what are called combination patents, it is only the combination claimed that may not be used. The mere making, using, or vending of the elements is not prohibited by the patent.

A sale, however small, of infringing articles, however trivial in value, is sufficient to ground an action, if the plaintiff's right is distinctly challenged thereby (*y*).

When an article is sold without any restriction on the buyer, whether it is manufactured under an English or a foreign patent, that, as against the vendor, gives the purchaser an absolute right to deal with what he so buys in any way he thinks fit; and, of course, that includes selling in any country where there is a patent in the possession of and owned by the vendor (*z*).

But the mere fact that the grantors of a licence to use an invention in Belgium had a monopoly of the same invention in England, would not impart, as a matter of construction, into the Belgian licence, the grant of a right to interfere with that monopoly when there was no express grant of a right to sell in England.

A licence to manufacture an article is an authority to purchasers to sell again without the consent of the patentee (*a*).

Infringement
by manu-
facture.

Procuring
manufacture
of infringing
articles is
infringement.

If it can be shown that a defendant in an action of infringement procured the making of articles according to the patentee's invention, that will be sufficient to entitle the plaintiff to a verdict against him upon that breach (*b*).

Offers to exe-
cute orders for
articles which

In the case of *Gwynne v. Drysdale* (*c*) a curious point was raised. The pursuer, being patentee of an invention of "improve-

(*t*) *Edison and Swan Co. v. Holland*, 1888, 5 P. O. R. pp. 482-3.

(*u*) 1875, L. R. 12 Ch. D. 831, n.

(*x*) 1878, L. R. 12 Ch. D. at p. 832; cp. *Briggs v. Lardour*, 1884, 2 P. O. R. 126.

(*y*) *Colo v. Saqui*, 1888, 5 P. O. R., per Kekewich, J., at p. 493.

(*z*) *Société Anonyme de Glaces v.*

Tilghman's Sand Blast Co., 1883, 25 Ch. D. 7, per Cotton, L. J., cp. *Betts v. Willmott*, 1870, L. R. 6 Ch. 239.

(*a*) *Thomas v. Hunt*, 1864, 17 C. B. N. S. 183.

(*b*) *Gibson v. Brand*, 1842, 1 Web. P. O. 681, per Tindal, C. J., and see note (*d*).

(*c*) 1885, 2 P. O. R. 160.

ments in pumping machines," which consisted in arranging the suction and discharge pipes to swivel, by making the pump case rotate, brought an action against the defenders for infringing this patent. The alleged infringements consisted of the sale of certain pumps, and offers to execute orders for swivelling pumps in response to applications by persons who applied at the instance of the pursuer. The defenders denied infringement. It was held by the Lord Ordinary (Maclaren), whose judgment was affirmed on appeal by the First Division of the Inner House of the Court of Session (*d*), that the defenders had not infringed, because the pumps which they had sold were not swivelling pumps at all, and as to their offers to execute orders for swivelling pumps, the patent did not claim every kind of swivelling pump, and the presumption must be that their offers related to such as would not be an infringement of the patent.

might or
might not
be infringe-
ments.

The following extract from the judgment of Lord Maclaren shows how far such offers will be treated as evidence of infringement:—

“In the first place, these cases are open to the observation that they were both offers obtained from the defender by persons who were seeking for evidence of a contravention of the patent, and it is quite certain he has never supplied swivelling pumps to any previous customer. Further, the offer is a very general one. He does not say that these swivelling pumps which he was to supply were to be according to the description in the pursuer's specification. . . . The patent does not claim every mode of swivelling a pump; indeed, I do not think a legal specification could be drawn such as would embrace every arrangement of swivelling; at all events, it is not so done here, and I cannot assume that the intention was to infringe the patent. On the contrary, the presumption is always in favour of innocence, and I must assume he meant to supply something which was not a contravention.” If the arrangement had gone on, and a swivelling pump had been ordered, “we would then have seen what it was like, and possibly a case of infringement might have been made out; but at present the mere fact that an offer was made to supply a swivelling pump, if desired, unaccompanied by any evidence of positive infringement, is not such evidence as, in my opinion, would justify the Court in granting an injunction or interdict against contravention.”

(*d*) 1886, 3 P. O. R. 65.

Making or working material part of invention is infringement.

The making or working any material part of an invention patented without the consent or licence of the patentee, is an infringement of his rights.

The cases in support of this statement will be considered when we come to deal with the infringement of combinations (*infra*, pp. 236 *et seq.*).

One or two general illustrations may, however, be given here with advantage.

In *Cornish v. Keene* (*d*), the patent comprised an invention which was composed of three distinct parts, and the plaintiffs proved that the defendants had used so much only of the invention as related to one of the three parts, yet the evidence was held to be sufficient to entitle the plaintiffs to a verdict upon the issue of infringement.

In *Newton v. Grand Junction Railway Co.* (*e*), Pollock, C. B., said, "It was argued that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But, in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part, for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement."

In *Sellers v. Dickinson* (*f*), the same learned judge said, "There may be an infringement by using so much of a combination as is material, and it would be a question for the jury whether that used was not substantially the same thing" (*f*). And again, "I think it may be laid down as a general proposition (if a general proposition can be laid down on a subject applicable to such a variety of matters

(*d*) 1835, 6 L. J. C. P. 225; 1 Web. P. C. 501; *cp. Hill v. Thompson*, 1818, 1 Web. P. C. 242; *Gillett v. Wilby*, 1839, 1 Web. P. C. 270; 9 C. & P. 336; *Newton v. Grand Junction Rail. Co.*, 1846, 20 L. J. Ex. 427, n.; 5 Exch. 334; *Sellers v. Dickinson*, 1850, 20 L. J. Ex. 417; 5 Exch. 324, 326; *Electric Telegraph Co. v. Brett*, 1851, 20 L. J. C. P. 123; 10 C. B. 838; *Smith v. L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69, 76; *Borill v. Keyworth*, 1857, 29 L. T. 194; 7 E. & B. 725, 737; *De la Rue v. Dickinson*, 1857, 29 L. T. 194; 7 E. & B. 738; *Lister v.*

Leather, 1858, 27 L. J. Q. B. 295; 8 E. & B. 1004, 1031, 1033; *Patent Bottle Envelope Co. v. Seymer*, 1858, 28 L. J. C. P. 22; 5 C. B. N. S. 172; *Thomas v. Foxwell*, 1858, 5 Jur. N. S. 39; *White v. Fenn*, 1867, 15 L. T. N. S. 505; 15 W. R. 348; *Parkes v. Stevens*, 1869, L. R. 8 Eq. 358, 366, 368; *Wright v. Hitchcock*, 1870, L. R. 5 Ex. 37; *Hinde v. Osborne*, 1885, 2 P. O. R. 68; *United Horsenail Co. v. Stewart*, *ibid.* 122.

(*e*) 1846, 5 Exch. 334.

(*f*) 5 Exch. 324; *Hills v. Liverpool Gas Co.*, 1863, 32 L. J. Ch. 28.

as patent law—matters, indeed, incommensurable with each other, for the same doctrine which would apply to a medicine would scarcely apply to a new material or a new metal), that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent” (g).

It is no answer for the defendant in an action of infringement to show that he has improved upon the plaintiff's invention, if, without the use of that invention, the improvement cannot be made available (h). Law as to improvements in patented articles.

A patent can be taken out for an improvement upon the subject-matter of the patent which is still running or in force, but cannot be exercised without the license or consent of the prior patentee during the currency of his grant, if it is so dependent upon the original invention as to be incapable of being used without it. At the end of that time the public has a right to choose between the two inventions (i). On the other hand the improvement cannot be used by the original patentee without the licence of the second patentee, but since 1883 either patentee can obtain a compulsory licence.

SECT. 2.—PRINCIPLES IN PRACTICAL OPERATION.

Although there cannot be a patent for an idea or a principle apart from its physical embodiment in adequate apparatus, yet if the specification discloses the idea, shows a method by which it can be carried out, and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea, is an infringement of the patent, though the method used, and even the purpose to which the principle or idea is applied, be different from those embodied in the specification (k). Thus, in Infringement of a principle in practical operation.

(g) *Ibid.* 326.

(h) *Neilson v. Harford*, 1841, 1 Web. P. C. 310, 323.

(i) *Ex parte Fox*, 1812, 1 Web. P. C. 413; *Harnar v. Playne*, 1807, 14 Ves. 130; *Lewis v. Davis*, 1829, 1 Web. P. C. 489; *Crane v. Price*, 1842, 1 Web. P. C. 413, per Tindal, C. J. A manufacturer who professes to sell to the public a machine under his own name as one with all the newest improvements, will not be restrained from selling it on an allegation that it is an infringement of the plaintiff's patent for an old machine

which had not the modern improvements: *Willcox Sewing Machine Co. v. Wood*, 1869, 20 L. T. N. S. 10.

(k) *Easterbrook v. The G. W. Rail. Co.*, 1885, per Wills, J., 2 P. O. R. at p. 207; cp. also *Crossley v. Beverley*, 1829, 1 Web. P. C. 106; *Jupe v. Pratt*, 1837, per Alderson, B., 1 Web. P. C. 146; *Houshill Co. v. Neilson*, 1843, per Lord Justice Clerk-Hope, 1 Web. P. C. at p. 683; *Otto v. Linford*, 1881-82, 46 L. T. N. S. 35; *Badische Anilin Fabrik v. Levinstein*, 1883, L. R. 24 Ch. D. 156, 171—173.

Minter v. Williams (l), the invention claimed being the application of a self-adjusting leverage to the back and seat of a chair, it was laid down that any application of that principle to the same subject would be an infringement of the patent.

Process for arriving at known result.

Where a patent is taken out for a process for arriving at a known result, any other person may take out a patent for another process, or may use another process without obtaining a patent, without any infringement of the process first patented (n.).

Cases.

In *Bovill v. Pimm* (n), the facts were these:—

Bovill v. Pimm.

In 1844, G. obtained a patent for "improvements in grinding wheat and other grains." He described as his invention "the forcing and distributing of atmospheric air from the eye or centre of mill-stones, for the purpose of cooling the grain during the process of grinding." This was effected by an air-box placed below the mill-stones, into which air was forced by the rapid rotation of a fan or blower, which caused a current of air perpendicular to the axis of the fan; and the air was conducted by a pipe through the eye of the lower stone to the centre of the two stones, and there distributed between them by an apparatus provided with fans or arms. In 1846, the plaintiff obtained a patent for "improvements in manufacturing wheat and other grain into meal and flour." His invention consisted in the application of ventilating vanes or screws at the centre of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current of air parallel to the axis of the vane, was attached externally to the eye of the upper mill-stone; the screw vane being set in rapid motion, the air was compelled to pass through the eye into the centre of the two stones, and so find its way out between them. In 1851, the defendant obtained a patent for "improvements in grinding wheat," and his plan was to remove from the centre of both stones a large circular portion of each, and in this space, opposite to the separation of the two stones, to place a fan or blower, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones:—It was held, that the defendant's invention was no infringement of the plaintiff's, but that each was a new method of accomplishing a well-known object, viz., the cooling grinding substances by the common principle of obtaining a current of air by a rotating vane.

(l) 1835, 5 L. J. K. B. 60; 1 Web. P. O. 134.

stein, 1883, per Pearson, J., 24 Ch. D. p. 170.

(n) *Badische Anilin Fabrik v. Levin-*

(n) 1856, 11 Exch. 718—739.

Pollock, C. B., in delivering the judgment of the court, said: "Where a subject is not new, as this certainly was not, viz., 'the cooling of substances undergoing the process of grinding' (which had been long known to be a desideratum in grinding, and to effect which various contrivances had been adopted, and several, if not many, patents taken out), any patent taken out for *a method of performing the operation* is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase (o).

Again, in *Seed v. Higgins* (p), the plaintiff claimed by his specification and disclaimer the application of centrifugal force in the particular manner described in the specification. The particular manner described was by the use of "a weight." The defendant employed a machine similar in many respects, but, though using weight, or pressure occasioned by weight, as a force, did not use "a weight:"—It was held, that this did not amount to an infringement of the plaintiff's patent. *Seed v. Higgins.*

In *Wilson v. Barbour* (q), the plaintiff and one of the defendants were patentees of an improvement in machines for spinning rope yarns, which they called an "Interceptor," and which consisted of rack-like clamps with intersecting teeth, forming an irregular elastic tube through which the fibre passed to the flyer, so that the twist imparted by the flyer was intercepted and prevented from passing to the smooth portion of the yarn or "sliver." An agreement was entered into between the plaintiff and the defendants, who were a firm of machine makers. The defendants undertook to make and sell the patented machines, and to use their best endeavours to develop the sale, the plaintiff to receive part of the profits, and "all future improvements of the patent, whether invented by plaintiff or defendants, were to belong to the patent." The defendants having found the plaintiff's "Interceptor" defective for spinning certain classes of yarn, made, *Wilson v. Barbour.*

(o) Cp. *Bovill v. Keyworth*, 1857, 7 E. & B. 725.

(p) 1860, 8 H. L. C. 650; op. *Palmer v. Wagstaffe*, 1854, 23 L. J. Ex. 217; 9 Ex. 494.

(q) 1889, 5 P. O. R. 246; op. *Bovill v. Pimm*, 1856, per Pollock, C. B., 11 Ex. at p. 739; *Needham v. Oxley*, 1865, 21 Newt. Lon. Jour. N. S. 300; *Curtis*

v. Platt, 1866, 35 L. J. Ch. 852; 11 L. T. N. S. 249; *Walker v. Hydro-Carbon Syndicate*, 1885, 2 P. O. R. 8; *Mackie v. Berry*, 1885, *ibid.* p. 146; *Sugg v. Bray*, 1885, *ibid.* pp. 233, 234, 236, 238, 239; *Lawrence v. Perry*, 1885, *ibid.* pp. 179, 188; *Proctor v. Bennis*, 1887, 4 P. O. R. 354; *Gosnell v. Bishop*, 1888, 5 P. O. R. 41.

without informing the plaintiff, various experiments for the purpose of improving it, but ultimately abandoned the principle of rack-like clamps, and adopted an interceptor consisting of two opposing surfaces, forming a continuous tube instead of an irregular one, as in the plaintiff's invention, the same results, viz., "nipping" and "rubbing" the yarn, being accomplished in both. The defendants sold a number of machines fitted with their own new interceptor without paying the plaintiff any royalty or share of profits on such sales.

While the judgment of the Court (*q*) was in favour of the plaintiff on the grounds—which are not material to the point now under consideration—that the defendants' interceptor, being an "improvement" within the meaning of the agreement, therefore belonged to the patent; and that the defendants, not having used their best endeavours to develop the sale of the plaintiff's invention, were liable in damages, it was held that the object aimed at by both interceptors not being new, and the means adopted for accomplishing it being different, the defendants' interceptor was not an infringement of the patent.

Curtis v. Platt.

Curtis v. Platt (*r*) is an authority for the same proposition. The plaintiff was the owner of a patent for improvements in spinning mules, which were well-known machines, working and acting long before that patent was taken out. For the efficient agency of these machines, it was found necessary that there should be a shaft with cams on it, and some means of arresting the shaft, staying it once, twice, or even four times during a single rotation, and thereby producing breaks or pauses for spaces of time in its rotatory motion. These pauses or breaks had been at various times attempted to be produced in various ways. One method of producing them was by the operation of a clutch-box, and it was patented by L. and R. The plaintiff's patent was for an improvement on this process, and its only merit consisted in a new arrangement of original elements, all of which were to be found in the patent of L. and R. The defendant used the same common elements for the same object, but in a different combination, with a different effect on the clutch-box, and with a different result. It was held by Wood, V.-C., and by the House

(*q*) Chancery Division of the High Court of Justice (Ireland), per Porter, M. R.

(*r*) 1863, 3 Ch. D. 136, n. ; 11 L. T. 247; explained by Cotton, L. J., in *Proctor v. Bennis*, 1887, 36 Ch. D. pp. 756—758.

of Lords on appeal, that there had been no infringement of the plaintiff's patent.

The effect of this decision is that "where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims, and the mode which he points out of effecting the improvement."

The opinions expressed by the judges in *Curtis v. Platt* do not apply to a case where there is not only novelty in the machine, but novelty in the result to be produced by that machine.

When a patent is taken out for a new result, not known before, and there is one process described in the patent which is effectual for the purpose of arriving at that new result at the time when the patent is taken out, the patentee is entitled to protection against all other processes for the same result, and no person can, without infringing upon his patent, adopt simply a different process for arriving at the same result (s).

New result by a process.

Obtaining same result by another process is an infringement.

Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been done before (t).

Or machine.

In *Proctor v. Bennis* (u), the patent in question had for its object "improved and self-acting mechanism for supplying to and dis-

(s) *Badische Anilin Fabrik v. Levinstein*, 1883, per Pearson, J., 24 Ch. D. at p. 171.

(t) *Curtis v. Platt*, 1863, 3 Ch. D. 136, n., per Wood, V.-C.; *Bovill v. Moore*, 1816, Dav. P. C. 405; *Hill v. Thompson*, 1818, 1 Web. P. C. 242; *Forsyth v. Riviere*, 1819, 1 Web. P. C. 97; *Webster v. Utter*, 1824, Godson's Patent Law, 232; *R. v. Lister*, 1826, Webst. Letts. Pat. 80; *Cochrane v. Braithwaite*, 1830, 3 Lond. Jour. N. S. 42; *Russell v. Cowley*, 1834, 1 Web. P. C. 463; *Morgan v. Seaward*, 1836, 1 Web. P. C. 171; *Walton v. Potter*, 1841, 11 L. J. O. P. 138; 1 Web. P. C. 586; *Neilson v. Harford*, 1841, 1 Web. P. C. 319; *Walton v. Bateman*, 1842, 1 Web. P. C. 616; *Muntz v. Foster*, 1844, 2 Web. P. C. 101; *Gamble v. Kurtz*, 1846, 3 C. B. 425; *Trotman v. Wood*, 1864, 16 C. B.

N. S. 479; *Hayward v. Hamilton*, 1861, Johnson's Pat. Man. 245; *Stead v. Anderson*, 1847, 16 L. J. C. P. 250; 2 Web. P. C. 156; *Barker v. Grace*, 1847, 17 L. J. Ex. 122; 1 Exch. 339; *Stevens v. Keating*, 1847, 19 L. J. Ex. 57; 2 Web. P. C. 181; *Electric Telegraph Co. v. Brett*, 1851, 20 L. J. C. P. 123; 10 C. B. 838; *Hancock v. Moulton*, 1852, Johnson's Pat. Man. 208; *Bateman v. Gray*, 1853, 22 L. J. Ex. 290; Macr. P. C. 102; *Smith v. London and North Western Railway Co.*, 1853, 2 E. & B. 69, 76; *Morewood v. Tupper*, 1855, 3 C. L. R. 718; *Simpson v. Holliday*, 1864, 20 Newt. Lon. Jour. N. S. 111; *Nedham v. Oxley*, 1865, 21 Newt. Lon. Jour. N. S. 300; *Curtis v. Platt*, 1866, 35 L. J. Ch. 582; *Murray v. Clayton*, 1872, L. R. 7 Ch. 585.

(u) 1887, 36 Ch. D. 740.

tributing fuel at intervals over the fire surface." The essence of the invention consisted in throwing coal on to the furnace by the intermittent radial action of a flap or door. Nothing of the kind had been done before. There had previously been imperfect machines for feeding furnaces automatically, but that had not previously been done by any intermittent radial action of a flap or door as in the case of the plaintiff's patent.

It was held by the Court of Appeal that the plaintiff's patent was infringed by a machine producing the same result by a combination of mechanical equivalents of the above contrivances, with some alterations and omissions which did not prevent the new machine from being one which took the substance and essence of the patented invention.

SECT. 3.—COMBINATIONS.

Test of infringement of combination.

The test of whether or not a combination has been infringed was thus stated by Cotton, L. J., in *Proctor v. Bennis* (x): "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variations or by mechanical equivalents the substance of it so as to produce the same result by practically the same means?"

(x) 1887, 36 Ch. D. at p. 754; cp. *Needham v. Johnson*, 1884, 1 P. O. R. 45. It was held, in *Proctor v. Bennis*, at p. 752, that a patent for a new combination of four elements is infringed by a machine containing some of such elements with mechanical equivalents for others; and it is immaterial to the defendant's liability that he has made improvements upon the plaintiff's invention, unless it can be shown that the improvements are of such a character as to prevent the two machines being in substance the same: *Ehrlich v. Ihlec*, 1888, 6 P. O. R. at p. 464, per Cotton, L. J.; cp. *Russell v. Ledsam*, 1845, 14 L. J. Ex. 145; 14 M. & W. 580; *Davis v. Feldman*, 1884, Griffin, P. C. 75; 1 P. O. R. 13, 193; *Tatham v. Dania*, 1869, Griffin, P. C. 213; *United Telephone Co. v. Nelson*, 1887, W. N. 1887, 193. A clumsy imitation of a patented machine, or a patented article, may be an infringement, although it is not such as would have been an anticipation defeating an inventor's right to a patent: *Murray v. Clayton*, 1872, L. R. 7 Ch. 585; *Daw v. Eley*, 1867, L. R. 3 Eq. 496; cp. *Hinde v. Osborne*, 1884, 1 P. O. R. 221; *Hayward v. Pavement Light Co.*, *ibid.* p. 207, affirmed, 1885, 2 P.

O. R. 64; *Useful Patents Co. v. Rylands*, *ibid.* 255; *Osmond v. Hirst*, *ibid.* 265; *Fairburn v. Household*, 1886, 3 P. O. R. 267; *Hocking v. Fraser*, *ibid.* 3; *United Telephone Co. v. St. George*, *ibid.* 321; *Edison v. Woodhouse*, *ibid.* pp. 173, 174; *United Telephone Co. v. Bassano*, *ibid.* 295. It is not for the Court to say how far a defendant's instrument will be an infringement if certain parts are altered or varied: *S. C.* at p. 318; *Downes v. Falcon Iron Works*, 1886, 3 P. O. R. 70; *Musgrave v. Hicks*, *ibid.* 49; *Kaye v. Chubb*, 1887, 4 P. O. R. 23; *Hocking v. Hocking*, *ibid.* 255, 434; *Wenham Co. v. May & Co.*, *ibid.* 303; *Moseley v. Victoria Rubber Co.*, *ibid.* 258; *Harvie v. Ross*, *ibid.* 234; *Fletcher v. Glasgow Gas Commissioners*, 1887, 4 P. O. R. 366. In this case the defendants admitted certain infringements, which they had discontinued, and offered to pay royalties in respect of, and successfully disproved other alleged infringements: *ibid.* 389; *Ellington v. Clark*, 1888, 6 P. O. R. 135; *Haslam Co. v. Hill*, *ibid.* 21; *Hoyd v. Horrocks*, *ibid.* 575; *Crampton v. Patents Investment Co.*, *ibid.* 382; *Gosnell v. Bishop*, *ibid.* 156.

The law as to the infringement of combinations may best be illustrated by a somewhat detailed examination of the cases bearing upon the subject.

Cases of infringement of combinations.

A patent for an entire combination is not infringed by a different combination for the same object of the same elements, though important, or of equivalents for them, if not a mere colourable evasion or imitation (z). Thus, in *Clark v. Adie* (a), the plaintiff, who was assignee of a patent for a machine for clipping horses, made a new machine for the same purpose, for which he did not take out a patent. The plaintiff's machine was very unlike the patented machine, the general combination of the parts of the latter machine not being copied, but a subordinate combination (a) of some of the parts (not expressly or impliedly claimed as a distinct invention in the specification of the patentee) being embodied in the plaintiff's machine. The defendant made and sold clipping machines in exact imitation of the plaintiff's machine. It was held that the defendant's patent did not protect the subordinate combination.

Patent for entire combination not infringed by different combination for same object.

Again, in *Parkes v. Stevens* (b), where by the specification of a patent for improvements in spherical gas lamps at railway stations and public places, protection was claimed for "the arrangement and combination of parts hereinbefore described and represented in the drawing annexed," it was held by James, V.-C., that the use by the defendant of a sliding spherical door, which, although its advantages were altogether collateral to the objects of the invention, was a feature in the plaintiff's lamps, and described in his specification, was no infringement of the plaintiff's patent.

His Lordship, however, added: "The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—Is it really and substantially a part of the invention?" (c).

Patent for entire combination protects every essential part.

(z) *Curtis v. Platt*, 1866, 35 L. J. Ch. 852. In considering the question of colourable evasion, the Court will look at the novelty of the object of the combination, and of the parts combined, *ibid.*; *Lister v. Leather*, 1858, 27 L. J. Q. B. 295; 8 E. & R. 1004, 1031. See a consideration of this case, *supra*, at p. 143; *exp. Dudgeon v. Thomson*, 1877,

L. R. 3 A. C. 34; *Clark v. Adie* (No. 1), 1875, L. R. 10 Ch. 667; *Townsend v. Haworth*, 1875, 12 Ch. D. 831, n.; *Harrison v. Anderston Foundry Co.*, 1876, L. R. 1 A. C. 574.

(a) *Supra*.

(b) 1869, L. R. 8 Eq. 358; *Saxby v. Clunns*, 1869-74, 43 L. J. Ex. 228.

(c) *Op. Walton v. Potter*, 1841, 1 Web.

Question is,
Has essence
of combina-
tion been
adopted?

In *Flower v. Lloyd (d)*, it was held by the Court of Appeal that in order to constitute an infringement of a patent for a combination, there must be an infringement of the whole combination, not in the sense that every step of the combination must be adopted, but that there must be an adoption of that which constitutes the essence of the combination.

In *United Telephone Co. v. Harrison (e)*, the plaintiffs were the owners of a patent for improvements in electric telephones. In the instruments which they manufactured and sold, the plaintiffs used a diaphragm or tympan of mica to receive the air vibrations produced by the voice, under which was placed a piece of cork, and below the cork was a piece of platina foil. At the date of the plaintiffs' patent it was not known that the instrument would work without the independent mica diaphragm, but this was subsequently discovered. The defendants made and sold instruments similar to those manufactured under the patent, except that they dispensed with the mica diaphragm and the cork. It was held that they had infringed the plaintiffs' patent.

The cases just cited illustrate the law as to the infringement of a patent for a combination by the adoption and reproduction of its essential parts.

Colourable
imitation or
substitution
of equiva-
lents.

To take the substance of a combination will be not the less an infringement because it has been coloured or disguised by immaterial variations, or by the substitution for some parts of the combination, of mechanical equivalents (*f*).

Cases.

In *Hayward v. Pavement Light Co. (g)*, the plaintiffs were owners of a patent for "Improvements in Pavement Lights," having for its object lights so constructed as to divert the rays of light in an inclined direction into the rooms which it is desired to light, by using glass moulded so as to consist of an angle or series of angles. The defendants used lights of glass moulded so as to

P. C. 586, 587; *Thorn v. Worthing Skating Rink Co.*, 1876, L. R. 6 Ch. D. 415, n.

(*d*) 1877, W. N. 132, and see *S.C. ibid.* 71; *Burnett v. Tate*, 1883, Johns. Pat. Man. 260; *Mason v. Goodwin*, 1889, 6 P. O. R. 235.

(*e*) 1882, 21 Ch. D. 720.

(*f*) *Dudgeon v. Thomson*, 1877, per Lord Cairns, C., 3 A. O. 43; cp. *Morgan v. Seaward*, 1836, per Alderson, B., 1 Web. P. C. 171; *Walton v. Potter*, 1841, 1 Web. P. C. 586; *Walton v. Bateman*, 1842, per Crosswell, J., 1 Web. P. C. 616; *Barrett v. Vernon*, 1877, 25 W. R. 343; *Heath v. Unwin*, 1845, 2 Web. P. C. 227; *Adair v. Young*, 1879; L. R. 12 Ch.

at p. 21. In *Webster v. Utter*, 1824, Higgins, Dig., p. 385, an action for the infringement of a patent for an improvement on the patent percussion gun-lock, by the addition of a bolt, sliding or moving in a groove, by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer; the defendant's lock had a spring in the bolt, and the jury, upon the evidence of mechanics that a spring in a bolt was the same thing as a bolt sliding in a groove, found that there had been an infringement.

(*g*) 1884, 1 P. O. R. 207; *Hinde v. Osborne*, *ibid.* 221; 2 P. O. R. 64.

consist of a curve. It was held that the defendants had infringed the plaintiffs' patent.

In *United Telephone Co. v. St. George (h)*, the plaintiffs were the owners of a patent claiming a combination for telephonic purposes of a diaphragm or tympan with electric tension regulators operating in a closed circuit. The defendant's instrument, which was alleged to be an infringement, consisted of a disc of carbonised leather behind a mouth-piece and a ball of carbonised wood, suspended by means of a flexible metallic conductor so as to rest lightly by gravity against the disc. The defendant denied the alleged infringement, and contended that his instrument did not contain either of the elements of the plaintiff's combination, and did not operate in a closed circuit. It was held that the defendant's disc was a diaphragm within the meaning of the specification; that the defendant's disc and ball were tension regulators covered by the specification; that the defendant's instrument did operate in a closed circuit; and that the plaintiffs were entitled to an injunction in the usual form.

In *Wenham Co. v. May (i)*, the owner of a patent for improvements in gas lamps brought an action against M. & Co., alleging infringement and asking for the usual relief. The defendants denied infringement. The only material difference between their combination and that of the plaintiffs' was, that whereas in the plaintiffs' lamp there were gauze coverings placed in two distinct positions, and serving the purpose of moderating and equalising the currents of air, in the defendants' lamp there was only one gauze covering, which did not occupy precisely the same position as either of the two in the plaintiffs' lamp, but which, according to the evidence, answered the same purpose, although less effectively. It was held, that having regard to the evidence and to the fact that upon the specification the equalising of the currents by the gauze, rather than the exact position of the gauze, appeared to be the aim of the invention, the defendants' combination was an infringement of the plaintiffs'.

In *Ehrlich v. Ihlee (j)*, the grantee of a patent for improvements in mechanical musical instruments brought an action for alleged infringement. The defendants denied infringement. It was held at the trial, that the plaintiff's combination was new; and that the

(h) 1886, 3 P. O. R. 321.

(i) 1887, 4 P. O. R. 303.

(j) 1888, 5 P. O. R. 437; *Winby v. Manchester, &c. Steam Tramways Co.*,

1889, 1890, 6 P. O. R. 365; 7 P. O. R. 30; *Shaw v. Jones*, *ibid.* 328; *Automatic Co. v. Combined Co.*, *ibid.* 120.

defendants had taken the same parts to perform the same functions, with the colourable variation of a rotating wind-chest and fixed music sheet, instead of the plaintiff's fixed wind-chest and rotating music sheet, and had therefore infringed. This decision was confirmed on appeal.

Mechanical
equivalents.

Mechanical equivalents may not be an infringement where a patent is only for an improved method of attaining an old object.

Thus, in *Gosnell v. Bishop (i)*, the owners of a patent for improvements in stretchers for trousers brought an action for alleged infringement. The defendants denied infringement. It was held that the defendants' stretchers, although obtaining the same result, obtained it by different means, and were a development beyond what was to be found in the plaintiffs' specification.

But a combination of known mechanical appliances and principles to attain a combination of results long sought for, but not previously obtained, in a machine in common use, is a new result, and the doctrine of mechanical equivalents applies in such a case.

This point was decided in *Thomson v. Moore (k)*. The plaintiff, in 1876, patented improvements in the mariners' compass, the chief features of which were an exceedingly light compass card consisting of a narrow rim of thin paper, the central portion being cut away, and the outer circumference composed of a thin rim of aluminium, it and the card being kept in shape and connected with the central boss by fine silken radial threads in tension: the needles short and light, arranged in a horizontal plane a little beneath the card, and attached to it by light silk threads; the objects attained being—(1) diminution of friction, resulting in increased sensitiveness and accuracy; (2) small magnetic moment and consequent amenability to Airy's system of correctors; (3) long vibrational period, the magnetic moment being small, and a comparatively large proportion of the weight of the card being thrown to the periphery, securing steadiness in stormy weather. In 1885, the defendant, who had previously patented certain "improvements in the adjustments of the mariners' compass," one of the features of which was a new arrangement of correctors, constructed and sold a compass card, admittedly an infringement of plaintiff's patent, and proceedings having been instituted, he consented to a perpetual injunction. In 1888 the

(i) 1888, 5 P. O. R. 156.

(k) 1889, 6 P. O. R. 426.

defendant constructed another card, resembling that of the plaintiff in—(1) extreme lightness; (2) smallness of needles and magnetic moment; and (3) length of vibrational period and consequent steadiness, the greater part of the weight being thrown to the periphery, as in the patented compass card; but differing from the card described in the plaintiff's specification in the following respects—(a) the circumference consisted of an L-shaped ring of aluminium, instead of a thin flat rim; (b) the centre portion in both cards was cut away, but defendant, instead of connecting it with the boss by silken spokes in tension, used flat parallel strips of aluminium; (c) the needles in both were short and light, but in defendant's card they were arranged in two vertical rows some distance below the card, and attached by aluminium wires, instead of silk threads. The same combination of results, viz., diminution of frictional error, steadiness, and amenability to correction, were obtained in both cards though not in the same degree. Defendant alleged that he disposed the needles in vertical rows, placed some distance below the card, in order to adapt the instrument to his own patented system of correctors, which he claimed was an improvement on plaintiff's patented arrangement. The plaintiff charged defendant's new card as a fresh infringement of his patent and a breach of the injunction, and moved for an attachment. It was held by the Master of the Rolls that the patent being for a new means of attaining an old and well-known object, viz., to produce a compass which would be steady and true under all circumstances, it was the case of a combination of known mechanical means for effecting a known improvement in an old machine, and that the doctrine of mechanical equivalents did not apply. The plaintiff having appealed, the Court of Appeal, reversing the order of the Master of the Rolls, held that the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration and small needles, so as to obtain a combination of results not previously obtained, viz., diminution of frictional error, steadiness and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied; that the question was whether there was a pith and substance of invention underlying the combination; and if so, has the defendant taken that pith and substance; that the defendant's card having obtained the same results by substantially the same means, agreeing in essentials with the plaintiff's patented card, and

Mechanical
equivalents.

differing only in non-essentials, it constituted a fresh infringement, and there must be an attachment (*l*).

In *Automatic Weighing Machine Co. v. Knight* (*m*), a new kind of weighing machine, wherein the introduction of a coin into the apparatus allowed the weight of the body to be weighed to be shown on the indicator, the machine acting automatically, was held not to be infringed by a weighing machine, in which the introduced coin raised an arm, and so enabled the person to operate a handle which set the machine in motion.

SECT. 4.—CHEMICAL PROCESSES AND PRODUCTS.

Chemical
equivalents.

In those cases where a patentee has made some discovery in chemistry, any person may afterwards use for the same purpose chemical equivalents which were not known to be such at the time the patent was taken out (*n*).

Thus in *Heath v. Urrain* (*o*)—an action for the infringement of a patent for certain improvements in the manufacture of iron and steel—the specification described the invention as consisting in “the use of carburet of manganese in any process whereby iron is converted into cast steel.” B. manufactured cast steel by placing oxide of manganese and carbonaceous matter into the pot at the same moment as the steel. Evidence was given that carburet of manganese would be formed by the combination of these substances before the steel was melted. They produced the same effect upon the steel as the carburet of manganese at a cheaper rate. This method of producing the effect was not known at the time of taking out the patent. It was held that this was a new invention and not an infringement of the patent.

Colourable
evasions.

A servile imitation or a colourable evasion of a chemical process or product will, however, be treated as an infringement.

Thus, in *Stevens v. Keating* (*p*), an action for the infringement of a patent for the manufacture of cements, the specification

(*l*) Cp. *Automatic Weighing Co. v. International Hygienic Society*, 1889, 6 P. O. R. 476.

(*m*) 1889, 6 P. O. R. 113. Cp. *United Horse Nail Co. v. Swedish Horse Nail Co.*, *ibid.* 7; *Boyd v. Horrocks*, *ibid.* 152.

(*n*) *Badische Anilin Fabrik v. Levinstein*, 1883, per Fenton, J., 24 Ch. D. at p. 170; 1885, 2 P. O. R. 80, 92, 93.

(*o*) 1850, 5 H. L. C. 545; *Morewood v. Tupper*, 1855, 3 O. L. R. 717.

(*p*) 1847, 2 Web. P. C. 181. His

lordship, however, said: If it had turned out that the defendants had, by the use of borax, produced a substance very superior indeed, I think it would have been a fair question for the jury to consider, whether that was a colourable imitation or evasion, or whether it was a person travelling in his own direction, and making discoveries in the field that was not closed against him. Cp. *Talbot v. La Roche*, 1854, 15 C. B. 310.

stated the invention to consist in producing certain hard cements of the combination of the powder of gypsum, powder of limestone and chalk, with other materials, such combinations being (subsequent to the mixing) submitted to heat. The specification then described the method of making cement from gypsum, in the course of which alkali was to be used, and was to be neutralised with an acid, the result was to be subjected to heat. The patentee claimed "the processes of mixing the powdered materials, alkalies, and acids, as hereinabove described," &c. The defendant manufactured cement by combining gypsum with borax, and subjecting the whole to heat. It was in evidence that borax is composed of an acid and an alkali. It was held by Pollock, C. B., that there was sufficient evidence of infringement.

Colourable
evasions.

Again, in *Hancock v. Moulton* (q), on an application to the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanized or cured caoutchouc, alleged to be an infringement of the plaintiffs' patent, it appeared that this patent was for obtaining a certain useful product by subjecting a mixture of sulphur and caoutchouc to heat. The mixture was first made mechanically, and then by the operation of heat the character of the caoutchouc was changed, so that it ceased to be liable to stiffen from cold; it was not decomposed by heat, and it was improved in elasticity. The patent extended to the incorporation of sulphur, and of sulphur only, with the caoutchouc, by means of heat. The defendant subsequently obtained a patent for the combination of hyposulphate of lead with caoutchouc. That combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiffs' invention. Turner, V.-C.: "Assuming the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confine their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. But it was alleged by the plaintiffs that the materials were not in truth different, or at least that the materials which produce the result are the same. It was said that the hyposulphate and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that

(q) 1852, Johns. Pat. Man. 260.

those parts being decomposed by *heat*, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent."

Again, in *Muntz v. Foster* (*r*), an action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottom of ships," Lord Lyndhurst, C., said: "The analysis proves that that compound (the metal manufactured by the defendants) consists, not of ordinary copper and zinc, but of those minerals in their greatest purity, and in the proportions recommended in the plaintiff's specification. If they were originally combined in this state the evasion is plain and direct. If they were purified in the course of this process, this, I think, would constitute a colourable evasion of the plaintiff's invention."

A person who takes out a patent for an invention which consists in the use of certain proportions is not bound to limit his claim to those precise proportions, and a colourable variation in those proportions will be an infringement of his patent (*s*).

The use of chemical equivalents known to be such at the date of the patent, is an infringement even though it lead to improvements in the process (*t*).

(*r*) 1844, 2 Web. P. C. 95.

(*s*) *Patent Type Founding Co. v. Richards*, 1859, 1 Johns. 381.

(*t*) *Badische Anilin v. Levinstein*, 1885, 2 P. O. R. 92, 93.

CHAPTER XIV.

ACTION OF INFRINGEMENT.

SECT. 1. ORIGIN AND DEVELOPMENT OF ACTION OF INFRINGEMENT.

SECT. 2. COMMENCEMENT OF ACTION.

- (1.) *General.*
- (2.) *Parties.*
 - (a) *Plaintiffs.*
 - (b) *Defendants.*
- (3.) *The Writ.*

SECT. 3. INTERLOCUTORY INJUNCTION.

SECT. 4. CONSOLIDATION OF ACTIONS.

SECT. 5. STATEMENT OF CLAIM.

SECT. 6. PARTICULARS OF BREACHES.

SECT. 7. DEFENCE.

- (1.) *General.*
- (2.) *Denial of Infringement.*
- (3.) *Denial of Plaintiff's Title.*

SECT. 8. PARTICULARS OF OBJECTIONS.

- (1.) *General.*
- (2.) *Under Act of 1835.*
- (3.) *Under Act of 1852.*
- (4.) *Under Act of 1883.*

SECT. 9. AMENDMENT OF PARTICULARS.

SECT. 10. INSPECTION AND DISCOVERY.

- (1.) *Inspection.*
- (2.) *Discovery.*

SECT. 11. MODE OF TRIAL.

- (1.) *Former Practice and Objections thereto. Issues.*
- (2.) *Existing Practice.*
- (3.) *Scientific Assessors.*

SECT. 12. PERPETUAL INJUNCTION.

SECT. 13. ACCOUNT AND DAMAGES.

- (1.) *Account.*
- (2.) *Damages.*

SECT. 14. DELIVERY UP OF INFRINGING ARTICLES.

SECT. 15. COSTS.

- (1.) *General.*
- (2.) *Certificate of Validity.*
 - (a) *Under Act of 1835.*
 - (b) *Under Act of 1852.*
 - (c) *Under Act of 1883.*
- (3.) *Certificate as to Particulars.*
 - (a) *Under Act of 1835.*
 - (b) *Under Act of 1852.*
 - (c) *Under Act of 1883.*
- (4.) *Apportionment of Costs of Issues.*
- (5.) *Costs on Higher Scale.*

SECT. 16. STAY OF EXECUTION.

SECT. 17. APPEALS.

SECT. 1.—ORIGIN AND DEVELOPMENT OF ACTION OF INFRINGEMENT.

Patent privileges worthless without legal remedies.

Vindication of patent privilege entirely dependent upon the law.

It is evident that a privilege, such as that granted by a patent for an invention, would be worthless if the law did not provide some remedy for the patentee against those who may invade it. The right to any species of corporeal property may to a great extent be vindicated by the physical means at the command of the owner; but with respect to an incorporeal chattel right, such as a patent privilege, which is a mere creature of the law, the proprietor must

depend almost entirely upon the law itself for vindication and support (a).

The infringement of patent rights was a wrong for which neither the common nor the early statute law of England provided any remedy (b).

It was, however, cognizable by the Court of Star Chamber, either as a contempt of the royal authority (c), or under its general jurisdiction for the repression of "cozenage," which is defined as "an offence whereby anything is done guilefully in or out of contracts which cannot fitly be termed by any special name," and was punished summarily and with severity. Thus, "apprentices or servants of the patentee attempting to reap the fruits of his ingenuity were to be treated as 'first rogues, and then whipped'" (d). Star Chamber.

The jurisdiction of the Star Chamber over the infringers of patent rights was objectionable, not only on account of its severity, but because it supported any grant which the Crown thought fit to make, and considered every infringement of letters patent as a contempt. Its jurisdiction objectionable.

The second section of the Statute of Monopolies provided that all questions affecting the force or validity of letters patent, should be heard, tried, and determined in the Courts of common law, according to the common laws of the realm, and not otherwise. An action at law was then declared and recognized to be the proper remedy for the infringement of patent rights. Monopolies to be tried at common law.

"In former times slight defects were held sufficient to avoid patents, and our Courts seemed always to look upon patent rights with the utmost jealousy. This feeling against patentees was doubtless produced by the widely spread and deeply rooted aversion to all monopolies, which was engendered by the monstrous oppression practised by means of patent grants previous to the passing of the Statute of Monopolies. That statute completely suppressed all unlawful grants, and most effectually guarded the rights of the public against illegal monopolies; but notwithstanding the securities which the statute provided for the public against illegal monopolies, it is singular enough that a period of two centuries should have elapsed before the public prejudices against grants of patent privileges to inventors disappeared, and before the judges began to Public feeling against monopolies formerly extended to patents.

Statute of Monopolies suppressed illegal grants.

Two centuries required to extinguish public feeling against patent privileges.

(a) Hindmarch, p. 248.

(b) Coryton, 262.

(c) Webster, Letts. Pat. p. 42, n. (y).

(d) Coryton, *ubi supra*, and authorities there cited.

determine questions respecting patent rights fairly between the patentees and the public (*g*).

Patents formerly failed chiefly by reason of insufficient specifications. Specifications formerly very imperfect.

“If the reported patent cases which have been decided in our Courts of law are examined, it will be found that in a great majority of those which were formerly determined against patentees, the parties failed to support their patents on the ground of the insufficiency of their specifications. And, indeed, if we look at the vague and meagre descriptions of their inventions which patentees were formerly in the practice of inserting in their specifications, we cannot be surprised that our Courts should have held that those instruments did not sufficiently comply with the conditions or provisos contained in patents by which they are required to be enrolled (*h*).

Specifications now much more perfect.

“But the decisions of our Courts avoiding patents on the ground of insufficient specifications, have been productive of great benefit to the public, and, indeed, to patentees themselves. For specifications are now drawn in a manner much more perfect than they were formerly, (although there is still room for very considerable improvement,) and consequently not only are the public now more frequently put in possession of the information they are entitled to receive, but patentees much less frequently fail to support their patents on the ground of the insufficiency of their specifications” (*h*).

Questions between patentees and public now fairly determined.

In the case of *Cartwright v. Eamer* (*i*), Lord Eldon said:—“The patent is to be considered as a bargain with the public, and the specification, therefore, is to be construed on the same principle of good faith as that which regulates all other contracts. If, therefore, the disclosure be such that the invention can be communicated to the public, the statute is satisfied.”

“Our Courts,” wrote Hindmarch (*g*), in 1846, “now universally adopt the principle laid down by Lord Eldon . . . and accordingly any question which may now arise respecting the validity of a patent for an invention, will be determined fairly and impartially between the parties in litigation, and without any strained or strict construction being put upon the law, or patent, in favour of or against either party.”

Damages at common law

In addition to an action at law, which was in form an action on the case for damages, the owner of an invaded patent was entitled

(*g*) Hindmarch, p. 249.
(*h*) *Ibid.* p. 250.

(*i*) 1800, cited 14 Ves. 131, 136.

to bring a suit in equity against the infringers of his privilege. A Court of law could only give the patentee damages for any actual injury he had sustained by the violation of his rights, and had neither power to prevent future infringements, nor any adequate machinery by which the full extent of the particular infringement complained of could be ascertained.

against
infringers.
Fuller remedy
in equity
Courts.

But the Court of Chancery, by means of its process of injunction, could protect the patentee against the future invasion of his privilege. It could command a person who had once violated a patent right to refrain from committing any repetition of the offence, on pain of rendering himself liable to be punished by attachment, and imprisonment for contempt at the discretion of the Court (*k*).

Injunction in
Chancery.

Again—and here the language of Hindmarch (*l*) may once more be quoted—“the infringement of a patent is generally committed in secret, or, at all events, under such circumstances as to preclude the possibility of procuring sufficient legal evidence of the extent of the infringement. There is in consequence very much difficulty in the way of procuring evidence of a violation of the patent by a suspected person, and it would be almost impossible in any case to show by legal evidence in a Court of law, the full extent of the injury which the patentee has sustained by the infringement of his patent. But a Court of Equity has the power, not possessed by a Court of law, of compelling a defendant to answer on oath the complaint made against him by the plaintiff’s bill, and to make a full discovery of everything which is necessary to enable the Court to do justice between the parties.”

Discovery in
equity.

The history of this equitable jurisdiction is curious and instructive. The privilege conferred by a patent was a legal right, of which the force and validity might, under the second section of the Statute of Monopolies, be determined in the Courts of Common Law alone. Equity followed the law, and, according to the strict theory of this maxim, could claim no independent jurisdiction in respect of the privilege, or the infringement of the privilege created by letters patent (*m*). But the Court of Chancery could, and did, interfere on principles similar to those which determined its action in cases of nuisance, breach of contract, waste, the invasion of copyright, or the property in trade secrets or trade marks, to protect

How Court of
Chancery
obtained
jurisdiction.

(*k*) Hindmarch, p. 306.
(*l*) *Ibid.*

(*m*) *Calcraft v. West*, 1845, 2 Jones & Lat. 128.

the property of the patentee until his legal right could be ascertained by the jurisdiction to which it properly belonged (*n*).

Previous trial at law was at first necessary.

The Court of Chancery at first exercised its jurisdiction in aid only of a patentee whose legal right was clear and undoubted, and refused to enforce a claim under letters patent, or a charter from the Crown, until it had been tested by an action at law (*o*). This principle of action itself became in turn a maxim of equity, "and in process of time a fictitious inability was the cause on which it founded its refusal to decide questions involving the validity of the grant, the claim of the plaintiff to the property it conferred, and the fact of infringement" (*p*).

Development of jurisdiction.

Gradually, however, the Court of Chancery abandoned this position, and assumed the attitude which it maintained till the fusion of law and equity by the Judicature Acts deprived the question of its practical importance. In *Hicks v. Raincock* (*q*), a demurrer to a bill for an injunction to stay the infringement of a patent right on the ground that the plaintiff had not established his title at law, was overruled: and in *Newman v. Milner* (*r*), it was said by the Lord Chancellor never to be the right of a defendant to have a case transmitted for trial at law, but that where the title of the party was clear a Court of Equity would act without a reference; and in *Wilson v. Tindal* (*s*), Lord Langdale, M. R., said that he had no doubt whatever as to the competency of the Court of Chancery to grant an injunction simpliciter.

But the early reluctance of the Court of Chancery to interfere in cases of disputed patent right had its justification in reason as well as in the maxim of equity.

"Before a patent privilege," says Hindmarch (*t*), "has been established by a verdict, the title of the patentee depends entirely upon his patent, which he has obtained by means of his own *ex parte* and unsupported representations to the Crown, and that circumstance

(*n*) *Harman v. Jones*, 1841, per Cottenham, L. C., 1 Cr. & Ph. 299; *Sparrow v. Oxford, Worcester and Wolverhampton Rail. Co.*, 1851, 9 Hare, 441.

(*o*) *Blanchard v. Hill*, 1742, 2 Atk. 484. "If one who has letters patent for an invention files a bill for an injunction to restrain another from pirating his invention, he must state in his bill that he has brought his action at law and so established his right by a good verdict, or a demurrer to his bill for want of

equity shall be sustained": Old MSS., cited 2 Coop. C. C. 61, n.

(*p*) *Coryton*, p. 320. See Fonb. Eq. 43.

(*q*) 1715, 2 Dick. 647; *op. Soltau v. De Held*, 1851, 2 Sim. N. S. 133, and cases there cited.

(*r*) 1794, 2 Ves. jun. 486.

(*s*) 1841, 1 Web. P. C. 730, n. (*a*); *op. Universities of Oxford and Cambridge v. Richardson*, 1802, 6 Ves. 689.

(*t*) Page 307.

alone would induce a Court of Equity to give a defendant a proper opportunity of testing the validity of the patent in a Court of law."

We find accordingly that, while asserting its right to act independently of references to law, the Court of Chancery still continued to display its original caution in granting injunctions.

The considerations which guided its decisions cannot be better stated than in the language of Lord Eldon: "Where the Crown on behalf of the public grants letters patent, the grantee entering into a contract with the Crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under colour of the patent, the Court has held that, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard that the grant of the Crown may in the result prove to have been valid" (u). "But where the patent is but of yesterday, and upon an application being made for an injunction *it is endeavoured to be shown* in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not from its own notions respecting the matter in dispute act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law and oblige him to establish the validity of his patent in a Court of Law, before it will grant him the benefit of an injunction" (x).

Principles upon which Court of Chancery granted injunctions.

Long possession of patent right.

Validity of recent patent must first be established at law.

The Patent Law Amendment Act, 1852, made the first advance towards the fusion of law and equity. Act of 1852.

Sect. 42 of that statute provided, that "in any action in any of her Majesty's Superior Courts of Record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not sitting then for a judge of such Court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such injunction, inspection, and account, and the proceedings therein respectively, as to such Court or judge may seem fit."

Injunction, inspection and account at common law under Act of 1852.

Although it was held in the judicial construction of this *But limited*

(u) *Harmer v. Playne*, 1807, 14 Ves. 130; cp. *Bridson v. McAlpine*, per Lord Langdale, M. R., 1846, 8 Beav. 229.

(x) *Hill v. Thompson*, 1817, 3 Mer. 622.

view of these powers taken.

statute (*y*), that "the intention of the legislature was to vest in the Courts of common law the power to order an injunction, inspection and account (theretofore) exclusively possessed by Courts of equity," a plaintiff does not seem to have been enabled to obtain such full relief from the Courts of law as he might have in equity (*z*). Thus it was decided in *Gittins v. Symes* (*a*), that the injunction which a Court of law might grant under 15 & 16 Vict. c. 83, s. 42, was, like the injunction under the 82nd section of the Common Law Procedure Act, 1854, a rule to show cause only, in the first instance: and in *Vidi v. Smith* (*b*), that "inspection" meant an inspection of the instrument or machinery manufactured or used by the parties with a view to evidence of infringement, and did not refer to an inspection of books.

The fusion of Law and Equity under Judicature Act, 1873.

Under the Judicature Act, 1873, the jurisdiction formerly exercised by the Courts of common law and equity is transferred to the High Court of Justice (sect. 16); and it is provided generally that in all matters "in which there is any conflict or variance between the rules of equity and the rules of the common law with reference to the same matter, the rules of equity shall prevail" (sect. 25, sub-sect. 11).

Act of 1883, s. 30.

The Patents Act, 1883, s. 30, provides that "in an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit."

Without entering for the present into a minute examination of this section, it may be stated generally that each division of the High Court has now the fullest powers of making orders for injunction, inspection, or account whenever it shall think proper so to do; and this jurisdiction may be exercised by any judge of the High Court (*c*), either on application in Court or on summons at Chambers (*d*).

(*y*) *Patent Type Founding Co. v. Lloyd*, 1860, per Martin, B., 5 H. & N. 198; cp. *Holland v. Fox*, 1854, 23 L. J. Q. B. 357; 3 E. & B. 977.

(*z*) Lawson, p. 189.

(*a*) 1854, 24 L. J. C. P. 48; 15 C. B. 362.

(*b*) 1854, 23 L. J. Q. B. 342; 3 E. & B. 969; cp. *Patent Type Founding Co. v.*

Lloyd, and *Patent Type Founding Co. v. Walter*, *ubi supra*.

(*c*) *Beddow v. Beddow*, 1878, L. R. 9 Ch. D. 89; *Thomas v. Williams*, 1880, L. R. 14 Ch. D. 864; *Quartz Consolidated, &c. Co. v. Beall*, 1878, L. R. 20 Ch. D. 301.

(*d*) *Frearsen v. Loe*, 1878, 26 W. R. 138.

SECT. 2.—COMMENCEMENT OF ACTION.

(1.) *General.*

Under the Patents Act, 1883 (*e*), a patentee cannot take proceedings in respect of infringements committed before the publication of his complete specification, and until letters patent have actually been granted to him; and “if any proceeding shall be taken in respect of an infringement of the patent, committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement” (*f*).

Provisions of Act of 1883, sects. 13, 15.

Besides the question as to whether any of these statutory limitations apply to his case, a patentee has frequently to consider how he ought to act when his patent is being infringed by several persons at the same time. Under these circumstances, the patentee has several difficulties to face and to choose between. He may take proceedings against one infringer successfully, but the others are not bound by the issue of such an action, and the consequence is that the patentee may have to establish his case from the beginning against any fresh person who chooses to impugn the patent and to contest its validity upon the same or different grounds (*g*), besides laying himself open to a charge of laches (*h*). Upon the other hand, even if he proceed by separate action, against the several infringers at the same time, he may still have to defend the validity of his patent in a number of distinct proceedings, in each of which it is impeached upon different grounds; and he will also render himself liable to a charge of vexatious and oppressive litigation.

Several infringers.

In the case of *Bovill v. Crate* (*i*), Wood, V.-C., suggested a way out of these difficulties:—

“After getting information of case after case of infringement (the patentee) might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write, at the same time, to all the others who were *in simili casu*, and say to them: ‘Are you willing to take this as a notice to you that the present case is to

Best manner to proceed where several infringers.

(*e*) Sects. 13 and 15.

(*f*) Sect. 17, sub-sect. 4 (b).

(*g*) *Bovill v. Goodier*, 1865-67, per Romilly, M. R., L. R. 2 Eq. p. 199.

(*h*) *Bridson v. Benecke*, 1849, 12 Beav. 1; *Bovill v. Crate*, 1865, L. R. 1 Eq. 398.

(*i*) 1865, L. R. 1 Eq. at p. 391.

determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once.'”

No notice of action necessary.

A plaintiff is entitled to apply for an injunction, and to have his costs as soon as his legal right is invaded, although unintentionally; and he is under no obligation to give the defendant any notice before commencing an action (*k*), or to discontinue proceedings upon the defendant admitting and promising not to repeat the infringement (*l*).

In the case of *Nunn v. D'Albuquerque* (*m*), the defendant had, in ignorance, infringed the plaintiff's patent, but submitted and offered before suit to pay the amount of profits made, which were very trifling. At the hearing, although a perpetual injunction was granted, no costs were given, and an account was granted only upon the plaintiff's request, and at his peril.

(2.) Parties.

(a) Plaintiffs.

Legal and equitable titles.

There was formerly a difference between the rules of law and equity with respect to the parties to proceedings for the infringement of patent rights. In an action at law no one could be plaintiff unless he was either a patentee, or could show a legal title of assignment to the whole or a part of the patent privilege; while, in the Court of Chancery, a person might be made a plaintiff, or co-plaintiff, when he had any equitable interest in the patent privilege, although such interest did not amount to a legal title (*n*).

Equity rules now prevail.

The rules of equity, however, now prevail, and all parties claiming any interest, legal or equitable, in the patent, if they do not join as co-plaintiffs, may, and ought to, be made defendants to the action, so that the infringing defendants may not be called upon to account twice, first to the plaintiff, and then to the persons who claim an interest in the patent (*o*).

(*k*) *Cooper v. Whittingham*, 1880, L. R. 15 Ch. D. 501; *Upmann v. Forester*, 1883, 24 Ch. D. 231; *Goodhart v. Hyett*, 1883, 25 Ch. D. 182; *United Telephone Co. v. London, &c. Telephone Co.*, 32 W. R. 870; *Nicols v. Pitman*, 1884, 26 Ch. D. 374; *Wittman v. Oppenheim*, 1884, 27 Ch. D. 260; 28 S. J. 499; *Upmann v. Elkan*, 1871, L. R. 12 Eq. 148; *Burgess v. Hills*, 1859, 26 Beav. 244, 247; *Burgess v. Hately*, 1859, 26 Beav. 249; *Edelsten v.*

Edelsten, 1863, 1 D. J. S. 203; *Davenport v. Rylands*, 1865, L. R. 1 Eq. 305.

(*l*) *Losh v. Hague*, 1837, 1 Web. P. C. 200; *Geary v. Norton*, 1846, 1 De G. & S. 9; *Proctor v. Bayley*, 1889, 6 P. O. R. 106.

(*m*) 1865, 34 Beav. 395.

(*n*) *Hindmarch*, 308.

(*o*) *Westhead v. Keene*, 1838, 8 L. J. Ch. 89; 2 Web. P. C. 36, n.; 1 Beav. 287; *Bergmann v. MacMillan*, 1881, 17

An action for infringement may be brought by the assignees of the patent infringed (*p*).

The assignees of a bankrupt patentee may bring it (*q*).

It is competent to the assignee of a separate and distinct portion of a patent to sue for an infringement of that part without joining one who has an interest in another part—the damages to be recovered in the action accruing to the former alone. In delivering judgment in the case in which this principle was laid down (*r*), Erle, C. J., said: “It is every day practice, for the sake of economy, to include in one patent several things which are in their nature perfectly severable and distinct. It is also every day practice to get rid of, by disclaimer, part of a patent which turns out to be old. Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part, which is the subject of infringement, may not maintain an action. Then, are the assignees bringing an action for an injury done solely to them by an infringement of that part of the patent which is thus vested in them alone, liable to be defeated because they have not joined the assignees of other parts of the patent, who have no manner of interest in the damages sought to be recovered in such action? I see no reason why the action should be defeated on any such ground. I see no reason why the plaintiffs should be put to the trouble and expense of applying for leave to use the names of the other parties, or of compelling them, by means of a judge’s order, to permit their names to be used upon an indemnity, where no practical advantage whatever is to be gained by it, the injury being to the assignees of part only, and the damages to be recovered being theirs only.”

Assignee of bankrupt.

Assignee of part of a patent.

Where one of two persons, who are tenants in common of a patent assigned to them, dies, actions for infringements committed during his lifetime survive to the other, who is entitled at law to recover the whole damages (*s*).

Survival of action to survivor of tenants in common.

The assignee of a patent may maintain an action for an infringe-

Assignee may

Ch. D. 423, per Fry, J.: “I do not for one moment say that a person who has obtained an assignment of a share of profits is not entitled to an account of profits from the person by whom they are payable. But in my judgment, in order to avoid multiplicity of actions, the account must be taken once for all in the presence of all the parties interested.” See also *Van Gelder v. Sowerby*

Bridge Flower Society, 1890, 7 P. O. R. 41.

(*p*) *Electric Telegraph Co. v. Brett*, 1851, 20 L. J. C. P. 123; 10 C. B. 838.

(*q*) *Blexam v. Elseo*, 1827, 6 B. & C. 169.

(*r*) *Dunnicliff v. Mallett*, 1839, 7 C. B. N. S. 209, 227.

(*s*) *Smith v. L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69.

sue original
grantee.

ment, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee; and the action is maintainable although there has been no infringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee (u).

In *Walton v. Lavater* (u), from which the last proposition is taken, the facts were these: The defendant assigned one moiety of his patent to the plaintiff, and the remaining moiety to other parties, D. and G., who subsequently assigned their share to the plaintiff. It was contended that the assignee of two separate moieties of a patent was not entitled to sue for an infringement in the same manner as he would have been if he had taken the whole interest in the patent under one assignment; but the Court of Common Pleas overruled this contention. "We are of opinion," said Erle, C. J., "that the assignment to the plaintiff of that partial interest . . . made the plaintiff in effect tenant in common with the defendant of the interest of the patent, and that the defendant, having afterwards assigned the remaining moiety to D. and G., when D. and G. assigned to the plaintiff . . . the plaintiff became assignee of the whole patent, as if the original assignment to him from the defendant had comprised the whole."

It must be noted that the decision in *Walton v. Lavater* applies only to the case of letters patent which are separable into parts, and the balance of authority is against the right of an assignee of a share in the profits of a patent for an invention which is one and indivisible to sue alone for the infringement of the privilege (x).

Mortgages by
way of as-
signment.

In the case of *Van Gelder v. Sowerby Bridge Flower Society* (y), the owners by assignment of a patent mortgaged it to various persons by way of assignment, and subsequently brought an action against S. for infringement without joining as parties their mortgagees, whose mortgages were all entered on the Register of Patents. At the trial S. took the preliminary objection (duly raised by his defence) that the plaintiffs were not the proprietors of the patent, and were not entitled to sue alone. Kekewich, J., held that the objection was good, and on the plaintiffs asking for leave to amend, ordered that they should pay the costs thrown away in any event, and should have leave to make an

(u) *Walton v. Lavater*, 1860, 8 C. B. N. S. 162. See *Anderson v. Patent Oxonite Co.*, 1886, 3 P. O. R. 279. As to the position of the general agent of foreign owners of an English patent, see *Adams v. N. B. Rail. Co.*, 1873, 29 L. T. N. S. 367.

(x) *Smith v. L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69; *Bergmann v. McMillan*, 1881, 17 Ch. D. 423; *contra*, *Sheehan v. G. E. Rail. Co.*, 1880, per Malins, V.-C., 16 Ch. D. at p. 62.

(y) 1890, 7 P. O. R. 41.

application by a given date to amend, by addition of parties, subject to such terms as the Court should think fit to impose (z).

There is still considerable difficulty in determining the question, how far the mere licensee of a patent privilege is entitled to sue for infringement. In the case of *George v. Beaumont* (a), Lord Eldon said: "If the patents should be determined good, damages might be recovered not only by the patentees, but by the persons who have obtained licences from them." This dictum is cited by Mr. Webster (b) as an authority for the proposition that "a licensee would be able to recover for any *special* damages which he may have sustained," and if this be the correct interpretation, it is not inconsistent with the law laid down in *Derosne v. Fairie* (c) and *Newby v. Harrison* (d), that a mere licensee can maintain no action alone for an infringement of the patent of which he has a licence. The principle of these decisions is this: The only right which a mere licensee can acquire under letters patent is a right of user. The patentee may grant licences to other persons, and consequently an infringement is an injury to himself and not to the licensee.

How far licensee entitled to sue for infringement.

In *Renard v. Levinstein*, there is some authority for the statement that an exclusive licensee can sue for infringement of the patent, of which he has an exclusive licence, alone; but in that case the owner of the patent was made a defendant in the action (e). In *Plimpton v. Malcolmson* (f), Jessel, M. R., held that the patentee had better be added as co-plaintiff; and this course has been adopted in subsequent cases (g). In *Heap v. Hartley* (h), the patentee of a machine granted an exclusive licence to the plaintiff to use and exercise his invention within a certain district for four years. Before the expiration of the four years certain machines bought by the defendants outside this district, from persons who had purchased them from the patentee, also outside the district, subsequently to the date of the licence, were taken by them into the district, and used there. The licensee brought an action to restrain such user. It was held, at the trial, that the defendants, as purchasers without notice, were not affected by the prior grant

Exclusive licensee.

(z) The consent of the mortgagees to be joined as plaintiffs having been withheld, the action was dismissed, with costs on the higher scale: *ubi supra*, at p. 46.

(a) 1315, 27 Rep. Art. 2nd Ser. 252.

(b) Letts. Pat. p. 24, and n. (o).

(c) 1855, 1 Web. P. C. 155.

(d) Before Lord Campbell, cited 2 H. & M. 628.

(e) *Renard v. Levinstein*, 1864-65, 2 H. & M. 628, 631.

(f) 1875, 3 Ch. D. 531.

(g) *Plimpton v. Spiller*, 1876-77, Goodove, P. C. 380; *Barnett v. Screw Stopper Bottling Co.*, 1884, 1 P. O. R. 9.

(h) *Heap v. Hartley*, 1888, 5 P. O. R. 603; 1889, 6 P. O. R. 495; 42 Ch. D. 461.

of the licence, and that the action must be dismissed with costs. Whether an action by an exclusive licensee in his own name, and without joinder of the patentee, to restrain an infringement of his rights under the licence, can be maintained, was held doubtful. The plaintiff appealed. The Court of Appeal held that the licence in this case being a simple licence and not a grant, the licensee was not entitled to sue in his own name without joinder of the patentee. "An exclusive licence," said Fry, L. J. (i), "is only a licence in one sense. . . . It is a leave to do a thing, and a contract not to allow anybody else to do a thing. But it confers, no more than any other licence, any interest or property in the thing. A licence may be, and often is, coupled with a grant, and that grant then may convey an interest in property, but the licence pure and simple, and by itself, never conveys an interest in property. It only enables a person to do lawfully what he could not otherwise do, except unlawfully. I think, therefore, that an exclusive licensee has no title whatever to sue."

Upon the other hand, there appears to be no doubt that a patentee who has granted an exclusive licence merely of his patent, and not an absolute assignment can bring an action of infringement in his own name without joining his licensee as co-plaintiff.

Trustee.

A person in whom letters patents are vested as trustee may bring an action for infringement without joining any of the beneficiaries; but the Court or a judge may at any stage of the proceedings order any of such persons to be made parties, either in addition to or in lieu of the previously existing parties (k).

(b) Defendants.

The defendants.

The actual infringer of a patent is, of course, a necessary defendant to an action for infringement.

In *Denley v. Blore* (l), it was held that the person physically using a patented invention, and not the person giving instructions and plans, which include its use, is the proper party to be sued for infringement; the contractor, for instance, and not the architect, in the case of a contrivance employed in house-building.

This decision, however, in no way affects the common law liability of a master for the acts of his servants.

(i) *Ubi supra*, at p. 501; 42 Ch. D. at p. 470.

(k) R. S. C. 1883, Ord. XVI. r. 8. (l) 1851, 38 Lond. Jour. 224.

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding that such infringement may be in contravention of their general orders (m). Master liable for infringements of his servants.

In an action to restrain the infringement of a patent for "improvements in fancy rollers of machines for carding wool," it appeared that a contract to clothe the rollers of a carding machine, in the execution of which the infringement complained of was committed, was carried out by a workman, selected by a manufacturer, but paid by the defendants. It was held, that the workman, although carrying on a distinct and separate trade, was *ad hoc* the agent of the defendant, and that the latter was properly sued for the infringement (n).

Although the ordinary form of injunction against a master or principal restrains his servants or agents also, every one of such servants or agents infringing a patent may be made a defendant to the action, and personally and individually may be made to pay the costs of it, and it is no justification for him to say that his master ordered him to do it (o).

A fortiori, the master of a ship, who is not a mere agent, but has a possession and control of a particular nature, may be sued as principal if he uses a patented invention on board the ship to the prejudice of the patentee (p).

In the case of *Nobel's Explosives Co. v. Jones* (q), the plaintiff charged that the defendants had imported and delivered, or had consigned to them, or had received or dealt with as owners, or as agents for the owners, large quantities of lithofracteur, and had transhipped the same, or caused the same to be transhipped and stored in the port of London. Defendants pleaded that their only intervention in relation to lithofracteur since the assignment of the patent to the plaintiffs had been in acting as custom-house agents to Messrs. Krebs & Co., the real owners of such lithofracteur. The defendants had merely obtained papers necessary for its transhipment, and never exercised over it any ownership or control. It was held by the Court of Appeal and the House of Lords—reversing the decision of Vice-Chancellor Bacon—that the agency of the defendants did not infringe the patent. "This Custom House agents.

(m) *Betts v. De Vitre*, 1868, L. R. 3 Ch. 441. Where a company is formed for working a patented machine, it is *ultra vires* to purchase the patent. *Re British and Foreign Cork Co.*, 1865, L. R. 1 Eq. 231.

(n) *Sykes v. Howarth*, 1878, 12 Ch. D. 826.

(o) *Betts v. De Vitre*, 1868, per Wood, V.-C., 11 Jur. 11; *Betts v. Neilson*, 1868-71, 6 N. R. 221; *Barker v. Shaw*, 1823, Holr. Pat. 60.

(p) *Adair v. Young*, 1879, per Cotton, L. J., 12 Ch. D. at p. 18.

(q) 1880-82, L. R. 17 Ch. D. 721; 8 App. Cas. 5.

agency," said Lord Selborne, L. C. (r), "was simply to remove certain legal difficulties in the way of the passage of the goods for the ship in which they were—for the account and at the risk of the true importers, Krebs & Co.—into a lighter of theirs supplied by them, and nothing whatever was done by the defendants except to comply with certain provisions of the law for that purpose." "Jones & Co.," added Lord Blackburn (s), . . . "never used the article itself; they did nothing whatever except take steps to remove two obstacles which were imposed by the Legislature, not for the benefit of the patentee, but in one case against a breach or infringement of the revenue laws, and in the other case that the article would explode and do mischief. How, in any sense, taking those steps to remove these two obstacles can be said to be a user of the patent has never been made clear to my mind. I am quite clear that it is not."

Purchasers of
infringing
articles.

An account directed against the manufacturer of a patented article does not license the use of that article in the hands of all the purchasers. The patent is a continuing patent, and the article may be followed into every man's hand, until the infringement is got rid of. So long as the article is used there is continuing damage (t). A manufacturer, and purchasers from him, may be made defendants in one action (u), and the patentee may have an account of profits against the manufacturer, and damages against the purchaser (x).

Third parties.

In the case of *Edison and Sican Co. v. Holland* (y) an interesting point was raised as to the construction of the third party rule (z).

The E. Company brought an action against H. and the J Company for infringing their patent by using certain incandescent lamps. The lamps were manufactured by the B. Company. After the commencement of the action, the defendants obtained an indemnity from the B. Company, and then took out a summons asking for leave to issue a notice to the B. Company to bring them into the action under the third party rule. It was contended that the third party rule did not enable the defendant in an action to go and make a contract of indemnity with reference to that particular action, and then bring the indemnifying parties in,

(r) S. C., 8 App. Cas. at p. 8.

(s) S. C., 8 App. Cas. at p. 13.

(t) *Penn v. Bibby*, 1885, L. R. 3 Eq. 208, per Wood, V.-C.

(u) *Proctor v. Bennis*, 1887, 36 Ch. D.

740.

(x) *Penn v. Bibby*, *ubi supra*.

(y) 1886, 3 P. O. R. 326-7; *United Telephone Co. v. Fleming*, 1895, 3 P. O. R. 268.

(z) R. S. O. 1883, Ord. XVI. r. 46.

but that the rule only contemplated an indemnity existing at the time of the commencement of the action. Vice-Chancellor Bacon, however, repelled this objection. "The policy of the law expressed in the rule," said his lordship, "is plainly this: that if A. is suing B., and B. denies his right to sue, B. says 'Even if he is entitled to sue, C. has indemnified me. Let him come here and fight his own battle, or help me to fight mine!' The object of the procedure is that there may be a discussion and a decision once for all of the real substance of the dispute. It is clearly right to issue the summons; there is no doubt about it. To go into the nature of the indemnity would be a most idle and absurd thing for me to do. The rule is enough; the rule is plain. . . . To say that it cannot be resorted to because the indemnity is in truth subsequent to the date of the issuing of the writ, can be no sort of objection to it. Whatever change takes place in the rights of the parties may be set right either by amendment or by adding parties. That is the constant and uninterrupted course of the Court."

In the case under consideration, Kay, J., ultimately made the following order, directing the costs of the proceedings to be costs in the action:—

"The B. Company, by their counsel, admitting their liability to indemnify the defendants against all claims of the plaintiffs in this action, the Court doth direct that the B. Company be at liberty to appear at the trial of this action, and take such part therein as the judge shall direct. And the B. Company shall be bound by the decision of the Court in this action in any question as to the above indemnity which may arise between them and the defendants, but not further or otherwise."

At the trial, the Court gave judgment partly in favour of plaintiffs and partly in favour of the defendants, but made no special order as to B., the third parties. The plaintiffs appealed, and their appeal was allowed with costs against the defendants. The plaintiffs then asked for an injunction and costs against the third parties, the B. Company (who had appeared on the appeal), and, if necessary, for an order to amend, so as to make them defendants. The Court disagreed as to the question of amendment, but held that under Ord. XVI. r. 54, the Court had jurisdiction to order the third parties to pay the costs both of the appeal and below, and that, as the third parties had in reality fought the plaintiffs and

failed, an order for the payment of such costs must be made against them as well as against the defendants (*a*).

Infringement
by foreigners.

Foreign
sovereigns.

Foreigners coming into this country are subject to actions for injuries done by their infringing on the sole and exclusive right granted by the Crown to patentees of inventions (*b*); but no Court in this country can deprive a foreign sovereign of his property because it has become tainted by the infringement of somebody's patent (*c*).

Caldwell
v. Van
Vlissingen.

P. and others, who were subjects of the King of Holland, were using on board their ships, within the dominions of England, a screw propeller made according to an English patent assigned to C. It was held by Turner, V.-C., that the infringement might be restrained by injunction, and that the defendants were liable to an action for damages. "I take the law to be universal," said his lordship, "that foreigners are in all cases subject to the laws of the country in which they may happen to be. . . . It was said that the prohibitory words of the patent were addressed only to the subjects of the Crown; but these prohibitory words are in aid of the grant, and not in derogation from it, and they were probably introduced at a time when the prohibition of the Crown could be enforced personally against parties who ventured to disobey it. The language of this part of the patent does not, therefore, appear to me to alter the case" (*b*).

But for the existing provisions as to *foreign vessels*, see pp. 220 and 496.

Varasseur v.
Krupp.

In *Varasseur v. Krupp*, it appeared that certain shells, alleged to have been made in accordance with the plaintiff's patented invention, had been purchased at *Essen*, in Germany, and had been brought to England, in order to complete the armament of three ships of war, which were being constructed for the Government of Japan. An injunction, restraining the defendants and the owners of the wharf where the shells were deposited from delivering them up to the Japanese Government, was dissolved, upon a motion on the part of the Mikado; and an order was made by Jessel, M. R., whose decision was affirmed by the Court of Appeal, that his Imperial Majesty should be allowed to remove the

(*a*) *Edison and Swan Co. v. Holland*, 1889, L. R. 41 Ch. D. 28; 6 P. O. R. 286. Rule 54 of Ord. XVI. is as follows:—The Court or a Judge may decide all questions of costs as between a third party and the other parties to the action, and may order any one or

more to pay the costs of any other or others, or give any direction as to costs as the justice of the case may require.

(*b*) *Caldwell v. Van Vlissingen*, 1851, 21 L. J. (N. S.) Ch. 97; 9 Hare, 415.

(*c*) *Varasseur v. Krupp*, 1878, L. R. 9 Ch. D. 352.

shells, which were his property, out of the jurisdiction of the Court. "It is argued," said Brett, L. J., "that if the Mikado were a private individual, then, although he has purchased these shells and paid for them, yet, inasmuch as there has been an infringement of the patent, the property is not in him, because the Court may order the shells to be destroyed. Is that argument good or not? To my mind it is utterly fallacious. The patent ran has nothing to do with the property. I am clearly of opinion that the patent law did not prevent the property from passing. The Mikado has a perfect right to have these goods. No Court in this country can prevent him from having goods which are the public property of his own country."

No jurisdiction to restrain dealing with goods of a foreign sovereign.

(3.) *The Writ.*

Service of a writ of summons at an agency in London where goods are received and sent out, but which is not really the defendant's place of business, is not sufficient (d).

Service of writ.

An action was instituted against G. & Co. for infringement of a patent; the writ was served on the clerk of M. at his office in London. G. & Co. had no place of business in England, but M. was their agent in London; their name was put up outside, and their letter paper bore the address of M.'s office. G. & Co. moved to set aside the service of the writ, but the notice of motion did not state the objections intended to be insisted upon. It was held that G. & Co. did not carry on business at this office, that even if they did M.'s clerk was probably not the person having the control or management of their business there; and that the service must be set aside, though without costs, because the notice of motion was defective, and because the defendants' conduct contributed to the plaintiff's mistake (e).

Forms of indorsement of the writ in actions of infringement will be found in the Appendix (f).

Indorsement of writ.

It is usual to indorse the writ for an injunction to restrain the infringement, for damages or an account of profits, and for delivery up or destruction of infringing articles.

In *Washburn and Moen Co. v. Cunard Co.* (g), the owners of a patent commenced an action to restrain infringement of their patent against a steamship company, who had brought certain

Service out of the jurisdiction.

(d) *Baillie v. Goodwin*, 1886, 3 P. O. R. 285.

(f) P. 781.

(e) *Ibid.* p. 283.

(g) 1889, 6 P. O. R. 398.

goods, alleged to be an infringement, from America to Liverpool. Under the bill of lading the goods were to be delivered at Liverpool to the agent of the consignees, who themselves resided at Dublin. The validity of the patent had been established in a previous action. The plaintiffs having moved for and obtained an injunction against the company and another company to whom part of the goods had already been delivered for transshipment to Dublin, then obtained leave to add the consignees as parties to the action, and to serve the writ on them out of the jurisdiction. The plaintiffs moved for an injunction against the consignees, and the consignees moved to discharge the order for service and to set aside the service. It was held that the action was properly brought against the steamship company, that the consignees would, if within the jurisdiction, have been proper parties to the action, and that, following *Massey v. Heynes* (e), they were rightly made parties though out of the jurisdiction; and that in exercise of the discretion given by R. S. C. Ord. XI. r. 2, in the case of a defendant living in Ireland, and of the general discretion possessed by the court, in reference to service out of the jurisdiction, this was a proper case for ordering such service without any special terms.

SECT. 3.—INTERLOCUTORY INJUNCTION.

What is interlocutory injunction.

An interlocutory injunction in a patent action is one granted before the hearing, by which the defendant is commanded to refrain from infringing the plaintiff's patent until the hearing or the further order of the Court (f).

Principles on which granted.

The principle on which the Court acts in granting or refusing interlocutory injunctions in cases of this description, was stated by Sir George Jessel, M. R., in *Dudgeon v. Thomson* (g):—

“The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it; or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result; or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent.”

The whole case law of the subject may be considered under the heads above set forth.

(e) 1888, L. R. 21 Q. B. D. 330.

(f) Cp. *Hindmarch*, p. 312. See forms,

Seton's Decrees, pp. 343, 344.

(g) 1877, 30 L. T. N. S. at p. 244.

I. "Where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it" (*h*). *First ground.*

The grounds on which an interlocutory injunction is granted in such cases may be shortly stated thus:—

Primâ facie evidence of a patentee's title is necessary before the Court can act upon the presumed validity of a patent without the right having been ascertained by a previous trial. Long and uninterrupted possession is *primâ facie* evidence of title which ought to be respected (*i*). *Primâ facie evidence of title necessary.*

An interdict by the Court of Session in Scotland offers *primâ facie* evidence of validity on which an English Court may grant an interlocutory injunction (*j*). *Effect of Scotch interdict.*

In a case where there has been long enjoyment under the patent (the enjoyment, of course, including use), the public have had the opportunity of contesting the patent, and the fact of their not having done so successfully, affords at least *primâ facie* evidence that the title of the patentee is good (*k*). Policy also is in favour of the Court's intervention in such cases. "If the case turned," said Turner, L. J., in *Davenport v. Jepson* (*k*), "on the question of comparative injury, see what the position of the plaintiff would be if an injunction were refused. Supposing his patent is valid, a number of persons are infringing it. If the Court refused an injunction in this case, it must refuse it in the case of each of the other infringers. Supposing the plaintiff to succeed at the hearing, the market will, in the meantime, have been flooded with articles wrongfully manufactured according to his patent." Upon the other hand, "it becomes the Court to be extremely cautious in administering its equitable jurisdiction by way of injunction; and such caution is requisite for two reasons, first, because if the legal right ultimately fail, or if the acts complained of turn out to be no violation of the legal right, the Court then has interfered without any authority whatever, the authority being merely derivative from the legal right, and in aid and protection of it; secondly, and

(*h*) Cp. also *Universities of Oxford and Cambridge v. Richardson*, 1802, 6 Ves. 706; *Harmer v. Playne*, 1807, 14 Ves. 130; *Hill v. Thompson*, 1817, 3 Mer. 622; *Bickford v. Skewes*, 1838, 1 Web. P. C. 213; *Curtis v. Cutts*, 1839, 8 L. J. Ch. 184; 2 Coop. C. C. 60, n.; *Electric Telegraph Co. v. Nott*, 1847, 2 Coop. 41; *Stevens v. Keating*, 1847, 19 L. J. Ex. 57; 2 Web. P. C. 176, 177; *Hancock v. Moulton*, 1852, Higgins's Dig. 1175; *Betts v. Menzies*, 1857, 3 Jur. N. S. 358; *Davenport v. Jepson*, 1862, 1 N. R.

173; *Renard v. Levinstein*, 1864, 10 L. T. N. S. 94; *Plympton v. Malcolmson*, 1875, L. R. 20 Eq. 37.

(*i*) *Stevens v. Keating*, *ubi supra*, per Lord Cottenham, C.

(*j*) Cp. Hindmarch, p. 312. See forms, Seton's Decrees, pp. 343, 344.

(*k*) *Caldwell v. Vanvlissengen*, 1851, per Turner, V.-C., 9 Hare, at p. 424; op. *Electric Telegraph Co. v. Nott*, 1847, 2 Coop. 41; *Davenport v. Jepson*, 1862, per Turner, L. J., 4 De G. F. & J. 446.

principally, because . . . there is no comparison between the evil of an error in refusing an injunction, and the evil of an error in granting an injunction" (l).

Characteristic
of long en-
joyment.

Duration of
enjoyment.

Undertaking
to keep
account.

The enjoyment, referred to by Sir George Jessel in *Dudgeon v. Thomson* (m), must, before the Court can recognize it, be shown to have been long, uninterrupted, and active. The periods of enjoyment which have been held sufficient range from thirteen (n) to three (o) years.

In *The British Tanning Co. v. Groth* (p), the owners of a patent for an "improved process and apparatus for tanning by aid of electricity" commenced an action of infringement against the owner of a subsequent patent, with a similar title, and moved for an interim injunction. The plaintiffs alleged that the defendant's process was equivalent to theirs. It appeared that the patentees of the plaintiffs' process had entered into an agreement with the defendant not to oppose any company formed for the purpose of purchasing his invention. Stirling, J., held that as the patent was of recent date, and the evidence was not strong enough to show that the two processes were identical, and considering the agreement aforesaid, although the defendant would give no undertaking to keep an account, no order should be made except that the motion stand to the trial.

The Court abstains from interfering by injunction in the case of a recently dated patent, where there is really a substantial question to be tried. The defendant in such a case is usually required to give an undertaking to keep an account until the hearing of the action (q).

Where, however, the only substantial defence to an action of infringement was that the patent was void on the ground that the complete specification did not disclose all that the plaintiff knew at the date thereof to be necessary for the purpose of working the invention, but where it was proved that a competent workman

(l) Per Lord Cottenham, C., *Electric Telegraph Co. v. Nott*, *ubi supra*, at p. 47.

(m) 1877, 30 L. T. N. S. at p. 244.

(n) *Harmer v. Playne*, 1807, 14 Ves. 130. See the cases enumerated in Lawson, p. 194.

(o) *Wheatstone v. Wilde*, 1861, Griffin, P. C. 247. Here Wood, V.-C., held that the exclusive enjoyment for three years of a patent for improvements in electro-magnetic telegraphs—a subject-matter as to which it was shown by the

patentee that inventors had been and were very much on the alert—would justify an interlocutory injunction. See, however, *Hill v. Thompson*, 1817, 3 Mer. 622; *Plympton v. Malcolmson*, L. R. 20 Eq. 37; *Renard v. Levinstein*, 1864, 19 L. T. N. S. 94.

(p) 1850, 7 P. O. R. 1.

(q) *Jackson v. Needle* (a case under the Patent Law Amendment Act, 1852), 1884, 1 P. O. R. 174.

could carry out the invention with no other assistance than that derived from the specification, it was held that the plaintiffs were entitled to the injunction they moved for (r).

There must be not merely possession and enjoyment, but uninterrupted and exclusive possession and enjoyment, under letters patent, in order to warrant the Court in granting an interlocutory injunction. When, therefore, it was shown that since the patent in dispute was granted, persons not claiming under the patent had manufactured machines upon the principle sought to be protected by it, adversely to and without the license of the plaintiffs, it was held by Lord Cottenham, C., that there was an end to the case of exclusive possession and enjoyment, though the patent had been in force for nearly fourteen years, and that an injunction must be refused (s).

Enjoyment must be exclusive.

In *Heugh v. Magill* (t), on a motion to restrain the infringement of a patent for certain improvements in a machine which was the subject of a prior substratum patent, the Master of the Rolls held that the undisturbed possession of the new patent did not commence till the substratum patent had expired.

Prior substratum patent.

An injunction to restrain an alleged infringement will not be granted on an interlocutory application, unless it has been shown that there has been actual user of the invention, even where the patent has been in force for a number of years (u).

Actual user necessary.

The Court will not enter into the question of the validity of a patent on an interlocutory motion for an injunction, unless it appears to be on the face of it so irretrievably and hopelessly bad that it could not possibly be supported (x). The law is that where a patentee has had long enjoyment then he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful (y). Upon the other hand, it is not a mere matter of course, because a patent is recent, to call on the patentee to establish his rights at law before he can obtain relief by injunction (z).

Question of validity, how far entered into.

(r) *Coles v. Baylis*, 1886, 3 P. O. R. 178.

(s) *Curtis v. Cutts*, 1839, 8 L. J. Ch. 184; 2 Coop. 60. It is not necessary for the plaintiff to allege that his patent has never been disputed: *Read v. Andrew*, 1885, per Bacon, V.-C., 2 P. O. R. 119, 122.

(t) 1877, W. N. 62.

(u) *Plimpton v. Malcolmson*, 1875, 44 L. J. Ch. 257.

(x) *Briggs v. Lardeur*, 1884, per Pearson, J., 1 P. O. R. 129; *Shillito v.*

Larmuth, 1885, 2 P. O. R. 2.

(y) *Betts v. Menzies*, 1857-62, 3 Jur. N. S. 357; op. also, *Universities of Oxford and Cambridge v. Richardson*, 1802, 6 Ves. 706; *Losh v. Hague*, 1837, 1 Web. P. C. 201; *Becston v. Ford*, 1830, per Lord Lyndhurst, C., 2 Coop. Ch. Ca. 58; *Bickford v. Skewes*, 1837, 4 M. & C. 498; *Muntz v. Foster*, 1843, 2 Web. P. C. 93, 95.

(z) *Clark v. Ferguson*, 1859, per Stuart, V.-C., 1 Giff. 184; op. *Gardner v. Broad-*

Second ground. II. Where the validity of the patent has been established elsewhere, and the Court sees no reason to doubt the propriety of the result.

Earlier rule. It was at one time (*a*) held that though a patentee had enjoyed his patent for a considerable period, and had succeeded in several actions for an infringement thereof in upholding his patent, and had obtained injunctions restraining the parties so infringing, yet if there were a new infringement by a different party, an injunction to restrain him would not be granted till after a trial at law, however palpable the infringement might be.

Later rule. In the later cases, however, a different doctrine has been asserted, the most terse statement of which will be found in the language of Lord Romilly, M. R., in *Borill v. Goodier* (*b*).

The Court will protect a patentee who has established the validity of his patent in one action, against a different defendant in another action, until that defendant proves its invalidity. The defendant in the first action may, notwithstanding, dispute the patent in the second.

Effect of fresh facts impeaching novelty.

An interlocutory injunction may be granted to a patentee in the cases to which the rule above stated applies, although a fresh fact is brought forward tending to impeach the novelty of the invention (*c*).

Award of arbitrator.

Where a patentee had brought an action for damages, and at the trial an arbitration had been agreed to, upon which the arbitrator by his award had established the validity of the patent, and the patent had been again invaded, the Court, upon a bill filed for an injunction to restrain the infringement, held that the award of the arbitrator must be considered as equivalent to a verdict establishing the validity of the patent, against which there had been no motion for a new trial (*d*).

Effect of action at law to test validity.

Where a patentee had been directed to proceed at law in order to try the validity of his patent, and had obtained judgment, then the Court of Chancery, both before and under Sir John Rolt's and Lord Cairns' Acts, granted him an injunction as a matter of course (*e*).

bent, 1856, 4 W. R. 767; 2 Jur. N. S. 1041.

(*a*) *Crosskill v. Ivory*, 1848, 10 L. T. 459; *cp. also, Crosskill v. Tuxford*, 1845, 5 L. T. 342.

(*b*) 1866, 35 L. J. Ch. 174; 35 Beav. 427; *cp. Davenport v. Jepson*, 1862, 4 De G. F. & J. 440; *Davenport v. Goldberg*, 1865, 2 H. & M. 282; *Borill v. Smith*,

1867, W. N. 1867, 240; *Dudgeon v. Thomson*, 1874, 30 L. T. N. S. 244; *Thorn v. Worthing Skating Rink Co.*, 1876, 6 Ch. D. 416, n.; *Hayward v. Pavement Light Co.*, 1884, 1 P. O. R. 207.

(*c*) *Newall v. Wilson*, 1852, 19 L. T. 161; 2 De G. M. & G. 472.

(*d*) *Lister v. Eastwood*, 1855, 26 L. T. 4.

(*e*) *Russell v. Cowley*, 1834, 2 Coop.

In *Boulton v. Bull* (*f*), where the patentee had been in possession for twenty-seven years, an injunction had been granted in order that the question as to the validity of the patent might be tried. There was a verdict for the plaintiff, subject to the opinion of the Court upon a case stated. The Court was equally divided in opinion as to the validity of the patent. Lord Rosslyn, C., refused to dissolve the injunction previously granted, but directed the plaintiff to bring another action to test the validity of his patent.

Where, however, after a verdict in favour of the plaintiff in an action for infringement, the defendant took steps to question its propriety, where, for example, he stated his intention of moving (*g*), or obtained a rule *nisi* for (*h*), a new trial, or tendered a bill of exceptions (*i*), the Court usually, but not necessarily (*k*), ordered the matter to stand over till the result of such application or proceeding was known.

III. Where the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent. *Third ground.*

It will be found that the cases under this head turn upon a more or less direct application of the doctrine of estoppel.

We will first consider the position of a licensee.

A licensee may be estopped from disputing the validity of a patent where (1) the license, being by deed, contains a recital necessarily involving an assertion of the validity of the patent (*l*); (2) the license not being by deed (*m*), or being merely verbal (*n*), is still in force, and the licensee is using the invention under it (*o*). *Position of licensee.*

The fact of a patent having been found invalid at law upon proceedings between the patentee and third parties, is no answer to a suit based upon the same patent for an injunction and consequent relief against a licensee who has covenanted to pay royalties, and is selling the invention contrary to his covenant without payment of the royalties (*p*). *Estoppel.*

C. C. 59, n.; *Neilson v. Harford*, 1841, 1 Web. P. C. 373.

(*f*) 1796, 3 Ves. 140.

(*g*) *Hill v. Thompson*, 1817, 3 Mer. 631; 1 Web. P. C. 235, 238.

(*h*) *Collard v. Allison*, 1839, 4 My. & Cr. 487.

(*i*) *Bridson v. McAlpine*, 1845, 8 Beav. 229.

(*k*) *Bridson v. Bencke*, 1849, 12 Beav. 1.

(*l*) *Bowman v. Taylor*, 1834, 2 Ad. &

E. 278; 1 Web. P. C. 292; *Smith v. Scott*, 1859, 28 L. J. C. P. 325; *Cutler v. Bower*, 1848, 17 L. J. Q. B. 217; 11 Q. B. 973.

(*m*) *Laures v. Purser*, 1856, 26 L. J. Q. B. 25; 6 E. & B. 930.

(*n*) *Crossley v. Dixon*, 1863, 10 H. L. C. 293, 308, 310.

(*o*) *Norton v. Brooks*, 1861, 7 H. & N. 499.

(*p*) *Grover and Baker Sewing Machine Co. v. Milliard*, 1862, 8 Jur. N. S. 714;

Apparent
exceptions.

There are certain apparent exceptions to the proposition just stated which require notice.

In *Hayne v. Maltby* (q), the facts were these: "A. fraudulently asserting that he had a right to a patent machine, covenanted with B. that he should use it in a particular manner, in consideration of which B. covenanted that he would not use any other; in an action by A. on the covenant, "held that B. was not estopped by his covenant from pleading in bar to the action that the invention was not new or that the patentee was not the inventor."

In this case, however, "the recital contained no assertion of right in the plaintiffs, except as assignees . . . the case was not properly one of estoppel" (r).

"The case of *Hayne v. Maltby*," said Lord Cottenham, C., in *Neilson v. Fothergill* (s), appears to me to come to this: that although a party has dealt with the patentee, and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party the opportunity of disputing his right; and that if the defendant successfully dispute his right, that, notwithstanding he has been dealing under a contract, it is competent for the defendant so to do."

In *Taylor v. Hare* (t), "A. having obtained a patent for an invention, of which he supposed himself the inventor, agreed to let B. use it upon payment of a certain annual sum, secured by bond: this sum was paid for several years, when B. discovering that A. was not the inventor, but that it was in public use before A. obtained his patent, brought an action for money had and received, to recover back the amount of the annuity paid." It was held that he could not recover.

Here, again, there had been distinct enjoyment under the patent, and this case is therefore distinguishable from *Chanter v. Leese* (u), in which it did not appear that there had been any enjoyment by the defendants (x).

After the determination of a license, the licensee may, on an

cp. *Taylor v. Hare*, 1805, 1 N. R. 260; 1 Web. P. C. 292; *Collinge v. Bowman*, 1834, 1 Web. P. C. 292; *Baird v. Neilson*, 1842, 8 Cl. & F. 726; *Hills v. Laming*, 1853, 23 L. J. Ex. 60.

(q) 1789, 3 T. R. 438.

(r) Per Patteson, J., in *Bowman v. Taylor*, 1834, 1 Web. P. C. 294.

(s) 1841, 1 Web. P. C. 290.

(t) 1805, 1 N. R. 260.

(u) 1839, 4 M. & W. 295; affirmed on appeal, 5 M. & W. 698; *Besseman v. Wright*, 1858, per Crompton, J., 6 W. R. 719.

(x) S. C., 1 Web. P. C. 295.

application for an injunction, dispute the validity of the patent as against the licensor (*y*).

In *Pidding v. Franks* (*z*) the plaintiff had granted by deed to one S., a defendant in the suit, an exclusive license to use a patent for the manufacture of coffee. S. made an equitable assignment of his whole interest under the patent to F. Knight-Bruce, V.-C., directed an action at law instead of granting an injunction in respect of an alleged infringement, whereupon the plaintiffs sought to have the defendants, other than S., put on terms not to dispute the validity of the patent. The application was refused. "Are the defendants," said Lord Cottenham, C., "not to be at liberty to say we have bought the patent and paid for it, but we do not intend to use it? They are mere equitable assignees, and why should they be deprived of the right which every stranger has of disputing the validity of the patent."

The conduct of a defendant may have been such as to estop him from disputing, upon an application for an interlocutory injunction, the validity of the plaintiff's patent. Estoppel by conduct.

Thus, in *Muntz v. Grenfell* (*a*), where the patent had been worked by the plaintiff and defendant as partners, under circumstances affording a presumption that the defendant did not, during the existence of the partnership, dispute that the patent was valid, Knight-Bruce, V.-C., held, upon an interlocutory application for an injunction, after the determination of the partnership, that the Court must assume the patent to be valid as against the defendant. *Axmann v. Lund* (*b*), although apparently contradictory of, is in reality distinguishable from, this case. In the latter, the plaintiff and the defendant had, during the subsistence of the partnership, taken and prosecuted legal proceedings against infringers. In the former, such proceedings had been taken, but were abandoned by the co-partners on advice that the specification was bad. Co-partners.

The rules above stated apply only to co-partners whose conduct or acts amount to an estoppel. There is nothing to prevent a co-partner who has not been privy to such acts from disputing the validity of a patent (*c*).

The fact that in a previous action at law for the infringement of Effect of defendant

(*y*) *Dangerfield v. Jones*, 1865, 13 L. T. N. S. 142.

(*z*) 1849, 18 L. J. Ch. 295; 1 Mac. & G. 66.

(*c*) 1842, 2 Coop. 61, n.

(*b*) 1874, L. R. 18 Eq. 330.

(*c*) *Goucher v. Clayton*, 1864-6; 34 L. J. Ch. 239; *Heugh v. Chamberlain*, 1877, 25 W. R. 742.

having submitted to judgment in previous action.

Patentee may not derogate from his own grant.

letters patent, a defendant had submitted to judgment, and had taken a licence for five years to work under the patent, would debar him from questioning its validity on an application for an *interlocutory* injunction till the hearing of a subsequent action (*d*).

A patentee may not derogate from his own grant (*e*). This proposition requires some explanation and qualification. It holds good in such cases as *Oldham v. Langmead* (*f*). Here the patentee had conveyed his interest in the patent to the plaintiff, and yet, in violation of his contract, he afterwards infringed the plaintiff's right, and then attempted to deny his having any title to convey. It was held by Lord Kenyon that he was estopped by his own deed from making that defence.

A defendant is not, however, estopped from disputing the validity of his patent as against purchasers of the said patent from his trustee in liquidation (*g*).

In the case of *Cropper v. Smith* (*h*), where this point arose incidentally, Bowen, L. J., said, "There is no estoppel of record, and there is no estoppel by deed, because the people who claim against (the defendant H.) are not parties or privies to the deed or to the record; nor is there estoppel *in pais*, or by matter of conduct. It is perfectly true that in his petition to the Crown (the defendant) did say that his invention was new, and on that the patent was granted to him: but 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 know that everybody who buys it, as a rule, takes it for what it is worth; and there is absolutely no evidence in this case that the plaintiff, who bought from the assignee in bankruptcy, and who gave a very small sum for the patent, was in the least relying in his purchase on the allegations made in the petition to the Crown by the patentee that the patent was a valid one."

When a patent has been upheld in one action for infringement, the defendant in a second action, who was not a party to the first, is not bound by the decision (*h*).

(*d*) *Goucher v. Clayton*, *ubi supra*, per Wood, V.-C. Here, however, the application was for a perpetual injunction. Cp. *Newall v. Elliot*, 1863-64, 1 H. & C. 797; *Dudgeon v. Thomson*, 1877, 30 L. T. N. S. 244.

(*e*) *Chambers v. Crichley*, 1864, 33 Beav. 374.

(*f*) 1789, 3 T. R. 439, 441.

(*g*) *Cropper v. Smith*, 1884, 1 P. O. R. per Bowen, L. J., at p. 94. Confirmed on this point by the House of Lords, 1885, 2 P. O. R. at p. 25.

(*h*) *Otto v. Steel*, 1886, 3 P. O. R. at p. 114.

An interlocutory injunction will be refused :

1. If there is any substantial doubt whether the acts complained of constitute an infringement of the plaintiff's patent (*i*).
2. If the application for it is made only after unnecessary and unexplained delay (*k*).
3. If there has been, on the part of the plaintiff, acquiescence in the wrong of which he complains (*l*).
4. If the balance of convenience is against granting it (*m*).

Refusal of
interlocutory
injunction.

These points may be illustrated very briefly.

1. An interlocutory injunction may be refused if there is a conflict of scientific opinion, leaving doubt in the mind of the judge, as to the fact of infringement (*n*) ; or if the alteration made by the defendant on the plaintiff's patent is "not merely colourable, but *prima facie* a decided improvement" (*o*) ; or when it appeared that there was a material difference between the process of the defendant and that of the plaintiff (*p*).

Infringement
doubtful.

On an application for an interlocutory injunction the plaintiff's affidavit should state particularly in what the alleged infringement of the patent consisted (*q*).

A patentee may, however, succeed in obtaining an injunction without proving actual infringement where the defendant alleges an intention to infringe, and claims the right to infringe, and it is plain that what is threatened to be done would constitute an infringement (*r*).

Where there is one question whether a patent is valid and another question whether it has been infringed (*s*), it depends on the degree of doubt which exists on those questions whether the Court will grant the interim injunction. In such cases it will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction (*t*).

2. An application for an interlocutory injunction, if *ex parte*, must be made at the earliest possible period, and if on notice, must be without any unnecessary or unexplained delay (*u*).

Application
to be made
without
delay.

(*i*) *Electric Telegraph Co. v. Nott*, 1846-7, 16 L. J. C. P. 174; 2 Coop. 41.

(*k*) *Bridson v. Benecke*, 1849, 12 Beav. 1.

(*l*) *Neilson v. Thompson*, 1840, 1 Web. P. C. 275, 285.

(*m*) *Electric Telegraph Co. v. Nott*.

(*n*) *Electric Telegraph Co. v. Nott*, *ubi supra*, per Lord Cottenham, C.

(*o*) *Morgan v. Seaward*, 1835, per Shadwell, V.-C., 1 Web. P. C. at p. 168.

(*p*) *Muntz v. Virian*, 1840, 2 Web.

P. C. at p. 88.

(*q*) *Hill v. Thompson*, 1817, per Lord Eldon, L. C., 1 Web. P. C. 230.

(*r*) *Frearson v. Loc*, 1878, per Jessel, M. R., 9 Ch. D. at p. 95.

(*s*) *Wood v. Cockerell*, 1819, per Lord Eldon, C., 2 Coop. 58 (n.).

(*t*) *Bridson v. M'Alpine*, 1845, 8 Beav. 229.

(*u*) *Bridson v. Benecke*, 1849, per Lord Langdale, M. R., 12 Beav. 3; *Greer v.*

Such delay is a ground for refusing an injunction notwithstanding the plaintiff's long enjoyment under the patent, and the establishment of its validity in an action against another party (*x*).

Meaning of
"laches."

A patentee is not bound to bring actions in respect of every infringement, but in order to support an injunction against an infringer who has been permitted to go on for some time, and against whom no action has been brought, distinct notice ought to be given to him that the patentees would seek to enforce their right (*y*), and failure to give such notice may be fatal (*z*).

A patentee is entitled to spend some time in making inquiries as to whether a defendant is a man of substance (*a*), or is really infringing (*b*).

In the case of *Osmond v. Hirst* (*c*), it was contended that the plaintiff had been guilty of *laches*, because, the defendant's patent having been in existence since 1882, he had not brought an action till 1885, and it was said that that must be proof of the fact that the plaintiff knew of the infringement. Bacon, V.-C., however, repelled that contention.

A patentee does not acquiesce in the infringement of his patent by omitting to take proceedings for the repeal of a subsequent patent extending to part of his invention, unless such subsequent patent is put in practice (*d*).

Although a motion for an injunction is refused on the ground of delay, an account may be ordered (*e*).

"Where there is an independent case against a motion, it is better to order the motion to stand till the trial if the defendant asks for it, because although, where the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action, yet, where there is an independent case against a motion, so that the defendant may say: 'If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me in any

Bristol Tanning Co., 1885, 2 P. O. R. 268; *Thomson v. Batty*, 1889, 4 Times Rep. 36.

(*x*) S. C., cp. *Bacon v. Jones*, 1839, 4 My. & Cr. 438; *Baxter v. Combe*, 1850, 1 Ir. Ch. R. 284; *Bovill v. Crate*, 1865, L. R. 1 Eq. 388.

(*y*) *Hancock v. Moulton*, 1852, M. Dig. 506; *Higgins's Dig.* 1201; cp. *Bovill v. Smith*, 1867, W. N. 1867, 240.

(*z*) *Smith v. L. & S. W. Rail. Co.*, 1854, 23 L. J. Ch. 562, Kay, 408.

(*a*) *United Telephone Co. v. Equitable Telephone Association*, 1888, 5 P. O. R. 233.

(*b*) S. C., and *Losh v. Hague*, 1837, 1 Web. P. C. 201.

(*c*) 1885, 2 P. O. R. 267.

(*d*) *Newall v. Wilson*, 1852, 2 De G. M. & G. 292.

(*e*) *Bovill v. Crate*, *ubi supra*.

view to unnecessary expense,' it is better, then, to order the motion to stand to the trial without prejudice to any question" (f).

3. The leading case on the doctrine of acquiescence in the infringement of a patent is *Neilson v. Thompson* (g). Acquiescence
in infringe-
ment.

There the subject-matter of the invention was an improvement in the application of air to produce heat in fires, forges, and furnaces. The patentee made his profit, not by selling the article, but by granting licences to ironmasters to use his patent on paying one shilling per ton on all the iron made. The plaintiff was aware that the defendants were at considerable expense erecting apparatus for the purpose of using his invention, and he permitted them to go on under the expectation that they would pay him a shilling a ton after a certain time. It was held by Lord Cottenham, L. C., that an interlocutory injunction must be refused on the defendant undertaking to keep an account and to deal with it as the Court might direct.

Delay or acquiescence, which would be fatal to an application for an interlocutory injunction, may not debar a plaintiff from obtaining a perpetual injunction at the trial (h).

"Mere delay to enforce a legal right is no bar to an action, unless the delay is such as to cause a statutory bar" (i).

"But acquiescence may be a ground for refusing an account of profits (k), or for limiting it to the date of commencing the action (l), or for granting damages instead of an injunction" (m).

In *Proctor v. Bennis* (n), an action by P., the patentee of a stoking machine, for infringement against persons who had purchased stoking machines made by B., it was proved that before the purchase P., knowing that they were going to set up stoking machines, went to them and asked them to try his machine, saying that they would find it a better machine than B.'s, without giving any intimation that he considered B.'s machine to be an infringement of his patent, though he admitted that he did at that time consider it to be so, and intended to take legal proceedings when he was in funds.

(f) *Lister v. Norton*, 1884, per Chitty, J., 1 P. O. R. at p. 116.

(g) 1841, 1 Web. P. C. 278; *Thomson v. Hughes*, 1890, 7 P. O. R. 71.

(h) *Johnson v. Wyatt*, 1863, 2 De G. & S. 18, 25; *Fullwood v. Fullwood*, 1878, 9 Ch. D. 176; *Proctor v. Bennis*, 1887, 36 Ch. D. per Cotton, L. J., at p. 758.

(i) *Three Towns Banking Co. v. Maddever*, 1884, 27 Ch. D. 530.

(k) *Crossley v. Beverley*, 1829, 1 Web. P. C. 120; *Harrison v. Taylor*, 1865, 11 Jur. N. S. 408.

(l) *Sayers v. Collyer*, 1884, 28 Ch. D. 103, per Fry, L. J.

(m) *Beard v. Turner*, 1866, 13 L. T. N. S. 746; *Ford v. Foster*, 1872, L. R. 7 Ch. 627.

(n) 1887, 36 Ch. D. 740.

The Court of Appeal, reversing the decision of the Vice-Chancellor of the county palatine, held that as the purchasers did not depose that when they bought B.'s machines they were ignorant of P.'s patent, nor was there any reason to believe that they were ignorant of it, or that P. supposed them to be so, P. had not, on the ground of acquiescence or estoppel, lost his right to sue them for an infringement in using B.'s machines, it not being the duty of a patentee to warn persons that what they are doing is an infringement, and P.'s conduct not amounting to a representation that it was not an infringement.

Object of Court in granting injunction.

4. The object of the Court in granting an injunction is to preserve to each party the benefit he is entitled to, until the question of right is tried (*o*).

In *Neilson v. Thompson* (*o*), the facts of which are set forth above at p. 275, an injunction was refused, because, to stop the defendants' works by injunction would have done an injury to them out of all proportion to the indirect benefit which it might have conferred upon the plaintiff by putting pressure upon the defendants, and inducing them thereby to take a licence of the plaintiff's patent.

Where the trade of the defendant is a new trade, and he is a seller of goods to a vast number of people, it is less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account; thus forcing the plaintiff to commence a multitude of actions against the purchasers (*p*).

In two cases (*q*), the Court left rival patentees to try their legal rights by proceedings for revocation, and declined to interfere between them by interlocutory injunction.

Where infringement long discontinued.

An injunction will not be granted when the only infringement has been long discontinued, and no probability is shown of its being continued. In *Proctor v. Bayley* (*r*), the plaintiff, the owner

(*o*) *Neilson v. Thompson*, 1840, per Lord Cottenham, L. C., 1 Web. P. C. 286.

(*p*) *Plimpton v. Spiller*, 1876-77, per Brett, J. A., 4 Ch. D. 291.

(*q*) *Copeland v. Webb*, 1862, 11 W. R. 134; cp. *Boskett v. Cunningham*, 1762, 2 Eden, 137.

(*r*) 1889, 6 P. O. R. 538. In this case it was also held that as the Palatine Court had, under Lord Cairns' Act, only jurisdiction to grant damages in a case where it was proper to grant an injunction, there was no jurisdiction in

the present case, and the action must be dismissed, but, owing to the defendants' conduct of their case, without costs, although the defendants must have the costs of their successful appeal. The Court refused to give any opinion as to whether the dismissal of this action would be prejudicial to a subsequent action at law for damages: cp. *Millington v. Fox*, 1846, 3 My. & Cr. 338; and *Geary v. Norton*, 1846, 1 De Gex & Sm. 9.

of a patent, the validity of which had been established in a previous action, brought an action against the defendants claiming an injunction and damages in respect of a previous user by the defendants of certain infringing machines in their works. The machines had been put up on trial, and proving unsuccessful, had been taken down five years, and removed from the defendants' premises three years before the commencement of the action. The defendants denied purchase or user of infringing machines, and, in the alternative, pleaded that their user of them was experimental, that it had long been discontinued, and that no threat or intention on their part to use infringing machines had been alleged or proved. It was held, at the trial, that the defendants had used machines which were an infringement of the plaintiff's invention, and to an extent amounting to more than an experimental user; and that though the act was discontinued and there was no threat to continue it, the plaintiff was entitled to an injunction in aid of his legal right. The defendants appealed. The Court of Appeal held, that in order to invoke the extraordinary jurisdiction to grant an injunction there must be some probability of the act being continued; and that assuming the defendants had infringed, as they were only users and not manufacturers, and the only infringement was put an end to in 1883, there was no evidence of any intention on their part to continue the wrongful act, and, therefore, an injunction ought not to be granted.

A plaintiff making application, whether *ex parte* (s) or after notice (t), for an interlocutory injunction must swear at the time of making it that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect (s).

Application
ex parte.

Injunctions are not now generally granted *ex parte*. An interim order, restraining the defendant till after a day named, is made, liberty being given to the plaintiff to serve notice for an injunction

(s) *Hill v. Thompson*, 1817-18, per Lord Eldon, L. C., 3 Mer. at p. 124.

(t) *Sturtz v. De la Rue*, 1828, per Lord Lyndhurst, L. C., 5 Russ. at p. 329;

Whitton v. Jennings, 1860, 1 Dr. & S. 110; *Mayer v. Spence*, 1860, 1 J. & H. 87.

for the day before such day. An undertaking to abide by the decision of the Court as to damages and other terms may be imposed upon the defendant (*f*).

SECT. 4.—THE CONSOLIDATION OF ACTIONS.

Consolidation of actions.

Order XLIX. r. 8, of the R. S. C. 1883, provides that causes or matters pending in the Chancery Division may be consolidated by order of the Court or a judge in the manner in use before the commencement of the Judicature Act in the superior Courts of common law.

Practice at common law.

According to the practice at common law actions could only be consolidated at the instance of the defendant; and the consolidation order could be made as soon as the defendants had appeared, and before declaration (*g*). How far have these rules been modified?

Existing practice.

1. Where a number of plaintiffs have commenced several actions against the same defendants, the Court may under its general jurisdiction, on the application of the plaintiffs, enlarge the time for taking the next step in the rest of the actions until one of them has been tried as a test action; but where the action so selected fails to be a real trial of the issue, another of the actions may be substituted as the test action (*h*). The plaintiff was not, without his consent, bound by the result of the one action tried, but might, after a verdict against him in one action, proceed with any of the others.

2. In *Foxwell v. Webster* (*i*)—where the plaintiff, who was the assignee of the patent alleged to be infringed, had filed 134 bills against separate defendants—four motions were made by four groups of defendants, amounting in the whole to seventy-seven, that the suits should be consolidated, and that either one suit selected by the plaintiff should be prosecuted, and proceedings in the remainder stayed, or else that the validity of the patent should be tried once for all, and the time for answering be enlarged, each defendant reserving his own defence on the ground of non-infringement.

Kindersley, V.-C., dismissed the motions without prejudice to

(*f*) Daniell's Chanc. Prac. 1611.

(*g*) Lush's Practice, 3rd edit. 965.

(*h*) *Amos v. Chadwick*, 1877, 4 Ch. D. 869; 9 Ch. D. 459; *Bennett v. Lord Bury*, 1880, 5 C. P. D. 339.

(*i*) 1863, 9 L. T. N. S. 362, 528. This was a suit to restrain the infringement of a patent for improvements in machinery or apparatus for sewing or stitching.

any application after answer, with a view to regulating the future course of the proceedings. "Now this," said his Lordship, "is the position of the patentee; if he were to bring together in any one suit any number, even more than one defendant, and any one defendant were to object that he ought not to be mixed up with the others, the objection would be successful, for a patentee has no right to join as defendants any number of persons infringing, not even two (k). Now here the plaintiff has filed 134 bills against 134 different persons, who, he alleges, are infringing; and it is said, 'How can it be necessary to file so many bills?' . . . It is a settled rule of this Court, that if a person wishes to obtain an injunction, he must not sleep upon his right; he must come to the Court speedily; and if in this case the plaintiff had proceeded against one or more of the persons alleged to be infringing and had abstained from filing bills against the others, his remedy by injunction against them would have been prejudiced. It would be in vain for him to say that he was waiting the result of a trial against some others.

"The fact that there are 134 suits does not affect the duty of each defendant to answer the interrogatories addressed to him, and which will or may give the plaintiff the benefit of a decree. . . . The defendants have come too soon."

On appeal, Lord Westbury suggested, that the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every machine made, used or sold by them, and whence obtained, and when used, and full discovery of the profits derived therefrom, undertaking also to pay a royalty in respect of each machine, if the validity of the patent and its infringement should be established. This course was agreed to on condition that the defendants would furnish verified models of every machine so made, used or sold by them respectively. Lord Westbury then made the order for consolidation cited above.

3. In the same case (l), Lord Westbury, L. C., made an order directing an issue as to the validity of the patent, certain defendants being selected as representatives, the result to be binding on the plaintiff and all the defendants. It appears, however,

(k) Cp. *Dilly v. Doig*, 1794, 2 Ves. Jun. 487, per Lord Loughborough, L.C.: "I do not remember any case upon patent rights, in which a number of people have been brought before the Court as parties, acting all separately

upon distinct grounds: it has always been against a particular defendant. In a case here, not long ago, upon *Boulton and Watts' Patent* there were several bills."

(l) 1863, 4 De G. J. & S. at p. 81.