

examination of the specification and the application left with it. The papers are sent up from the registry-room to an official superintendent, who sorts them out according to the subjects which have been allotted to the different examiners. The examining staff, it should be remarked, is divided into three groups and different subjects are assigned to different assistant examiners in those groups. The duties of the assistant examiner at this stage are as follows:—(1) to see that the formal documents are in proper order; (2) to ascertain whether the nature of the invention has been fairly described, and the application, specification, and drawings, if any, have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention; (3) to see that the specification describes the invention only (*r*).

Report.

If the assistant examiner is satisfied that the specification and drawings have not been prepared in the prescribed manner, he makes a report to that effect by a minute attached to the specification. That minute is sent through one of the examiners to the letter department, where a letter is drafted from the report and is then sent down to be signed either by the comptroller-general or by the chief examiner, who therefore see all the requirements made by the Office.

(*r*) Under sub-sect. 5 of sect. 7 of the Act of 1883, the examiner was required to report to the comptroller as to the similarity of rival applications, in order that notice of interference, as it was called, might be given to the applicants. The reason for inserting that provision, which was done in committee, was this: patent agents said that there was a period in the existence of an application—that is, during the period of provisional protection—when they knew nothing about what was being done, while the Patent Office was in possession of that information, and therefore they thought it only reasonable, when the examiner was looking through the applications for patents, that he should use some part of his knowledge for their advantage, and give the second person notice that a prior application had been made in order that he might not waste his time and money in going on with the second application, if he thought fit. This notice of interference saved him the trouble of constantly watching the Patent Office Journal to see whether

anything like his own was coming out and directed his attention to a particular number of a particular year. The procedure relating to notices of interference had, however, many disadvantages. (a) If the second applicant published his complete specification before the first, the latter could sign as his invention all the matter of the second application, though he might not otherwise have thought of it. (b) notice of interference was sometimes given when there was in reality no similarity; (c) on the other hand, owing to the necessary generality of the provisional specification, similarity between two inventions sometimes escaped notice; (d) this procedure was a serious drain on the examiners' time and it was estimated that no less than ten assistant examiners were employed solely in carrying out this particular work. On the recommendation, therefore, of the Committee of 1887, sub-sect. 5 of sect. 7 was repealed by the Act of 1888, sect. 2.

When the answer to the objection communicated by letter is received, it is registered according to date, and is then sent from the registry to the room of the same examiner who first dealt with it. If the applicant requests to be heard, or if the comptroller refuses the application and offers a hearing, the applicant is heard at the Patent Office before the comptroller or chief examiner, from whose decision an appeal lies to the law officer. In the case of such an appeal, all the papers are transmitted to the law officer's clerk.

Hearing before comptroller.

Where a complete specification is left after a provisional, the two are referred to the same assistant examiner who had the first application. His duties are to see whether the complete specification has been prepared in the prescribed form and to satisfy himself that the invention particularly described in the complete specification is substantially the same as that which is described in the provisional. The examiners used at first to examine the claims, but the comptroller-general was instructed by the law officers on 31st March, 1885, that the examiners had no power under sect. 9, sub-sect. (1), to deal with the claims at the end of the complete specification, that their duty was confined to seeing that there were claims, and that they were not to compare them or see that the description bore out the claims of the specification.

Second report of examiner where complete specification left subsequently.

The examining staff also assist the comptroller-general as expert assessors in the case of oppositions under sect. 11, and of amendments of specifications under sect. 18.

Duties of examiners in hearings before the comptroller. Patent Museum transferred to Science and Art Department.

In accordance with sect. 41 of the Act of 1883, the Patent Museum and its contents were, on January 1st, 1884, transferred to the Science and Art Department, South Kensington, under whose management it has since remained (s). It no longer forms

(s) The origin of the Patent Museum is thus traced by Mr. Cole, Secretary to the Science and Art Department, in his evidence before the Select Committee of 1865 (Report, &c., 1865, pp. 116 *et seq.*). After the Exhibition of 1851, a considerable amount of public opinion began to be formed on the necessity of industrial education; memorials were presented from the great towns of England noticing the advantages of the Conservatoire des Arts et Métiers and the Central School of Arts and Manufactures at Paris, and praying that a great central college should be

established in London, and that a museum of arts and manufactures should be formed at the college. These memorials were supported by resolution passed by the chief British jurors at the Paris Exhibition, and by the report of a committee appointed by the Commissioners of 1851 to consider the best mode of aiding in establishing a museum of inventions. Mr. Bennet Woodcroft (Bennet Woodcroft's evidence, *ibid.* at p. 3), at that time Professor of Machinery at University College, had a collection of models, partly belonging to himself and partly

Models.

a separate section, but has been incorporated with the general science collections of the South Kensington Museum. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled in case of dispute by the Board of Trade (*l*). This power is rarely, if ever, exercised at the present time.

Publications of the Patent Office.

The publications of the Patent Office, both from their bulk and intrinsic value, deserve some notice. The history of the Old Law Specifications Series (*ii*), which ranges from A.D. 1617 to

lent to him for use at his lectures. Upon being appointed assistant to the commissioners in 1852, he transferred some of those models to his own room at the Patent Office. The interest of the engineering public was aroused, and a very large number of other models was supplied to the Commissioners of Patents. The Commissioners of the Exhibition of 1851 were also in possession of many valuable models. The whole collection was preserved first in Kensington Palace, then in Gore House, and afterwards in the iron museum, popularly known as "The Boilers," which was erected for the purpose of receiving it. This Patent Museum, which was opened to the public in 1855, had no connection with the Board of Trade or the Science and Art Department, and it consisted solely of the collections given by the exhibitors of 1851 and the patent models belonging to Mr. Bennet Woodcroft and the Commissioners of 1851. It was found necessary, however, to remove the Science and Art Department out of Marlborough House in order to provide for the repairing of that place for the Prince of Wales; and the Marlborough House establishment, which had been open for four years, was then moved up to South Kensington, Parliament granting a vote of 10,000*l.* for that particular purpose.

The Museum at Marlborough House having thus been transferred to the iron building, the Commissioners of 1851 handed over their collection to the charge of the Science and Art Department, and the rules which were in force at Marlborough House were put into force at Kensington. Owing, however, to a dispute between the Commissioners of Patents and the Science and Art Department as to a rule enforced

by the latter making a charge of 6*d.* for admission to the Museum on five days of the week, part of the Museum buildings at South Kensington reserved for the Commissioners of Patents and called the Patent Museum to which the public were admitted without charge.

Mr. Bennet Woodcroft was superintendent of the Museum, as well as of specifications.

(*l*) Act 1883, sect. 42.

(*ii*) Down to the end of 1875 the specifications were printed uniformly in pica type, on paper of imp. 8vo size, with outline lithographic reproductions of the drawings the same size as the originals. In 1876 a new system was adopted, whereby a smaller type was used, and the size of the drawings reduced by photo-lithography to the imp. 8vo or 4to size. The specifications were also put up into volumes of 10 for distribution among public libraries &c., and each volume was accompanied by a title-page and index of author and subjects. This index was discontinued in 1882. Prior to 1852 the provisional specification was unknown; from 1852 to 1883 all provisional specifications deposited were printed, but this was discontinued under sect. 4 of the 1883 Act. The number of these applications which never become patents now exceeds one-half of the whole number of applications. The drawings are now mounted on a sheet of blank paper so that they may be read continuously with the specification. The familiar blue covers have been discontinued since 1888. Only specifications of patents in force are kept in stock or will be printed at the expense of the Office. Specifications of earlier patents which are out of print will be reprinted at the cost of the purchaser.

September 30th, 1852, is somewhat curious. The series is based on the calendars of grants kept by an officer with the title of Clerk of the Patents—an office which existed some years prior to 1617, but to which at that date certain additional duties were attached. From these calendars, which were kept at the old Patent Office in Quality Court, and which were afterwards transferred to the Record Office, the first two volumes of chronological indexes, or rather calendars, were prepared. The specifications, or in lieu of these the text of the actual grants, were transcribed from the originals at the Record Office, and were printed with admirable despatch. For historical purposes, however, it is important to remember that the series has been prepared from a calendar of secondary importance, necessitating in case of doubtful grants reference to the original patent rolls, with their respective calendars and name indexes. The petitions, which in many cases are of greater value than the grants themselves, must be sought either in the State Papers or in the Petition Entry Books. So far, however, as the literature of the patent specification is concerned, the official series may claim to be practically complete. The publication of the chronological indexes (*x*) was discontinued in 1868, the information being practically duplicated in the Official Journal (*y*) and elsewhere. The annual

(*x*) The volumes for the years 1867 and 1868 were published under the title of "Descriptive Index." In 1869 it was changed to "Chronological and Descriptive Index of Patents Applied for and Patents Granted." The publication was discontinued in 1875.

(*y*) The following is a list of the journals of the Patent Office, past and present:—

(1) Commissioners of Patents Journal, 1851—1883. 38 vols. imp. Svo.

(2) Official Journal of the Patent Office, 1881—1888. 10 vols. imp. Svo.

Continued now in the Illustrated Official Journal (5).

(3) Illustrated Journal of Patented Inventions (including complete specifications accepted), 1881—1887. Imp. Svo.

Continued now in Illustrated Official Journal (5).

(4) Reports of Patent Cases (after vol. 3, including Reports of Design and Trademark Cases), 1881—1888. 5 vols. imp. Svo.

Continued now in Illustrated Official Journal (5).

(5) Illustrated Official Journal (Patents), incorporating Nos. (2), (3), and (4). From 1889, in continuation. Imp. Svo.

The Commissioners' Journal commenced in January, 1854, and was published on the evenings of Tuesday and Friday in each week. It contained information relating to each stage of patent procedure from the date of application to the voiding of the patent. In addition, the patent lists of leading foreign countries and colonies were translated and printed, with their laws and regulations, and much other useful information. In 1884 the scope of the work was restricted entirely to an official record of the various stages through which a patent has to pass. In the same year the Illustrated Journal, containing abridgments of all complete specifications accepted, and the Report of Patent Cases, *both new publications*, were issued, the latter originally as a supplement to the Official Journal, but subsequently as a separate publication.

name and subject indexes (*z*) have been continued without interruption to date. A fuller account of these and other publications is given below. The attention of the inventor, however, should be drawn to the Key, or reference index to the publications of the Patent Office. This useful guide directs the searcher at once to the specific heading in the current subject-matter indexes and to the Abridgment Class, under which any particular invention is dealt with. These classified abridgments (*a*) being now almost abreast of the current issue, and, moreover, being distributed throughout the leading libraries of the United Kingdom, an inventor is enabled to make a useful, if not an entirely complete, search as to the novelty of his invention with a facility which contrasts favourably with the opportunities afforded him at any previous period in the history of patent law, either in this or any other country.

Sale Office.

The Sale Office took the place of the Stationery Office in 1884 as the sole office for the sale of the Patent Office publications. In 1894 the Office was removed from 38, Cursitor Street, to 4

In 1889 these three journals were merged into one, and the price of the amalgamated journal was fixed at 6*d.* for each number. Each section, however, at the end of the year forms a separate volume. The index to official section is divided into two parts, Part I. being the name index of applicants for the year, Part II. recording the different stages subsequent to the acceptance of the provisional specification. An inventor, therefore, by the annual payment of 1*l.* 15*s.* obtains—(1) a name index of all applications for the year; (2) a record of all official stages through which an application has to pass; (3) an illustrated abridgment of accepted complete specifications; (4) reports of all patent cases occurring in the year.

(*z*) The following is a fuller account of the subject-matter indexes:—

- (1) Subject-matter Index of Patents of Invention, A.D. 1617—1852, two parts (prepared from titles only).
- (2) Subject-matter Index of Patents Applied for and Patents Granted, 1852—1883.

The indexes for the years 1852—1870 were prepared from the specifications, and were in the form of a classified index of subjects, accompanied by separate synopsis and key. The

only indexes for the years 1870—1873 were the indexes intended to accompany the chronological and descriptive indexes. From 1874 a fuller index was again published down to 1883, the years 1882 and 1883 being made from titles only.

- (3) Subject-matter Index of Applications for Patents, 1884—1888 (discontinued after this date).
- (4) Subject-matter Index of Accepted Complete Specifications.
- (5) Monthly Consolidated Subject-matter Index.

(*a*) *Abridgments* (in classes and chronologically arranged) of specifications of patented inventions from the earliest enrolled to date. The abridgments (unillustrated) were issued in 12mo size, and are for the most part brought down to the year 1876. The prefaces of the earlier volumes in this series contain a valuable introduction to the history of the art, and are of considerable literary and antiquarian value. With the year 1877 the new series of illustrated abridgments commences. The periods 1877—1883 and 1884—1888 are now completed; those for 1889—1892 and 1893—1899 are in course of preparation. The volumes are of imp. 8vo size, and are published at the uniform price of 1*s.*

more convenient site in Quality Court, adjoining the buildings of the Patent Office.

In addition to the printed specifications, indexes, and other publications of the Patent Office, the library (*b*) contains a collection of the leading British and foreign scientific journals, transactions of the learned societies, and text-books of science and art.

Contents of library.

(*b*) In March, 1855, the Commissioners of Patents established a public library of research within the Patent Office. The library contains the most complete collection of English, colonial, and foreign patent literature in existence in any country, besides possessing a valuable selection of works relating to the applied sciences. It is especially rich

in its collection of periodical, technical, and scientific literature. The library was removed to its present position on the second floor of the building in 1866. It was again extended in 1886, and thrown open to the public from 10 a.m. to 10 p.m. The annual number of its readers now exceeds 100,000.

CHAPTER V.

OUTLINE PROCEDURE TO OBTAIN A PATENT (a).

Scope of chapter.

It is proposed in this chapter to give a general account of the procedure to obtain letters patent, without any detailed reference to the statutes and judicial decisions. These are fully considered in the general body of this work, and in the notes to the Acts of 1852—1888.

Form of application.

Applicants desirous of taking out a British patent must first of all leave at the Patent Office an application in the proper form, which can be obtained at Room No. 6, Inland Revenue Department, Royal Courts of Justice, or through any money order office in the United Kingdom (b).

Declaration and Petition.

The application (see Form A to Patents Rules, 1890, Appendix, *post*, p. 805) consists of a declaration by the applicant that he is in possession of an invention for "improvements in," &c., or as the case may be, setting out the title of the invention; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of his knowledge and belief: and it concludes with a prayer that a patent may be granted in respect thereof.

Joint application.

Where an application is made by two or more persons jointly, the declaration must state which one of the applicants, or, if necessary, which two or more of them, is or are the inventor or inventors (c).

(a) See the Patents, &c., Acts, sects. 4—10, and notes, *post*, pp. 549 *et seq.*, also Patent Rules, *post*, p. 689.

(b) The circular of the Patent Office contains an abstract of the procedure referred to in this chapter.

(c) In the petitions for patents prior to 1852 a declaration on the part of the applicant of his intention to work the patent and an indication of the beneficial effects anticipated therefrom formed a not uncommon feature of these documents. By the Patent Law

Amendment Act, 1852, the form was stereotyped to a declaration by the inventor that the invention claimed would prove "of great public utility." a statement which assumes the inventor's intention to work the grant. By the Act of 1863, however, the inventor is confined to a declaration of novelty. The obligation, therefore, to work the grant has, apparently, disappeared from English patent jurisprudence.

Advantage is often taken of the law as to importation by agents who, in the case of inventions communicated by clients abroad, frequently make the application in their own names on Form A1, and when the patent is sealed, assign it, if desired, to their clients.

Communications from abroad.

The application must be signed by the applicant himself, or, if more than one applicant, by each applicant; all further proceedings may be conducted through an agent duly authorised in writing. This authority may be given at the time of signing the application, or at any other time. Where one of the applicants is a company or corporation (*d*), the secretary or other principal officer should, after his signature, add the words, "for the ——" (naming the company or corporation). If a firm are applicants, each member of the firm should sign the application.

Signature of applicant.

Authority to agent.

An application for a British patent under the international or colonial arrangements must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. It must be on Form A2 (see p. 807), and must be accompanied by duplicate copies of the specifications, like other applications. It must also be accompanied by a copy or copies of the specification and drawings, as filed in the Patent Office of the foreign state or British possession in respect of the first foreign application, duly certified by the official chief of such Patent Office, or otherwise verified to the satisfaction of the comptroller. There must also be a statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification be in a foreign language, a translation must be annexed to and verified by the statutory declaration. This declaration must be made before a British Minister or person exercising the functions of a British Minister or a consul, vice-consul, or other person exercising these functions or before a notary public, a Judge, or a magistrate.

Applications under International Convention, &c.

When filling up the proper form of application, the applicant should decide whether to leave a provisional or a complete specification (*e*) in the first instance.

Provisional or complete specification?

(*d*) An official notice draws attention to the fact that in all cases of applications signed on behalf of bodies corporate the

seal of the company shall be duly affixed.

(*e*) For forms, see p. 808.

Advantages
of filing
provisional
specification
with appli-
cation.

The relative advantages of these two courses may be briefly stated.

An application for provisional protection involves less immediate outlay, and thus costs less to an applicant who desires for any reason to abandon his application before the date at which a complete specification becomes due.

The provisional specification is not accessible to the public until the complete specification has been accepted; and if the application for any reason is not completed, it is never open to the public at all. In case an inventor is unable or unwilling to proceed with his application, or is from any cause unwilling to do so, the provisional specification is not published. He is thereby enabled to repeat his application at any subsequent period he may think fit, always provided he has not by his own act rendered a subsequent application invalid by publication, by sale or user, or otherwise, and that between the date of his two applications an application has not been made by another inventor for an invention wholly or partly covering his.

In a provisional specification only a general description of the nature of the invention is required. The inventor has, therefore, time to mature the details of his invention, and is also able without the expense of a disclaimer to leave out of his complete specification any part of his invention which may have been anticipated.

A provisional specification is of use when an inventor (a) wishes to bring his invention into the market at a trifling cost and test its commercial value before patenting it, or (b) is still undecided as to whether he will file applications for letters patent abroad, or (c) desires to have before him the exhaustive report of the Patent Office Examiner in the United States in determining what to claim in his complete specification, or (d) through fear of anticipation desires to secure an early date for an invention the details of which he has not had time to mature.

Only one invention may be comprised in a patent (f), but it is not competent for any person in an action or other proceeding to take any objection to a patent upon this ground when the specifications have been passed by the examiner.

When a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept

(f) See, e.g., *Hearson's Application* (1884), Griff. P. C. 265. (1885), Griff. P. C. 266; *Jones' Patent*

Only one
invention in
patent.

such application, amend it so as to apply to one invention only, and may make application for separate patents for each such invention accordingly. Every such application bears the date of the first application, unless the comptroller otherwise orders, when the later applications may bear date on the days they are actually made.

A provisional specification, on the other hand, protects an applicant merely against the objection that his invention has been anticipated by his own publication and use of it before letters patent have been granted to him. It gives him none of the rights of a patentee. He cannot prosecute infringers unless and until he has obtained a patent, and even then an action will not lie in respect of any infringement committed before the date of the publication of the complete specification; nor can he obtain an injunction in respect of past Acts, though these may be treated as evidence of intention to infringe in future, and so be used if an action is brought to protect the patent when granted.

Advantages of complete specification in first instance.

But after the acceptance of the complete specification, and until the date of sealing or the expiration of the time for sealing the patent, the applicant has all the privileges of a patentee except an immediate right to institute legal proceedings, and the right to use the words "patent," "patented" (cf. below, pp. 656, 657).

Infringements committed after the acceptance of the complete specification are actionable; and an action may be brought whenever a patent has been sealed.

The mode of procedure by filing a provisional specification, although less expensive in the first instance, ultimately costs a little more than that by filing a complete specification at once, as two specifications have to be drawn. The stamp fees are the same in each case, 1*l.* being upon the application form and 3*l.* upon the complete specification. There is no stamp on the provisional.

A complete specification may with advantage be filed at once by an applicant whose invention is fully matured, who is anxious to put it on the market at once and to secure himself from infringement, and who has decided for what foreign patents to apply.

Upon the application being left at the Patent Office, the applicant gets an official receipt, bearing the date of application and a number, which become the date and the number of the patent itself when ultimately granted. The specifications when filed have to be in duplicate.

Procedure at the Patent Office. Date and number of application.

Communica-
tions through
post.

Papers may be transmitted to the Patent Office through the post by prepaid letter.

The application and all subsequent stages are advertised in the Illustrated Official Journal.

Each application is numbered in the order of its receipt, the numbers beginning with 1 at the commencement of every year. Applications of the same date are co-equal as to priority irrespective of the number.

First re-
ference to
examiner.
Examiner's
report.

Every application is referred by the comptroller to an examiner, who ascertains and reports to him whether—(1) the nature of the invention has been fairly described; (2) the application, specification, and drawings, if any, have been prepared in the prescribed manner; (3) the title sufficiently indicates the subject-matter of the invention; and (4) whether the specification describes more than one invention.

No report as
to novelty or
utility.

These are the only points which the examiner has to ascertain. He is neither required nor entitled to pronounce upon the novelty or utility of the invention as described in the specification. His report is not binding on the comptroller (*g*).

Refusal of
patent.

The comptroller-general, however, may refuse to grant a patent for any invention of which the use would, in his opinion, be contrary to law or morality, and from such refusal no appeal is provided.

Amendment
required.

If the examiner report against the applicant upon any of the points mentioned above, the comptroller-general may require that the application, specification, or drawings be amended before he proceeds with the application.

Against this decision the applicant may appeal to the law officer, whose judgment is final. The fee payable for such an appeal is 3*l.* on Form T, Patents Rules, 1890 (*h*).

Acceptance
of applica-
tion, &c.

If the examiner report in the affirmative upon each of the issues submitted to him, the application is accepted, and notice of such acceptance is given to the applicant. The number of the

Former
notices of in-
terference.

(*g*) *Re C.'s Application* (1890), 7 R. P. C. 250.

(*h*) See pp. 710, 817. Before the Act of 1888, if after an application had been made, but before a patent had been sealed, an application was made accompanied by a specification bearing the same or a similar title, it was the duty of the examiner to report to the comptroller whether the specification appeared to him to comprise the same

invention. If the examiner reported in the affirmative, the comptroller was required to give notice to the applicants that the examiner had so reported and thereafter might refuse to seal a patent to the second applicant. This refusal was liable to be appealed against to the law officer upon the usual terms. The Act of 1888 abolished these "notices of interference" as they were called.

application and the name of the applicant are advertised in the Illustrated Official Journal (i).

Advertisement of application.

Subsequent procedure varies according as a provisional or complete specification is left in first instance by the applicant.

When provisional specification left in first instance.

An applicant who has filed a provisional specification only must, within nine months (k) from the date of his application, deposit

Filing of complete specification subsequently.

at the Patent Office a complete specification particularly describing (a) the nature of the invention and (b) the best method

known to the inventor of carrying it out, and ending with a distinct statement of the invention claimed. The comptroller

Extension of time.

has power to extend for one month, but no longer, the time for filing the complete specification, if he is satisfied that the delay

required is reasonable. The fee payable for such extension is 2*l*.

Joint applicants may file a specification agreed upon between themselves, as the comptroller cannot accept two specifications

with different words as the same application (l).

Unless a complete specification is left within the prescribed or extended time, the application is deemed to be abandoned.

Abandoned application.

A list of the numbers of abandoned applications is published monthly in the Illustrated Official Journal.

A complete specification filed by an applicant who has already obtained provisional protection bears a stamp duty of 3*l*. It is

The complete specification.

filed in duplicate, and is at once referred by the comptroller to an examiner, in order to be compared with the provisional

specification. If the examiner report that the complete specification (1) does not fairly describe the invention, (2) does not terminate with a

Report of examiner.

distinct claim or claims, (3) claims more than one invention, or (4) is substantially larger than that contained in the pro-

visional, the comptroller may refuse to accept it unless and until amended to his satisfaction.

Amendment required.

From such a refusal the applicant may, on payment of a fee of 3*l*., appeal to the law officer, who may reverse or vary the order of the comptroller, and whose decision is final.

Unless a complete specification is accepted within twelve months from the date of application (save in the case of an

Complete specification must be accepted in twelve months.

(i) In case of any alteration in the title of the application it is again advertised in full.

(k) Calendar months reckoned exclusive of the day of application: *Keser v Ledsam* (1845), 14 M. & W.

574; 14 L. J. Ex. 353; *Williams v. Nash* (1859), 28 Beav. 93; 28 L. J. Ch. 886.

(l) Application of *Apostoloff and Freudenberg* (1896), 13 R. P. C. 275.

appeal having been lodged against the refusal to accept) the application becomes void.

Extension of time.

The comptroller may, however, enlarge the time for a period not exceeding three months on payment of fees of 2*l.*, 4*l.*, or 6*l.*, according as the period does not exceed one, two, or three months.

Examination of claims.

Provided the specification ends with a statement of the invention claimed distinct from the description of the invention, 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. There must be a real statement of the invention claimed; and if there is such a statement, it is not competent for the Patent Office to inquire whether it goes beyond or is in conformity with the description of the invention.

When provisional specification not filed.

When an application is accompanied with a complete specification in the first instance, the necessary documents and drawings must be filed, and the full fee of 4*l.* is payable at once, being 1*l.* on the application and 3*l.* on the complete specification.

Acceptance of complete specification.

When the complete specification, whether filed alone in the first instance or in pursuance of a previous provisional specification, has been accepted, the comptroller at once advertises the acceptance, and hands it to the Queen's printers for publication. The specification is usually printed within three weeks from the date of acceptance; and as a patent is not sealed until after the expiration of two months from the publication of the acceptance of the complete specification, there is ample time for inspection and if need be opposition by the public.

Specification printed.

Inspection.

The duplicates of the complete specification and the provisional (if any) and the application are open to public inspection from the date of the advertisement of the acceptance of the complete specification.

Printed copies of complete specifications may be purchased at the Patent Office Sale Branch in Quality Court at the uniform price of 8*d.* These can also be obtained by forwarding through the post patent form C1—*i.e.*, a post-card obtainable at the money order offices, price 8½*d.* each.

Sealing.

The patent, if unopposed, is sealed about ten weeks after the acceptance of the complete specification.

Opposition:

Within two months after the advertisement of the acceptance of a complete specification, any person may oppose the grant of a patent on any one or more of the following grounds:—

(1) That the applicant had obtained the invention from the opponent, or from some person of whom he is the legal representative ;

(2) That the invention had been patented in this country on an application of prior date ;

(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 and the leaving of the complete specification, but on no other ground.

The rules and practice relating to opposition may be shortly stated as follows :—

Grounds of.
Notice of
opposition.

Having settled the ground of his opposition, an opponent should fill in the proper form, Form D, Patents Rules, 1890 (*m*), which may be obtained at the Patent Office, and which should be signed by himself.

A notice of opposition must state the grounds on which the person giving it intends to oppose the grant of a patent and the opponent's address for service in the United Kingdom.

If one of the grounds of opposition is that the invention has been patented in this country on a prior application, the title, numbers, and date of the patent so granted must be specified in the notice. A notice of opposition bears a stamp of 10s.

Any person may oppose before the comptroller-general, but only persons having a special interest in the patent will be heard on an appeal to the law officer.

Who may
oppose.

On receiving notice of opposition, the comptroller forwards a copy of the notice to the applicant.

Procedure.

Within fourteen days after the expiration of two months from the advertisement of the acceptance of the complete specification, an opponent may file statutory declarations in support of his opposition, and must deliver to the applicant a list thereof.

Statutory
declarations.

Within fourteen days from the delivery of such list, the applicant may leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent may file statutory declarations in reply, giving the applicant a list of such declarations as before.

No further evidence may be left on either side except by leave

Further
evidence.

(*m*) Appendix, *post*, p. 809.

of the comptroller, or by written consent of the parties duly notified to him.

The comptroller's leave will not be obtained unless he is satisfied that the further evidence it is desired to leave was not reasonably obtainable, or was not within the knowledge of the party within the time previously allowed.

The comptroller has power to extend the times above mentioned on such terms as he thinks fit.

The hearing.

On the completion of the evidence the comptroller, on the application of either party, appoints a time for the hearing of the case, and gives the parties seven days' notice of such appointment.

Each party has to pay a fee of 1*l.* for the hearing.

The comptroller has no power to allow costs.

Comptroller's decision.

The comptroller's decision is given in writing, is duly notified by him to the parties, and may be appealed against to one of the law officers.

Appeal to law officer.

Any person intending to appeal (n) to the law officer must file in the Patent Office a notice of such intention within fourteen days from the date of the decision appealed against, or within such further time as the comptroller may allow.

Such notice states the nature of the decision appealed against and also whether the appeal is from the whole or a part, and so what part, of such decision.

A copy of the notice of appeal must be sent by the appellant to the law officer's clerk at Room 549, Royal Courts of Justice, London, and also to the respondent. Upon notice of appeal being filed, the comptroller transmits all the necessary papers to the law officer's clerk, who gives at least seven days' notice to the parties of the time and place appointed for the hearing of the appeal.

Evidence.

The evidence used on appeal to the law officer is the same as that used at the hearing before the comptroller.

Further evidence.

No further evidence may be given (save as to matters which have occurred or come to the knowledge of either party after the date of the decision appealed against), except with the law officer's leave upon application for that purpose.

Cross-examination of declarants.

The law officer is required, at the request of either party, to order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration

(n) See Form T, *post*, p. 817.

in the matter to which the appeal relates, unless, in his opinion, there is good ground for not making such order.

When such an order is desired, a list of the persons whose attendance is required should be left with the law officer's clerk, with a request for an order; and copies of the list and the request should be sent to the other side. Any person requiring the attendance of a witness for cross-examination must tender to such witness a reasonable sum for conduct-money.

Conduct-money.

The law officer, in making an order as to costs, may either fix the amount or direct by whom and in what manner the amount of such costs shall be ascertained.

Costs.

If the law officer's order as to costs be not complied with in the time fixed therein, or within fourteen days after the amount has been fixed or ascertained, the party to whom such costs are to be paid may apply to the law officer for an order for payment. To enforce this order it may be made a rule of the High Court of Justice, when the processes of execution to enforce orders of the High Court are available.

Enforcement of order for costs.

Any notice or other document required to be given to the law officer's clerk may be sent by a prepaid letter through the post.

The fee payable by an appellant from the comptroller to the law officer is . . .

If no opposition be entered, or if opposition, though entered, be successfully met, the comptroller will cause a patent to be sealed with the seal of the Patent Office, and dated as of the day of the original application.

Sealing of the patent.

The term of a patent is fourteen years from its date.

Every patent, when sealed, has effect throughout the United Kingdom and the Isle of Man.

The patent must issue within fifteen months from the date of application. To this rule there are three exceptions:

Delay in sealing patent.

(1) When the sealing is delayed by an appeal to the law officer or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(2) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the original applicant.

(3) If the comptroller has allowed an extension of time for the leaving or acceptance of the complete specification, he may allow a further extension of time equal to the sum of the extensions

allowed in leaving and accepting the complete specifications after the said fifteen months for the sealing of the patent.

Renewal fees.

The privilege granted by a patent under the Act of 1883 will expire at the end of four years, unless a certificate of renewal has been obtained, and certain fees paid (o).

A patent ceases if the patentee fails to make the prescribed payment within the prescribed times.

Enlargement of time for payment of renewal fees.

If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of time.

The comptroller shall if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee (p) for enlargement not exceeding 10*l.*, enlarge the time accordingly, subject to the following conditions:—

(a) The time for making any payment shall not be enlarged for more than three months.

Infringement.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

In case the last day for paying one of the prescribed fees should fall on Christmas Day, Good Friday, or on a Saturday, or on a day observed as a holiday at the Bank of England or as a public fast or thanksgiving day, the fee may be paid on the day next following.

Loss of patent.

If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed on payment of a fee of 2*l.*

Amendment of specification, &c.

Specifications and drawings may be amended by way of disclaimer, correction, or explanation. Shortly stated, the practice is as follows:—

The applicant leaves at the Patent Office a written request

(o) See *post*, p. 711.

(p) The fees at present prescribed are—

For an enlargement not exceeding 1 month	£ 1
" " " 2 months.....	3
" " " 3 months.....	5

Form F, Patents Rules, 1890 (*q*), stating the nature of the proposed amendment and his reasons for the same. The Patent Office fee is 1*l.* 10*s.* or 3*l.*, according as the application to amend is made before or after the sealing of the patent.

The request and the proposed amendment are advertised in the Official Journal (*r*). Any person may give notice at the Patent Office of opposition to the amendment. Such notice should be in Form G, Patents Rules, 1890 (*s*), and bears a stamp of 10*s.* The comptroller gives notice of the opposition to the applicant, and hears and decides the case, subject to an appeal to the law officer, whose decision is final. Only an interested party will be heard in opposition before the law officer.

Where notice of opposition is not given or is not prosecuted, the comptroller determines whether the proposed amendment should be allowed. The decision of the comptroller may be appealed against to the law officer, as before.

No amendment will be allowed that materially enlarges the scope of the invention originally claimed.

Clerical errors can be amended at any time. The application is made on Form P, Patents Rules, 1890 (*t*).

(*q*) See Appendix, p. 810.

(*r*) The fee for correction of a clerical error is 5*s.* up to, and 1*l.* after, the seal-

ing of the patent.

(*s*) See Appendix, p. 810.

(*t*) See Appendix, p. 815.

CHAPTER VI.

SPECIFICATION OF AN INVENTION.

SECT. 1. ORIGIN AND DEVELOPMENT OF SPECIFICATION.

SECT. 2. THE TITLE.

SECT. 3. PROVISIONAL SPECIFICATION.

SECT. 4. COMPLETE SPECIFICATION AND CLAIMS.

(1) *Sufficiency of Complete Specification.*(2) *The Claims.*(3) *The Drawings.*

SECT. 5. CONSTRUCTION OF COMPLETE SPECIFICATION.

SECT. 1.—ORIGIN AND DEVELOPMENT OF SPECIFICATION.

Specification
the con-
sideration for
the grant.

THE instruction of the public in the manufacture or exercise of a patented invention has always been considered part of the motive or policy of the grant, and different means of attaining this object have been adopted at different stages in the history of patent law. The earliest practice, and that to which Lord Coke refers, was to insert in the grant a proviso requiring the inventor and his assignee to take apprentices during the last seven years of the term, and to teach them "the knowledge and mystery" of his invention (a).

Formerly no
specification.

There was, however, no obligation upon a patentee to define clearly the objects to which his patent extended, and the public at once were exposed to the danger of unconsciously infringing the privilege, and had no security for acquiring the invention on the expiration of the patent (b). The only indications to the public of the scope of the invention were the short recitals in the letters patent themselves. And there is little doubt that a patent

(a) See 1 Web. P. C. p. 36, Buck's invention.

(b) "It must, however, be remembered that though at common law no instrument was required to be enrolled, it was nevertheless necessary that the

party should be in possession of a mode of putting his invention into practice, for otherwise the patent would be void for false suggestion and failure of consideration" (Web. P. C. p. 8, n.).

without such a recital, and also without a condition requiring a specification or description of the invention in some way or other for the use of the public, would have been absolutely void for want of consideration (c).

The description of inventions which were formerly contained in patents was, however, very meagre and unsatisfactory (d), and the old practice being found inconvenient, it became the custom, near the end of the reign of Queen Anne, to insert a proviso into all patents, obliging the patentee within a given time after the date of his grant to "particularly describe and ascertain the nature of his invention, and in what manner the same is to be performed," by an instrument under his hand and seal called a "specification," and to enrol the said specification in the Court of Chancery. The authority by which this clause was introduced does not appear, and was not, at any rate, parliamentary. The idea was probably suggested either by the Attorney- or Solicitor-General of the day (e), or else by some patentee anxious to state clearly the ambit of the invention, and secure his full rights. According to Webster (f), the earliest patent containing the proviso for a specification was that granted October 3rd, 1711 (g), to John Nasmyth. The specification or description of a patented invention by instrument enrolled is not required neither by the common law nor by the Statute of Monopolies, but is only a condition or proviso which is contained in the patent itself.

Introduction of proviso for specification.

Nasmyth's patent, October 3rd, 1711.

After the grant of the patent, with the proviso as above, the enrolment of the specification could not be dispensed with except by Act of Parliament. Such an Act was passed in 1813 (53 Geo. III. c. 179), in the case of James Lee, who had obtained patents in 1812 for certain new methods of preparing hemp and flax, with provisos for the enrolment of specifications within

James Lee's Patent Act, 1813.

(c) Hindmarch, p. 151.

(d) See the form of grant, p. 667.

(e) Report, &c., 1829; Web. Letts. Pat. p. 6, n. (o). It is to be observed that some years before this a duty upon all parchment writings was granted to the Crown. It may be that the obtaining of an extra duty upon the specification was one of the objects in view when provision was made for the enrolment of a separate deed of specification. See the memorandum at end of Nasmyth's Specification, A.D. 1711, No. 387.

(f) 1 P. C. p. 36, n. (c).

(g) An inspection of the specifications at the Patent Office bears out Webster's statement. The date of enrolment of the specification was the 1st April, 1712, as appears from the printed specification, No. 387, A.D. 1711. Nasmyth's case was not, however, consistently followed at first, but very soon it became usual to insert the proviso for enrolment of a specification in all cases. The specification in Nasmyth's case was extremely short, being only a few lines, not more than the recital of the invention in the letters patent usual at the time.

fifteen months of their dates respectively. An Act of Parliament was obtained dispensing with these provisoes and substituting others, on the ground that if the specifications should be enrolled in the usual manner, foreign agents might obtain copies of them and send them abroad (*h*).

Lord Eldon
on Lee's
Patent Act.

Referring to this case (*i*), Lord Eldon said that it was a very peculiar one, the Act being intended to secure to the State in time of war the benefit of a most important discovery, and added that, in his opinion, the Legislature would pause a long time before they passed such an Act in future.

(*h*) The substituted conditions are of some interest. The patentee was required by the Act, instead of enrolling his specification, to deliver the same to the Lord Chancellor within fifteen months from the date of the first patent, with an affidavit that the whole of the invention and the method of using the same was therein described. The specification and affidavit were then to be enclosed in a cover, under the seal of the Lord Chancellor, and lodged in the office of one of the Masters of Chancery, to be nominated by the Lord Chancellor, and were to be preserved by that master (sect. 1). The said packet was not to be removed from the custody of the said Master on any pretence, except by order of the Lord Chancellor, who was empowered to call for and open the same whenever it might be necessary on account of applications for patents for inventions of a similar nature, or on account of any trial at law; and after such use being made, the packet was to be sealed up again and deposited with the Master as before (sect. 2). Two copies of the said specification, with affidavits by the patentee that they were true copies, were to be delivered under cover, sealed by the patentee, one to the Lord Chancellor of Ireland (who was required to deposit the same in the custody of one of the Masters of Chancery in Ireland) and the other to the Lord Chief Baron of the Exchequer in Scotland (to be deposited by him in the custody of the King's Remembrancer in the Exchequer in Scotland) (sect. 3). The said packets so deposited were to be kept and might be opened and examined, when necessary, by the Lord Chancellor in Ireland and the Lord Chief Baron in Scotland, and then sealed up again and deposited as before (sect. 4). The several packets so deposited were to be kept as afore-

said until the expiration of seven years from the passing of the Act, and were then to be enrolled by the persons having custody of the same and by the patentee or his executors, administrators, or assignees, in the Courts of Chancery in England, Scotland, and Ireland, as directed by the patents respectively (sect. 5). The delivery of the said specifications and the enrolment thereof within four months after the expiration of the seven years aforesaid were to be deemed an effectual fulfilment of the provisoes in the patents (sect. 6). A doquet, or abstract, of the said several letters patent, containing the date and the words in which the invention is therein described, was, within four months from the passing of the Act, to be enrolled in place of the specifications (sect. 7). In case a specification of the invention was not duly enrolled, in pursuance of each patent, within four months after the said term of seven years from the passing of the Act, the patent was to become void (sect. 8). Cf. Report, &c., 1829. "Mr. Lee's invention was tried on a large scale, but did not prove successful; it was intended to prepare flax for spinning, without previous dew-rotting or water-rotting." Cf. Booth's Act, 1793 (32 Geo. III. c. 73). Booth intended to operate by machinery upon a tissue or web of carded wool, so as to interlace or entangle, and felt the fibres together, and thus form cloth, or rather felt, without the previous operation of spinning and weaving. Booth's invention was tried on a large scale at Taunton, also near Salisbury, and again at Merton, near London, but without success, the felt not having any of the strength and durability of woollen cloth (Report, &c., 1829).

(*i*) *In re Lacy*, Web. P. C. 491.

No private Act of the same kind appears to have passed subsequently (*k*). Applications to the Lord Chancellor to dispense with the enrolment of the specifications of letters patent were frequently made, but without success. Thus, in *Ex parte Koops* (*l*), a petition that the enrolment might be dispensed with, or some provision made for preventing the specification being made public, on the ground that foreigners would obtain the invention, was dismissed. In pronouncing judgment, Lord Eldon said: "As to the worth of the apprehension suggested, a man has nothing more to do than to pirate your invention in a single instance, and he will then force you to bring an action, and then the specification must be produced. But with regard to the King's subjects a very strong objection occurs, which makes it necessary that the specification should be capable of being produced. They have a right to apply to the Patent Office to see the specification, that they may not throw away their time and labour, perhaps at a great expense, upon an invention upon which the patentee might afterwards come with his specification, alleging an infringement of his patent, when, if those persons had seen the specification, they never would have engaged in their project. The enrolment is, therefore, for the benefit of the public."

Endeavours
to avoid
enrolment of
specification.

Specifications were formerly framed in the manner usual with deeds-poll, commencing "To all to whom these presents shall come," &c. Forms are given in the Appendix (*m*).

The old method of enrolling specifications and the law applicable thereto were found, for many reasons, to be objectionable. Amongst these were—(1) the difficulty of preserving inventions from foreign piracy (*n*); (2) the difficulty of search (*o*).

(*k*) In *Ex parte Koops* (1802), 6 Ves. 595, Lord Eldon said: "Either upon this or some other case in the last session a clause for this purpose (in dispensing with the enrolment of a specification) was inserted in an Act of Parliament, and upon the motion of Lord Thurlow, upon reasons applying not only to that, but to all cases, and seconded by Lord Rosslyn, the clause was universally rejected, and rejected, as it appeared to me, upon very substantial grounds, in which I readily concur."

(*l*) (1802), 6 Ves. 595.

(*m*) 818-820 *post*.

(*n*) This led, about 1819, to the introduction of a Bill into the House of Commons for concealing the specifications of all inventions for which patents

were granted in order that they might not be sent abroad. It was thrown out. A few years later (1822) a petition was presented to the House of Commons praying for some amendments in the law relative to patents for inventions, and a Bill was brought in for that purpose. One of its principal provisions was to give security to the inventor from the time of his first application for a patent during a certain time allowed for making experiments before the date of the patent. This measure, however, was lost on the second reading. See Act of 1833, sect. 44. See Appendix, p. 179 of the Report, &c., 1829.

(*o*) Specifications were originally enrolled in the Enrolment Office, the Rolls

Provisional protection under Act of 1852.

Provisional specification.

Complete specification.

Provisional protection and specifications under Patents Acts, 1883—1888.

The Patent Law Amendment Act, 1852, which adopted a practice in force in several Continental countries, strongly recommended by most of the witnesses who gave evidence before the Committees of 1829 and 1851, provided that a petition for the grant of letters patent should be accompanied by a statement in writing describing the nature of the invention which it was sought to patent; this statement was called the provisional specification (*p*). The effect of the procedure prescribed by the Act was, that a patentee might use his invention for six months without prejudice to his patent by that user, but he obtained no rights against the public until his patent had been sealed, and even then the patent would not relate back to acts done in the interval. The patentee was only protected against the consequences of his own publication, and then might employ workmen and obtain machinery without the risk of being betrayed (*q*).

In lieu of a provisional specification, an inventor was empowered to deposit in the first instance an instrument in writing under his hand and seal, called a complete specification, particularly describing and ascertaining the nature of his invention and in what manner it was to be performed. The effect of such deposit was to protect the invention for a period of six months from the date of the application, and to give the applicant during such period the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention, duly sealed as of the day of the date of such application (*r*).

Under the Patents Acts, 1883—1888, substantially the same procedure prevails, except that (1) the provisional protection extends not, as before, for a term of six months from the date of

Chapel, or the Petty Bag Office, at the option of the grantee, and could thus be discovered and inspected by the public only after laborious searches. The statutes 11 & 12 Vict. c. 94, s. 14, and 12 & 13 Vict. c. 109, s. 15, which directed their enrolment in the Enrolment Office of the Court of Chancery alone, left the evil without a remedy so far as former specifications were concerned. Again, a patentee was not obliged to enrol his specification for a certain time, usually six months, after obtaining his patent. The result was well stated by a witness in his evidence before the Committee of 1851: "A man gets hold of an idea; he runs immediately to the

Patent Office before he has made any attempt to perfect his process. He gets a protection for six months, and he goes about examining every publication connected with the particular and getting all the information he can; and when the time for delivering in his specification comes he has entirely altered the original view he entertained."

(*p*) Act of 1852, sect. 6.

(*q*) *Ibid.* sect. 8; and see *Ex parte Bates and Redgate*, L. R. 4 Ch. 573; 58 L. J. Ch. 501 (per Lord Hatherley, L. C.).

(*r*) Patent Law Amendment Act, 1852, sect. 9.

application, but for the period between the date of application and the date of sealing (s), and (2) that if the applicant does not leave a complete specification in the first instance he may leave it at any subsequent time within nine months from the date of application (t), or within such extended time, not exceeding one month, after the said nine months, as the comptroller may, on payment of the prescribed fee, allow (u).

Under the Act of 1885 (x) it is provided that where an application for a patent has been abandoned or become void the specification or specifications and drawings (if any) accompanying or left in connection with such application shall not at any time be open to public inspection, or be published by the comptroller. All the provisional specifications under the Act of 1852 were published.

Provisional specifications of abandoned application now secret.

SECT. 2.—THE TITLE.

It is the function of a title to disclose in general terms the subject-matter of the invention. Formerly, when no provisional specification was filed, and when the patent was granted subject to the filing in future of a complete specification, the accuracy of a title was a matter of great importance. It fulfilled to a large extent the function of a provisional specification, and conformity between it and the invention as subsequently disclosed was dangerous, and often fatal to the patent.

Function of the title.

Since 1852, and especially since the present Act has been in force, the importance of the title has much diminished. It is still required, but (*semble*) its absence does not invalidate the patent (y). As an indication to those searching and for catalogue purposes it is still of use. It is also sometimes of assistance towards the construction of a doubtfully worded claim. But it will no longer be construed with the severity at one time usual.

Title no longer of great importance.

Even before 1852 the degree of variance between title and the disclosed invention which would invalidate a patent was a matter of fact, and not of law; and, as happens in questions of fact, no rule of anything like universal application can be deduced. The decisions, viewed as legal decisions, are diverse and not easily reconcilable.

(s) Act of 1883, sect. 14.

(t) 1883, sect. 8 (1).

(u) 1885, sect. 3.

(x) Sect. 4.

(y) *Siddell v. Vickers* (1890), 15 A. C. 498; 50 L. J. Ch. 105; 7 R. P. C. 292.

Report of
examiner on
title.

Under the Patents Act, 1883 (sect. 6), the duty is imposed upon the official examiner (to whom an application for letters patent is referred) of ascertaining and reporting upon the sufficiency of the title; and if his report is adverse, the comptroller-general may refuse the application, subject to appeal to the law officer, whose decision is final, unless and until it is amended (z) to his satisfaction.

Insufficiency
semble, a
ground for
refusing a
patent.

In *Newall v. Elliott* (a), Pollock, C. B., stated that he had when Attorney-General refused an application for a patent for "an improvement in locomotion" on the ground that the title was too general. In *Cook v. Pearce* (b), a patent had been taken out "for improvements in carriages," and the invention consisted in an improvement in pinion shutters which could only be used in some kinds of carriages. The title was held by the Exchequer Chamber to be sufficient. But Tindal, C. J., who delivered the judgment of the Court, observed that an objection to such a title might well have been taken on the part of the Crown before it granted a patent for the invention.

These cases, although somewhat old, may be taken as examples of the kind of title to which objection may be taken by the examiners.

Brown's
patent.

A more recent case is *Brown's Patent* (c). Application was made for a patent, the specification being intituled "Improvements in casks and tubs;" the complete specification stated that the invention was applicable to "barrels or other casks, and also to tubs and analogous vessels in which the staves are formed with a cross or groove for receiving the head or bottom." The comptroller-general refused to accept the specification unless the words "and analogous vessels" were added to the title or omitted from the specification, on the ground that the title did not, in view of the words "and analogous vessels" in the specification, sufficiently indicate the subject-matter of the invention. Webster, A.-G., reversed this, basing his decision on the construction of the document before him. He added: "The patentee is entitled to frame his title in his own way provided he does not infringe the rules of the statute, and I think, having regard to the narrow nature of the claims, the present title is

A patentee
may frame
his title in his
own way if he
do not in-
fringe statu-
tory rules.

(z) 1883, sect. 2.

(a) (1864) 13 W. R. 15.

(b) (1844) 8 Q. B. 1054; 13 L. J. Q. B. 189. Cf. *Sturtz v. De la Rue* (1828), 1 W. P. C. 83; 5 Russ. 322; *Nickels v. Haslam* (1844), 13 L. J. C. P. 146; 8

Scott, N. R. 97; *Beard v. Egerton* (1846), 3 C. B. 97; 15 L. J. C. P. 270; *Hills v. London Gaslight Co.* (1860), 5 H. & N. 312; 29 L. J. Ex. 409.

(c) (1887) Griff. A. P. C. 1.

sufficient. It must, of course, be distinctly understood that I express no opinion as to whether, if the specification comes to be litigated, he can claim anything more than that which is covered by his title and claims, but he has elected to stand upon his title, and his claim being thus specific, I think the title sufficient."

In view of the power to require and admit amendments vested in the comptroller-general by sect. 7 of the present Act, it is improbable that many applications for letters patent will be finally rejected for defects in the title. But an inventor may still bring upon himself considerable trouble and delay by failure to frame his title with care.

If he has devised too narrow a title, he may find that his claims are construed much more rigidly than he intended when he drew the specification and applied for the patent. This is the danger to which the law officer drew attention in the case last quoted. If the title be so large or indefinite as to be calculated to deceive, the examiners will refuse to pass it.

The title of an invention ought accurately to describe the nature of it, and should neither be so large as to include anything more than the patentee has actually invented, nor so narrow as to exclude any part of the invention (*d*). But mere generality in the terms of a title, if the description was not in any respect inaccurate, was formerly held to be no ground for avoiding a patent already granted (*e*). And the generality of words in a title may be restricted by the specification (*f*).

Title must describe nature of invention.

Mere generality not fatal to patent.

Insufficiency in the title is not a ground of opposition (*g*).

In view of the present state of the law, the old authorities are not of the greatest importance, but for reference' sake the chief are appended:—

Cochrane v. Smethurst (*h*).—A patent had been granted for "a method or methods of more completely lighting cities, towns, and villages." The invention consisted in improvements in street lamps. The title was held to be too large.

Campion v. Benyon (*i*).—A patent had been obtained for "a new and improved method of making and manufacturing double canvas and sailcloth with hemp and flax without any starch

(*d*) Hindmarch, p. 43.

(*e*) *Cook v. Pearce* (1844), per Tindal, C. J., 8 Q. B. 1004; 13 L. J. Q. B. 189.

(*f*) *Hornblower v. Boulton* (1799), Dav. P. C. 230; 8 T. R. 95; *Newton v. Vaucher* (1851), 21 L. J. Ex. 305;

6 Ex. 866; *Lister v. Norton* (1896), 3 R. P. C. 199, 203.

(*g*) 1883, sect. 11; 1888, sect. 4.

(*h*) (1816) Dav. P. C. 354.

(*i*) (1821) 6 B. Moo. 71; *Brunton v. Hawkes* (1821), 4 B. & Ald. 541.

whatever," and it appeared that sailcloth had been made without starch before. It was held that the title was too large, as it embraced more than the patentee had actually discovered.

Bloxam v. Elsee (k).—An action for the infringement of two patents for "an invention of making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide and from one to forty-five feet and upwards in length." It appeared, however, that the machine described in the specification would work to one width only. It was held by the Court of King's Bench that the consideration for the grant was the invention of a machine for making paper in sheets of width and length varying within the limits designated, and that there had been a failure in a material part of the patentee's representation.

Bainbridge v. Wigley (l).—The title of the patent was "Certain improvements in the flageolet or English flute, whereby the fingering will be rendered more easy, and notes produced that were never before produced." At the trial it appeared that, while the instrument was a great improvement, only one new note was produced. Lord Ellenborough held that there was a failure of the consideration for the patent, which was fatal to the grant.

Cases.

Neilson v. Harford (m).—The title of a patent was "An invention for the improved application of air to produce heat in fires, forges, and furnaces where bellows and other blowing apparatus are required." The invention consisted in passing the air from the blowing apparatus into an artificially heated receptacle, and then into the furnace. It was objected, on the trial of an action for the infringement of this patent, that it was doubtful whether the patent was for the invention of the application of hot air or only for an improved mode of applying hot air. Upon this question coming before the Court of Exchequer, it was held that, although the title of the patent was ambiguous, it was sufficiently explained by the specification, and was not at variance with it, as was the case in *R. v. Wheeler*.

R. v. Wheeler (n) was a *scire facias* for the repeal of letters patent "for a new and improved method of drying and preparing malt." In the specification, the patentee claimed to be the inventor, not of a method of drying or preparing malt, but of a

(k) (1825) 6 B. & C. 169, 178; cp. *Fellon v. Greaves* (1829), 3 C. & P. 611.

(l) (1810) Parl. Rep. 1829, 197; 1 Carp. P. C. 270.

(m) (1841) 8 M. & W. 806; 1 W. P. R. 331; cp. *Beard v. Egerton* (1846), 3 C. B. 97; 15 L. J. C. P. 270.

(n) (1819) 2 B. & Ald. 345.

method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree, viz., the qualities of being soluble in water and colouring the liquor in which it should be dissolved, which latter was the object in view. This was to be effected by a second and additional process: the application of a very high degree of heat. It was held by the Court of King's Bench that the invention mentioned in the specification was so entirely different from that mentioned in the patent as that the latter remained wholly undescribed and unspecified.

Variance between title and specification.

In *Rex v. Metcalf (o)*, another *scire facias*, the defendant had obtained a patent for the manufacture of hair-brushes which were described as "tapering." The specification described a method of making brushes in which the bristles would be of unequal length. Lord Ellenborough said: "If the word 'tapering' be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be used in its perverted sense." No such evidence having been given, Lord Ellenborough directed the jury to find that it was not a *tapering*, but only an unequal, brush, and there was a verdict for the Crown.

In *Fisher v. Dewick (p)*, tried before Coltman, J., the patent was for improvements in machinery for making bobbin net-lace. Sir John Campbell, for the defendant, objected that the title misdescribed the subject-matter, the invention being only for making a spot during a particular part in the process, and being useless where that addition was not wanted; and he said the title should have been, "for a mode of making spots in bobbin net-lace." But the learned Judge said: "Is the invention applicable to anything but the making of bobbin net-lace, and is it not an improvement?" and he overruled the objection, and the Court of Common Pleas supported his ruling, Tindal, C. J., observing that it could not, without great refinement, be said that the invention was not an improvement in the manufacture of bobbin net-lace.

In *Croll v. Edge (q)*, a patent had been granted "for certain improvements in the manufacture of gas for the purpose of

(o) (1817) 1 Web. P. C. 141, n.; 2 Stark. R. 249.

(p) (1838). Not reported on this point, but cited by Pollock, A.-G., in the course

of his argument in *Cook v. Pearce*, 8 Q. B. 1056.

(q) (1847-50) 19 L. J. C. P. 261; 9 C. B. 479, 490, 492.

illumination and in the apparatus used when transmitting and measuring gas." A specification was enrolled in which the words "therein and" were interpolated between "used" and "when." The Court of Common Pleas held that the patent was bad. "The title," said Maule, J., "did not profess to comprehend improvements in any apparatus used in making gas. The patentees, in representing to the Crown the nature of the invention which they had discovered, did not give the Crown notice that they claimed the exclusive use of any apparatus for making gas. . . . When the body of the specification is looked at, one main part of the patentee's claim consists of what may be, and probably is, a new mode of manufacturing clay retorts—an apparatus used in the manufacture, and not in the transmitting and measuring, of gas. . . . No patent at all has been granted to them for that. It seems to us that they have specified for a more extensive and a different patent from that which was granted to them."

In *Orley v. Holden* (*r*), the title of the patent was "for improvements in the doors and sashes of carriages." In his specification the inventor stated: "I have shown my invention as applied to railway carriage doors and window fittings, although equally applicable to the doors and windows of any other carriages, or in any position where windows and doors are subject to jar and vibration." It was objected that the specification claimed more than the patent. But the Court of Common Pleas overruled this objection. "The invention," said Erle, C. J.; "specified and claimed, is truly an improvement in the doors and windows of carriages, not the less because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined accordingly to the doors and windows of carriages."

Amendment
of title.

The amendment of the specification of letters patent is clearly dealt with by Sir Richard Webster, A.-G., in *Dart's Patent* (*s*).

Decisions of
law officer.

Dart's Patent (*s*).—Here the question was, What is the proper course to be adopted where the applicant desires to omit a part of his invention as covered by the original title prior to the

(*r*) (1860) 8 C. B. N. S. 666, 705; 30 L. J. C. P. 68; cp. *Patent Bottle Envelope Co. v. Seymer* (1858), 28 L. J. C. P. 22; 5 C. B. N. S. 164; *Parke v. Stevens* (1869), L. R. 8 Eq. 358; 38 L. J. Ch. *Wright v.* 627; *Hitchcock* (1870), L. R.

5 Ex. 37; 39 L. J. Ex. 97. . . .
(*s*) Griff. P. C. p. 307; cp. *Trans. I. P. A.*, vol. v., pp. 52—56, A. V. Newton. And see *Jones' Patent*, Griff. 313, and generally as to amendment *post*, p. 219.

time that the complete specification has been accepted by the office?

Webster, A.-G., said: "If the applicant merely desires to omit part of the invention described in the original title and provisional specification, I do not see that any amendment of the title and provisional specification is of necessity required, as I think that a proper disclaiming clause might be inserted in the complete, indicating that part only of the invention originally covered by the title of the provisional was intended to be claimed. But should the applicant think that some risk to the validity of his patent might be occasioned by such a course being adopted, it is open to him to lodge a complete, omitting the part desired to be left out, and open to the Patent Office, under the powers of sub-sects. 7 and 9" (of the Patents Act, 1883), "to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain.

"It must, however, be distinctly understood that such an amendment in the title and provisional ought, in my opinion, to be confined to excision only, and not to amendment or other explanation, and the excision must be such as does not extend the scope of the title" (t).

SECT. 3.—PROVISIONAL SPECIFICATION.

The provisional specification was introduced by the Patent Law Amendment Act, 1852, of which sect. 6 required a specification describing the nature of the invention to be left with the petition for letters patent. Origin of.

The specification was then referred to one of the law officers, who, if satisfied as to its sufficiency and formal correctness, certified that the applicant's petition should be allowed, and in due course the desired grant was made.

Under the Act of 1852, it was a condition of the patent grant that the patentee should file within six months a full specification particularly describing and ascertaining the nature of the invention, and in what manner it was to be performed. On the Proviso for filing specification under Act of 1852.

(t) In this case an incidental question arose respecting the payment of a fee required by the Patent Office on *Dart's Application*. Webster, A.-G., said: "The matter is not exactly for me to determine, but in the view which I take

—viz., that this matter ought to be dealt with under sects. 7 and 9, and not under sect. 18—I am of opinion that no fee was properly chargeable as in the case of an application to amend."

patentee's failure to comply with this condition, his letters patent were to become void.

According to this mode of procedure, an inventor received from the Crown the consideration for disclosing his invention before he had fully disclosed it (*u*).

Under the Act of 1883 this process was reversed, and the filing of a complete specification became a condition precedent to the sealing of a patent.

Office of provisional specification under the Act of 1852.

Sect. 6 of the Patent Law Amendment Act, 1852, provided as follows: "There shall be left (at the office of the commissioners) a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the applicant for letters patent, *describing the nature of the invention*;" and sect. 8 made the grant of provisional protection depend upon the law officer "being satisfied that the provisional specification" did accurately "*describe the nature of the invention*" (*x*).

The sufficiency of the provisional specification turned, therefore, upon the meaning which was to be attached to the words in italics.

Law officers' rule.

The following rule of practice was adopted by the law officers: "The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprised of the improvement and of the means by which it is to be carried into effect" (*y*). The rule was stated in similar terms by Smith, L. J., in *Gadd v. Mayor, &c., of Manchester* (*z*).

Scope of provisional specification.

The scope of the provisional specification has been clearly defined in several leading cases; and though the statute under which the points arose is now repealed, yet the Act of 1883 (sect. 5, sub-sect. 3) has on this matter practically re-enacted it. The following is still good law: "The office of the provisional specification is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out, otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and

(*u*) See Transactions of the Inst. of Pat. Agents, vol. iv., p. 155, G. G. M. Hardingham.

(*x*) This the law officer certified by a "certificate of allowance."

(*y*) There is an interesting discussion on the effect of this rule upon the statu-

tory provisions in the Transactions of the Inst. of Pat. Agents (vol. i., pp. 68 *et seq.*, W. Spence).

(*z*) (1892) 9 R. P. C. 516, 529, and see the judgment of Kekewich, J. (reversed on the facts) at 9 R. P. C. 259 *et seq.*

deliberation" (a). This dictum is regarded by Kay, J., as the leading dictum upon this part of patent law (b).

In a subsequent case between the same parties (*Newall v. Elliott* (c)), Pollock, C. B., expressed himself more fully to the same effect:

"The object of the statute, which requires a provisional specification, is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for the patent, to give some notion of what his invention is. That has been followed up by an Act of Parliament requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and to make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance. . . . I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention, so as to enable the Attorney-General, and in fact to enable a jury, ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification."

Channell, B., added: "I entirely adopt the test which my Lord Chief Baron suggested: that the question is as to the identity of the invention which is disclosed by the full specification with that of which a short note or minute was made in the provisional specification" (d).

The language of Byles, J., in *Re Newall and Elliott* (e), was adopted by Kay, J., in *Lucas v. Miller* (f); and in *Woodward v. Sansum* (g) Lopes, L. J., said: "A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention, so as to protect the inventor until the time for filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping

Cases under Act of 1883.

(a) Byles, J., in *Re Newall and Elliott* (1858), 4 C. B. N. S. 269; 27 L. J. C. P. 337.

(b) *Lucas v. Miller* (1885), 2 R. P. C. 157, 159. See also remarks of Lord Blackburn in *Bailey v. Robertson* (1878), 3 App. Ca. 1055.

(c) (1864) 10 Jur. N. S. at p. 955.

(d) 10 Jur. N. S. 960; cp. *Penn v.*

Bibby, Penn v. Jack (1866), per Lord Chelmsford, L. R. 2 Ch. 134; 36 L. J. Ch. 455.

(e) (1858) 4 C. B. N. S. 269; 27 L. J. C. P. 337.

(f) (1885) per Kay, J., 2 R. P. C. at p. 159.

(g) (1887) 4 R. P. C. 166.

within what I may call the ambit of his invention as disclosed in his provisional specification." It is not necessary that the provisional specification should suffice to enable even a skilled man to understand the method of carrying out the invention (*h*). And Lord Herschell has pointed out that the provisional may be much more general and less detailed in its terms than the complete (*i*). But though it may be a rough description, it must be fairly and honestly framed (*k*).

One of the most recent cases in which the function of the provisional specification has been considered is *The Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate* (*l*), in the course of which A. L. Smith, L. J., delivering the judgment of the Court of Appeal, said: "In a provisional specification, no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out the invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter with that of the complete specification which is to come thereafter may be ascertained."

It may happen that the provisional goes beyond the complete, and that yet the specification is good, for the force of the objection of disconformity depends not upon whether the provisional, but upon whether the complete, is excessive (*m*). A part of the invention included in the provisional may be dropped in the complete (*n*); but if the ambit of the invention in the complete goes beyond that covered by the provisional, there is disconformity which will prove fatal to the patent (*o*). Since the complete may be cut down by the provisional, but cannot be enlarged by it, the drafting of the provisional is of great importance to the inventor. The provisional specification need contain no claims (*p*), and provided that the invention is sufficiently described and identified, there would seem to be an advantage in stating as little as

(*h*) *Stoner v. Todd* (1874), 4 Ch. Div. 58; 46 L. J. Ch. 32; *Nuttall v. Hargreaves* (1892), 1 Ch. 29; 8 R. P. C. 450; 61 L. J. Ch. 94; *United Telephone Co. v. Harrison* (1882), 21 Ch. Div. at p. 720; 51 L. J. Ch. 705.

(*i*) *Vickers v. Siddell* (1890), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292, 306.

(*k*) Per Fry, J., in *United Telephone Co. v. Harrison* (1882), 21 Ch. Div. 720; 51 L. J. Ch. 705; *Stoner v. Todd* (*supra*).

(*l*) (1895) 12 R. P. C. at p. 257. The

recent cases quoted in the next section (Disconformity) should also be consulted.

(*m*) Kekewich, J., in *Siddell v. Vickers* (1888), 39 Ch. Div. 97; 5 R. P. C. 51.

(*n*) *Penn v. Bibby* (1866), 2 Ch. 127; 36 L. J. Ch. 455.

(*o*) See *Vickers v. Siddell* (1890), 15 App. Ca. 505; 60 L. J. Ch. 105; 7 R. P. C. 292. And see *Disconformity, infra*, p. 146.

(*p*) *Lucas v. Miller* (1885), 2 R. P. C. 155.

possible; generally speaking, there seems to be no good reason for giving any details of the working in the provisional.

The comparative advantages and disadvantages of filing the provisional and complete specifications at the same or different times have been dealt with *ante* (p. 119 *et seq.*). Suffice it to say here that if the complete be withheld for a time, though some risk of disconformity may be incurred, the inventor gains an opportunity of developing his method without loss of time, and the patent when granted dates back to the application (*q*). Under the present Act, the grant of the patent, though when sealed it dates back to the application (*r*), is not made until the complete has been lodged, and the patent has been sealed (*s*); hence the provisional is not published until the complete is published (*t*). But the inventor is able to use the invention without prejudice to the validity of the patent to be granted for the same (*u*). If eventually part of the invention covered by the provisional be dropped, the provisional is a publication of that part if such part is practically disclosed in the provisional (*x*). But though the inventor is protected against the result of user and publication after the date of the provisional, an action for infringement does not lie until the patent has been granted (*y*), and then only in respect of infringements committed after the acceptance of the complete specification (*z*).

Provisional specification not published separately.

No action for infringement till complete is accepted.

The rules relating to the form of provisional specification and the size of paper upon which it must be written or printed are to be found in the Appendix; see Rules 6 (2), 10 (*a*), and 30—33 (*b*). The provisional specification must commence with the title (*c*), and, if required, be accompanied by drawings (*d*). Every application must be referred to an examiner, who must ascertain whether these requirements have been complied with, but it is for the comptroller to exercise his discretion (*e*). The form provided is Form B in the Appendix to the Rules (*f*). The provisional specification must be signed by the applicant or his agent on the last sheet, the date having been inserted. These regulations

Rules relating to the filing of a provisional specification.

(*q*) Act of 1883, sect. 13.

(*r*) Act of 1883, sect. 13.

(*s*) Act of 1883, sect. 9 (2), (4), and sect. 12.

(*t*) Act of 1883, sect. 8 (1), 10, 13.

(*u*) Act of 1883, sect. 14.

(*x*) *Stoner v. Todd* (1876), 4 Ch. Div. 58: 46 L. J. Ch. 32.

(*y*) Act of 1883, sect. 15.

(*z*) Sect. 13, and see *Ex parte Bates*

and *Redgate*, per Hatherley, L. C., 4 Ch. 577: 38 L. J. Ch. 501.

(*a*) *Post*, p. 685.

(*b*) *Post*, p. 694.

(*c*) Act of 1883, sect. 5 (5).

(*d*) Act of 1883, sect. 5 (3).

(*e*) *In the Matter of C.'s Patent* (1890), 7 R. P. C. 250.

(*f*) *Post*, p. 808.

(which are to be found in the marginal note to the form) are directory only; a patent has been granted to two persons, though the complete specification was signed by one only (g).

Disconformity between the Provisional and the Complete Specifications.

The office of the provisional specification being to describe the nature of the invention, nothing more is required in it. The office of a complete specification is very different; it must particularly describe the nature of the invention and the manner in which it is to be performed.

It has always been necessary that the invention protected by the patent should be accurately described before the patent was granted. At a time when no provisional specification was requisite, and when the patent was granted before the specification was lodged, the interim guide to the nature of the invention was the title, and disconformity of a material nature between the title and the invention would render the grant invalid. See *ante*, p. 135 *et seq.*

Disconformity under the old law.

When, in 1852, the provisional specification was introduced, the more important functions of the title fell to the lot of the provisional specification, and conformity between the provisional and complete became important. If a man invented a patentable manufacture, which he described in general but sufficient terms in his provisional, he obtained his patent for that invention. When subsequently he came to file his complete specification, he might have included within its terms a totally different manufacture. He would thus have obtained a patent for an invention the full details of which he had not disclosed, or he might, by including in his complete specification an invention not disclosed by the provisional, make his patent cover that which he did not invent. Hence the law was framed so as to enable a patent for an invention to be revoked, if the complete specification went beyond the provisional specification. This defect—to which the name disconformity, or nonconformity, was given—could also be set up by way of defence to an action for infringement, since it rendered the grant void (h).

The Act of 1883.

In 1883 a change was made in the procedure for obtaining a patent. It is now provided that the patent shall not be sealed

(g) Per Webster, A.-G., in *Grenfell and McEroy's Patent* (1890), 7 R. P. C. 151.

(h) See cases *infra*.

until the complete specification has been left at the Patent Office and accepted (*i*). But as a patent, when granted, dates back to the day of application, the same reasons exist now as formerly for requiring conformity between the two specifications.

It has been doubted whether disconformity is any longer a ground either of revocation or defence in an action for infringement. The Act of 1883 (sect. 9) provides that "where a complete specification is left after a provisional specification the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and *whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification;*" and if the conditions are not complied with to the satisfaction of the examiner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction: sect. 9 (2).

Disconformity is still available as a defence in an infringement action.

Upon this it has been argued that if the comptroller accepts the complete specification after its examination by the examiners, there can no longer be any objection on the ground of disconformity (*k*).

It has now been decided, however, that disconformity between provisional and complete is a good answer to an action for infringement, and makes the patent void. In *Siddell v. Vickers* (*l*), Cotton, L. J., treated the point as an open one. But when the case came before the House of Lords (*m*), Lord Halsbury, L. C., said:—

"It is suggested that the new machinery of the comptroller and the examiner has superseded the power of raising any objection to the conformity of the provisional and the complete specification. I am unable myself to take that view. I think it is an essential condition of a good patent that the invention described in the provisional should be the same as that in the complete specification; and I think the third sub-section of sect. 26 preserves this as a ground upon which an action for infringement of a patent right may be defended and a ground upon which a patent may be revoked."

This dictum was not necessary to the decision, and was not in

(*i*) Sects. 5 & 12.
(*k*) *Siddell v. Vickers* (1890), 7 R. P. C. 292; 15 A. C. 496; 60 L. J. Ch. 105.

(*l*) (1888) 39 Ch. Div. 92; 5 R. P. C. 81.

(*m*) (1890) 15 A. C. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

terms adopted by the other law lords, though they did not dissent from it. But in subsequent cases it has been assumed by the Judges that disconformity would be fatal, and in practice it is constantly pleaded and argued as a defence open to the party attacking the patent. And, save perhaps in the House of Lords, it can no longer be contested that a patent is invalidated by disconformity between the provisional and complete, for in *Nuttall v. Hargreaves* (*n*) Lindley and Bowen and Fry, L. JJ., decided that the law is as stated in the dictum of Lord Halsbury (*o*).

Disconformity as a ground for refusing a grant.

Disconformity is not open as a ground of opposition to the grant of a patent save in the circumstances provided for by the Patents Act, 1888, sect. 4. This provides that any person may oppose under the ordinary conditions (*p*), on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.

Sir Robert Reid, S.-G., has decided in *Edwards's Patent* (*q*) that this section does not prevent an inventor from developing his invention to such extent as he might have done under the old law. In fact, though it may enable an opponent to object to the sealing of a patent on the ground of disconformity, it does not make that disconformity which previously could not have been so regarded; and it would require a clear case to cause the law officer to stop a patent on the ground of disconformity between the specifications (*r*).

Revocation for disconformity.

A patent once granted may be revoked on the ground of disconformity (*s*), but the persons who have a *locus standi* to petition for revocation are limited (*t*).

What amounts to Disconformity.—The question of disconformity is one of fact (*u*). What the Court has to determine is whether a distinct invention is claimed in the complete, which is not covered

(*n*) (1892) 1 Ch. 23; 61 L. J. Ch. 94; 8 R. P. C. 450.

(*o*) In *Haythornethwaite's Application* (1889), 7 R. P. C. 70, Clarke, S.-G., said that he could not, in dealing with an application, consider whether a specification alleged to be an anticipation satisfied the rules as to conformity.

(*p*) *Post*, Act of 1883, sect. 11.

(*q*) (1894) 11 R. P. C. 461.

(*r*) See the remarks of Webster, A.-G., in *Anderson and Anderson* (1888), 7 R. P. C. 323.

(*s*) *Nuttall v. Hargreaves* (1892), 1 Ch. 23; 61 L. J. Ch. 94; 8 R. P. C. 451.

(*t*) See *infra*. Chap. XV., and Act of 1883, sect. 26 (4).

(*u*) *Needham v. Oxley* (1863), 8 L. J. N. S. 532, 604.

by the provisional. The question is not whether the provisional is defective, but whether the complete is excessive (x).

If the complete specification, besides describing the invention foreshadowed in the provisional, sets out and claims an invention independent of that which is in the provisional specification, it is bad. It would be equally bad if the invention described in the complete specification were a wholly different invention from that described in the provisional specification (y).

"In considering whether a complete specification goes beyond the limits allowed by law, two questions only have to be considered: (1) What is the nature of the invention for which the patentee has obtained provisional protection? and (2) is what is described in the complete specification an invention of a different nature from the former? . . . The whole object of provisional protection is to enable a patentee to work at and improve, without risk of his invalidating, his patent by premature publication or user. The only limit set to what he can do in this respect is that the invention as finally specified must not be a different invention from that provisionally protected" (z).

Lord Justice Lindley said in *Nuttall v. Hargreaves* (a) that the patentee need not go into details in the provisional specification.

"It is sufficient to describe the nature of the invention, but the nature of the invention there described must be the nature of the same invention as that to which the complete specification relates."

There is no disconformity where the inventions described by the two documents are substantially one and the same, or where the excess, if any, in the complete specification is attributable to the legitimate functions of that document (b), or where the complete specification is a legitimate development of the provisional (c).

The point may be pushed further. If a patentee, when he

The points to be considered in deciding the question of disconformity.

Legitimate development is not disconformity.

(x) Kekewich, J., in *Siddell v. Tickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 81.

(y) *Walling v. Stevens* (1886), 3 R. P. C. 147, following the remarks of Lord Blackburn in *Bailey v. Robertson* (1878), 3 A. C. at p. 1075. And see per Smith, L. J., in *Lane-Fox v. Kensington, &c., Electric Lighting Co.* (1892), 3 Ch. 424; 9 R. P. C. at p. 413. Serious difficulties have arisen when a specification has been amended without due regard to the scope of the provisional; see, e.g., *Lane-Fox v. Kensington Electric Lighting Co.*, *supra*; *Gaulard and Gibbs' Patent* (1890), 7 R. P. C.

367; *Moser v. Marsden* (1893), 10 R. P. C. 205, 350.

(z) Lindley, L. J., in *Gadd v. Mayor of Manchester* (1892), 9 R. P. C. at p. 526.

(a) (1892) 1 Ch. 23, 29; 61 L. J. Ch. 94; 8 R. P. C. 450.

(b) *Moseley v. Victoria Rubber Co.* (1887), 4 R. P. C. at p. 251; *Walling v. Stevens* (1886), 3 R. P. C. 37, 41, 147.

(c) *Horrocks v. Stubbs* (1886), 3 R. P. C. 233, 236; *Moseley v. Victoria Rubber Works*, *supra*.

files his complete specification, has a development or improvement in his mind which is not *per se* a separate invention, he not only may, but is bound to, disclose it to the public; there is no illegitimate variance when the complete specification does no more than disclose the improvement (d).

Crampton v. Patents Investment Co.

Improved methods of carrying out the same invention.

In *Crampton v. The Patents Investment Co.* (e), Field, J., expresses himself to the same effect:—

“If, in the course of the time between the complete and the provisional specification, [the inventor] discovers that the invention he claims to be the inventor of can be better performed or better done or improved by any further addition to it, not in the shape of a new invention, . . . it is not only his privilege, but it is his duty to the public to do it, because the object of the complete specification, whether it is filed with the application or six months after, is to tell the public how the thing is done. That is the price which the man who wants to be a patentee has to pay to the public for it.”

Bailey v. Robertson.

To the same effect is *Bailey v. Robertson* (f), in the course of which Lord Blackburn said: “it becomes pretty clear that when the nature of an invention has been described in the provisional specification in the way which has been mentioned, if something were found out during the six months to make the invention work better or in respect to the mode in which the operations may be performed—a thing which is very likely to happen when, in carrying out his invention, the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it—still the nature of his invention remains the same, and it is no objection that in the complete specification, which comes afterwards, the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made, and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that, I think it is good.” . . . This rule has been repeatedly acted upon, *e.g.*, in *Moseley v. Victoria Rubber Co.* (g), *Woodward v. Sansum* (h), *Gadd v. The Mayor*

(d) Bowen, L. J., in *Miller v. Scarle, Barker & Co.* (1893), 10 R. P. C. at p. 111; and see *post*, p. 165. The rule was the same as regards conformity between title and specification: *Crossley v. Beverley* (1829), 9 B. & C. 63; 1 W.

P. C. 112.

(e) (1888) 5 R. P. C. 382, affirmed 6 R. P. C. 287.

(f) (1878) 3 App. Ca. 1055.

(g) (1887) 4 R. P. C. 241, 251.

(h) (1887) 4 R. P. C. 166.

Manchester (i), and *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate (k)*.

In *Woodward v. Sansum (kk)*, Lopes, L. J., said that it is essential that the nature of the invention should be the same, but, "upon principle and upon authority, it is clear that improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification are allowable, and cannot be successfully relied on for the purpose of invalidating a patent for disconformity."

Woodward v. Sansum.

But though a patentee is not prevented from including in his complete specification improvements in the means of carrying out the invention disclosed in the provisional specification, he may not, under colour of making an improvement, include a totally different invention (l).

A new invention may not be introduced under colour of an improvement in the original.

It is not an objection that the complete specification does not extend to everything comprehended within the provisional (m); but the omitted part cannot be read into the complete merely because it is mentioned in the provisional (n).

The following examples may elucidate what does or what does not amount to nonconformity, though it must be remembered that the decision depends in every case mainly on the facts:—

In *Penn v. Bibby (o)* the provisional specification described the nature of the invention in the most general terms to consist in employing wood in the construction of the bearings and the bushes for the shafts of screw and submerged propellers. The complete specification described a particular mode of employing wood to prevent the parts of a propeller shaft which are within the bearings from coming in contact with the metal of the bearings, and to cause them to revolve against pieces of wood and between the inner surfaces of the metal bearings and the outer surfaces of the propelling shaft. The claim at the end of the specification was, "the employing of wood in the construction of the bearings and bushes for propelling shafts as

Variance of provisional and complete specifications.

(i) (1892) 9 R. P. C. 516.

(k) (1895) 12 R. P. C. 257.

(kk) (1887) 4 R. P. C. 166.

(l) *Gadd v. Mayor of Manchester* (1892), 9 R. P. C. 516, 526; *United Telephone Co. v. Harrison* (1882), 21 Ch. Div. 720, 746; 51 L. J. Ch. 705.

(m) *Thomas v. Welch* (1866), L. R. 1 C. P. 192; 35 L. J. C. P. 200; *Penn v. Bibby* (1866), 2 Ch. at pp. 130, 135; 36 L. J. Ch. 455.

(n) *Mackelcan v. Rennie*, 13 C. B. N. S. 52.

(o) (1866) 2 Ch. 130; 36 L. J. Ch. 455.

Penn v. Bibby. herein described." It was argued for the defendant that if the words "herein described" were to be disregarded, the patent was void, as the claim would then be for the employment of wood in every possible way in the bearings and bushes of propellers; on the other hand, if those words limited the claim to the precise description in the specification, that was not what was described in the provisional specification, and the plaintiff had, therefore, obtained a patent for one thing and specified another. Lord Chelmsford said that there could be no doubt that the claim in the specification must be read with the limitation produced by the words "herein described," and that the question thereupon arose whether this occasioned a departure from the provisional specification so as to render the patent void. He then proceeded:—

"It is clear, therefore, that, unless the complete specification in this case claims something different from the provisional specification, the objection to the patent under consideration cannot prevail. But there is not the slightest foundation for the objection in point of fact, and each specification appears to me faithfully to fulfil its own office.

Variance of provisional and complete specifications.

"But it was said that one part of the complete specification went beyond the provisional and extended to something which could not be included in it, viz., the application of wood to the shaft so as to revolve therewith, the provisional specification confining the employment of wood to the bearings and bushes. If wood applied in this manner to the shaft may be properly called a bearing, then there is no excess in this part of the specification; but if, strictly speaking, this application of wood would not come within the description of a bearing, then the answer to the objection is that it is not claimed, the claim being limited to the employment of wood in the construction of bearings and bushes. There is, therefore, no departure from the provisional specification in the complete specification."

Thomas v. Welch.

In *Thomas v. Welch* (*p*), an action for the infringement of a patent for sewing machines, the provisional specification stated that a certain instrument or *another* acting *therewith* held the work during the insertion of the needle, and again during its withdrawal. The complete specification contained drawings of sewing machines, with details of parts thereof, and concluded with five separate claims. Thereafter the plaintiff

(*p*) (1866) L. R. 1 C. P. 192; 35 L. J. C. P. 200.

disclaimed all the claiming clauses, and the amended specification stated, "G is the instrument by which the work is held during the insertion of the needle." Three forms of *g* were described; and the specification continued: "It is the arranging an instrument, *g*, as herein described, which, while it is the means of holding the fabric during the insertion and withdrawal of the needle, is also the means by which the step-by-step movement is given to the fabric or material for the succession of stitches which constitutes *the peculiarity of the invention.*" The words in italics were inserted for the first time in the amended specification, *the* taking the place of *another* in the original specification. Erle, C. J., in delivering judgment, said: "The provisional specification describes an instrument, and then says that this *or another acting therewith* acts to hold the work during the insertion of the needle. It is said that the complete specification contains nothing corresponding to this second alternative. Assuming that this is so (*g*), I do not think the objection ought to prevail. The difference is a slight one, and injured nobody, and it may be that the patentee had something in his mind when he filed his provisional specification which he found afterwards would be useless. As he could not disclaim formally part of the provisional specification, he might, I think, in such a case as the present, have omitted it from his complete specification."

Variance of provisional and complete specifications.

In *Wright v. Hitchcock* (*v*), an action for the improvement of a patent "for improvements in the manufacture of frills or ruffles and in the machinery or apparatus employed therein," the alleged variance consisted in the addition in the complete specification of the word *trimmings* to the words *frills* or *ruffles*, which appeared alone in the provisional. Kelly, C. B., said: "By whatever name it is described, the thing is in itself identical: it is something attached to any part of the dress either of men or women, whether it is called the frill of a sleeve, or the ruffle of a shirt, or the trimming of a lady's dress. These are all *ejusdem generis*, and the description is only important for the purpose of showing for what purpose the product may be ultimately used when it has been manufactured by means of the plaintiff's invention."

Wright v. Hitchcock.

(*g*) His lordship, however, suggested another view: "It may be that one form of *g* mentioned in the complete specification, which is in two parts, is

what was referred to in the expression 'and another acting therewith.'" (*v*) (1870) L. R. 5 Exch. 37, 46; 39 L. J. Ex. 97.

Lucas v. Miller.

In *Lucas v. Miller (s)*, the plaintiff, who was the patentee of an improved form of bicycle lamp, brought an action against the defendant for infringing this patent. The complete specification comprised a method of attaching washers to the lamp, which was not mentioned in the provisional specification. This, the defendant alleged, invalidated the patent. It was held, however, by Kay, J., that the patent was valid, as the method of attaching the washers was only a matter of detail which the patentee had a right to add to his specified invention, and not a separate invention.

Bailey v. Robertson (t).—The provisional claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphate of lime; in the complete a claim was made for a solution composed of bisulphite of lime alone, no directions as to the mode of use being given: bisulphite of lime had been used before by a prior patentee. Held, there was "disconformity."

Nuttall v. Hargreaves.

Nuttall v. Hargreaves (u).—The patentee of an invention for tapping barrels had described his invention in the provisional as a plug screwed into the barrel end, with a valve and spring and guide to keep the valve in its place; in the complete he added the description of a gauge strainer to keep impurities from escaping into the tap, and it appeared that the gauge strainer was the only novel part of the invention. It was decided that the patent was invalid (*x*).

To upset a patent, the disconformity must be clear.

Keeping in view the offices of the provisional and complete specifications respectively, the Court will construe the former with the aid of the knowledge of what has been claimed by the latter, and will decide whether, on a fair interpretation, each essential part of the claim is covered by the provisional specification (*y*); and the Court will not decide against the validity of the patent on the ground of disconformity unless the invention disclosed in the provisional clearly differs from that shown in the complete (*z*).

(s) (1885) 2 R. P. C. 155.

(t) (1878) 3 App. Ca. 1055. See also *Hutchinson v. Pattullo* (1887), 4 R. P. C. 329; 5 R. P. C. 351.

(u) (1892) 1 Ch. 23; 61 L. J. Ch. 94; 8 R. P. C. 450.

(x) In *Gadd v. Mayor of Manchester* (1892), 9 R. P. C. 516, 527, Lindley, L. J., said that the decision in this case went beyond any other and depended on the facts; but so do all these decisions. See also *Re Gaulard and Gibbs'*

Patent (1889), 6 R. P. C. 215; 7 R. P. C. 367; *King, Brown & Co. v. Anglo-American Brush Corporation* (1889), 6 R. P. C. 367, 414.

(y) *Siddell v. Vickers* (1888), 89 Ca. Div. 97; 5 R. P. C. 81, 416. But see *Mackelcan v. Rennie* (1862), 13 C. B. N. S. 52.

(z) Lindley, L. J., in *Gadd v. Mayor of Manchester*, *supra*; Romer, J., in *Chadburn v. Mehan* (1895), 12 R. P. C. 120, 135.

An objection of variance should be stated in the particulars, and will probably be rejected unless it is so stated (a). A mere general allegation of disconformity is not sufficient. Thus, in *The Anglo-American Brush Electric Light Corporation v. Crompton* (b), the defendants delivered particulars of objection, of which one was as follows: "That the alleged invention described in the complete specification as amended is a different invention from that described in the provisional specification." Bacon, V.-C., made an order for further and better particulars of the alleged disconformity, and this order was confirmed by the Court of Appeal. "The defendants," said Cotton, L. J., "ought to give such particulars as would inform the plaintiffs of the nature and scope of this objection of nonconformity. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them. Each case must depend on its own circumstances."

Anglo-American Brush, &c., Co. v. Crompton.

SECTION 4.—THE COMPLETE SPECIFICATION.

1. Sufficiency of the Complete Specification.

The aim of the Legislature in requiring a patentee particularly to describe and ascertain the nature of his invention and the manner in which it is to be performed appears to be threefold: (1) to prevent any person from inadvertently infringing the patent right during the term of the monopoly; (2) to put the public in possession of the patentee's secret on the expiry of the patent term; (3) to prevent patents being granted for known inventions.

Objects of complete specification.

The disclosure of the invention is often said to be the consideration for the grant of the patent, and consequently it becomes necessary that the invention should be so described that the public may have the benefit of the consideration on the lapse of the monopoly.

"The object of the specification," said Tindal, C. J., in *Walton*

(a) *Walling v. Stevens* (1886), 3 R. P. C. at p. 152. The plea of insufficiency of the specification entitles the defendant to raise disconformity: *Penn*

v. Bibby (1866), 2 Ch. 127; 36 L. J. Ch. 455.

(b) (1887) 34 Ch. Div. 152; 56 L. J. Ch. 167; 4 R. P. C. 27.

Specification must not be ambiguous.

v. Potter (c), "is that it is the price which the party who obtains the patent pays for it, and it would be a hard bargain on the part of the public if he were allowed to clothe his discovery and his description in characters so dark and so ambiguous that no one could make from it when the fourteen years have expired, and he should not have paid the price for which he enjoyed the exclusive privilege, but that he should have it in his hands for as long a period as he chooses; and therefore it is always a proper answer, when a patent is set up, to say that you have not so described it that it may be understood."

Utmost good faith requisite.

It is a principle of patent law that there must be the utmost good faith in the specification, which must be fair, full, and unambiguous. The specification should point out in definite, explicit terms what the invention really is and what is claimed (*d*).

"It is incumbent on the patentee," said Ashhurst, J., in *Turner v. Winter (e)*, "to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable; and if it appear there is any unnecessary ambiguity affectedly introduced into the specification or anything which tends to mislead the public, in that case the patent is void."

The Patents Act, 1883 (sect. 5, sub-sect. 4) provides that a complete specification must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed (*f*), and must be accompanied by drawings if required: and sub-sect. (5) adds that a complete specification must commence with the title and end with a distinct statement of the invention claimed (*g*). As these sub-sections but repeat the law existent before the passing of the Patents Act, 1883, they may be interpreted in the light of the decisions old as well as recent.

Specification must not be vague.

The complete specification must not be vague. It must state clearly both what the invention is, and how it can be carried out (*h*). "Is this specification such that a fair man, willing or wishing to understand the specification, can reasonably gather

(*c*) (1841) 1 W. P. C. 595; 11 L. J. C. P. 138; cf. *Galloway v. Bleaden* (1839), 1 W. P. C. 521.

(*d*) *Fairburn v. Household* (1886), 3 R. P. C. 263; *Sturtz v. De la Rue* (1828), 1 W. P. C. 83; 5 Russ. 322.

(*e*) (1787) 1 W. P. C. 80.

(*f*) These two requisites are distinct, and should be kept so in the specification, per Lindley, L. J., in

Edison v. Holland (1889), 6 R. P. C. 243, 279, 280, also per Grove, J., in *Philpott v. Hanbury* (1885), 2 R. P. C. 35, 38.

(*g*) These provisions are only directory: *Vickers v. Siddell* (1890), 15 A. C. 696; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*h*) See, e.g., Ashhurst, J., in *Turner v. Winter*, 1 W. P. C. 77; 1 T. R. 662.

from it what the patentee considers his invention and what he says he prohibits the public from using?" (i). Such is the test.

In *Turner v. Winter* (k), the specification stated as an ingredient in a certain mixture "fossil salt." The Court found that "fossil salt" was a generic term, including "sal gem" as well as other species, and that "sal gem" would alone answer the purpose. It was decided that the specification was ambiguous and misleading, and therefore bad.

In *Hastings v. Brown* (l), the specification in a patent relating to a windlass stated that the object was "to hold without slipping a chain cable of any size." Before the date of this patent no cable-holder was known which would hold chains of different sizes, and the claim was for an invention by which a single windlass might raise cables of different diameters. It appeared that a windlass capable of holding a chain cable of a given size was not new. The Court of Queen's Bench held that the specification did not unequivocally show that the object was to construct a single windlass capable of holding different chain cables, whatever their size, and that such a windlass was not therefore protected by the patent (m).

In *Gandy v. Reddaway* (n), the claim was for making belts or bands for driving machinery of cotton canvas woven hard, stitched and saturated with oil. The result of the evidence was that a workable belt for machinery could not be made out of the whole, but only out of a particular subdivision, of the class known as cotton canvas "woven hard," and there was no proof that a workman of ordinary skill would have rejected every other sort of "hard" canvas but that particular kind. It was held that, in the absence of such proofs (n), the specification was insufficient.

In *Savory v. Price* (n), an action for the infringement of a patent for a method of making Seidlitz powders, the specification gave three distinct recipes for preparing the ingredients, and then

Specification must state plainest way of producing invention.

(i) Per Grove, J., in *Philpott v. Hanbury* (1885), 2 R. P. C. at p. 38.

(k) (1787) 1 W. P. C. 77; 1 T. R. 602.

(l) (1853) 22 L. J. Q. B. 161; 1 E. & B. 450; Higgins's Dig. p. 196; cp. *Mackelcan v. Rennie* (1862), 13 C. B. N. S. 59. A specification which does not differentiate the useful from the useless at its various stages is bad for ambiguity: *Badische Anilin und Soda Fabrik v. Levinstein* (1885), 2 R. P. C. at p. 115; 29 Ch. Div. 366, per Bowen

and Fry, L. JJ.; cp. *Hairburn v. Household* (1886), 3 R. P. C. 128. See *Edison v. Holland*, 6 R. P. C. 281.

(m) (1885) 2 R. P. C. 49. On a question of sufficiency, instructions issued by a patentee to workmen as to the mode of working his patented process are material: *Pooley v. Pointon* (1885), 2 R. P. C. at p. 172.

(n) (1823) 1 Ry. & Mo. 3; 1 W. P. C. 83.

directed two scruples of each of the three ingredients resulting from those recipes to be dissolved in half a pint of water to produce the imitation of water from the medicinal springs at Seidlitz. It was proved that, by following the directions given in the specification, the result was obtained, and that it was new and useful. It appeared that the three recipes were only common processes for preparing three well-known substances—viz., Rochelle salts, carbonate of soda, and tartaric acid—which were sold in shops before the date of the patent, and those three substances being used as directed constituted the patent Seidlitz powder. The specification did not give any name to the ingredients resulting from the three recipes, *but gave those recipes without comment, as if they were part of the method of making the Seidlitz powder.* It was held that the patent could not be supported. “By reading this specification,” said Abbott, C. J., “we are led to suppose a laborious process necessary to the production of the ingredients, when, in fact, we might go to any chemist’s shop and buy the same things ready-made. The public are misled by this specification, which tends to make people believe that an elaborate process is essential to the invention.”

In *Sturtz v. De la Rue (o)*, a suit to restrain the infringement of a patent for “improvements in copper and other plate printing,” the subject-matter was a method of preparing a glazed surface on paper by coating it with a mixture of white lead and size before the application of pressure. The specification directed that the white lead used should be “the finest and purest chemical white lead.” The evidence showed that ordinary white lead would not answer the purpose, and that only a purer material imported from Germany and sold at one particular shop in London would produce the required effect. It was held that the specification was insufficient.

“It is a principle of patent law,” said Lord Lyndhurst, L. C., “that there must be the utmost good faith in the specification. It must describe the invention in such a way that a person of ordinary skill in the trade shall be able to carry on the process. Here the specification says that there is to be added to the size certain proportions ‘of the finest and purest chemical white lead.’ A workman would naturally go to a chemist’s shop and ask for

Full disclosure of materials necessary.

(o) (1828) 1 W. P. C. 83; 5 Russ. 322. See also as another example *Badische, &c. v. Levinstein* (1887), 12 App. Ca.

710, 723; 4 R. P. C. 449; *Wegmann v. Corcoran* (1879), 13 Ch. Div. 65, 71, 78, 87.

'the finest and purest chemical white lead;' the answer which he would receive would be that there was no substance known in the trade by that name. He would be compelled to ask for the purest and finest white lead, and, according to the evidence, the purest and finest white lead that can be procured in London will not answer the purpose. It is said that there is a substance prepared on the Continent which is white lead or some preparation of white lead, and that by using it in the manner described in the specification the desired effect is produced. If that be so, the patentee ought to have directed the attention of the public to that circumstance. He ought to have said, 'The purest white lead which can be obtained in the shops of London will not do; but there is a purer white lead prepared on the Continent, and imported into this country, which alone must be used.' 'The purest and finest chemical white lead' must mean the finest and purest white lead usually gotten in the general market for that commodity, unless the public be put on their guard by a statement that what would be called very fine and pure white lead in the ordinary sense of the trade will not answer, but that the white lead used must be of a superlatively pure and fine quality prepared in a particular way, and to be gotten only in a particular place. If the article is not made in this country, but may be imported, it would be necessary to mention that circumstance."

The method of carrying out the invention must be properly stated in the specification, and the insertion or representation of anything which will not answer the purpose will vitiate the specification for insufficiency.

In *Turner v. Winter* (p) the specification was so drawn that any ordinarily qualified person attempting to carry out the invention would have used "minium" in a certain process. In fact, "minium" would not answer the purpose, and the inventor himself never used it. The Court decided against the specification on this ground.

In *Ralston v. Smith* (q), objections were raised to the specification, and particularly with regard to the uncertainty of the material, the language of the amended specification being that the plaintiff took "a roller of hard metal or other suitable material."

Ambiguity in the statement of materials.

(p) (1787) 1 W. P. C. 77; 1 T. R. 602.

(q) (1865), 11 H. L. C. 223; 35 L. J. C. P. 49.

Lord Westbury said: "I do not think those words 'or other suitable material' contain anything like such a generality of direction as would be fatal to the patent; 'other suitable material,' no doubt, would mean any material equally sufficient for the purpose with hard metal."

Upon the same principle of *ejusdem generis*, specifications referring to "other combustible matter" (*r*).

Proportions.

If the specification states the articles of which the thing invented is to be composed, but omits the proportions, the specification will ordinarily be insufficient (*s*). But a reasonable latitude in the statement of proportions is permissible, and if there can be no reasonable doubt, the fact that the proportions are not stated in express words will not impair the sufficiency.

Ambiguity in statement of proportions.

In the *Patent Typefoundry Co. v. Richards* (*t*), a suit to restrain from infringing a patent for "improvements in the manufacture of type," the specification stated: "The object of the invention is to make type harder, tougher, and more enduring by employing tin in large proportions with antimony and to greatly reduce or omit the use of lead. The best proportions I am acquainted with are seventy-five of tin and twenty-five of antimony, but this may be to some extent varied; and when lead is also used, I find that it must not exceed fifty parts in one hundred of the combined metals employed." A demurrer on the ground that this specification was bad for uncertainty was overruled. "What I have to determine," said Wood, V.C., "is whether this specification is so clearly and manifestly bad that no explanation by workmen or other experts . . . could induce the Court to hold that this is a new invention set forth with sufficient clearness and precision. . . . A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say, 'I limit my claim to these precise proportions.' Even if the patentee had in terms absolutely tied himself down to 25 per cent. as a minimum in the place of 1 or 2 per cent., supposing that to be the proportion previously used, a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent."

Reasonable latitude allowed.

"It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a

(*r*) *Bickford v. Skewes* (1837-39), 1 W. P. C. 218; 1 Q. B. 938; 10 L. J. Q. B. 302.

(*s*) Per Lord Mansfield; see 1 W. P. C. 54, note (*e*).
(*t*) (1860) 2 L. T. N. S. 359; 1 Johns. 81.

useful practice, whether anything of the kind was ever done before, and whether a variation from the given proportion to others slightly different would not be a colourable evasion. These are all questions for a jury. The only opinion I express is that the specification is not void on the face of it" (u).

Thus in *The British Dynamite Co. v. Krebs* (x), a suit for the infringement of a patent for "improvements in explosive compounds and in the means of igniting the same," the specification stated: "The invention relates to the use of nitro-glycerine in an altered condition which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, . . . whereby it is converted into a powder, which I call dynamite, or Nobel's safety powder." It was objected that there was no sufficient statement of the quantity of the liquid to be absorbed. The House of Lords, however, restoring the order of Fry, J., which had been reversed by the Court of Appeal, held that the specification was sufficient. "When you speak," said Lord Cairns, L. C., "of a porous substance absorbing a fluid, if the porous substance is in one piece, you naturally expect that the absorption will continue up to the point when the porous substance can hold no more; and when the porous substance is to continue a powder, the act of absorption itself will show the point at which the absorption must stop, lest the absorbing substance should become not a powder, but a paste."

The specification must not contain a statement of any alleged method of producing the invention described therein which will not answer that purpose, and the deficiency of which is either known to the patentee, or would not be detected by an ordinary workman without further inquiry and experiment.

Method described must answer.

Thus in *Crompton v. Ibbotson* (y) the plaintiff's patent was for "an improved method of dyeing and finishing paper," and the specification described the invention to consist in conducting paper by means of cloth or cloths against a heated cylinder, and contained the following words: "which cloth may be made of any suitable material, but I prefer it to be made of linen, warp, and woollen weft." The patentee knew from repeated trials that no other substance would do. Lord Tenterden, C. J., held

(u) See also *Betts v. Neilson* (1868-71), per Lord Westbury, L. R. 5 H. L. at p. 21; 40 L. J. Ch. 317.

P. C. 190; cp. *Otto v. Linford* (1881-82), per Jessel, M. R., 46 L. T. 40.

(x) (1875-79) *Goode v. P. C.* 88; 13 R.

(y) (1828) 1 Web. P. C. 83.

that the specification was bad. "Other persons," said his Lordship, "misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail; and the public, therefore, has not the full and certain benefit of the invention."

In the same case, Bayley, J., observed: "A party knowing that given materials will not answer the purpose, he is bound in his specification so to word it as to prevent parties from trying experiments on that which he knows will not answer" (z).

Simpson v. Holliday.

A clear statement of the law on this question is that given in *Simpson v. Holliday* (a), which shows that if the method does not produce the invention described, innocence of intention to mislead will not avail to support the patent, and that it will not avail that another method, which can be successfully carried out, is specified.

In this case, the patentee of an invention for "improvements in the preparation of red and purple dyes" stated in his specification: "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." It was proved in evidence, and admitted by the plaintiff, that the operation would not succeed if conducted by the first of these methods, viz., without heat. Wood, V.-C., found that the specification was sufficient, and gave the following statement of the law: "If the Court had any notion whatever that (the first method) was put in with an intent to mislead, then without doubt or hesitation it would hold the patent to be bad, because there are two points in these cases of somewhat confused description in specifications which the Court mainly attends to: whether or no it has been put in with a fraudulent intent to mislead, which at once leads the Court to decide against the validity of the patent, or, on the other hand, whether, although put in innocently by mistake and without any fraudulent intent, it is such a description as will or can mislead any ordinary workman in the operation that he has to carry on."

(z) S. C., 1 Carp. P. C. 462; cp. *Derosne v. Fairie* (1835), 1 Web. P. C. at p. 165, side-note: "A specification must state at least one method which will succeed;" *Beard v. Egerton* (1846-49), per Maule, J., 19 L. J. C. P. at p. 39: "If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is

bad." In *Cole v. Saqui* (1888), 5 R. P. C. at p. 494, Kekewich, J., said: "I can see no objection to a patentee stating in his specification that what he has invented with reference to some particular machine may be applied to some other machine."

(a) (1864-66) Higgins's Dig. p. 413; 20 Newt. Lon. Jour. N. S. 108.

On appeal, however, to the House of Lords, the findings of the Vice-Chancellor were reversed, and Lord Westbury, L. C., said (b):

“If the true construction of the specification 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.

“If a specification alleges that a particular process which may be slow, troublesome, and expensive, is efficient, and the statement is untrue, the vice is not removed by the fact that the same specification also describes another process which is efficient, and which is stated to be speedy, certain, and economical.”

These cases may be advantageously compared with *Thomson v. Batty* (c). There, in a specification for improvements in compasses, there was a claim for the employment of a large bowl filled or partially filled with a viscous fluid. It was proved that “partially filled” alone gave the proper effect, though “filling” gave some effect. Kekewich, J., refused to say that the specification was not sufficient.

Specifications stating certain things as necessary to the invention which, in fact, are unnecessary, have often been held to be bad. But it will probably be found that the unnecessary parts of the specifications either were put in with intent to puzzle, or, in fact, did make the specification vague and ambiguous; e.g., in *R. v. Arkwright* (d) Buller, J., said: “If those (parts) are of no use, but are thrown in merely to puzzle, I have no difficulty in saying upon that ground alone that the patent is void.” It must always be remembered that the necessity of any given thing must be judged according to the state of knowledge at the time of the invention, not at the time when the dispute arose. In *Lewis v. Marling* (e) Bayley, J., said: “At the period when the

Specifications containing unnecessary details.

(b) S. C., 5 N. R. p. 340; 35 L. J. Ch. 811; L. R. 1 H. L. 315; cp. *Bickford v. Skewes* (1841), 1 Web. P. C. 211; *Neilson v. Harford* (1841), 11 L. J. Ex. 20; S. M. & W. 806; *Morgan v. Seaward* (1835-37), per Alderson, B., 1 Web. P. C. 174; *Hinks v. Safety Lighting Co.* (1876), per Jessel, M. R., 4 Ch. D. at p. 615; 46 L. J. Ch. 185; *British Dynamite Co. v. Krebs* (1875-79), per James, L. J.; *Goodeve's P. C.* p. 90; *Otto v. Linford* (1881-82), per Jessel, M. R., 46 L. T. p. 40;

Philpott v. Hanbury (1885), 2 R. P. C. 33; *United Horsenail Co. v. Stewart* (1885), 2 R. P. C. 122, 132, 133; *Coles v. Baylis* (1886), 3 R. P. C. p. 180; *Kurtz v. Spence* (1888), 5 R. P. C. at p. 183.

(c) (1888) 6 R. P. C. 84.

(d) (1785) 1 W. P. C. 66, 69; see *Lewis v. Marling*, 1 W. P. C. 493; 10 B. & C. 22.

(e) (1829) 10 B. & C. 22; 4 C. & P. 57; 1 W. P. C. 493; and see *Edison v. Woodhouse* (1887), 4 R. P. C. 99.

specification was made, the plush was in use, and there was no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material; and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the validity of the patent."

Best method of carrying out should be disclosed.

The specification must disclose the best method of carrying out the invention known to the inventor. "It is essential that a patentee, when he is disclosing his invention to the world, should give, not only the way of performing it, but he should explain how best it may be performed" (*f*).

Best method known to patentee to be disclosed.

So, too, if the patentee make the article for which the patent is granted with cheaper materials than those which he has enumerated, although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention or enable them to derive the same benefit which he himself does (*g*).

The rule is interpreted the more strictly if the invention be of small merit (*h*). In *Liardet v. Johnson* (*i*) (a patent for trusses for ruptures) the patentee omitted what was very material for tempering steel, viz., rubbing it with tallow, and for want of that Lord Mansfield held the patent bad.

Specification must disclose patentee's own way of producing invention.

Again, in *Wood v. Zimmer* (*k*), an action to try the validity of Zinck's patent for "a method of making verdigris," it appeared that the method described in the specification was sufficient to make the verdigris, but that Zinck had been accustomed clandestinely to put aquafortis into the boiler, whereby one of the ingredients (copper) was dissolved more rapidly, but the verdigris so produced was neither better nor cheaper than that made according to the specification. It was held that the patent was bad. In delivering judgment Gibbs, C. J., said: "It is said that the method described makes verdigris, and that the specification is, therefore, sufficient. The law is not so: a man who applies for a patent and possesses a mode of carrying on that invention in the most beneficial manner must disclose the means of producing it in equal perfection and with as little expense and

(*f*) *Plimpton v. Malcolmson* (1876), 3 Ch. Div. at p. 576; Kekewich, J., in *Thomson v. Batty* (1889), 6 R. P. C. 84, 100, 101.

(*g*) *Turner v. Winter* (1787), 1 W. P. C. 77, 81; 1 T. R. 602; *Plimpton v.*

Malcolmson (*supra*).

(*h*) *Hinks v. Safety Lighting Co.* (1876), 4 Ch. Div. 607; 46 L. J. Ch. 135.

(*i*) (1778) 1 W. P. C. 53, 81.

(*k*) (1815) 1 W. P. C. 82.

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

In determining whether the best method known to the patentee has been disclosed, instructions issued by him as to the method of working are material (l).

If the inventor describes the best method known to him, the specification is sufficient. An inventor may know of a material the use of which eventually proves to be a great improvement, but the non-disclosure of this material will not invalidate the patent, if the inventor at the time of filing his specification is not aware of the advantage to which it might be put in connection with the invention (m).

Since an inventor is not only at liberty, but is bound, to give his specification in the most improved state known to him at the date of the specification, it follows that developments and improvements discovered between the date of the provisional specification and that of the complete may have to be included. Bowen, L. J., in *Miller v. Scarle, Barker & Co.* (n), speaking of a certain improvement, said: "To my mind the patentee when the complete specification was filed, if he had this altered adjustment in his mind, was bound to disclose it to the public, and was bound to give the public the benefit of all that he knew about this mechanical equivalent. . . . It seems to me nothing but a performance of his duty to the public." The law was long ago laid down to the same effect by Bayley, J., and Tindal, C. J. (o).

Improvements discovered subsequent to the provisional.

Edison and Swan v. Woodhouse (p) shows the limits to this doctrine. In that case a patentee left his provisional specification in November, 1879, and filed his complete in May, 1880. He left a provisional relating to another patent in December, 1879.

(l) *Pooley v. Pointon* (1885), 2 R. P. C. 167, 172.

(m) *Thomson v. Batty* (1889), 6 R. P. C. 84, 100, 101.

(n) (1893) 10 R. P. C. 106, 111.

(o) *Lewis v. Marling* (1829), 1 W. P. C. at p. 496; 10 B. & C. 26; *Jones v. Heaton*, 1 W. P. C. 404, n.

(p) (1886) 32 Ch. Div. 520.

The former specification claimed an electric lamp with a carbon filament; the second claimed a method of making the carbon filaments. It was objected that the former specification was insufficient for non-disclosure of the best way of making the carbon filaments, a way evidently known to the patentee at the time when the complete specification was filed. Butt, J., said that, whilst a patentee is not entitled to withhold from the public a discovery of which he is aware forming an important integral part of the patent, yet he is equally not at liberty to put into his final specification a perfectly independent discovery which he had not made at the time of filing the provisional; and the Judge held, on the facts of the case, that the specification was sufficient (q).

Summary.

The result seems to be capable of being fairly stated as follows: The inventor must disclose the whole invention. If, therefore, an improvement or development is an integral portion of the invention covered by the provisional or a method of carrying it into effect, the patentee must disclose it in the complete. But if it be an independent invention, especially if it be such as cannot be included in the complete without risk of objection on the ground of disconformity, there is no obligation on the part of the patentee to include it in the complete specification.

The rule being that the patentee must disclose what he knows regarding the way in which the invention may be best carried into effect, it is material to observe that in the case of a communicated invention the importer, and not the foreign communicator, is for the purposes of this rule, as for other purposes, the patentee, and the completeness of the disclosure is judged by the state of his knowledge alone (r).

In imported inventions, the importer's knowledge is the test.

But an imported invention must be communicated with sufficient exactitude to enable the importer to describe it so that the public in England reading the specification may be able to understand it (s).

It is submitted that when the importer is only agent for the foreign inventor, *bonâ fides* both on the part of the foreign inventor and of the importer is requisite, for it cannot be that the agent may be deliberately kept in ignorance of facts which, if communicated to him, would make the specification insufficient.

(q) And see *Coles v. Baylis* (1886), 3 R. P. C. 178.

(r) *Moser v. Marsden* (1893), 10 R. P. C.

350, 359.

(s) *Wegmann v. Corcoran* (1878), per Fry, J., 13 Ch. Div. at p. 77.

When the importer is acting on his own behalf in patenting the invention in England, *bonâ fides* on his part and sufficient information to describe the invention with accuracy are all that is required.

It is important that the public should know exactly what the patentee claims, and for this purpose the specification must state what is admitted to be old and what is claimed to be new. This may be done either in the body of the specification or in the claims (t). It is not necessary that the new and the old should be pointed out and distinguished in express terms; it suffices if from the specification and claims the distinction can be drawn. If the specification end with claims, that portion of the body of the specification which is not covered by them is impliedly disclaimed; and, as an inventor will not usually fail to claim what is novel, the claim may generally be taken to be an indication of what the applicant considers new, the parts not claimed being those which he considers old. But each specification must be construed according to its own form and contents (u).

The new and the old to be distinguishable.

Abinger, C. B., in *Carpenter v. Smith* (x) said: "It is required as a condition of every patent that the patentee shall set forth in his specification a true account and description of his patent or invention, and it is necessary in that specification that he should state what his invention is, what he claims to be new and what he admits to be old; for if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part or the combination of the whole as new, why then his patent must be taken to be a patent for the whole and for each particular part, and his patent will be void if any particular part turns out to be old, or the combination itself not new."

Reasons for this rule.

Protection of patentee.

Macfarland v. Price (y) was an action for the infringement of the plaintiff's patent for "certain improvements in the making of

Macfarland v. Price.

(t) *Nordenfelt v. Gardner* (1883), 1 R. P. C. at p. 74.

(u) See remarks of Lord Selborne in *Harrison v. Anderston Foundry Co.* (1876), 1 App. Ca. at p. 578.

(x) (1841) 1 W. P. C. 530, 540; 9 M. & W. 300; 11 L. J. Ex. 213.

(y) (1816) 1 W. P. C. 74. "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).

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 drawings showed the particular part which had been pirated, and which was the substance of the invention. Lord Ellenborough, C. J., nonsuited 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 (z).

Novel elements to be distinguished.

In *Holmes v. The London and North-Western Railway Co.* (a), the plaintiff had obtained a patent for "an improved turning table for railway purposes," all the component parts of which except one were comprised in a prior specification. The plaintiff claimed "the improved turning table hereinbefore described" without making any distinction between the various parts. The jury found that the introduction of certain suspending rods made the table a new instrument. The patent was, however, upset on the ground that the plaintiff had not complied with the rule which requires a patentee distinctly to state what is new and what is old.

Sir W. M. James, V.-C., expressed himself to the same effect in *Parkes v. Stevens* (b) :—

"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."

Improvements.

In particular in the specification for an improved instrument or invention the improvement must be distinctly pointed out. The earliest authority for this is *Williams v. Brodie* (c). The plaintiff's invention, which was admitted to be ingenious and

(z) Cp. *Bovill v. Moore* 1816). Dav. P. C. 361; *Saunders v. Aston* (1832), per Littledale, J., 3 B. & Ad. 881; *Kay v. Marshall* (1836), 2 Web. P. C. 39, 71.

(a) (1852) Mac. P. C. 13; 22 L. J. C. P. 57.

(b) (1869) 8 Eq. 358; 38 L. J. Ch. 627.

(c) (1785) 1 W. P. C. 75; cf. *Hornblower v. Boulton* (1799), 8 T. R. 95; *Hill v. Thompson* (1818), 1 W. P. C. 229; 5 Taunt. 375. When the invention has been imported from abroad, see *Moser v. Marsden* (1893), 10 R. P. C. 350, 359.

useful, consisted in the insertion of a pipe into an old stove for conveying the air, 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.

A leading case on this point is *Foxwell v. Bostock* (d). 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.

*Foxwell v.
Bostock.*

"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 (e) 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." In *Cartsburn Sugar Refining Co. v. Sharp* (f) the first claim

(d) (1864) 4 De G. J. & S. 298; cf. *Parkes v. Sterens* (1869), 8 Fq. 358; 33 L. J. Ch. 627, affirmed L. R. 5 Ch. 36; *Rowcliffe v. Merris* (1886), 3 R. P.

C. 17, 145.

(e) But, as regards combinations, see *infra*.

(f) (1884) 1 R. P. C. 181.

of the specification was, "In a sugar-moulding machine, the rotatory drum and series of moulds combined with the hopper and distributors, and the packer, *f*, inclined towards and adapted to fill the moulds substantially as described." In fact, the packer alone was novel; therefore Lord Kinnear held that the specification was bad, as the part of the machine in which the improvement was made was not clearly distinguished.

Fairburn v. Household and Rosher (*g*) was a case in which a patent for improvements in tramway engines was held insufficient, as it did not indicate with clearness what the patentee claimed as new (*h*).

Combina-
tions.

Ambiguity
of the dictum
in *Foxwell v.*
Bostock.

The dictum of Lord Westbury in *Foxwell v. Bostock* (*i*), so far as it deals with improvements, has been fully accepted, and undoubtedly expresses the present law. But though, when carefully considered, it will equally be found a correct exposition of the law relative to combinations, the language is such as to convey the impression that an applicant for a patent for a combination must state what part of the combination is new and what is old. If he is claiming the parts of which the combination is made up, he must specify which of them he says are a novelty. But if he be claiming the combination alone (or even the combination with parts), he must be taken to assert that the combination is new as a whole, and that he claims the combination as the novelty. Hence it becomes unnecessary further to state what is new; he claims the whole as new, and satisfies the requirement mentioned in Lord Westbury's dictum. If anything more was intended by his Lordship, to that extent he went too far. The following bears on the point (*k*):—

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

(*g*) (1886) 3 R. P. C. 128, 263.

(*h*) And see *Hill v. Thompson*, 1 W. P. C. 229, 247; *Rowcliffe v. Morris* (1886), 3 R. P. C. 17, 145; *Leggott v. McGeech* (1894), 10 R. P. C. 429, 434.

(*i*) (1864) 4 Do G. J. & S. 298, 313.

(*k*) See *Kelly v. Heathman* (1890), 45 Ch. Div. 256, 260; 59 L. J. Ch. 22; 7 R. P. C. 343.

(*l*) (1876) 1 App. Ca. 574.

combination is also the merit, if it be a merit, which remains to be proved by evidence. So also with regard to the discrimination between what is new and what is old. If it is clear that the claim is for a combination, and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new. If, indeed, it were left open on the specification for the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, . . . then it might be necessary to see that the patentee had carefully distinguished those subordinate or subsidiary parts and had not left *in dubio* what claims to parts, in addition to the claim for the combination, he meant to assert."

In a later case (*m*) Lord Hatherley said: "But I apprehend, my lords (and I do not read the decision in the case of *Foxwell v. Bostock* as deciding more than I am stating), you must in some way or other inform those whom you are dealing with, by which I mean the general public, . . . you must inform them in some mode or other whether you have subdivided, if I may use the term, your machine into those separate parts and claim for each part the merit of novelty, or whether you are simply making a combination of things *per se* old, but which have never been used before in combination, and which make up, as you say, your machine, for which you claim protection as a novel and useful machine."

In *Moore v. Bennett* (*n*) Lord Selborne said: "It appears to me to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved. 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,

Meaning of
Foxwell v.
Bostock.

(*m*) *Clark v. Adie* (1877), 2 App. Cas. 315, 328; 46 L. J. Ch. 585.

Sugar, &c., Co. v. Sharp (1884), per Lord Kinneir, 1 R. P. C. at p. 185.

(*n*) (1884) 1 R. P. C. 129; *Cartsburn*

according to the decision in *Foxwell 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 (o), 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 ’ ” (p).

But “ where the claim is for a combination (q), 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 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.”

Combination
must be
claimed *qua*
combination.

Stated shortly, therefore, the meaning of *Foxwell 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 ” (r).

(o) Per James, V.-C., in *Parke v. Stevens* (1869-70), L. R. 8 Eq. at p. 365; 38 L. J. Ch. 627; and cp. *Harrison v. The Annerston Foundry Co.* (1876), per Lord Hatherley, 1 App. Ca. at p. 583.

(p) In *Nordenfelt v. Gardner* (1884), 1 R. P. C. 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.

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

(r) *Rowcliffe v. Morris* (1886), 3 R. P. C. at p. 24.

In *Proctor v. Bennis* (s), Bowen, L. J., says: "When a combination, and nothing more, is claimed, the combination being a novelty, it is immaterial that the patentee should point out how far he claims the novelty for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to me to be the true law as laid down in *Harrison v. Anderston Foundry Co.* (t), without a reference to which case *Foxwell v. Bostock* (u) is liable to be misunderstood" (r).

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

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

"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" (z). Elements known to be old.

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 (a). Specification sufficient if Court can see that only improvement claimed.

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 (b). Specification sufficient if intelligible to ordinary skilled artisan.

In *Shaw v. Jones* (c), 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

(s) (1887) 36 Ch. Div. 740, 762, 763; 57 L. J. Ch. 11; 4 R. P. C. 333. Lord Watson in the course of the argument in *Kaye v. Chubb* (1888), 5 R. P. C. 649, said, "If you claim a combination you need not say which of the parts are new." And cf. the statement of the same learned lord in *Iyon v. Goddard* (1894), 11 R. P. C. 357.

(t) 36 Ch. Div. 740.

(u) *Supra*, p. 169.

(r) See also *Kelly v. Heathman* (1890), 7 R. P. C. 343; 45 Ch. Div. 256; *Peckover v. Rowland* (1893), 10

R. P. C. 234.

(y) *Lister v. Leather* (1858), 8 E. & B. 1004; 27 L. J. Q. B. 295; *Watling v. Stevens* (1886), 3 R. P. C. 147.

(z) *Tetley v. Easton* (1853), per Coleridge, J., Macr. P. C. 87; 23 L. J. Q. B. 77.

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

(b) *Parke v. Stevens* (1869), per James, V.-C., 8 Eq. at p. 365; 38 L. J. Ch. 627.

(c) (1889) 6 R. P. C. 328.

evidence of witnesses who had done the very thing indicated in the specification without other instructions than the specification itself.

In patent for new combination only, specification need not distinguish subordinate elements.

Quere, if useful and useless need be distinguished.

Where a patentee claims a new combination only, and not the subordinate elements included in that combination, if the combination and the mode of working it are properly described, it is not necessary to specify which of the subordinate integers are new (*d*).

It is often stated that a specification must distinguish between useful and useless elements (*e*). In a sense, this is so. If the useless elements are put in to puzzle, or even if their effect is to make the specification as a whole ambiguous or unworkable, the specification is bad on these grounds. If the useless elements are clearly stated and separable from the others, *e.g.*, if they are the subject of a distinct claim, the patent will be endangered as containing a claim for that which is not subject-matter. It seems, therefore, that it is not merely for want of pointing out the useless and the useful that a specification, otherwise sufficient, will be invalidated.

A specification may describe the invention and the mode of putting it into operation sufficiently clearly to enable one person to understand it, but it may at the same time be utterly incomprehensible to another. "No sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch" (*f*). There may be three classes of persons: (i.) skilled scientific men, experienced in dealing with the particular kind of manufacture to which the invention belongs; (ii.) workmen accustomed to manufacture things of the class in question; (iii.) persons having no particular skill or knowledge bearing on the matter.

Specification not addressed to persons ignorant of subject-matter.

"It is plain," said Jessel, M. R., in *Plimpton v. Malcolmson* (*g*), "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

(*d*) *Moore v. Bennett* (1884), 1 R. P. C. 129.

(*e*) See, *e.g.*, in *Badische Anilin v. Levinstein* (1885), 29 Ch. Div. at p. 413.

(*f*) Lord Ellenborough in *Harmar v.*

Playne (1809), 11 East, 101; Dav. P. C. 311.

(*g*) (1875) 3 Ch. Div. 531, 563; 45 L. J. Ch. 505; *cp. Bray v. Gardner* (1887), 4 R. P. C. 400.

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 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.”

Test of sufficiency.

This is usually cited as containing shortly but clearly an exposition of the law on this point. It is submitted, however, that the statement of the Master of the Rolls as it stands needs qualification. The ordinary workman spoken of by him must be understood to be a workman engaged in the particular class of work to which the invention applies, or be one who in the ordinary course of things might be engaged in the carrying out of the invention. A specification of a patent for roller skates unintelligible to a workman engaged in the making of roller skates would be bad; but if a patent for making a new dye is obtained, the fact that the roller skate manufacturer could not understand the specification, would not prove fatal to the patent.

In *Elliott v. Ashton* (*h*), Coltman, J., said “the patentee must give such a description in his specification as will enable a workman of competent skill, conversant with the trade, to carry the invention into effect.”

In *Miller v. Scarle, Barker & Co.* (*i*), Bowen, L. J., said: “Now nothing is more certain in patent law (I myself and other Judges have had frequently to point it out) that specifications and figures which are attached to them are addressed to persons who are supposed to be competent to understand the subject to which the specification addresses itself, not to a highly skilled person, but to an ordinary person who understands and can appreciate what he is reading.”

(*h*) (1840) 1 W. P. C. 222.

(*i*) (1893) 10 R. P. C. 106, 111.

In *British Dynamite Co. v. Krebs* (k), Cairns, L. C., says: "When the nature of the invention is thus ascertained by the Court as a matter of construction, the Court has then to enquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture."

Specification is insufficient if experiment is required to discover its meaning.

In *Badische Anilin und Soda Fabrik v. Lerinstein* (l), Lord Halsbury said: "The specification is said not to give sufficient information to enable the operator to obtain the result without fresh experiment and research. If this were true the patent would undoubtedly be bad; but this is in a great measure a question of fact; and Pearson, J., a most careful and competent Judge, heard the witnesses and gave credit to those who, on the part of the plaintiffs, proved that in the hands of a reasonably competent workman acquainted with the dyeing industry, the specification is sufficient to enable him to procure the result. . . . More than once the questions put as to a competent workman possessed of knowledge in the particular industry were answered by a reply about an "ordinary workman," without the essential words, "possessed of knowledge in the particular industry."

The older cases are to the same effect: *Neilson v. Harford* (m), *Bickford v. Skewes* (n), *Harmar v. Playne* (o), and *Heath v. Unwin* (p), all show that, whilst a description sufficient for the understanding of a highly trained mind does not suffice, the specification is sufficient if it enables a workman of ordinary skill in the particular industry to carry out the invention (q). In short, the person upon whose ability to understand the sufficiency of a specification depends is neither simply an uninstructed member of the general public nor an eminent specialist, but the workman of ordinary skill and information on the subject.

With regard to the amount of information to be given, the following remarks of Lindley, L. J., in *Edison v. Holland* (r), are instructive: "With reference to the degree of clearness and distinctness of the language necessary to be used in order to

Degree of clearness required.

(k) (1879) 1 Good. P. C. 88, 91; see now a report of this case in 13 R. P. C. 190.

(l) (1887) 12 App. Ca. 710, 713; 4 R. P. C. 449.

(m) (1841) 1 W. P. C. 295; 10 L. J. Ex. 493; 11 L. J. Ex. 20.

(n) (1841) 1 W. P. C. 211; 10 L. J. Q. B. 302.

(o) (1809) Dav. P. C. 311; 11 East, 101.

(p) (1852) 2 W. P. C. at p. 245.

(q) And see *Hornblower v. Boulton* (1799), 8 T. R. 100; *Edison v. Woodhouse*, 4 R. P. C. 92; *Edison v. Holland*, 6 R. P. C. 243, 280.

(r) (1880) 6 R. P. C. at pp. 279, 280.

comply with those conditions, it is obvious that no hard and fast rule can be laid down; the degree of clearness can only be stated in language which itself admits of considerable latitude in its application. On the one hand, the patentee must make the nature of his invention, and how to perform it, clear and intelligible; on the other hand, it is not necessary for him to instruct persons wholly ignorant of the subject-matter to which his invention relates, in all that they must know before they can understand what he is talking about." . . . In complying with their first condition, *i.e.*, in describing the nature of his invention, the patentee does all that is necessary, if he makes the nature of his invention plain to persons having a reasonably competent knowledge of the subject, although from want of skill they could not practically carry out the invention. In complying with the second condition, *i.e.*, in describing in what manner the invention is to be performed, the patentee does all that is necessary, if he makes it plain to persons having reasonable skill in doing such things as have to be done, in order to work the patent, what they are to do in order to perform his invention. If, as may happen, they are to do something the like of which has never been done before, he must tell them how to do it, if a reasonably competent workman would not himself see how to do it on reading the specification or on having it read to him.

The invention and the means of performing it may be described in words, or assistance may be obtained from drawings, and provided that the test suggested in the remarks of Lindley, L. J. (just quoted), is satisfied, the specification gives the proper amount of information. It is a question of fact, no general rule can be laid down to cover what is sufficient. A rule which was framed to meet an inventor's small mechanical improvement, would obviously be inapplicable to such a patent as was in dispute in the *Badische, &c. v. Levinstein (s)*. When the construction of the specification had been arrived at by the Court, the sufficiency used to be a question left to the jury (*t*); and the matter is still one to be determined by evidence (*u*).

Sufficiency is mainly a matter of fact.

(s) (1887) 12 A. C. 710; 4 R. P. C. 449.

(t) *Macnamara v. Hulse*, 2 W. P. C. 128, 129; *Hill v. Thompson* (1817), 1 W. P. C. 237; *Bickford v. Skewes* (1841), 1 Q. B. 938; 10 L. J. Q. B. 302; 1 W. P. C. 214; *Wallington v. Dale* (1852), 7 Ex. 888; 23 L. J. Ex. 49; *Beard v. Egerton* (1848), 19 L. J. C. P.

38; 8 C. B. 165; *Parkes v. Stevens*, 8 Eq. 358; 5 Ch. 36; 38 L. J. Ch. 627; note (*d*) Ed. 121.

(u) Lord Cairns in *British Dynamite Co. v. Krebs* (1879), 1 Good. P. C. 88; 13 R. P. C. 190; *Badische Anilin, &c. v. Levinstein* (1887), 12 A. C. 710, 713; 4 R. P. C. 449.

Since the specification is deemed to be sufficient if information is given in it enough to enable the competent workman, as above described, to manufacture the article, the case is of an *à fortiori* nature if in fact subject-matter of the invention has actually been made from the specification and from the specification alone (x).

But the specification must give information to enable a competent person to carry out the invention without the aid of external information, for "it does not prove that a specification is sufficient because a man from knowledge he has got from three trials, and seeing people immediately employed about it, is able to make use of it" (y). If the specification gives sufficient information, but, owing to want of skill, a person possessed of competent knowledge is unable to make the article, nevertheless the specification is good: *Edison v. Holland* (z), per Lindley, L. J.

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, and a specification need not explain any facts with which an ordinary workman must necessarily be acquainted.

Thus, in *Crossley v. Beverley* (a), 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.

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 (b), and if experiments are necessary in order to produce any beneficial effect from an invention at all, the specification will be bad (c).

In *Macnamara v. Hulse* (d), an action for the infringement of a

(x) *Cornish v. Keene* (1835), 1 W. P. C. 501; and see *Morgan v. Seaward*, 1 W. P. C. 170; *Shaw v. Jones* (1889), 6 R. P. C. 328, 335.

(y) Buller, J., in *R. v. Arkwright* (1785), 1 W. P. C. 66; Dav. P. C. 106. See also *Morgan v. Seaward* (1836), 1 W. P. C. 174; *Wegmann v. Corcoran* (1879), 13 Ch. Div. 65.

(z) (1889) 6 R. P. C. at p. 286.

(a) (1829) 1 W. P. C. 106, 112; 3 C. & P. 513; and see *Hopkinson v.*

St. James, &c., Electric Light Co. (1893), 10 R. P. C. 46.

(b) *Morgan v. Seaward* (1836), per Alderson, B., 1 Web. P. C. 174: cf. *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.

(c) *Neilson v. Harford* (1811), per Parke, B., 1 Web. P. C. 371.

(d) (1842) 2 Web. P. C. 128, 129.

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 experiment to determine what is the proper angle, it is not good, but if any angle is a benefit, it will do." But the law must not be unduly strained against the inventor (e).

In *Edison v. Woodhouse and Rawson* (f), the specification spoke of a filament but nowhere defined the term, nor drew any distinction between it and a rod. It was objected that consequently the specification was too vague. To this Fry, L. J., replied, that, "in a patent of this description, definition is required only to such an extent as would enable a practical workman to construct the required apparatus; that there is distinct evidence that such a workman could make the required apparatus from the specification, and that no witness of the defendants allege that such a workman would have any difficulty or require any further experiments, and that the specification itself. . . . contains descriptions of six forms of filaments, and the description, it is obvious, would afford material assistance to any workman in doubt."

The law is not to be strained against the sufficiency of the specification

In a subsequent case (g), Lindley, L. J., dealing with the same specification said that the meaning of "filament" could be gathered from the rest of the document, and this he considered to be sufficient.

In the same case (h) it was objected that the specification did not give sufficient instructions relating to the carbonisation of the filaments; Lindley, L. J., after saying that it is not fatal to a specification to show that even a workman could not carry out the invention as instructed by it without practice, goes on to say: "If a person is told to carbonise a thread, and for want of thought, or practice, he takes a porous crucible for the purpose, and does not protect his thread, and fails, when if he had packed

The fact that a workman cannot at once carry out the invention is not always fatal.

(e) Lord Shand in *Lyon v. Goddard* (1894), 11 R. P. C. 364.

(f) (1887) 4 R. P. C. 79, 92.

(g) *Edison v. Holland* (1889), 6 R. P. C. at p. 281.

(h) *Ibid.*, p. 282.

this crucible, or had taken a non-porous crucible, he would have succeeded, his failure can hardly be said to be the fault of his instructor, if a little thought and consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that a workman may use a wrong tool when he has a right one, which a little thought will lead him to see ought to be used, does not warrant the inference that a specification is bad if it does not tell him which tool to use. . . . if a patentee says that something must be done, which a reasonably competent man would know how to do, the patentee need not tell him how to do it, nor warn him to be careful, and to exercise such forethought and attention as the delicacy of the process to be used, or the material to be employed, plainly demand" (i).

Verbal errors in complete specification. Error which would not mislead does not vitiate.

A specification is not vitiated by a mere verbal error in the specification which cannot mislead, as where air is called an imponderable substance, or sulphur a mineral (k), nor by a mistake in a matter foreign to the invention, nor by the inaccurate use of words which are explained by the context, as where the word "discolouring" was used to signify depriving of colour, and the word "baked" to signify crystallized (l).

And if in a particular figure there is some error of the draughtsman which a skilled workman would at once perceive to be an error, and such an error as he could correct, it is nothing more than like the mere misprint of a word which anybody could read, although it was so misprinted (m):

A known or obvious slip need not be mentioned (n), and known methods or compounds may be described by general words (o). The question comes back to this:—Does the specification as it stands mislead the ordinarily competent man?

What errors are immaterial.

"When it is stated," said Lord Westbury, L. C., in *Simpson v. Holliday* (p), "that an error in a specification which any workman

(i) See also *Plimpton v. Malcolmson* (1876), 3 Ch. Div. 531; 45 L. J. Ch. 505; *Simpson v. Holliday* (1886), L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Macnamara v. Hulse* (1842), 2 W. P. C. 128, n. In *The Lifeboat Co. v. Chambers* (1891), 8 R. P. C. 418, it was decided that an omission which an ordinary shipbuilder could obviate or supply by himself, would not, *per se*, vitiate the patent.

(k) *Neilson v. Harford* (1841), 1 W. P. C. 331, 340; 8 M. & W. 806; 11 L. J. Ex. 20; *Minter v. Mower* (1835),

1 W. P. C. 142; 6 A. & E. 735.

(l) *Derosne v. Fairie* (1835), 1 W. P. C. 154.

(m) Per Bowen, L. J., in *Miller v. Scarle Barker* (1893), 10 R. Pl. 111.

(n) *Morgan v. Seaward* (1896), 1 W. P. C. 177; 2 M. & W. 558; *Crossley v. Beverley* (1829), 3 C. & P. 513; 1 W. P. C. 106; *Househill Co. v. Neilson* (1842), 1 W. P. C. 676.

(o) There seems some danger in so doing; see *Savory v. Price* (1823), 1 W. P. C. 83; 1 Ry. & Mo. 3.

(p) (1865) 13 W. R. 578.

of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is because such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once perceived by a workman possessed of ordinary knowledge of the subject."

In conclusion the general rule may be summed up as follows : Summary.
A complete specification is, and the Courts must declare it to be, 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.

If the specification is insufficient, the patent is invalidated, and honesty of purpose is no answer to a deficiency in this respect (q). If two inventions are described and claimed in the same specification, the insufficient description of one will avoid the patent granted as regards both (r). If two processes are described as efficient and both are claimed as part of the invention, but on trial one is found to be useless, the entire patent will be voided (s). Honest intention will not sustain an insufficient specification.

2. The Claims.

A claim is a short clause inserted in a specification, wherein the patentee particularly points out what he claims as his invention. It is the part of the specification which defines and limits with precision that which is alleged to have been invented. Definition of claim.

Prior to the Patents Act, 1883, although usual, it was unnecessary to insert claiming clauses in the specification of inventions. Thus, in *Lister v. Leather* (t), 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 Origin of claims.

(q) *Simpson v. Holliday* (1864), Hig. Dig. 443. (1870), 10 Eq. 522.

(r) *Morgan v. Seaward*, 1 W. P. C. 167, 173; *Hill v. Thompson*, 1 W. P. C. 235; (s) *Simpson v. Holliday* (1866), 13 W. R. 578.

(t) (1858) 8 E. & B. at p. 1033; 27 L. J. Q. B. 295.

Act of 1883,
s. 5, sub-s. 5.

there be no claim." The Act of 1883, sect. 5, sub-sect. 5, however, provides that a complete specification "must end with a distinct statement of the invention claimed."

Provided the specification ends with a statement of the invention 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 (*u*). There must, however, be a real statement of the invention claimed, and not merely a colourable compliance with the terms of the statute, nor a mere reference to the previous description, *e.g.* "I claim the invention described in the specification," would not be regarded as sufficient (*r*).

"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 (*y*).

The fact that a complete specification does not conclude with "a distinct statement" as above defined is not made a ground for revocation under sect. 26 of the Act, and cannot be urged as an objection to the validity of a patent (*z*); the section is merely directory (*z*).

Absence of a
claim does
vitate the
specification.

The result seems to be that the omission of a distinct claim would cause the examiners to report that the specification had not been prepared in the prescribed manner, and would cause the comptroller to refuse the application, or to require an amendment of the specification (*a*). If the patent is granted, the omission

(*u*) *Re Smith*, Griff. 268. *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.

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

(*y*) *Siddell v. Vickers* (1888), per Lopes, L. J., 5 R. P. C. at p. 433; 39 Ch. Div. 92. 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 on the accompanying drawings," not to be "a distinct statement" within this subsection. In the House of Lords the matter did not call for a decision.

(*z*) So decided by the House of Lords affirming the Court of Appeal in *Vickers v. Siddell* (1890), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 202.

(*a*) Act of 1883, sects. 6, 7.

of a claim is neither a ground for revocation, nor is it a defence to an action for infringement (b).

The function of a claim has been considered on several occasions. The view taken under the former Acts is to be found in *Kay v. Marshall* (c), where Lord Cottenham said: "It (the claim) is introduced lest in describing and ascertaining the nature of his invention, and by what means it is to be performed (particularly in the case of a patent for an improvement), 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."

Function of a claim.

In *Plimpton v. Spiller* (d), James, L. J., said: "The real object of what is called a claim . . . is not to claim anything which is not mentioned in the specification, but to disclaim something; . . . having described his invention and the mode of carrying that invention into effect, by way of security he says: 'But take notice, I do not claim the whole of the machine, I do not claim the whole of that *modus operandi* but that which is new, and that which I claim is that which I am now about to state.' That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification."

Claim is to a large extent a disclaimer.

The law under the older Act as stated in *Plimpton v. Spiller* has recently been declared still to hold good under the present Act, and the judgments of James, L. J., have been quoted with approval both by Kay, L. J., and Smith, L. J. (e). But according to a dictum of Lord Herschell in *Parkinson v. Simon* (f), the view of the functions of a claim stated in the old cases need modification. On counsel saying that a claim is a disclaimer, and must not be taken to widen the description in the body of the specification, Lord Herschell said: "Since 1883 it is not correct to speak of a claim as a disclaimer, as one can now only protect what is claimed."

To consider whether, before 1883, the negative operation of the claim was not too exclusively considered, would now be

But it is more than merely a disclaimer.

(b) *Vickers v. Siddell* (sup).

(c) (1836) 1 My. & Cr. 383; 2 W. P. C.

(d) (1877) *Plimpton v. Spiller*, 6 Ch. Div. 412; 47 L. J. Ch. 211. And see per Jessel, M. R. in *Hinks v. Safety Lighting Co.* (1876), 4 Ch. Div. 607;

46 L. J. Ch. 185; per Kay, J., in *Lucas v. Miller* (1855), 2 R. P. C. 155.

(e) *Edison-Bell Phonograph Co. v. Smith and Young* (1894), 11 R. P. C. 389, at pp. 401, 405.

(f) (1895) 12 R. P. C. at p. 406.

unprofitable. Since the coming into operation of the 1883 Act, a claim must not be taken to be merely a disclaimer. It is a disclaimer, but it is something more. The law now requires that the claim shall be "a distinct statement of the invention claimed." When a patentee says: "I claim A.B." he must be taken to mean I claim nothing but A.B., but A.B. I do claim.

This view is supported by the dictum of Lord Herschell, just quoted, and receives indirectly support from the decision of the House of Lords in the case under argument when the late Lord Chancellor made his remark. On the other hand, the adoption, in *Edison v. Smith* (g), of the dicta of James, L. J., in *Plimpton v. Spiller* (h), tells against it. It will be observed, however, that Kay, L. J., in quoting the language of James, L. J. (i), evidently adopts it only in respect to the particular claim before him at the time. Smith, L. J., certainly goes farther (k), but obviously he had in mind the practice which prevailed before the Act of 1883, and not the provisions of that Act itself. It is submitted that the view of the function of a claim which prevailed when a claim was put in only *ex abundantia cautela*, no longer prevails now that the Legislature has directed that a distinct statement of the invention claimed ought to be added to the specification, but that the obiter dictum of Lord Herschell will, when the point calls for decision, be declared to be a correct statement of law.

Office of a claim as stated in *Siddell v. Vickers*.

The language of Kekewich, J., in *Siddell v. Vickers* (l) may be quoted: "Its office [*i.e.* of the claim] is to sum up what has been explained in detail, and to state distinctly, that is, in a manner fairly intelligible to the competent student, what is claimed, and if necessary for distinctness, what is not claimed, so as if, as is likely and usual, the copiousness of explanation and illustration has proved embarrassing, no reasonable doubt may remain as to what is of the essence of the invention, and what is left at large for the ingenuity of subsequent makers in the same field."

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.

The claim must not go beyond the invention.

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

In *Minter v. Mower* (m), the patent was taken out for "an

(g) (1894) 11 R. P. C. 389.

(h) (1877) 6 Ch. Div. 412; 47 L. J. Ch. 211.

(i) 11 R. P. C. 401.

(k) 11 R. P. C. 405.

(l) (1888) 39 C. D. 92, 96.

(m) (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. 361.

improvement in the construction, making, or manufacturing of chairs." The specification concluded, "what I claim as my invention 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.

Patentee must not claim more than he has himself invented.

In *Bloxam v. Elsee* (n), 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.

A claim must not be so wide, either in itself or upon the evidence, as to include that which, either on account of anticipation, or for other reasons, is not patentable.

Claim must not be too wide—

In *Wyeth v. Stone*, an American case mentioned by Mr. Justice

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. 627, 631; *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. 522.
(n) (1827) 6 B. & C. 169; 1 W. P. C. 132, n.

either apart
from the
evidence,

Curtis in his work on *Patents* (o), 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* (p), "chooses to put forward his claim in so preposterous a form as that, of course he 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."

or upon the
evidence.

Jordan v. Moore (q) 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 is better as an illustration of the rule that a patentee cannot claim more than he has invented. 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.

The validity
of wide
claims.

In the course of his judgment in *Edison-Bell Phonograph Corporation v. Smith* (r), Wright, J., said: "No case has been cited to show that exception can be taken to a claim on the ground of its being too wide or general, without evidence to show that it includes something old or useless;" and the words were quoted with approval by Smith, L. J. (s). But if through generality the claim covers something which is not patentable, e.g., a principle, the claim will be bad, though neither old nor useless. The dictum of Wright, J., therefore, must probably be extended to this, that a claim, though wide or general, will not

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

(p) (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.

(q) (1866) L. R. 1 C. P. 624; 35 L. J. C. P. 268; see also *Patterson v. Gas Light and Coke Co.* (1875), 2 Ch. Div. 812, 834; 45 L. J. Ch. 843.

(r) (1894) 11 R. P. C. 165.

(s) (1894) 11 R. P. C. 405.

be bad unless it includes something old, useless, or otherwise not the subject of a valid patent.

It may one day be a point whether even this is good law. In *Booth v. Kennard* (t) the claim ran thus: "I claim for making gas direct from seeds and matter herein named, for practical illumination or other useful purposes, instead of making it from oils, resins, or gums previously extracted from such substances." It was decided that the claim was too large owing to the existence of a prior patent; that, even if the invention had been new, the claim would have been too large and the patent bad (u). With the exception of this case, there seems to be no very clear decision which impugns the generality of the law as laid down in the *Edison-Bell case*. But, inasmuch as the claims before the 1883 Act could not extend but only limited the other parts of the specification (v), much assistance in coming to a conclusion cannot be derived from the absence of cases. If, as is submitted, the functions of the claim are now of a positive as well as of a negative character, the mere width of a claim may well be a ground for declaring it bad. The dictum of Wright, J.—unnecessary to the decision in the case before him, and not stating the law in very decided terms—will not be much in the way of such a conclusion.

Though a claim to an old process would be bad, the patentee is not debarred from pointing out that the invention is also available for a use in a manner which is not new, provided that he makes no exclusive claim to the old method (y). And if a material resulting from a process is claimed, the specification of a particular user of it, comprehended in the general user claimed, will not vitiate the patent (z).

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 (a).

In *Reg. v. Cutler* (b), the case of *Lewis v. Marling* (a) was quoted as establishing the doctrine that if the specification of

Claim to a something useless.

Reg. v. Cutler.

(t) (1857) 2 H. & N. 84; 26 L. J. Ex. 305. And see, per Malins, V.-C., in *Rushton v. Crawley* (1870), 10 Eq. 527.

(u) In this case the claim was too wide, because it went beyond what was described in the specification, and no method of carrying the claim into effect was given.

(v) See Pollock, C. B., in *Heath v. Unwin* (1855), 25 L. J. C. P. at p. 20;

5 H. L. C. 505.

(y) *Goddard v. Lyon* (1894), 11 R. P. C. 354, 360.

(z) *Neilson v. Betts* (1871), L. R. 5 H. L. 1, 21; 40 L. J. Ch. 317.

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

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

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 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 *Levis v. Marling* (c), "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 (d) is a conclusive authority in favour of the law laid down by the Court of King's Bench in *Reg. v. Cutler* (db). 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."

These cases are but illustrations of the principle that no part of a specification may be vague and ambiguous. As applied to claims the law may be gathered to be that if the useless part is claimed as being a necessary part of the invention, or an alternative mode of carrying it out, the claim is bad; the reason being that the public are likely to be misled. If, however, the useless part of

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

(d) (1866) 5 N. R. 340.
(db) *Supra*, p. 187.

the claim would neither puzzle nor mislead, the claim will not be invalidated. A claim which is futile, and has no effect upon the monopoly, and which is uselessly added, will not vitiate a patent otherwise good (*e*); unless it makes the rest of the specification vague or misleading.

It may be stated as a general rule that claims may include anything which can be the subject of a valid patent, but nothing else. For instance, a new idea coupled with a mode of carrying it out, new combinations or improvements may be claimed. On the other hand, an abstract principle cannot be *per se* the subject of a claim (*f*), nor can the *mere* application of an old thing to an analogous purpose (*g*).

In claims for improvements it must be specifically pointed out what is the improvement claimed and what is the old part of the article; whereas, in claims for combinations, there is no need specifically to distinguish the new from the old. But if it is desired that the patent should cover the details of the combination, these must be specifically pointed out and claimed (*h*). And in any case, in a specification of a patent for a combination, the claim must be so drawn that the public may know whether what is claimed is a combination alone, or the combination with the parts of which it is made up (*i*).

It is altogether a question of construction of the particular instrument before the Court (*k*). The specification should be viewed as a whole, and keeping in mind the state of knowledge at the date of publication, it must then be decided whether the claim is for a combination, or for the particular parts making up the combination—called the subordinate integers,—or for both (*l*).

The language used in *Lister v. Leather* (*m*), to the effect that a valid patent for an entire combination for a process gives

Claims may cover anything which could be the subject of a patent.

Improvements and combinations.

If the elements are to be covered by the patent they must be specifically claimed.

(*e*) And see the concluding part of the speech of Lord Cairns in *British Dynamite Co. v. Krebs*, Good. P. C. at p. 94; 13 R. P. C. 190; *Plimpton v. Spiller* (1877), 6 Ch. Div. at p. 434.

(*f*) *Neilson v. Harford* (1841), 1 W. P. C. at p. 337; S M. & W. 806; *Otto v. Linford* (1882), 46 L. T. 39.

(*g*) *Harwood v. G. N. Ry.* (1860-5), 11 H. L. C. 654; 35 L. J. Q. B. 27.

(*h*) The development of the law in this respect has already been dealt with, *ante*, pp. 170 *et seq.* And see *Forwell v. Bostock* (1864), 4 De G., J. & S. 298, 311; *Moore v. Bennett* (1861), 1 R. P. C. at

p. 143; *Rowcliffe v. Morris* (1886), 3 R. P. C. 17, 145.

(*i*) Per Bristowe, V.-C., in *Rowcliffe v. Morris* (*ubi sup.*).

(*k*) *Rowcliffe v. Morris* (*sup.*); *Kelly v. Heathman*, 45 Ch. Div. 256; 60 L. J. Ch. 22; 8 R. P. C. 343; *Murray v. Clayton* (1873), 7 Ch. 570, 578; *Clark v. Adie*, 10 Ch. at p. 671; 45 L. J. Ch. 228; *Lister v. Leather* (1858), 8 E. & B. 1023.

(*l*) *Westinghouse v. Lancs. and Yorkshire Ry.* (1884), 1 R. P. C. 98, 229.

(*m*) (1858) 1 E. & B. 1004, 1023.

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, has been adversely criticised, and is no longer law (*n*). A claim for a combination of three elements is very different from, and does not cover the three elements separately. It is important to bear this in mind when drawing claims. If the subordinate integers are not claimed, infringement of them cannot be complained of; if they are separately claimed, and are not novel, they avoid the whole patent and must be got rid of.

Claim for subordinate integers.

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

"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 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."

(*n*) Per Lord Chelmsford, 1 App. Ca. 581. 46 L. J. Ch. 585; followed by Cotton, L. J., in *Cropper v. Smith* (1884), 1 R.

(*o*) (1873-75) 2 App. Cas. at p. 321; P. C. at p. 87.

“When one does find in a claim,” said Cotton, L. J., in *Cropper v. Smith* (p), “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 which are introduced into it, and help, together with other things, to make the entire combination.”

Claim for subordinate integer *in gross*.

If the subordinate integers thus claimed are claimed only as appendant to the main invention—if, in fact, it 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. Thus, in *The British Dynamite Co. v. Krebs* (q), 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. “He does not,” said Lord Cairns, “claim the means of explosion *in gross*, but only as appendant to the dynamite, and he would not be allowed under this patent to claim them for any other purpose. In other words, he claims in the first claim the dynamite, the substance itself, and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could have been exploded, he might have omitted his second

Integers appendant.

Claims for subordinate integers as appendant.

(p) (1884), 1 R. P. C. at p. 88.

(q) (1875-9) Good. P. C. 88; 13 R. P. C. 190; followed in *The Pneumatic Tyre Co. v. Caswell* (1896), 13 R. P. C. 164, in which it was stated that the

addition to valid claims of claims for mere methods of application of the invention, which are surplusages, does not invalidate the patent.

claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the user of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

In this connection it may be more broadly stated, that if there are two constructions, one of which will support and the other invalidate the patent, the Court will construe the specification so as to support the patent. But the proposition cannot be sustained as a general statement of law; it applies only when there is an ambiguity in the language of the claim (*r*).

It is said that 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.

Plimpton v. Spiller explained.

Plimpton v. Spiller (*s*), an exceptional case, illustrates the above. There 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.

"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 (*t*): "If you can say that the subsidiary

(*r*) See per Lord Davey in *Parkinson v. Simon* (1895), 12 R. P. C. at p. 411.

(*s*) (1876-77) L. R. 6 Ch. D. at p. 426;

47 L. J. Ch. 211.

(*t*) S.C., L. R. 6 Ch. D. at p. 433; cp. *Betts v. Neilson* (1871), L. R. 5

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* (u) "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*."

The effect of a bad claim is to avoid not only the claim itself, but the patent as a whole goes too (x). And *bonâ fides* on the part of the patentee will not save the grant. The patentee may amend his specification by disclaiming the obnoxious claim, but only subject to the restriction imposed by sect. 20, as to which see *infra*, p. 228 and p. 592.

Effect of a bad claim is to invalidate the patent.

The drafting of claims becomes, therefore, a matter of great difficulty, for if they be too wide they subject the patentee to the danger of invalidation; and if too narrow, it becomes comparatively difficult to show that an infringer has contravened the patent. Especially does the difficulty arise in the case of combinations. Often the general idea as carried out in practice is first claimed, and then follow claims for the subordinate parts, either in combination or otherwise according to circumstances. It is the width of the general claim which in practice is found to be most dangerous, and often, in lieu of a general claim, the particular parts are claimed in combination in as many ways as may occur to the ingenious draftsman, so as to render the path of the infringer difficult. In the result, claims are becoming as numerous and as bulky as the paragraphs of the object clause of a memorandum of association.

The following is a good example of how a meritorious invention

H. L. at p. 21; 40 L. J. Ch. 317. 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."

(u) 1884, 1 R. P. C. at p. 90.

(x) *British Dynamite Co. v. Krebs* (1879), Good. P. C. 93; *Rose v. Braby* (1894), 11 R. P. C. 198; *Parkinson v. Simon* (1895), 12 R. P. C. at p. 408. See a suggested limitation in *Adamant Stone and Paving Co. Ltd. v. Corporation of Liverpool* (1897), 14 R. P. C. at p. 23.

may be defeated:—*Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate* (y). The patent was for a method of obtaining gold and silver from ore. The first claim was “for the process of obtaining gold and silver from ores and other compounds, consisting in dissolving them out by treating the powdered ore or compound with a solution containing a quantity of cyanogen, or a cyanide, or cyanogen-yielding substances, substantially as hereinbefore described.” The Court of Appeal, deciding that it was old knowledge that cyanide of potassium would act as a solvent of finely divided gold, but not that it would act as a solvent of gold to extract it from the ore, nevertheless felt obliged to decide against the patentee, because the first claim claimed the use of any cyanide of potassium in solution (without limitation as to quantity), to extract gold from ore, a claim useless and too wide, it being proved that only a dilute solution would effect the purpose.

“Substantially as described.”

It is a common practice to add to the claim the words: “substantially (z) as before described,” or words to the like effect, the object being to limit the generality of a claim by the description contained in the body of the specification. The claim may, and indeed should, be read in the light of the information contained in the specification (a); but the inclusion of the words just stated do not always have the limiting effect intended. The question is one of construction, and depends entirely upon the exact framing of the specification; each case must depend upon its own facts. If this be borne in mind, the following case may carefully be noted:

Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate (b). It was argued that a general claim for the use of a cyanide was restricted, by the words “substantially as described,” to the proportions mentioned in the specification. But a second claim embracing the dilute solution contained the specified amount. The Court of Appeal (affirming Romer, J.), said that the true construction was that the first claim and the second were different, and that consequently the wide interpretation which must be given to the first made the whole bad.

Parkinson v. Simon.

Parkinson v. Simon (c): the patent in this case was for “Improvements in sieves for purifying grain.” There were four

(y) (1895) 12 R. P. C. 232.

(z) In *Young v. Rosenthal* (1884), 1 R. P. C. 33, Mr. Justice Grove commented adversely upon the use of the word “substantially.” He regarded it

as entirely useless.

(a) (1895) 12 R. P. C. 232.

(b) *Edison v. Woodhouse* (1887), 1 R. P. C. at p. 107.

(c) (1895) 12 R. P. C. 403.

claims, the last of which was for the combination of a sieve and side deposit surfaces with a deflector. The other three claims did not mention the deflector, *e.g.*, the first claim was "in apparatus such as described a sieve tapering in width towards the delivery or tail end in combination with one or more side deposit surfaces increasing in width towards the delivery or tail end substantially as and for the purpose described and illustrated in the accompanying drawings." The specification itself mentioned and described the deflector and referred to the drawings, and these contained diagrams of the deflector in combination with the general apparatus. For the present purpose it may be taken that the claims—of which the first just quoted is an example—were bad unless they included the combination with the deflector. It was argued for the patentee that the words "in apparatus such as described," and "substantially as and for the purpose described," by reference incorporated in the claim a claim to the combination of deflector and sieve. The House of Lords rejected the contention. Lord Herschell said: "I find it impossible to put that construction upon the words 'in apparatus such as described.' The effect of it necessarily would be to make all the four claims mean exactly the same thing, because, of course, if 'in apparatus such as described' means apparatus containing every one of the parts described, and if you only claim what you do claim in that apparatus, obviously that is a claim to a combination which is precisely the same in each of the four cases referred to . . . I think 'in apparatus such as described,' naturally refers to the general use of the apparatus specified in the first two lines of the specification. 'This invention relates to oscillating sieves used for purifying . . . grain or other substances.'"

It will be noticed that Lord Herschell based his interpretation of these particular claims on the necessity of giving a meaning to each claim (*d*). This may not always be possible, and, as Lindley, L. J., pointed out in *The Wenham Gas Co. v. The Champion Gas Lamp Co.* (*e*), a repetition of a claim, though mere redundancy, does not vitiate a patent. If, however, the claims are susceptible of a different meaning, *Parkinson v. Simon* shows that the Court will probably, though not necessarily, so interpret the claims as to give each that different meaning (*f*).

A meaning to be given if possible to each claim.

(*d*) See also per Kay, J., in *Longbottom v. Shaw* (1888), 5 R. P. C. 502.

(*e*) (1892) 9 R. P. C. at p. 55.

(*f*) See also *Jordan v. Moore* (1866),

*Edison Bell
v. Young.*

In *The Edison Bell Phonograph Corporation v. Smith and Young* (g), the specification stated: "Having now particularly described and ascertained the nature of this invention and in what way the same is to be performed, I claim (i) in a phonograph, attaching both the recording point and the reproducing point to the same diaphragm; means being provided whereby either of the points may be brought into operative position on the surface of the phonogram." It was urged that this claim was a claim for a monopoly for every form of phonograph in which the two styles are attached to one diaphragm so that each style can be brought to bear on the cylinder, and was therefore too wide. The Court of Appeal (confirming Wright, J.), rejected this contention, and held that the words "Having now particularly described, &c.," had the effect of limiting the claim to the arrangement carried out by any means substantially as described in the specification. It may be pointed out that this case was decided before the *Cassel Gold* (h) case, and also before *Parkinson v. Simon* (i). It may, perhaps, also be suggested that the remarks of Bowen, L. J., commenting on *Plimpton v. Spiller* (k) seem applicable to the Edison Phonograph case: "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 on the true construction of Plimpton's patent" (l).

Amongst other cases in which the effect of such words as "substantially as described" was considered are *Penn v. Bibby* (m); *Easterbrook v. Great Western Ry.* (n) (in both of which they had a limiting effect); *Lawrence v. Perry* (o), and see also *United Telephone Co. v. Bassano* (p).

In avoiding too great width, care must be taken to avoid the opposite danger.

Claim for
specific
improvement.

If a specific mechanical improvement is claimed, the inventor must be held strictly to that particular mechanical device which

L. R. 1 C. P. 624; 35 L. J. C. P. 268 in which it was attempted, without success, to cut down the generality of one claim, by the words "substantially as described" included in another.

(g) (1894) 11 R. P. C. 389.

(h) *Ante*, p. 194.

(i) *Ante*, p. 194.

(k) (1877) 6 Ch. Div. 412; 47 L. J.

Ch. 211. This case may be referred to as further illustration.

(l) *Cropper v. Smith*, 1 R. P. C. 90.

(m) (1866) 2 Ch. 130, 131; 36 L. J. Ch. 455.

(n) (1885) 2 R. P. C. 201.

(o) (1885) 2 R. P. C. 179.

(p) (1888) 3 R. P. C. 295, 315.

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 *boni fide* employed a different system and a different way must not be held to have infringed (q).

Thus, in *Seed v. Higgins* (r), 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 particular means described in the specification. It was held that the claim was strictly limited thereto.

Seed v. Higgins

In *Nobel v. Anderson* (s), the patent was for an improvement in explosives, and one of the claims was for the "manufacture from nitro-glycerine and soluble nitro-cellulose, of a horny or semi-horny explosive compound, susceptible of granulation, substantially as and for the purposes herein described." The defendant made an explosive using nitro-glycerine and insoluble nitro-cellulose. The Court finding as a fact that the soluble and the insoluble nitro-cellulose are different substances, held that the defendant had not infringed.

Sometimes the patentee claims to carry out his invention by specified means, "or any 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 (t).

The words "or some mechanical equivalent."

(q) *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. 840; 22 L. J. Ex. 295; 9 Ex. 494; 23 L. J. Ex. 217; *Proctor v. Bennis* (1888), L. R. 36 C. D. 740; 57 L. J. Ch. 11; 4 R. P. C. 333; *Ehrlich v. Ihlee* (1888), 5 R. P. C. 437, 453.

Eq. at p. 512; 36 L. J. Ch. 482. When a specification has been the subject of a disclaimer, the specification and disclaimer are to be construed fairly and not strictly. *Hocking & Co. v. Hocking* (1888), per Cotton, L. J., 4 R. P. C. at p. 439.

(s) (1894) 11 R. P. C. 519; 12 R. P. C. 164.

(r) (1860) 27 L. J. Q. B. 148, 411; 8 H. L. C. 550; cp. *Daw v. Eley* (1865), 3

(t) *Curtis v. Platt* (1863), per Wood, V.-C., 3 Ch. Div. 137, n. As to the word "substantially," see per Grove, J.,

Construction
of a claim.

The construction of a claim is governed by the same rules as are applicable to the construction of a specification generally, or both see *post*, p. 202.

A claim must always be construed with reference to the whole context of a specification (*u*). 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 (*v*).

General
claim may be
modified by
specification,

In *Arnold v. Bradbury* (*y*), 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* (*z*), the patentee claimed "the herein described method of preparing the illuminating part of an electric lamp, consisting of electrically heating the 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

in *Young v. Rosenthal* (1884), 1 R. P. C. 33; see also *Westinghouse v. Lanc. & Yorkshire Ry. Co.* (1884), 2291 R. P. C.

(*u*) *Plimpton v. Spiller* (1876-77), per James, L. J., L. R. 6 Ch. D. at p. 426; 47 L. J. Ch. 211; *Leadbeater v. Kitchin* (1890), 7 R. P. C. 235; *Siddell v. Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 416; *Edison-Bell Phonograph Co. v. Smith* (1894), 11 R. P. C. 389.

(*v*) *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; 25 L. J. C. P. 8.

(*y*) (1871) L. R. 6 Ch. D. 706.

(*z*) (1887) 4 R. P. C. 99, 107. In *Newton v. Vaucher* (1851), 6 Exch. at p. 864; 21 L. J. Ca. 305, 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.

moment that 'carbonic oxide' or 'carbonic acid' would answer the purpose, or could be meant by carbon gas."

In *Gandy v. Reddaway* (a), 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."

3. Drawings.

At one time drawings were unnecessary, but though unnecessary were very generally employed to explain the specification (b). Under the Act of 1883, sect. 5 (3) and (4), the specifications, both provisional and complete, must be accompanied by drawings if required by the comptroller. The Act of 1886, sect. 2, provides that the requirement as to drawings "shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings, the complete specification refers to the drawings which accompany the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification." Act of 1883. Act of 1886.

The specifications when lodged are referred to an examiner to

(a) (1883-85) 2 R. P. C. 52.

(b) *Boulton v. Bull* (1793), 2 H. Bl. 482; *Bloxham v. Elsee* (1825-7), 1 C. &

P. 568; *Hastings v. Brown* (1853), 1 E. & B. 450; 22 L. J. Q. B. 161.

consider whether they are in order, and one of the matters he must report on is, whether the drawings (if any) have been prepared in the prescribed manner (c). If the report is adverse the comptroller may refuse to grant the application until amendment has been made (d).

But rule 30 of the Patent Rules, 1890, provides that the provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them.

The prescribed rules provide for all details connected with the preparation and lodging of the drawings; see *post*, Patent Rules, 1890, rules 30 to 33.

Specifications
without
letterpress.

At one time drawings alone might have been a sufficient specification (c), provided (probably) that the title was attached. But under the present Act, a claim would be required, and a specification without any letterpress would, to say the least, be very unusual. It will be observed that in sect. 5 of the Act, the specification and drawings are spoken of as distinct.

Effect of
drawings.

The law as to the effect of drawings annexed to the specification may be stated as follows: An inventor is not tied down to make such a specification as, by words only, would enable a workman of ordinary skill to make his invention, but is allowed to call in the aid of drawings (if any) (f), which he annexes to his specification (g). The drawings are taken as part of the specification (h), and are admissible to explain an ambiguity (i). But the drawings must be clear themselves (k). And if the words of the specification itself be clear, drawings cannot be allowed to alter the meaning (l).

Fairburn v.
Household.

The extent to which drawings can be relied on where there is ambiguity in a complete specification was considered in the case of *Fairburn v. Household* (m).

The question at issue there was, whether the patentee of an

(c) Act of 1883, sect. 6.

(d) *Ibid.*, sect. 7.

(e) *Brunton v. Hawkes* (1820), 1 Carp. P. C. 405; 4 B. & Ald. 541; *Poupard v. Fardell* (1869), 18 W. R. 127; *Forwell v. Bostock* (1864), 4 De G. J. & S. 298, 363.

(f) This was once doubted; *Ex parte Fox* (1812), 1 V. & B. 67. But see 1 W. P. C. 75, n., note to *Macfarland v. Price*.

(g) *Bloxham v. Elsee* (1825), 1 C. & P. 564; *Daw v. Eley* (1867), 3 Eq. 500, n.; *Brown v. Jackson* (1895), 12

R. P. C. at p. 324.

(h) *Morgan v. Seaward* (1836), 1 W. P. C. 173; *Morton v. Middleton* (1863), 1 Ct. Sess. 3rd series, 722, 724.

(i) *Hastings v. Brown* (1853), 1 E. & B. 450; 22 L. J. Q. B. 161; *Daw v. Eley* (*sup.*); *Matthews v. Parmenter* (1896), 13 R. P. C. 518.

(k) *Clark v. Adie* (1877), 2 App. Ca. 315; 46 L. J. Ch. 585.

(l) *Stewart v. Bell's Trustee* (1883), 11 Ct. Sess. Ca., 4th series, 236.

(m) (1886) 3 R. P. C. 263.

invention for "improvements in fluid injectors" had sufficiently claimed in his specification a lift for water by means of steam, "lifting the water, in the first instance, by a divided column into a vacuum chamber."

The plaintiff admitted that the claim was ambiguous, but contended that the ambiguity was removed by words in the specification referring to the drawings, that the Courts were therefore thrown back upon the description in the specification and annexed drawing, that on going back to the description they would find a steam lifter J. referred to, which appeared in the drawing as a transverse tube, and that every one would know what the effect of that tube would be, viz. to divide the rising column of water, and so make it into a double column.

The Court of Appeal, however, repelled these contentions, and held that the plaintiff had not sufficiently in his specification indicated that he claimed the transverse pipe dividing the column of water.

"A man," said Cotton, L. J., "in his specification ought to point out that which he says is the essential invention comprised here in more definite and explicit terms so as really to show what his invention is, and what he has claimed by the specification."

Drawings should be accompanied by a scale whenever the identity of proportions is in question; and, indeed, a scale is generally a convenience (*n*).

An error in the drawings, if explained in the specification so as to prevent the ordinary skilled workman from going wrong, will not hurt the patent (*o*). And generally it may be said that if the drawings, though not skilfully drawn, are sufficient to enable the persons of the class who would be expected and entitled to understand the specification to make the thing invented, the drawings will suffice (*p*).

Erroneous drawings.

4. Miscellaneous.

Forms, see *post*, p. 818; Acceptance of specification, see pp. 565, 569; Publication of specification, see pp. 572, 580; Time for submitting, see p. 567. And see Patent Rules for details of practice, *post*, pp. 689 *et seq.*

(*n*) *Morton v. Middleton* (1863), 1 Ct. Sess., 3rd series, 721. *v. Holliday* (1866), 13 W. R. 577.
 (*o*) *Miller v. Scarle, Barker & Co.* (1893), 10 R. P. C. 106, 111; *Simpson* (*p*) *Bovill v. Moore* (1816), Dav. P. C. 361.

SECTION 5.—CONSTRUCTION OF COMPLETE SPECIFICATION.

Various
ideas of
construction.

Different views have prevailed, in the development of our patent law, as to the principles on which the specification of an invention ought to be construed. Three doctrines have been advanced: (1) that a patent being a grant of a monopoly must be very strictly construed; (2) that the invention being meritorious, and the patent being a reward, must be benevolently construed; (3) that letters patent must be construed like any other document.

Strict inter-
pretation.

In early times, it was the fashion of the Courts of justice to lean in favour of the public against the patentee (*q*).

Benevolent
interpreta-
tion.

About the year 1830 (*r*), 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 (*s*).

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

Thus, in *Haworth v. Harcastle* (*u*), 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 contrary, such construction ought to be made as will, consistently with the fair import of the language used,

(*q*) *Hullett v. Hague* (1831), 2 B. & Ad. 370; *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 R. P. C. pp. 90, 91.

(*r*) 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."

(*s*) See the cases in note (*q*), *supra*.

(*t*) In *Sellers v. Dickinson* (1850), 20 L. J. Ex. 417; 5 Ex. 312, 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."

(*u*) (1834) 1 W. P. C. at p. 455; 1 Bing. N. C. 182.

make the claim of invention co-extensive with the new discovery of the grantee of the patent."

Again, in *Russell v. Cowley* (x), Alderson, B., said that 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* (y), 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.* (z), his lordship said: "I am anxious, as I believe every Judge is who knows anything of patent law, to support honest *bona 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* (a), 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 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."

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

"Judicial anxiety" to support a useful invention.

Substantial invention of merit.

(x) (1834) 1 Web. P. C. 470.

(y) (1845) 15 L. J. C. P. 49; 2 C. B. 446; *cf.* *Househill Co. v. Nielson* (1843), 1 W. P. C. 679; *Beard v. Egerton* (1848), 5 C. B. 165; 19 L. J. C. P. 36; *Trotman v. Wood* (1864), per Willes, J., 16 C. B. N. S. at p. 503; *Simpson v.*

Holliday (1866), 13 W. R. 578; *Adie v. Clark* (1876), per James, L. J., 3 C. D. at p. 142.

(z) (1876) L. R. 4 C. D. at p. 612; 46 L. J. Ch. 185.

(a) (1876-77) L. R. 4 Ch. D. at p. 423.

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

“ 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 (c), 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* (d), 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

(b) (1881-82) 46 L. T. at p. 39. It might be suspected that sometimes benevolence of construction varies directly with the merit of invention. *Fletcher v. Glasgow Gas Commissioners* (1887), 4 R. P. C. 386, 388; *Hinks v. Safety Lighting Co.* (1876), 4 Ch. Div.

607; 46 L. J. Ch. 185; *Nobel v. Anderson* (1890), 11 R. P. C. 525.

(c) Cp. *Bickford v. Skeeces* (1841), 1 Web. P. C. 214.

(d) (1884) 1 R. P. C. at pp. 89, 91; *Sugg v. Bray* (1885), per North, J., 2 R. P. C. at pp. 230, 231.

old principle of construction, which is not all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Shepherd's Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign. '*Verba debent intelligi cum effectu ut res magis valeat quam pereat*' (e). 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" (f).

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

In *Harrison v. Anderston Foundry Co.* (g), Lord Chelmsford said: "In the construction of a specification it appears to me

Present
theory of
construction.

(e) 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.

(f) In *Newton v. Grand Junction Rail. Co.* (1845-46), 5 Ex. at p. 335; 20 L. J. Ca. 427, n.; 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 R. P. C., at p. 307.

(g) 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; 46 L. J. Ch. 585; *Dudgeon v. Thomson* (1877), per Lord Blackburn, 3 App. Cas. at p. 53; *Roberts v. Heywood* (1879), 27 W. R. 454.

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.”

Needham v. Johnson.

In *Needham v. Johnson* (*h*), 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, these 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.”

To be construed by the rules applicable to other documents.

In *Leadbitter v. Kitchin* (*i*), Esher, M. R., said that the true rule is to construe the specification precisely according to the same rules which are applied to any other document. In *Edison-Bell Phonograph Corporation v. Smith* (*k*) the same learned Judge said: “There are certain rules as to the effect of patents, when you have construed them, which are different from other instruments; but as to the rule of construction of a patent, when the question is what is the true construction, I cannot doubt myself that the same rules of construction or the same canons of construction are to be applied to the construction of a patent, or to any part of it, as are used with regard to any other instrument.” Kay, L. J., delivered judgment to the like effect (*l*). Again, in *Nobel's Explosives Co. v. Anderson* (*l*), Lord Esher said: “I am clearly of opinion that, whether the patent be a pioneer patent, or a master patent, or a patent of the first invention, or whether

(*h*) (1884) 1 R. P. C. at p. 58. See also *Lister v. Norton* (1882), 3 R. P. C. 199; *Automatic Co. v. Knight* (1889), 6 R. P. C. 297, 307.

(*i*) (1890) 7 R. P. C. 235.
 (*k*) (1894) 11 R. P. C. 389.
 (*l*) (1894) 11 R. P. C. 519; in the House of Lords, 12 R. P. C. 164.

it be a valuable patent or a patent for the smallest thing, or whether it be for a patent for an improvement, or whatever the patent may be, the canons of construction of the patent are precisely the same. What is more, I am further of opinion that the canons of construction of a patent are the same canons of construction that are to be applied to every written instrument which has to be construed by the Court."

This statement of the principle upon which patents should be construed is that which found favour with the House of Lords in *Parkinson v. Simon* (m). Lord Halsbury said that the whole instrument must be looked at and the necessary rules of construction must prevail, and he protested against the suggestion that the meaning of the specification should, if possible, be so stretched as to support the patent (n).

It may be said, in conclusion, that the specification will not be construed as rigorously as was at one time the practice (o), and the Court will not be on the look out for flaws in the document; but the words used will be taken in the sense in which they would be understood at the time of publication by those to whom they are addressed, and the Court will determine the meaning of the specification according to the ordinary rules of construction. But if the language is ambiguous, and fairly capable of more than one construction, the Court will adopt that which supports the patent, unless the ambiguity be intentional (p), or *semble* misleading to the public.

Thus, a patentee will not be presumed to have claimed what is well known to be old; but if he clearly does claim it, the Court cannot assist him by a benevolent construction (q). Absurdity of result is no ground for misconstruing, if the construction be clear (r).

The construction of the specification is matter of law, and will be a question for the Judge, its sufficiency is matter of fact, and in a jury trial (s) will be for the jury to determine (t). The

If the specification fairly bears two constructions, that which will support it is to be taken.

(m) (1895) 12 R. P. C. 403.

(n) Even to prevent a man derogating from his own grant: *Hocking & Co. v. Hocking* (1889), 6 R. P. C. 69.

(o) Per Lord Shand in *Lyon v. Goddard* (1894), 11 R. P. C. 354.

(p) Per Lord Davey in *Parkinson v. Simon* (1895), 12 R. P. C. 403, 411.

(q) *Haworth v. Hardeastle* (1834), 1 W. P. C. 480; 1 Bing. N. C. 182;

Oxley v. Holden (1860), 8 C. B. N. S.

68; 30 L. J. C. P. 666; *Clark v. Adie* (1877), 2 A. C. 423, 437; 46 L. J. Ch. 598.

(r) *Cropper v. Smith* (1884), 1 R. P. C. 90.

(s) Patent actions are now tried without a jury unless the Court otherwise directs: 1883, sect. 28 (1).

(t) *Hill v. Thompson* (1817), 1 Web. P. C. at p. 237; *Derosne v. Fairie* (1835), 1 Web. P. C. 154; *Bickford v. Skewes* (1841), 1 Web. P. C. 214; *Neilson v.*

decision of the Court of Appeal on the construction of a specification, being a decision on a point of law, is binding on Courts below (ii).

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

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* (x):—"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 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."

Evidence to assist the construction.

But though the Court has to determine the construction, it will often require evidence to assist it in arriving at the true

Harford (1841), 1 Web. P. C. 295; *Beard v. Egerton* (1848), 19 L. J. C. P. 38; 8 C. B. 165; *Wallington v. Dale* (1852), 7 Ex. 888; 23 L. J. Ex. 49; *Seed v. Higgins* (1860), 8 H. L. C. 561; 30 L. J. Q. B. 314; *Nobel's Explosive Co. v. Anderson* (1894), 11 R. P. C. at p. 520. *Morton v. Middleton* (1863), 1 Ct. of Sess., 3rd ser. 721; *Parkes v. Stevens* (1869) L. R. 8 Eq. 358; 38 L. J. Ch. 627.

(ii) *Otto v. Steel* (1886), 3 R. P. C. 109; *Edison v. Holland* (1890), 6 R. P. C. 276; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.* (1890), 6 R. P. C. 370.

(x) (1862) 10 H. L. C. 134; 31 L. J. Q. B. 233; cp. *Muntz v. Foster* (1842), per Tindal, C. J., 2 Web. P. C. 105; *Allen v. Rawson* (1845), 1 C. B. 551; *Tetley v. Easton* (1852), Macr. P. C. 48; *Bush v. Fox* (1856), 23 L. J. Ex. 257; Macr. P. C. 178; *Booth v. Kennard* (1857), 2 H. & N. 84; 26 L. J. Ex. 306; *Thomas v. Foxwell* (1859), 5 Jur. N. S. 38; 8 Jur. N. S. 271; *Hills v. London Gas Light Co.* (1860), 5 H. & N. 312; 29 L. J. Ex. 409; *Hills v. Eaton* (1862), 31 L. J. Ch. 457; 4 De G. F. & J. 288; *Pneumatic Tyre Co. v. Caswell* (1896), 13 R. P. C. at p. 179.

meaning. Evidence as to the state of knowledge at the date of the patent will be necessary, for specifications are to be construed according to the state of knowledge at the date of the patent (*y*).

And not only must the state of knowledge be taken into account, but also the class of persons to whom the specification is addressed. Evidence, therefore, may be tendered to show the meaning that would be attached to the specification by the skilled workman. "That doctrine [the skilled workman test] is applicable only where a particular description of work mentioned in a specification or something to be done appears to be ambiguous. If you read it without knowledge, it appears to you to be ambiguous, but then it is said, 'It appears to you to be ambiguous, but any workman of ordinary skill in the trade who would have to apply that description would understand it only in one way, and would be able to act upon it.' If that is true, then it is said that, although grammatically or with literal accuracy, there might be a doubt about it, there is no real business doubt about it, and the one meaning and the only meaning which you could attach to it is that which would strike an ordinary workman in the trade who would have to deal with it, and would strike him as the only way in which the work could be done" (*z*). Evidence would be required to enable the Court to determine a matter such as this.

Moreover, nearly every specification contains terms of art and technical expressions as to the meaning of which evidence will be received. In *Hills v. Evans* (*a*), Lord Westbury said that, although the construction of the specification belongs to the Court, the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) are matters of fact upon which evidence may be given (*b*). See also the extract from *Betts v. Menzies* quoted above (p. 208).

Evidence as to terms of art.

The functions of witnesses with regard to the interpretation of the specification have been dealt with on several occasions.

(*y*) See, e.g., Cotton, L. J., in *Edison v. Woodhouse* (1887), 4 R. P. C. at p. 94; Lord Herschell in *Boyl v. Horrocks* (1892), 9 R. P. C. at p. 82; Kay, L. J., in *Nettlefolds v. Reynolds* (1892), 9 R. P. C. 295; and Lord Esher, M. R., in *Nobel's Explosive Co. v. Anderson* (1894), 11 R. P. C. 523; also *Badische Anilin, &c. v. Levinstein* (1887), 12 App.

Ca. 710; 4 R. P. C. 449.

(*z*) Per Esher, M. R., in *Edison-Bell, &c. Co. v. Smith* (1894), 11 R. P. C. 396.

(*a*) (1862-3) 31 L. J. Ch. 457; 4 De G. F. & G. 288.

(*b*) And see *Neilson v. Harford* (1841), 1 W. P. C. 331, 370; 8 M. & W. 806; 11 L. J. Ex. 20.

Expert
evidence.

Lord Watson has said that evidence directed to the meaning of the specification is material only so far as it may supply scientific facts which ought to be taken into account in arriving at the true meaning of the instrument (c). The evidence of skilled workmen has been compared to that of handwriting experts: they call attention to particular things, which the Court has then to consider for itself (d). This, however, is hardly their function as regards construction of the specification; the business of an expert in such a case is to explain the technicalities of the invention, the meaning of the terms employed, the state of knowledge at the date of publication, and the way in which a skilled workman would read the specification. His opinion as to the construction is of little account. A handwriting expert points out certain facts, and gives his opinion.

A witness may sometimes be asked what he understands by the specification (e), and he may be asked what would the specification suggest to a person of ordinary mechanical skill (f), though the Court will not attach importance to the answer as a construction of the document. In *United Telephone Co. v. Bassano* (g), expert witnesses, speaking as to the specification, said that the word diaphragm or tympan must mean a diaphragm capable of being acted upon. Having obtained this assistance, the Court proceeded to construe the specification for itself.

In *Gadd v. Mayor of Manchester* (h), Smith, L. J., said: "Mr. Davey stated that 'chain and link gearing would be tensional,' that is that it would act by tension as distinguished from torsion, and that a chain passing over pulleys with or without teeth was distinctly an example of the plaintiff's invention. Dr. Hopkinson's opinion was that there were no inventions in the complete specification outside the invention described in the provisional. . . . Mr. Newbiggin said: 'I think that the methods described were fairly within the description of mechanical equivalents in the provisional,' . . . and Sir F. Bramwell . . . stated that there was no difference in the working of links and pitch pulleys and chain and link gearing and cords, and that it was the same, leaving

(c) *King, Brown & Co. v. Anglo-American Brush Corporation* (1892), App. Ca. 367; 9 R. P. C. 313.

(d) *Boyd v. Horrocks* (1892), 9 R. P. C. at p. 81, per Lord Herschell.

(e) Per Halsbury, L. C., in *Kaye v. Chubb* (1888), 5 R. P. C. 650.

(f) *Fletcher v. Glasgow Gas Commis-*

sioners (1887), 4 R. P. C. 386; and see *Gandy v. Reddaway* (1885), 2 R. P. C. 49.

(g) (1886) 3 R. P. C. 295, 315; Griff. 220.

(h) (1892) 9 R. P. C. at p. 532. And see a statement of the position of expert witnesses made in *Brooks v. Steele* (1896), 14 R. P. C. 46.

expense out of the question. In my judgment the evidence of Mr. Davey and Sir F. Bramwell is legal evidence, and that of Dr. Hopkinson and Mr. Newbiggin, in so far as they give their opinion upon the meaning of the specification, is not."

The Lord Justice in the same case refused to read the opinions of experts as to the meaning of the specification, as they were not evidence "except as to the meaning of scientific terms when they occur, or as to the working of mechanical appliances, or as to what such working will bring about."

In determining the meaning of the specification, the entire document must be looked to (i). The title (k) will sometimes assist in getting at the meaning; the provisional specification, the complete, the claims, and the drawings (l) may all be looked at. But the provisional, though it may be looked at to ascertain the meaning of the complete (m), cannot supply a defect in it (n), nor can the complete extend the provisional, for the complete must itself be within the provisional (o). And great weight will be given to the claim (p). As regards the effect of the words "substantially as described," "hereinbefore described," "in apparatus such as described," see *ante*, p. 194, also *Penn v. Bibby* (q), *Lawrence v. Perry* (r), *Easterbrook v. Great Western Railway* (s), and *United Telephone Co. v. Bassano* (t), and per Blackburn, J., in *Betts v. Menzies* (u).

The whole specification must be read for the purpose of arriving at the true construction.

As each specification must be construed in accordance with its own wording, decided cases cannot be of any very great assistance in arriving at the meaning of any particular specification; but the following references to decisions delivered since the passing of the Patent Act, 1883, may be of use:—

Decided cases on construction.

Edison v. Woodhouse (x): an apparently general claim construed to be for an element made strictly as described in the specification (per Cotton, C. J.).

(i) *Plimpton v. Spiller* (1876), 6 Ch. Div. 412; 47 L. J. Ch. 211; *Edison v. Woodhouse* (1888), 4 R. P. C. 79, 107; *Edison-Bell Co. v. Smith* (1894), 11 R. P. C. at p. 395; *Leadbeater v. Kitchen* (1890), 7 R. P. C. 235.

(k) *Newton v. Vaucher* (1851), 21 L. J. Ex. 305; 6 Ex. 859; *Househill Co. v. Neilson* (1842), 1 W. P. C. at p. 679.

(l) *Ante*, p. 200. And see *Nuttall v. Hargreaves* (1891), 8 R. P. C. 276, 450; (1892) 1 Ch. 23; *Pether v. Shaw* (1894), 10 R. P. C. 293; *Matthews v. Parmenter* (1896), 13 R. P. C. 518.

(m) Per Esher, M. R., in *Parkinson v. Simon* (1895), 11 R. P. C. at p. 503.

(n) *Mackelcan v. Rennie*, 13 C. B. N. S. 52.

(o) *Ante*, pp. 146 *et seq.*

(p) Blackburn, J., in *Betts v. Menzies* (1862), 10 H. L. C. 117; 31 L. J. Q. B. 233, 239.

(q) (1866) 2 Ch. pp. 130, 131; 36 L. J. Ch. 455.

(r) (1885) 2 R. P. C. 179.

(s) (1885) 2 R. P. C. 201, 208.

(t) (1886) 3 R. P. C. 295.

(u) 10 H. L. C. 117; 31 L. J. Q. B. 233.

(x) (1887) 4 R. P. C. 79.

Proctor v. Bennis (y): Claim held to be for a combination. See also *Elias v. Grovesend Tinsplate Co. (z)*; *Kelly v. Heathman (a)*.

Hutchinson v. Patullo (b): Claim held limited to a method, and not to extend to the principle, though the method was not described.

Kaye v. Chubb (c): Claim construed to be not only for the apparatus described, but for every apparatus of substantially the same construction.

Vorwerk v. Evans (d): Claim construed to be not for waistbands generally, but for waistbands of the particular formation described.

Nuttall v. Hargreaves (e): Claim for a method held to be a claim for the thing described in the figures.

Pether v. Shaw (f): Claim held not limited to the apparatus shown in the drawings, but to include other appliances described in the specification which were old.

Peckover v. Rowland (g): In a combination, claim held limited to the combination, and not extended to the separate parts. See also *Westinghouse v. Lancashire and Yorkshire Railway Co. (h)*; *Vickers v. Siddell (i)*.

Boyd v. Horrocks (k): Invention held to be an improvement in a well-known machine, and to be confined to the particular improvement. This construction was disapproved of by the House of Lords.

(y) (1887) 36 Ch. Div. 740; 4 R. P. C. 333; 57 L. J. Ch. 11.

(z) (1870) 7 R. P. C. 455.

(a) (1889) 45 Ch. Div. 256; 60 L. J. Ch. 22; 7 R. P. C. 343.

(b) (1887) 4 R. P. C. 329; 5 R. P. C. 351.

(c) (1888) 5 R. P. C. 641.

(d) (1890) 7 R. P. C. 265.

(e) (1891) 8 R. P. C. 276, 450. (1892) 1 Ch. 23.

(f) (1893) 10 R. P. C. 293.

(g) (1893) 10 R. P. C. 234.

(h) (1884) 1 R. P. C. 98, 229.

(i) (1890) 15 A. C. 496; 7 R. P. C. 292; 60 L. J. Ch. 105.

(k) (1889-91) 6 R. P. C. 159; 9 R. P. C. 77.

CHAPTER VII.

AMENDMENT OF THE SPECIFICATION.

History of Amendment.

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 affixing to it as altered the Great Seal, which was in his custody (*a*). Clerical errors in the enrolment of letters patent or specifications were alterable by the Master of the Rolls (*b*).

Early law as to amendments.

Alteration of patent.

Alteration of enrolment.

(*a*) Hindmarch, 214 *et seq.*; cf. *Ex parte Beck* (1781), 1 W. P. C. 430; 1 Bro. C. C. 578.

(*b*) *Re Sharp's Patent* (1840), 1 W. 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:—

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 "Herefordwest," 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."

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

Defect in substance fatal at common law.

According to common law, letters patent were wholly void for 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

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 Chancery, 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.

Redmund's Case.—July 25th, 1825, letters patent 9th November, 1831. to David Redmund, "for an improvement

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 (c). The necessity of providing some mode of escape from the defects which inevitably arose and the costs incurred led to a series of enactments, the first of which (Lord Brougham's Act, 5 & 6 Will. IV. c. 83) was the result of the report of the Select Committee of 1829 (d). Legislation.

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 L. 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. 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), *ibid.* April to June, xiii.; Lawson, 59. See also *Whitehouse's Patent* (1830), 1 W. P. C. 455.

(c) Web. Letts. Pat. 17.

(d) Subsequent statutes dealing with amendment are 5 & 6 Will. IV. c. 83; 7 & 8 Vict. c. 94; 12 & 13 Vict. c. 109; 15 & 16 Vict. c. 83; 16 & 17 Vict. c. 115. These are all now repealed. 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 enlarge the terms of his specification: *Ralston v. Smith*

(1865), 11 H. L. C. 223; 35 L. J. C. P. 49, per Lord Chelmsford; *Forwell v. Bos-tock* (1864), 4 De G. J. & S. 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; *Bateman's Patent* (1854), Macr. P. C. 116; *In re Lucas* (1854), Macr. P. C. 235; *Lister v. Leather* (1858), 8 El. & B. 1034; 27 L. J. Q. B. 295; *Thomas v. Welch* (1866), L. R. 1 C. P. 192; 35 L. J. C. P. 200.

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: 15 & 16 Vict. c. 83, sect. 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. 148, 411; 8 H. L. C. 550; *In re Medlock* (1865), Newton's Lon. Jour. N. S. vol. xxii. p. 69; *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205, 227; 40 L. J. Ch. 739.

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, sect. 18, sub-sect. 8. (2) The amendment, in all courts and for all purposes, is deemed to be part of the specification: *ibid.* sub-sect. 9. (3) The amended specification has now a retrospective effect, subject to such conditions as may be imposed on the

In spite of the Acts, the emendation of clerical errors by the Master of the Rolls continued; and how far the power was affected by Lord Brougham's Act is discussed by Lord Langdale, M. R., in *Re Sharp's Patent* (e).

The whole procedure is now governed by the Patent Acts, 1883 to 1888.

Amendment of Clerical Errors.

Present jurisdiction of Master of Rolls.

Sect. 18 of the Patents Act, 1883, does not affect the power of the Master of the Rolls to allow amendments verbal or clerical (f); nor was that power transferred by the Judicature Act to the High Court of Justice (g). 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 any one asking for amendment within that section (f).

Correction of errors by the Comptroller.

By sect. 91 (h) the comptroller-general is empowered, on request in writing accompanied by the prescribed fee, to correct any clerical error in or in connection with an application for a patent, or any clerical error in the name, style, or address of the registered proprietor of a patent. And Patent Rule 16 (i) provides that any document for the amending of which no special provision is made by the Acts may be amended if it can be done without detriment to the interests of any person, and on such terms as the comptroller may think fit.

But for the amendment of the specification special provision is made by sects. 7 and 18.

Amendment under Sect. 7 of the Act of 1883.

Comptroller may require an amendment under sect. 7.

Sect. 7 provides in effect that if the examiner reports against the details of the application or against the general formal sufficiency of the specification, description, drawings, &c., the comptroller, subject to appeal to the law officer, may require

applicant or patentee on his obtaining leave to amend: *ibid.* sub-sects. 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 15 & 16 Vict. c. 83, sect. 39. (5) Every amendment of a specification is advertised.

(e) (1840) 1 W. P. C. at p. 646.

(f) *Re Gare* (1884), per Brett, M. R. 26 Ch. D. 105. Cp. *Re Johnson* (1877), per Jessel, M. R., L. R. 5 Ch. D. 503;

46 L. J. Ch. 555. 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 W. P. C. 649; *Re Dixon* (1881), Eng. Rep. Jan. to Mar. 1881, vol. xvi.; Lawson, p. 59.

(g) Jud. Act, 1873, sect. 17, sub-sect. 6; *Re Morgan*, 24 W. R. 245.

(h) See *post*, p. 647.

(i) See *post*, p. 687.

the specifications or drawings to be amended (*h*). But it does not seem clear whether the comptroller can be required to amend at the desire of the applicant. In practice the point would hardly arise. The procedure under sect. 7 is very different from that under sect. 18, and especially in that whatever takes place is done in private, without prior advertisement, and without hearing opposition. It may therefore become of importance to discover whether and at what period the applicant has a right to amend under sect. 7.

No opposition heard under sect. 7.

There are three cases which may throw light on the subject:—

Dart's Patent (l). Applicants in the title to their complete specification omitted the words "and motors" from the title as it appeared in the provisional specification, and the comptroller-general refused to accept the complete with the restricted title unless leave to amend were applied for and given under sect. 18. Webster, A.-G., said *inter alia*: "Under sect. 7 (1), if the title does not sufficiently indicate the subject-matter of the invention, the comptroller-general may require that the application be amended. . . . It is open to (the applicant) to lodge a complete, omitting the part desired to be left out, and open to the Patent Office, under the powers of sects. 7 and 9, to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain. This being so, I think the refusal of the Patent Office to accept Messrs. Newton's specification was wrong, and that they should have given the applicants the option either of filing the specification with the original title and inserting a disclaiming clause, or if the applicants were unwilling to adopt that course, should, under the powers of sects. 7 and 9, have amended the original title in the application and in the specification." The Attorney-General added: "In the view I take—viz., that this matter ought to be dealt with under sects. 7 and 9, and not under sect. 18—I am of opinion that no fee was properly chargeable as in the case of an application to amend."

Re Dart's Patent.

In *re Jones's Patent (m)*, application was made under sect. 18 to amend a complete specification before acceptance and publication. The comptroller-general, in view of the fact that the specification was not open to public inspection, did not require the advertisement of the application. In proceedings taken

Re Jones's Patent.

(*h*) See Application, *ante*, pp. 122 *et seq.*

(*l*) Griff. 307.

(*m*) *Ibid.* 313.

Sect. 18
applies after
publication,
sect. 7 before.

under sect. 18 this would be improper (*n*), and before the law officer (Webster, A.-G.) the question arose whether sect. 7 was applicable. He said: "The language of sect. 18 of the Act is somewhat obscure, but I am of opinion, having regard to the earlier sections, particularly 7 and 9, that sect. 18 was intended to apply to the amendment of specifications after they had become public property. Any other amendments must, in my opinion, be dealt with under sects. 7 and 9, and not under sect. 18. Under these circumstances, I am of opinion that the fact that the office had not signified its acceptance of the complete specification as lodged is immaterial, and that any proceedings for amendment must be taken pursuant to sect. 18."

Comptroller
is not fettered
by the
examiner's
report.

In the course of *C.'s Application* (*o*), Webster, A.-G., pointed out that the comptroller is not fettered by the report of the examiner. Whether the report be unfavourable or not, the comptroller has power to require amendment.

While from these cases it may be deduced that the comptroller has full power to require proper amendments before acceptance of the complete specification, it is nowhere stated that the applicant can require him to deal with the case under sect. 7, however appropriate the amendment may be in itself. While, on the one hand, *Jones's case* (*p*) tends to show that the comptroller ought to use his powers in a proper case and ought not to drive the applicant to sect. 18, *Dart's case* (*q*) is an authority for saying that when once the complete has been lodged the application to amend must be made under sect. 18. In the last-mentioned case, Webster, A.-G., stated that the application must be under sect. 18 if the specification had become "public property," and his decision can only mean that, when the complete has been lodged, it becomes public property, though not yet accepted by the Patent Office. The law may be summarised as follows:—

Summary of
the law under
sect. 7.

(1) The comptroller may require amendment under sect. 7, and should do so if the applicant points out a proper amendment which he (the applicant) requires, and which the comptroller approves of (*r*), or if the examiner reports against the specification (*s*), or if the comptroller himself sees that amendment

(*n*) Sect. 18, sub-sect. (2).

(*o*) (1891) 7 R. P. C. 250.

(*p*) See p. 217, *ante*.

(*q*) Griff. 307.

(*r*) *Jones's Patent*, *ibid.* 313.

(*s*) *C.'s Application* (1891), 7 R. P. C. 250.

is desirable (ss). (2) This power ceases when the specification has become "public property"; then all application must be made under sect. 18 (t).

The cases are reconcilable, and the law clear, if it be borne in mind that amendment under sect. 7 must be, in form at any rate, on the requirement of the comptroller, and if the date when a specification becomes "public property" be the date of acceptance, and not the date when the complete is lodged. This latter supposition, it is submitted, tallies with sect. 10 of the Act, but does not quite fit in with Sir Richard Webster's dictum in *Dart's case* (t).

If the comptroller requires an amendment, there is an appeal to the law officer (u), and the applicant and the comptroller will be heard on the appeal (v), and the law officer will state upon what terms the application will be accepted (w). Appeal.

Amendment under Sect. 18.

This section deals with the law and procedure of amendment after publication of the specification, and when no action for infringement nor proceedings for revocation are pending (z).

Who may apply.—Sub-sect. 1 provides that a request for amendment may be made by an applicant or a patentee. Therefore a person who has made application for a patent or a person for the time being entitled to a patent (a) is entitled to apply for amendment. An applicant is a person who has made application under sect. 5 of the Act of 1883, and whose application has not yet been granted or refused. An assignee, not by way of mortgage (b), of the patent can make the application, so can a trustee in bankruptcy or an executor of the patentee. Can a mortgagee of a patent apply alone for amendment? Probably not (b). It seems doubtful whether an amendment can be made at the request of a mortgagor alone. If it can there would be nothing to prevent the mortgagor applying to disclaim the most valuable claim. At any rate, the mortgagee should have a right to be heard. The position of co-owners is not dissimilar in this

Mortgagee.
Mortgagor.
Co-owners.

(ss) *C's Application* (1891), 7 R. P. C. 250.

(t) *Dart's case*, Griff. 307.

(u) 1883, sect. 7 (2).

(v) *Ibid.* (3).

(w) *Ibid.*

(z) Sect. 18 (10).

(a) Sect. 46.

(b) *Van Gelder, Apsimon & Co. v. Sowerby Bridge Flour Co.* (1890), 7 R. P. C. 208; 44 Ch. Div. 374; 59 L. J. Ch. 583.

Seemle, mortgagor and mortgagee should join.

regard. Each co-owner is for the time being "entitled to the benefit of a patent"; so also in a sense are both mortgagor and mortgagee. It is noteworthy in this connection that the Privy Council declared that the non-joinder of a mortgagee was an irregularity in proceedings for prolongation (c), though the section of the Act which authorises a petition for prolongation provides that a "patentee" may present the petition (d). The proceedings, however, were not stopped: the petitioners agreed to a course which would safeguard the rights of the mortgagees. There are difficulties in either view, but it is submitted that the mortgagor should not apply without the mortgagee, nor the mortgagee without the mortgagor; also, it is submitted, co-owners must all join. But the comptroller could not be expected to take notice of the absence of interested parties, unless their names were on the register (e).

Request for leave to amend.

Procedure.—The application can be made at any time, but second disclaimers are not encouraged (f). The applicant must leave a request at the Patent Office. It 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 (g).

Advertisement of application.

The request is advertised, together with the reasons of the amendment, in the Official Journal and in such other papers as to the comptroller may seem fit. The reasons given (h) are

(c) (1887) Church's Patent, 3 R. P. C. 95.

(d) Sect. 25.

(e) Sect. 23. Formerly an assignee could disclaim even after he had parted with his patent rights: *Spilsbury v. Clough* (1842), 2 Q. B. 466; 1 W. P. C. 255; 11 L. J. Q. B. 109.

(f) *Re Haddan* (1885), Griff. A. P. C. 13; two applications for the same amendment will also be discouraged; *Re Arnold* (1887), *ibid.* 5.

(g) P. R. 1890, r. 52.

(h) 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 6) 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 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.'

advertised, but do not form any part of the amendment itself (i). Davey, S.-G., said that the reasons are part of the request, and as such should be advertised, but that he would be very sorry to disallow an amendment merely because the reasons were insufficient (h). When the comptroller-general considered that the specification not having been published, advertisements were unnecessary, objection was made before the law officer, and with success, to any amendment (i). The precise form of amendment must be stated in the request (m).

The application to amend must be signed by the applicant or patentee, but subsequent proceedings may be carried on by an agent (o). See *post* forms, p. 810.

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

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 (q), state his address for service,

Opposition to amendments.

Grounds of opposition.

The proposed amendments are as follows:—

On p. 1 — To strike out "..." &c.
 On p. 38. To insert "..." &c.
 (2) No. —, 26th Jan. 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 being some of the features contained in the modification described under the said patent, and the usual mode of carrying out the invention described in the said specification, and that the aforesaid modification might be considered as an improvement of such parts.'" &c.

(Amendments set out as before.)
 6th August, 1884. Improvements in machines for producing stereotyped plates, and for printing.

"J. B. (as agent) 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 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.)
 (i) *Cunnington v. Nuttall* (1871), L. R. 5 H. L. 205, 227; 40 L. J. Ch. 739.
 (h) *Ashworth's Patent*, Griff. A. P. Cases, 7.

(l) *Jones's Patent*, Griff. 313.
 (m) 1883, sect. 18 (2), and see *Andrew v. Crossley* (1892), 1 Ch. 492, 501; 61 L. J. Ch. 437; 9 R. P. C. 165, 171; and see per Field, J., in *Van Gelder's Patent* (1889), 6 R. P. C. 23. On the other hand, see *Fabensfabriken, &c. v. Bowker* (1891), 8 R. P. C. 389.

(n) Patent Rule 52.
 (o) Patent Rule 8.
 (p) 1883, s. 18 (2). The time cannot be extended, as Rule 51 does not apply.
 (q) Rule 53. In one case the signature was not on the document when filed, but

and be accompanied by an unstamped copy (r). The fee is 10s.

Statutory
declarations.

This copy is forwarded by the comptroller to the applicant (s). Within fourteen days after the expiration of one month from the first advertisement of the proposed amendment the opponent may leave statutory declarations in support of his opposition at the Patent Office, and on so doing shall deliver to the applicant a list of such statutory declarations (t). The applicant has fourteen days thereafter to lodge at the Patent Office statutory declarations in answer, and to deliver to the opponent a list, and within fourteen days from such delivery the opponent may lodge statutory declarations in reply, which must be confined to matters strictly in reply; and deliver a list to the applicant (u). 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 (x). Ten days' notice, at least, of the date of hearing is given by the comptroller to the parties (y), and the comptroller then hears the parties, their counsel, solicitors, or agents, and decides upon the case subject to an appeal to the law officer (z), whose decision is final. By sect. 94 the comptroller is prevented from deciding against an applicant without giving him an opportunity of being heard.

Who may
oppose.

In sub-sect. 2 it is provided that *any* person may give notice of opposition. Sub-sect. 4 deals with appeals to the law officer, and provides that he shall hear a person entitled to be heard in opposition to the request for amendment. It would seem, from a comparison of these two sub-sections, that any person may oppose before the comptroller, but before the law officer only such person as is in the law officer's opinion entitled to be heard in opposition. In the case of *Re Bell* (a), the comptroller went into the question of the opponents' interest, although it was not directly raised in the issues. In the same case, Clarke, S.G., decided that the opponents had no right to be heard before him, but their right to be heard before the comptroller was not dealt by him. It is probable that if the point arises it will be decided that the right to oppose before the comptroller is unlimited.

was added afterwards. The comptroller overruled an objection founded on this: *Re Codd*, Griff. P. C. 305.

(r) P. R. 1890, r. 53; Form G., *post*, p. 810.

(s) P. R. 1890, r. 54.

(t) *Ibid.* r. 55.

(u) Rule 38.

(x) Rule 39.

(y) *Ibid.* r. 41.

(z) 1883, sect. 18 (3).

(a) (1887) Griff. A. P. C. 11.

Re Bell is no decision to the contrary: it merely decides that on the facts of that case the ground of opposition was not open to the opponents (*aa*).

The grounds of opposition are not defined; they are practically unlimited.

Grounds of opposition.

Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller must determine whether, and subject to what conditions, if any, the amendment ought to be allowed; and the applicant may appeal from the comptroller to the law officer (*b*).

Where no opposition.

In *Re Cochrane* (*c*), 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 matters 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.

The amendment when allowed must be advertised by the comptroller forthwith in the Official Journal of the Patent Office, and elsewhere as to the comptroller seems fit (*d*).

Advertisement of amendment.

It is the duty of the officials of the Patent Office to make the amendment when it has been allowed, and the applicant need not any longer trouble about the matter, the clerical part of the procedure not being his business at all (*e*). But the comptroller may require the applicant to leave at the Patent Office a new specification as amended (*f*), or may impose other conditions (*g*) before giving leave to amend. The Patent Office ought not to issue unamended copies of the specification after an amendment has been allowed (*h*).

Actual amendment to be made by the officials of the Patent Office.

The printed copies of the amended specification will be headed with a notice that the amendment has been made.

What Amendments are Allowed.—Under the old practice, amendment by way of disclaimer alone was allowed; the present Act extends the powers to “amendment by way of disclaimer,

Amendment allowed by way of disclaimer, correction, or explanation.

(*aa*) See the decisions on sect. 11 of the Act of 1883, viz. *Re Glossop's Patent*, Griff. 285; *Heath and Frost's Patent*, Griff. 288; *Steinart's Application*, 13 R. P. C. 627.

(*b*) 1883, sect. 18 (5) and (6).

(*c*) (1885) Griff. 304.

(*d*) 1883, sect. 21; P. R., r. 59.

(*e*) Per Lindley, L. J., in *Andrew v. Crossley* (1892), 1 Ch. 492, 502; 9 R. P. C. 165; 61 L. J. Ch. 437.

(*f*) P. R., r. 57.

(*g*) *Infra*, p. 228.

(*h*) Kay, L. J., in *Andrew v. Crossley* (1892), 1 Ch. 492, 505; 61 L. J. Ch. 437.

Amendment must not enlarge the claim.

correction, or explanation" (i). But any amendment which makes the specification as amended claim an invention substantially larger than, or substantially different from, the invention claimed originally, must be disallowed (k).

In one respect, many an amendment may be said to extend the monopoly—*e.g.*, when one claim is bad, the disclaimer of it may convert a bad patent into a good one. Before amendment there is no monopoly; after amendment there is. But there is no objection to an amendment because of such an extension as this; the section deals only with enlargement of the "invention" protected, not of the protection given (l).

The applicant will not be allowed to amend his specification by disclaiming the main part of the original invention, or so altering it as merely to claim an obvious alternative resting on the part which he proposes to omit (m).

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

Any amendment or disclaimer will in general be allowed which merely removes an ambiguity rather than a defect in the original claim (p), or restricts the original claim, or alters part of the description without affecting the claim.

Re Cochrane.

In *Re Cochrane* (q), 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."

(i) Sect. 18 (1).

(k) Sub-sect. 8. And see *Re Johnson's Patent* (1896), 13 R. P. C. 659.

(l) The remarks of Lord Chelmsford in *Ralston v. Smith* (1865), 11 H. L. C. 223, 35 L. J. C. P. 49, are interesting. But the Act then in force had not the same provisions as the Act of 1883.

(m) *Re Heath and Frost* (1886), Griff.

312. And see *Ralston v. Smith, sup.*

(n) *Re Walker* (1886), Griff. A. P. C. 92.

(o) *Re Serrell* (1889), 6 R. P. C. 101;

Nairn's Patent (1891), 8 R. P. C. 444.

(p) *Moser v. Marsden* (1893), 10 R. P. C. 350; 13 R. P. C. 24.

(q) (1885) Griff. P. C. 304, 305; *Re Ashworth* (1886), Griff. A. P. C. 6; *Re Rylands* (1888), 5 R. P. C. 665.

In *Re Nordenfelt (r)*, 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 Nordenfelt.

In *Re Lake (s)* 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 Lake.

In *Re Morgan (t)* 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 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 he did not allow the addition of the words italicised above.

Re Morgan.

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. *Kelly v. Heathman (u)* may be considered almost an extreme case. There the specification claimed—(1) the two ladders occupy the space of only one; (2) the ready means of working by the cord; (3) the simple bracket lever by which the ladder was secured at any required length. The patentee amended by leave, striking out (1), (2), and (3), and substituting the following: "The combination in a telescope ladder, as herein described, of means for raising, lowering, and stopping, all as herein described and shown in the accompanying drawings." North, J., held that the

Amendment by explanation.

(r) (1887) Griff. A. P. C. 18.

(s) (1887) Griff. A. P. C. 16.

(t) (1886) Griff. A. P. C. 17.

(u) (1890) 45 Ch. Div. 256; 7 R. P. C. 343; 60 L. J. Ch. 22. See also *Allen's Patent*, Griff. A. P. C. 3.

amendment was by way of correction or explanation, and that the original claims were really for a combination, a construction which by the amendment was made clear. This case did not go to the Court of Appeal.

Must be consistent with fulfilment of condition of patent.

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 (x).

Re Nordenfelt (x) 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."

That a patentee desires that the principle upon which his invention is based should be better understood, is not a sufficient reason for amendment. It is the duty of the patentee to fulfil the condition of his patent, and to file a proper specification in the first instance (x).

It is no reason for allowing an amendment that, subsequently to the date of the original specification, increased knowledge has rendered a change desirable. Thus in *Re Beck and Justice's Patent* (y), 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 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.

But an explanation will be allowed which is necessary to

(x) (1887) Griff. A. P. C. 18.

(y) (1896) Griff. A. P. C. 10.

remove an ambiguity which prevents the real meaning of a patentee from being understood (*z*). So, if a specification is on the face of it clearly capable 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 of them (*a*). In *Bateman's Patent* (*b*), 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.

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

In case of doubt it has hitherto been considered the duty of the law officer to lean in favour of an amendment; as there is no appeal, an adverse decision might deprive a patentee of valuable rights, whereas the patentee takes the amendment (if allowed) at his peril (*d*). But, in view of the case of *Moser v. Marsden* (*e*), a change may be expected. That case shows that in any action subsequent to the amendment the propriety and validity of the amendment cannot be questioned, and the law officers have already shown a disposition to criticise more closely the scope of the amendment proposed, so that the patent may not thereby be widened (*f*).

In considering whether an amendment should be allowed, the age of the patent is a fact which may well be considered; but in the case of *Lacy's Patent* (*g*), Clarke, S.-G., stated that the same principle should govern the decision, whatever the age of the patent. So far as principles are to be applied, this is doubtless so, but where the matter is entirely discretionary, the time which has elapsed since the patent was granted is a material circumstance for the law officer's decision.

The age of the patent is material.

The most usual grounds on which application is made under sect. 18 for the amendment of specifications are, that it is desired to correct sundry errors, clerical and otherwise, which interfere

Grounds of application to amend.

(*z*) *Re Ashworth* (1886), Griff. A. P. C. 6.
 (*a*) *Re Ryland* (1888), 5 R. P. C. at p. 668.
 (*b*) (1854) Mac. P. C. 116.
 (*c*) *Re Hampton and Facer* (1887), Griff. A. P. C. at pp. 14, 15. But cf. *Re Guest and Barrow* (1888), 5 R. P. C. 313.
 (*d*) *Re Lake* (1887), Griff. A. P. C. 16;

cf. *Re Bateman, supra*.
 (*e*) (1896) 13 R. P. C. 24, and see *post*, pp. 231, 232.
 (*f*) *Re Parkinson* (1896), 13 R. P. C. 509; *Re Dellwick* (1896), 2 Ch. 705; 13 R. P. C. 591. And see an article in the *Law Journal*, 7th November, 1896.
 (*g*) (1890) 7 R. P. C. 469.

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.

An amendment will not be disallowed merely because the reasons given for it are insufficient (*h*); the reasons are no part of the disclaimer itself (*i*).

Conditions imposed.

Conditions.—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 (*k*), and he has the same power in this respect as the law officer on appeal (*l*). The comptroller has, however, no power to make the payment of costs, as costs, a condition of allowing an amendment, though he may, perhaps, award pecuniary compensation in a fit case (*m*).

Conditions of amendment before 1883.

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 (*n*),—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 (*o*). Such a condition protects the continued user of articles made by the opponents prior to 1st January, 1884, and also the sale of articles in stock and unsold prior to 1st January, 1884 (*p*). But if the opponents 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 (*q*).

Modern practice.

The 20th sect. of the present Act provides that “where an amendment by way of disclaimer, correction, or explanation has

(*h*) *Re Ashworth* (1886), Griff. A. P. C. 6.

(*i*) *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205, 227, 228; 40 L. J. Ch. 739; R. P. C. 213.

(*k*) *Hearson's Patent* (1884), Griff. 309; 1 R. P. C. 213; whether an opponent appears or not, *Andrew v. Crossley* (1892), 1 Ch. 492, 497; 9 R. P. C. 265; 61 L. J. Ch. 437; see also *Ainsworth's Patent* (1896), 13 R. P. C. 76, 78.

(*l*) *Re Pietschmann* (1884), Griff. 314.

(*m*) *Re Pietschmann* (1884), Griff. 314,

impliedly overruling *Re Codd* (1881), Griff. 305.

(*n*) *Re Haddan* (1885), Griff. A. P. C. 13.

(*o*) *Re Hearson* (1884), 1 R. P. C. 213; *Re Cheesbrough* (1884), Griff. 303; *Re Westinghouse* (1885), Griff. 315; *Re Ashworth* (1888), Griff. A. P. C. 6.

(*p*) *Re Cheesbrough*, *supra*.

(*q*) *Ibid.*; *Re Smith* (1855), Mac. P. C. 232, 234; cf. *Re Harrison* (1883), Mac. P. C. 31.

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" (r).

It is, therefore, the practice in the case of patents issued since the passing of the Act of 1883 not to impose conditions as to bringing actions for infringement prior to the date of the amendment; in the absence of very special circumstances, the matter is left to sect. 20 (s).

It should be observed, however, that sect. 20 does not prevent an action for an injunction, when the amendment is made prior to action brought. But an injunction would not be granted unless there was reason to fear future infringements.

Under the old practice the condition restricting the right to bring an action was not necessarily bounded by the year 1884. Davey, S.-G., in *Re Ashworth* (t), said: "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, I should impose the condition that no action should be brought for anything done at any time before the amendment (u).

Condition
not to sue.

It seems to be the practice when a condition not to sue is imposed to require written undertaking from the applicant to observe the terms of the condition, but such undertaking is not entered on the register. Further, if the condition is not accepted, the applicant must inform the comptroller, and the amendment will then not be made (x).

Appeals to the Law Officer.—Whether there be an opponent or

(r) See *Wenham v. Carpenter* (1888), 5 R. P. C. 68.

(s) *Re Allen* (1887), Griff. A. P. C. 3; *Re Ainsworth* (1895), 13 R. P. C. 78.

(t) (1886) Griff. P. C. at p. 9.

(u) The means of identification of

protected articles under this condition must vary with the circumstances of each case; see *Re Haddan* (1885), Griff. A. P. C. 12; *Re Edison*, Lawson, 64.

(x) *Andrew v. Crossley* (1892), 1 Ch. 492; 9 R. P. C. 165; 61 L. J. Ch. 437.

not, there is a right of appeal to the law officer from the comptroller (*y*). The law officer will then hear the parties, and if the appeal be from a refusal to allow the amendment, the comptroller will also be heard (*z*). But the law officer will hear an opponent only if in his opinion the opponent is a person "entitled to be heard in opposition" (*a*).

Procedure.

The procedure is governed by the Law Officer's Rules (*b*). The notice of intention to appeal must be filed at the Patent Office within fourteen days from the date of the decision appealed against, and the notice must contain a statement of what part of the decision is appealed against. Applicants or opponents are entitled to notice from the opposite appealing party (*c*). The comptroller, or the law officer, may extend the time for the appeal (*d*).

evidence before the law officer.

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 (*e*).

There is power to examine on oath (*f*).

There is no appeal from the law officer.

The following cases relate to this part of the subject:—

In *Re Cheesbrough* (*g*), 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., affirmed the action of the comptroller, as the retention of these words had been objected to by the opponents themselves.

In *Re Arnold* (*h*), 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

(*y*) Act of 1883, sect. 18, sub-sect. 6.

(*z*) *Ibid.* sub-sect. (4), (7). The comptroller often appears by one of the examiners.

(*a*) See *ante*, p. 222, as to persons entitled to be heard before the law officer.

(*b*) *Post*, p. 713.

(*c*) *Re Ryland* (1888), 5 R. P. C. 665; *Re Hill*, *ibid.* 599.

(*d*) L. O. R. 5.

(*e*) L. O. R. r. 8; *Re Hampton and Facer* (1887), Griff. A. P. C. 18.

(*f*) Act of 1883, sect. 38.

(*g*) (1884) Griff. 303.

(*h*) (1887) Griff. A. P. C. 5.

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.

Costs.—The comptroller-general has no power to give costs, either directly or indirectly (*i*). The law officer may make such order as to costs as he thinks right (*k*). As a rule the unsuccessful party will bear the costs (*l*). But in *Re Ashworth* (*m*), where the specification was loosely framed, Davey, S.-G., although allowing an amendment, refused to give any costs of the appeal.

In *Re Morgan* (*n*), 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."

Effect of an Improper Amendment.—The 9th sub-sect. of sect. 18, provides that "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 shall, in all Courts and for all purposes, be deemed to form part of the specification."

Amendment once made to be conclusive, as to power to make.

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 this was so appears from the language used by Lord Blackburn in the case of *Dudgeon v. Thomson* (*o*), and also from the language of the then Attorney-General, Sir Richard Bethell, in *Bateman's*

(*i*) *I. Pietschmann* (1884), Griff. 314.

(*k*) 1883, sect. 38.

(*l*) *Haddan's Patent* (1886), Griff. A. P. C. 12.

(*m*) (1886) Griff. A. P. C. 6; also in *Re Haddan*, Griff. A. P. C. 12, costs

were refused, because the disclaimer allowed by the appeal was a second disclaimer.

(*n*) (1886) Griff. A. P. C. 17.

(*o*) (1874) 3 App. Ca. 34, 55.

Patent (p). And sub-sect. 8 of sect. 18 of the Act of 1883, specifically prescribes that *no amendment shall be allowed if the result would be to make the specification as amended claim an invention that would be substantially larger than or different from that claimed by the original specification.*

The difficulty caused by sub-sects. 8 and 9 (which are apparently, if not really, contradictory), was considered in *Re Van Gelder's Patent (q)*. It was there decided that no prohibition will issue against the law officer on the ground that he has allowed an amendment improperly. The facts were these: 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 prohibit 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, the Court 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.

The Court in the same case expressed the opinion that the true meaning of sub-sect. 9 is that leave to amend is conclusive, if the amendment be consonant to sub-sect. 8, and not otherwise (*r*). But in a subsequent case in the House of Lords, *Moser v. Marsden (s)*, it was objected by the defendant in an action for infringement, that the amendment enlarged the claim; the House decided that this objection was not open to the defendant,

(p) (1854) Mac. P. C. 116.

(q) (1889) 6 R. P. C. 22.

(r) See the decision of Romer, J., in *Fabensfabriken, &c. v. Bowker* (1891), 8 R. P. C. 389, which is not quite in

accordance with the above.

(s) (1896) 13 R. P. C. 24. See also *Re Dellwick's Patent* (1896), 2 Ch. 705; 13 R. P. C. 591.

and that the amendment once made was conclusive as to the right to make the amendment. It was also said that the amended specification must be treated as though it were the original specification.

This decision is in accordance with the *ratio decidendi* of *Lane-Fox v. Kensington and Knightsbridge Electric Lighting Co.* (t) and *Goulard and Gibbs' Patent* (u) in the Court of Appeal and in the House of Lords (x). See also *Moser v. Marsden* in the Court of Appeal (y).

Amendment Pending Action.

Sub-sect. 10 of the 18th sect. of the Patents' Act, 1883, provided that the preceding sub-sections do not apply when and so long as any action for infringement or *other legal proceeding in relation to a patent* is pending. Doubts as to what was included in the words italicised arose (z); hence the 5th sect. of the Act of 1888 repealed the sub-section, but re-enacted it with the substitution for the italicised words of this expression, "a proceeding for revocation of."

Act of 1883.

Act of 1888 includes proceedings for revocation.

Sect. 19 of the Act of 1883 provides that when any action for the infringement or proceeding for the revocation of a patent is pending (a), 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.

Disclaimer pending action.

The exact effect on each other of these sections is not very clear. Taken literally, it would appear that leave may be granted by the Court to apply to the Patent Office for amendment, but that the procedure sketched out in sect. 18 will not in such cases apply. This was not intended, nor, it appears, is that the meaning to be attached to the section. In *Re Hall* (b) Cave, J., said: "Nothing is said in the Act as to the course of the proceedings upon the application to the comptroller-general for an amendment; but it is clear, notwithstanding the awkward

Procedure to be the same as under sect. 18.

(t) (1892) 9 R. P. C. 413; 3 Ch. 424. See judgment of Lindley, L. J., on the disconformity question.

(u) (1889) 6 R. P. C. 215; 7 R. P. C. 367.

(x) (1890) 7 R. P. C. 367.

(y) (1893) 10 R. P. C. 350, 359; in the House of Lords (1896), 13 R. P. C.

24; see *ante*, p. 232.

(z) See *Re Hall* (1888), 21 Q. B. D. 137; 5 R. P. C. 307; 57 L. J. Q. B. 494.

(a) Act of 1883, sect. 18, sub-sect. 10; Act of 1888, sect. 5.

(b) (1888) 21 Q. B. D. 137; 5 R. P. C. 306; 57 L. J. Q. B. 494.

language of sub-sect. 10 of sect. 18, that the procedure under sect. 18 is meant to apply to cases where leave to make the application is given by the Judge under sect. 19 "(c).

Pending action the right to amend is limited to disclaimer.

The first step to take if it is desired to disclaim pending action (and it will be observed that amendment otherwise than by way of disclaimer is not permissible) is to get the leave of the Court or a Judge. The application may be made by summons at Chambers (d): The Court means "Her Majesty's High Court of Justice in England" (e); but the Palatine Court of Lancaster can entertain the application made in the course of actions heard therein (f); the House of Lords probably cannot (g).

Steps to be taken.

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 (h).

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 (i).

Advertisement of amendment.

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 (k).

The following points relative to amendment pending an action for infringement or proceedings for revocation are noteworthy:—

1. Leave is not required after judgment, nor can it be given (l).

Where several pending actions.

2. Where two actions for infringement, and a proceeding for revocation, are going on at the same time, the comptroller cannot refuse leave to amend merely on the ground that liberty to apply has been obtained in one of them only: *Re Hall* (m) overruling impliedly *Re Codd* (n). 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

(c) And see *Lang's Patent* (1890), 7 R. P. C. 469.

(d) *Singer v. Stassen* (1884), W. N. 83; 1 R. P. C. 121.

(e) Act of 1883, sect. 117 (1). See *post*, p. 663.

(f) See Chancery of Lancaster Act, 1890, also *Winter v. Baybut* (1884), 1 R. P. C. 76.

(g) *Cropper v. Smith*, No. 2 (1884),

28 Ch. Div. at p. 152; 54 L. J. Ch. 237; 1 R. P. C. 254.

(h) P. R. 1890, r. 58.

(i) P. R. 1890, r. 57.

(k) P. R. 1890, r. 59.

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

(m) (1888) 21 Q. B. D. 137; 57 L. J. Q. B. 494; 5 R. P. C. 307.

(n) (1884) Griff. P. C. 305.

application for amendment having been refused not on its own merits, but upon a technical point.

3. If the action in which the order is made be discontinued, there is no longer any need to obtain leave, and any order already made lapses. Hence, if leave be granted to apply to make certain amendments and the action be then discontinued, application may be made to make amendments other than those specified in the order (o).

Where action discontinued.

4. Pending an appeal, application to amend may be made without leave (p).

Amendment pending an appeal.

5. In *Andrew v. Crossley* (q) the facts were as follows: On 19th May C. applied to the comptroller for leave to amend, and on 9th June leave was granted, but upon a certain condition. To this condition C. assented during the argument. On 11th June C. commenced an action for infringement; on 30th June the Patent Office asked C. for a written undertaking to the effect already agreed; on 9th July C. signed and sent it in; on 26th August the actual amendment was made. The Court of Appeal (affirming Chitty, J.) held that as the condition was accepted during the argument, the amendment was complete so far as C. was concerned on the 9th June, before action brought, and therefore was good, though the leave of the Court had not been obtained.

Date of amendment.

In the case of *Farbenfabriken, &c., Co. v. Bowker* (r), an action on an amended specification, the amendment was objected to on the ground that, an action having been commenced, the amendment was vitiated for want of leave of the Court. Romer, J., said that the point was not taken in the particulars, and he was not satisfied that the action was in fact pending at the time of the amendment; but if so, the amendment having been made, he did not think that he ought to go behind the comptroller's amendment (s).

Going behind the amendment.

The Court will generally impose conditions, and liberty to apply to amend will not be given to one party unless the Court sees that no injustice is done to the other (t).

(o) *Bell's Application*, Griff. A. P. C. 10.

(1896), App. Ca. 496; 13 R. P. C. 581.

(p) *Cropper v. Smith*, 28 Ch. Div.

(q) (1892) 1 Ch. 492; 61 L. J. Ch. 437; 9 R. P. C. 165.

148; 1 R. P. C. 254. But where the

(r) (1891) 8 R. P. C. 389.

appeal is from an order revoking the

(s) And see *ante*, p. 216.

patent there will be nothing to amend,

(t) *Goulard v. Lindsay* (1888), 38

unless the order be so framed that pend-

Ch. Div. at p. 41; 57 L. J. Ch. 687; 5

ing appeal the patent shall continue.

See in this respect *Deeley v. Perkes*

Conditions.

No hard and fast rule has been laid down as to the conditions which will be imposed; these are in the discretion of the Court (u). And whenever the Court or a Judge exercises discretion upon the particular facts, the Court of Appeal will not interfere unless he was absolutely wrong (x).

Amongst the more usual conditions are the following:—

Use of amended specification.

1. A condition that the amended specification shall not be given in evidence at the trial. This is usually imposed in the absence of special circumstances. It was done in *Singer v. Stassen* (y), *Allen v. Douulton* (z), *Bray v. Gardner* (a).

Condition as to costs.

2. Conditions as to costs. The ordinary rule is to make it a condition of leave being granted that (a) the costs of and occasioned by the application for leave to disclaim (b); and (b) the costs also of the action up to the time of leave being obtained (c), should be paid in any event by the applicant. In *Goulard v. Gibbs* (d), pending petition for revocation, the patentee applied for leave to disclaim, and leave was given on condition that all costs of the petition, up to and including the petition for revocation, should be paid by the patentee.

Condition as to prior infringements.

3. Conditions as to damages and prior infringements. In *Codd v. Bratby* (e), liberty to amend an old patent was granted on condition that the amended specification should not be put in evidence at the trial, and that no evidence of any infringement prior to the amendment should be given at the trial. In *Goulard v. Lindsay* (f), the Court of Appeal imposed the condition that no relief should be given in respect of any infringement before the disclaimer. In *Lang v. Whitecross Co.* (g) patentees of 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

R. P. C. 192; *Bray v. Gardiner* (1887) 34 Ch. Div. 668; 56 L. J. Ch. 497; 4 R. P. C. 40.

(u) *Lang v. Whitecross Co.*, in the House of Lords, 7 R. P. C. 389.

(x) *Allen v. Douulton* (1887), 4 R. P. C. 377; *Bray v. Gardiner* (*supra*).

(y) (1884) 1 R. P. C. 121. This case shows that the 19th sect. is retrospective.

(z) (1887) 4 R. P. C. 377.

(a) *Ibid.* p. 40, n.; 34 Ch. Div. 668.

(b) *Winter v. Baybut*, 1884, 1 R. P. C. 76; *Singer v. Stassen*, 1884, *ibid.* 121; *Codd v. Bratby*, 1884, *ibid.* 211.

(c) *Lang v. Whitecross Co.* (1890), 7

R. P. C. 389; *Fusee Vesta Co. v. Bryant and May* (1887-88), 34 Ch. D. 458; 37 Ch. D. 120; 56 L. J. Ch. 187; 4 R. P. C. 73; *Haslam, &c., Co. v. Goodfellow*, (1888), 37 Ch. D. 118, 123; 57 L. J. Ch. 245; 5 R. P. C. 28. 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.

(d) (1888) 5 R. P. C. 189.

(e) (1884) 1 R. P. C. 209.

(f) (1888) 38 Ch. Div. 38; 57 L. J. Ch. 687; 5 R. P. C. 192.

(g) (1890) 7 R. P. C. 389.

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 (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 the 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.

By sect. 20, in any event where any amendment has been allowed (whether pending action or not), no damages will 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. It will be noticed that the protection given by this section is not confined to a defendant in the action in the course of which leave to amend is given. But an injunction might be obtained in a proper case, save that in the course of an action the conditions of amendment would probably be a bar to an injunction against the defendant in the same action.

Restriction on recovery of damages.

Injunctions on infringements prior to amendment.

Where the conditions render relief in the action impossible.

If in the result the conditions on which leave to amend should be given are such that a pending action would virtually be rendered useless, leave may properly be refused. In *Meyer v. Sherwood (h)*, the plaintiff at close of defendant's case asked for a postponement of the case and for leave to apply at the Patent Office for disclaimer. The application was granted; but after disclaimer, when the plaintiff applied for leave to amend his pleadings, Smith, J., decided that, as he could give leave only on terms of payment of costs up to the time of application and on an agreement to abandon all damages to date, it would be better to dismiss the action. The defendant having given an

(h) (1890) 7 R. P. C. 283. As to the right to an injunction, see *post*, p. 432; as regards an injunction already

obtained under the old law, see *Dudgeon v. Thompson* (1878), 3 App. Ca. 34.

undertaking not to infringe, the Court of Appeal affirmed the decision. Had the undertaking not been given, the order would have been affirmed subject to the addition of the words "reserving to the plaintiffs liberty to bring a fresh action for an injunction, if so advised" (i).

Usual
conditions
summarised.

The general result of the ordinarily imposed conditions may be thus summarised: the patentee must pay the costs up to date of disclaimer, and is debarred from obtaining damages against any person for infringement prior to the disclaimer, unless the Court is satisfied that the specification was originally drawn in good faith and with reasonable skill and knowledge. Against the defendant in the action no damages can be obtained. Injunctions may be obtained against parties other than the defendant in the action, but against him an injunction can generally be obtained only in a fresh action.

(i) See also *Haslam v. Goodfellow* (1888), 5 R. P. C. 28; 37 Ch. Div. 118.

CHAPTER VIII.

OPPOSITION TO GRANT (a).

OPPOSITION may be 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—44 (c); and in case of an appeal to the law officer by the Law Officers' Rules (d).

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 (e). The specifications and drawings being left in duplicate, one set goes to the printer's, and the other set is open to inspection. So soon as the specifications are printed, and the drawings reproduced, they can be purchased (f).

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 (g) from the date of the advertisement of the acceptance of a complete specification, notice of opposition to the grant of the patent may be given at the Patent Office. The notice must set out the grounds of opposition (h).

Time within which notice of opposition may be given

(a) Opposition to the extension of letters patent is fully dealt with at pp. 503 *et seq.*

(b) Chap. VII., pp. 222 *et seq.*

(c) Pp. 696 *et seq.*

(d) Pp. 713 *et seq.*

(e) Act of 1883, sect. 10.

(f) At the Patent Office (Sale Branch).

(g) 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 the date of hearing the opposition.

(h) Act of 1883, sect. 11, sub-sect. 1. See also Form D, p. 809.

Grounds of opposition.

Invention obtained from opponent.

Patent of prior date.

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

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

Sufficiency of notice.

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

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

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

3. That (*j*) 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.

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 (*k*).

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 (*l*).

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

(*i*) But see *re Stewart's Application* (1896), 13 R. P. C. 627.

(*j*) Act of 1888, sect. 4, sub-sect. 1.

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

Green's Patent (1885, Griffin, P. C. 286).—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 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."

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

granted in such prior application are required to be specified in the notice (m).

Insufficiency in the notice of opposition is not, however, generally a fatal defect. The Patents Rules provide (n) 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.

Insufficiency not a fatal defect. Amendment by comptroller of documents.

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

In *Re Airey* (o) 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.

In *Re Lake* (p) 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 with a prior patent. 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* (q) an application for a patent was opposed on the ground "that the invention, or material parts thereof, had been

(m) *Ibid.* r. 36.

(n) *Ibid.* r. 16.

(o) (1888) 5 R. P. C. 348; cp. *In re Daniel* (1888), 5 R. P. C. 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 sect. 7, subsect. 6, of the Act of 1883, and rules 11, 12, 13, and 15 of the Patents Rules, 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, 10.

(p) (1886) Griff. A. P. C. 35.

(q) (1889) Goodeve, 10, 11; cp. *Re Jones* (1885), Griff. 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 infringement; and see *Re Cumming* (1884), Griff. P. C. 277.

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* (r) 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 reopen the case, but suggested that if the opponent appealed the law officer might, under the circumstances, send the case back to him for rehearing. On appeal Webster, A.-G., gave a direction to this effect.

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

On receipt of the notice of opposition, a copy of the same is transmitted by the comptroller to the applicant (s). 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 in support of his opposition, and on so leaving shall deliver to the applicant a list thereof (t).

in support of application;

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 (u). If the opponent fails 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 (x).

in reply.

Where declaration necessary.

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

(r) (1885) Griff. A. P. C. 43.

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

(t) *Ibid.* r. 37. As to the form of such statutory declarations, see r. 17A.

(u) *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.

(x) See Goodeve, 20.

on the existence of a prior patented invention of which the opponent is patentee, statutory declarations are sometimes dispensed with (y).

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 (z).

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* (a)—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.

In *Re Jones* (b)—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.”

(y) *Re Dundon* (1885), Griff. P. C. 278. The cost of unnecessary declarations will be put upon the party filing them, whatever be the result of the opposition: *Brand’s Application* (1895),

12 R. P. C. 102.

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

(a) (1884) Griff. P. C. 293, 294.

(b) (1885) Griff. A. P. C. 34.

No evidence
after reply
except by
leave.

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 (c). Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application (d). 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.

Appointment
for hearing.

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 (e). If neither party applies to be heard, the comptroller will decide the case (f).

Right to
begin.

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 (g). Before the law officer, the appellant begins save where fraud is alleged, when the party alleging fraud begins.

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

Decision of
comptroller
communi-
cated to
parties.

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

Costs.

The comptroller has no power to award costs.

Appeals to
law officer.

Any person intending to appeal (l) to the law officer from

(c) P. R. 1890, r. 39.

(d) *Ibid.* r. 40.

(e) See p. 809.

(f) 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.

(g) *Luke's Patent* (1836), Griff. P. C. 294.

(h) P. R. 1890, r. 42.

(i) *Ibid.* r. 44.

(k) Act of 1883, sect. 11, sub-sect. 2.

(l) The appeal may be against sealing the patent or against sealing it without a reference to prior patents: *Brownhill's Application* (1889), 6 R. P. C. 135.

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*). 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 authorised 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 opponent appeals.

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

Where comptroller requires amendment.

The effect of the Law Officers' 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 is to part only of the comptroller's decision, the person receiving

Appeal limited to terms of notice or counter-notice.

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

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

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

(*p*) *Re Anderson and McKinnell*

(1886), Griff. A. P. C. 23.

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

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

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).

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;

(s) *Re Bairstow* (1888), per Clarke, S.-G., 5 R. P. C. 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 Sielaff* (1888), 5 R. P. C. 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. See also *Ex parte Sheffield* (1872), 8 Ch. 357; 42 L. J. Ch. 356.

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

(a) Act of 1883, sect. 11, sub-sect. 4.

(b) (1889) 6 R. P. C. 548.

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 (d).

Any person who can allege good grounds of opposition as defined by sect. 11 may oppose the grant of a patent before the comptroller, but on appeal to the law officer only such persons as in his opinion are entitled to be heard will be granted a hearing (e). The law officer cannot hear persons who could not have opposed before the comptroller (ee).

Who may oppose before law officer.

"I shall hesitate very much," said Herschell, S.-G., in *Re Glossop* (f), "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 (g), Clarke, S.-G., observed, "It seems to me 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

(c) (1888) 5 R. P. C. 343.

(d) And see *Stuart's Application* (1892), 9 R. P. C. 452.

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

(1885), Griff. A. P. C. 10.

(ee) *Re Stewart's Application* (1896), 13 R. P. C. 627.

(f) (1884) Griff. P. C. 285.

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

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."

Persons held entitled to oppose before law officer.

The following persons have accordingly been held entitled:—the licensee under a prior patent (*h*); the grantee of a prior expired patent (*i*); the assignee and manufacturer under a lapsed patent (*h*). In *Hetherington's Patent* (*l*) the applicant falsely stated in his specification that he was the inventor of a contrivance, but he did not claim it; it was decided that the true owner had a *locus standi* to be heard.

Not entitled.

The following have been held not to be entitled:—an agent for the real opponent (*m*), a manufacturer under one of the patents relied on (*n*), and a person who was about to work the invention for which the prior patent had been granted (*o*).

In *Re MacEroy* (*p*), 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 comptroller 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* (*k*) and *Re Heath and Frost* (*q*).

But when a person is properly before the law officer, he may ground his opposition on prior specifications, though he be not interested in them (*qq*).

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. As to the meaning of "application of prior date" where an application has been antedated under international and colonial arrangements,

(*h*) *Re Hill* (1888), 5 R. P. C. 599.

(*i*) *Re Lancaster* (1884), Griff. 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": *Stewart's Application* (1896), 13 R. P. C. 627.

(*k*) *Re Glossop* (1884), Griff. 285.

(*l*) (1890) 7 R. P. C. 419. The law officer would refuse to seal a patent if

the specification contained statements known to be false (*ibid.*).

(*m*) *Re Heath and Frost* (1886), Griff. 288. In this case leave to amend by inserting in the notice of opposition the name of the real opponent was refused.

(*n*) *Re MacEroy* (1888), 5 R. P. C. 285.

(*o*) *Re Bairstow* (1888), 5 R. P. C. 286. As to an applicant whose patent has not been sealed, *quere*: *Dundon's Patent* (1886), Griff. 278.

(*p*) (1888) 5 R. P. C. 285.

(*q*) Griff. 288.

(*qq*) *Stewart's Application* (1896), 13 R. P. C. 627.

see *Everitt's Patent* (r), and *infra*, p. 540. An accepted complete specification is for this purpose a patented invention (s).

This point was decided in *Re L'Oiseau and Pierrard* (t). In that case an application for a patent was opposed by the grantee 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."

L'Oiseau and Pierrard's Patent.

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 (u). The existence of inventions which had received only provisional protection will not suffice to prevent the sealing of a patent for the same subject-matter (x).

The mere description of an applicant's invention in a prior specification is not enough (y): it must be claimed. "Sect. 11," said Clarke, S.-G., in *Re Von Buch* (z), "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."

Description in a prior application not enough unless the applicant's invention is covered by the prior claim.

Again, it is no answer to a *bonâ fide* applicant for a patent to allege that experiments, or even drawings, were being made by

(r) (1888) Griff. A. P. C. 28; *Main's Patent* (1891), 8 R. P. C. 13
 (s) Act of 1883, sect. 15.
 (t) (1887) Griff. A. P. C. 36.
 (u) *Re Bailey* (1884), Griff. P. C. 269.
 Semble, however, that if the law officer should find that there was a distinct reference in a provisional specification to an invention or a devise 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), Griff. A. P. C. 33.
 (x) *Bailey's Patent* (1886), Griff. 269.
 (y) In order to ascertain the state of knowledge prior specifications may be admitted in evidence: *Jones's Patent* (1885), per Davey, S.-G., Griff. A. P. C. 34.
 (z) (1886) Griff. A. P. C. 41.

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 (a).

In *Brownhill's Patent* (b), 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 (c), 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 (d). Costs are not intended to amount to a full indemnity against the expense of the appeal (e).

In *Re Ainsworth* (f) 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 (g).

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

(b) (1889) 6 R. P. C. 136.

(c) Per Webster, A.-G., *In re Anderson* (1886), Griff. A. P. C. 25; and see *In re Stubbs* (1884), Griff. P. C. 298, per Webster, A.-G.: "I regard these appeals as rehearings. . . . 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."

(d) *Re Fletcher* (1888), Griff. A. P. C. 31.

(e) *Stuart's Application* (1892), 9 R. P. C. 452.

(f) (1885) Griff. P. C. 269.

(g) *Re Knight* (1886), Griff. A. P. C. 35.

In *Re Dietz* (h) 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.

1. "That the applicant obtained the invention from the person giving notice of opposition or from a person of whom he is the legal representative." *First ground of opposition.*

"Obtained the invention" means "obtained the invention which is purported to be patented." If the invention is identical with what was obtained from the opponent, the opponent has a right to oppose, and the patent will be stopped, though the opponent himself does not desire to obtain a patent for the invention, or even if he would be unable to do so (i).

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. Where, therefore, an invention is in whole (k) or in part (l) a communication, the first ground of opposition is not available to the person from whom it has been obtained. Not available in case of imported inventions.

"Prior to the passing of the Act of 1883," said Webster, A.-G., in *Re Edmunds* (l), "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 important 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

(h) (1889) 6 R. P. C. 297.

(i) *Thwaites's Application* (1892), 9 R. P. C. 515.

(k) *Re Lake* (1888), 5 R. P. C. 415.

(l) *Re Edmunds* (1886), Griff. P. C. 281. This case has been followed in *Re Higgins* (1892), 9 R. P. C. 74.

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."

Importer is inventor.

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

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

In *re Marshall* (*o*) 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* (*p*), 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* (*q*), 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 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.

(*m*) Cp. *Abel's Application* (1876), Johns. Pat. Man. p. 178; *Adolph Spiel's Patent* (1888), 5 R. P. C. at p. 282; *Bairstow's Patent* (1888), 5 R. P. C. at p. 287; and *Re Edmunds*, *supra*; *Re Higgins*, *supra*.

(*n*) *Re Fiechter* (1882), Griff. P. C. 284, per James, A.-G.; and see the

comments of Webster, A.-G., upon this case in *Re Edmunds*, *ibid.* 283.

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

(*p*) (1889) 6 R. P. C. p. 296.

(*q*) (1889) Goodeve, P. C. 33; 6 R. P. C. 104.

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 (r).

Practice in case of overlapping inventions.

In *Re Russell* (s), it appeared that the applicant *Russell* and the opponent *Muntz* had either contributed to the invention, or arrived independently at the same result. 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, nor that Mr. *Muntz* was the inventor, but that they were both the inventors" (t). 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 licence 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."

When applicant and opponent are practically joint inventors.

Terms on which patent sealed.

(r) 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), Griff. P. C. 294; *Re Hatfield* (1884), Griff. P. C. 288. The old practice was different. 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. 8 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), Griff. A. P. C. 25.

(s) (1857) 2 De G. & J. 130.

(t) Cp. *Re Fox* (1812), 1 Web. P. C. 431; *Re Cutler* (1839), 1 Web. P. C. 426; *Tolson's Patent* (1856), 6 De G. M. & G. 422; *Russell's Patent* (1857), 2 De G. & J. 130; *Spence's Patent* (1859), 3 De G. & J. 523; *Tolhausen's Patent* (1866), 14 W. R. 551; *Vincent's Patent* (1867), L. R. 2 Ch. 341; *Manceaux's Patent* (1870), L. R. 6 Ch. 272.

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

The precedent set by Lord Cranworth in *Russell's Patent* was followed with modifications by Gorst, S.-G., in *Re Luke (u)*. 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."

"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 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" (x).

Terms on
which patent
sealed.

In *Re Garthwaite (y)*, 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 (z)*, an application for a patent for

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

(x) 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.

(y) (1886) Griff. P. C. 284.

(z) (1884) Griff. P. C. 279.

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

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 or to cause a patent to the servant to be stopped (b).

Where confidential relation subsists between applicant and opponent.

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 (c).

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 (d). 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 (e).

The words “legal representative” in sect. 11 must be

Meaning of “legal representative.”

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

(b) *Re Heald’s Patent* (1891), 8 R. P. C. 429.

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

(d) *Healey’s Application* (1872), Johns. Pat. Man. 174; *Conniff’s Application* (1872), *Ibid.*; *Macfarlane’s Patent* (1883), *Ibid.*; *Kurtz v. Spence* (1888), per Kekewich, J., 5 R. P. C. at p. 181.

(e) *Saxby v. Gloucester Waggon Co.* (1883), per Lord Blackburn, Griff. A. P. C. 57.

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 (*f*), 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 in alleged fraud of that assignment (*g*).

2. "That the invention has been patented (*h*) in this country on an application of prior date" (*hh*).

As to who is entitled to be heard before the law officer in opposition to a grant, see *supra*, pp. 248 *et seq.*

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

Re Main's Patent (*h*) was a converse case; the opponent obtained his patent subsequent to the applicant's American application, but prior to the English application; the case fell within sect. 103, and the opposition was overruled on the ground that the applicant had a right to rely on the American date.

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 (*l*). And in determining this, mechanical equivalents must be taken into consideration (*m*).

"Stopping a patent," said Webster, A.-G., in *Re Stubbs* (*n*), "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

(*f*) *Re Edmunds* (1886), per Webster A.-G., Griff. P. C. 281.

(*g*) *Adolph Spiel's Patent* (1888), 5 R. P. C. 281.

(*h*) As to the meaning of "patented" in this connection, see *ante*, pp. 248 *et seq.*, where the cases bearing upon the subject are fully considered. It is immaterial whether the prior patent be good or bad: *Thornborough and Wilks's Patent* (1896), 13 R. P. C. 115.

(*hh*) Though the patent has lapsed or expired: *Stewart's Application* (1896), 13 R. P. C. 627.

(*i*) *Re Everitt* (1866), Griff. A. P. C. 28.

(*k*) (1890) 7 R. P. C. 13.

(*l*) (1884) Griff. P. C. 298. Cf. *Cumming's Patent* (1884), per James A.-G., Griff. P. C. 277; *Jones's Patent* (1885), Griff. A. P. C. 34; *Newman's Patent* (1888), 5 R. P. C. 271; *Stuart's Application* (1892), 9 R. P. C. 452. Substantial identity will, however, be sufficient.

(*m*) *Hudd Smith's Application* (1896), 13 R. P. C. 200.

(*n*) (1884) Griff. 298.

Second ground of opposition.

Who may oppose before law officer.

Application antedated under Act of 1883, sect. 103.

Application refused only if identical with that covered by the former patent.

must be distinctly understood that I shall not stop the patent, unless I am satisfied that the inventions are identical."

In *Re Jones (o)* Davey, S.-G., said: "I am not entitled to express an opinion whether Mr. Jones' 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."

In *Re Webster (p)*, 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 (q)*, 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 (*r*), 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 india-rubber 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 (s)*, 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 compressing 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.

If after excising what is covered by the opponent's patent, there is clearly nothing left of a patentable nature, the patent will be refused (*t*); not that the law officer has to consider

(o) Griff. A. P. C. 33, 34.

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

(q) (1885) Griff. P. C. 310.

(r) *Re Aire and Calder Glass Bottle Works, and Walker's Application* (1888), 5 R. P. C. 345; *Re Wallis and Ratcliff*

(1888), 5 R. P. C. 347; *Re Daniel* (1888), 5 R. P. C. 413.

(s) (1887) Goodeve, P. C. 57.

(t) *Wylie and Morton's Application* (1896), 13 R. P. C. 97; *Boult's Application* (1893), 10 R. P. C. 275; *Hedge's Application* (1895), 12 R. P. C. 136.

whether an invention is good subject-matter (*u*), but because in such cases it may generally be assumed that the invention intended to be patented is the whole, and that is identical with a previously patented invention (*x*).

Application
when granted.

When an opposition to an application for a patent merely raises a question of infringement (*y*), where the differences between the interfering inventions are such that they cannot be considered as substantially identical (*z*), 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 (*a*), the application will be granted. But where the applicant's invention differs only colourably from that of the opponent, the patent may be stopped, and the law officer may deal with the question of mechanical equivalents (*b*).

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 (*c*).

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

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.

Claims may
be struck out.

In *Hall and Hall's Patent* (*e*), 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.

(*u*) *Todd's Application* (1892), 9 R. P. C. 487.

(*x*) This seems to follow from *Hedge's Application* (*supra*). And see *Hudd Smith's Application* (1896), 13 R. P. C. 200.

(*y*) *Jones's Patent* (1885), Griff. A. P. C. 34; *Siclaff's Application* (1888), 5 R. P. C. at p. 487.

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

(*a*) *Re Lorrain* (1888), 5 R. P. C. 142. The patentee of the later patent frames

his specification at his peril, *Ibid.*; *Re Brownhill* (1889), 6 R. P. C. 195.

(*b*) See *Wylie and Morton's Application* (1896), 13 R. P. C. 97; *Haythornethwaite's Application* (1889), 7 R. P. C. 70. And cf. *Stubbs' case*, Griff. 298.

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

(*d*) *Lake's Patent* (1889), 6 R. P. C. p. 548.

(*e*) (1888) 5 R. P. C. 283.

In *Re Guest and Barrow* (*f*), 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. . . . 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 (*g*); 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."

Form of general disclaiming clause.
Reference to existing knowledge.

General allegation of defect.
General disclaimer.

The insertion of these disclaimers does 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 (*h*), who are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (*i*).

Purpose of general disclaimer.

In *Atherton's Patent* (*k*), Webster, A.-G., 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 recognised 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 (*l*). 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

Special disclaiming clause.

(*f*) (1835) 5 R. P. C. 313; *Re Cooper and Ford* (1885), Griff. P. C. 275; *Re Hill* (1888), 5 R. P. C. 599.

(*g*) 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."

(*h*) *Hill's Application* (1888), 5 R. P. C. 599.

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

(*k*) (1889) 6 R. P. C. p. 547.

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

prior patented invention everything that is described and claimed therein (*m*).

Forms of special disclaiming clauses.

Thus in *Re Hoskins* (*n*), an application by H. for a patent for "improvements in folding cots and hammock frames," opposed by N., the following order was made:—

"This invention refers to the improvements (*o*) 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* (*p*), 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 (*q*) 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* (*r*), 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 (*s*).

And in *Re Guest and Barrow* (*s*), Webster, A.-G., said: "I

(*m*) In *Re Teague* (1884), Griff. 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 certain parts from the specification.

(*n*) (1884) Griff. P. C. 291.

(*o*) 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.

(*p*) (1888) 5 R. P. C. 279.

(*q*) 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 R. P. C. 597. In *Re Welch* (1884), Griff. P. C. 300, the word "claimed" was omitted. See, however, *Re Newman, ubi supra*; *Re Airey* (1888), 5 R. P. C. 348; *Re Lynde* (1888), *Ibid.* 661; *Re Wallace* (1889), 6 R. P. C. 134.

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

(*s*) (1888) 5 R. P. C. 313. And he will not get a reference merely to call attention to his patent. *Adam's Application* (1896), 13 R. P. C. 548.

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." This agrees with the views of Clarke, S.-G., expressed in *Anderson and McKinnell's Application* (t). See also *Sielaff's Application* (u).

In *Stell's Patent* (x), Webster, A.-G., said: "The principles upon which the law officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and, secondly, if it is clear that the public would be misled by the later specification without disclaimer. . . . Many years ago Lord Cairns pointed out that these disclaimers were of no value to the prior patentee, except for the purpose of preventing the public being misled, or of preventing unfair dealing by means of patents which might be subsequently granted. I think that a prior patentee who asks for a disclaimer must satisfy the comptroller or the law officer on appeal that it is necessary for his protection."

Principles on which the law officers act.

In *Welch's Patent* (y), the same Attorney-General said: "I do not think that a later patentee ought to be compelled to insert a special reference to the earlier specification of the opponent, unless it is practically admitted by the later applicant that the governing principle was for the first time discovered or disclosed in the opponent's specification."

Sometimes the law officer requires not only a reference to a prior specification, but an express disclaimer (z); sometimes a mere reference will suffice to satisfy the requirements (a). In a specification relating to a patent for a mere improvement, one or other is often required.

A reference or disclaimer in the specification should be directed only if the patent without this would have to be refused (b):

Cases in which disclaimer or reference is required. Third ground of opposition.

3. "That the complete specification describes or claims an invention other than that described in the provisional speci-

(f) (1887) 2 Griff. 23.

(u) (1888) 5 R. P. C. 485.

(z) (1891) 8 R. P. C. 235. And see *Tattersall's Patent* (1892), 9 R. P. C. 150.

(y) (1891) 8 R. P. C. 443.

(z) E.g., *Welch's Patent* (1891), 8 R. P. C. 443.

(a) E.g., *Van Gelder's Application* (1892), 9 R. P. C. 325; *Maxim and Silvermann's Application* (1894), 11 R. P. C. 314.

(b) *Marsden's Patent* (1896), 13 R. P. C. 87. And see *Stuart's Application* (1892), 9 R. P. C. 452.

cation, 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."

Disconformity in itself was not under the Act of 1883 (c), 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 (d).

Generally.

The Act of 1888 does not prevent the inventor who has sent in a provisional specification from developing his invention in the complete unless he thereby makes the invention a different one to that described in the provisional. In the latter case a person who files the subsequent provisional specification covering the enlarged invention will be entitled to stop the patent; otherwise he will not (e).

General rule of law officer.

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. The general rule is that the patent will be sealed unless the comptroller (or on appeal the law officer) is quite satisfied that the objection should prevail. In case of doubt the patent should be sealed (f).

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

(d) The opposition allowed by the Act of 1888 enured to the benefit even of those who filed their provisional specification before 1888: *Anderson and Anderson's Patent* (1890), 7 R. P. C. 323.

(e) *Edwards's Patent* (1894), 11 R. P. C.

461. See *Disconformity*, ante, pp. 149, 150.

(f) *Russell's Patent* (1857), 2 De G. & J. 130; *Spence's Patent* (1859), 3 De G. & J. 523; *Tattersall's Patent* (1892), 9 R. P. C. 150; *Stuart's Application* (1892), 9 R. P. C. 452; *Todd's Patent* (1892), 9 R. P. C. 487.

CHAPTER IX.

THE GRANT.

I. PERSONS TO WHOM A GRANT MAY BE MADE.

A GRANT cannot be made save to the true and first inventor (or to one or more persons who include the true and first inventor), and not to him if he comes within the class of those persons who are disqualified from making application for patent grants. It will be necessary, therefore, to consider (1) the meaning of "true and first inventor," and (2) who may apply for a grant.

1. *The True and First Inventor.*

The Statute of Monopolies (sect. 6) allows that monopoly grants may be made in certain events to the "true and first inventor"; and the Patents Act, 1883 (sect. 5, sub-sect. 2), provides that the applicant for a patent (or one of them) must declare himself to be the "true and first inventor" of the invention which it is desired to patent (*a*). If the person (or one of the persons) to whom the patent is granted is not the true and first inventor, the grant is invalid.

When it is stated that the patentee is the true and first inventor, it is not intended to convey that the invention is novel. The point is, not whether there be an invention, but granted that there be, is the claimant the inventor? Is he the discoverer, or is some one else the discoverer, of that which for the moment is admitted to be an invention? This is the question to be determined. In other words, the objection of want of novelty or of subject-matter does not raise the same issue as the objection that the claimant is not the true and first inventor (*b*).

The determination of the true and first inventor does not involve an inquiry into novelty.

(*a*) See forms of application, *post*, p. 805.

(*b*) *Thomson v. Macdonald* (1891), 5 R. P. C. at p. 9; *Winby v. Manchester Tram Co.* (1891), 5 R. P. C. 61, 66; *Pneumatic Tyre Co. v. Caswell*

(1896), 13 R. P. C. at p. 187; *Cornish v. Keene* (1831), 1 W. P. C. at p. 507; *Gibson v. Brand* (1841), 1 W. P. C. 627; *Muntz v. Foster* (1844), 2 W. P. C. at p. 102.

A question of fact.

Whether a man is or is not the true and first inventor is a question of fact (c).

Undisclosed inventions.

The true and first inventor is not necessarily the first discoverer of the invention. If it had been discovered by another, but the discovery had never been divulged, he who independently discovers the same thing, and is the first to disclose it or to apply for a patent which is eventually granted, is the true and first inventor (d). In *Forsyth v. Rivière* (e) it was decided that if two or more discover the same thing simultaneously, he who first communicates it to the public is the true and first inventor. This follows from the principle that a patent is the reward for bringing new trades to the knowledge of the public.

Effect of assistance of others on claim to be the inventor.

Sometimes the patentee has obtained assistance in putting his ideas into practice. The result may or may not be that he is not the true and first inventor. Thus in *Minter v. Wells* (f) Alderson, B., dealing with the facts of the case, said: "If Sutton suggested the principle to Mr. Minter, then he would be the inventor; if, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Mr. Minter used for the purpose of enabling him to carry his original conception into effect."

Illustrations.

In *Bloxham v. Elsee* (g) an engineer employed by the patentee gave professional assistance, and suggested several mechanical parts of the machine the subject of the patent, but the main invention was exclusively that of the patentee, who was held to be a true and first inventor. But in *Tennant's Case* (h) a patent for a bleaching preparation was declared invalid because the patentee had been assisted by a chemist who enabled him to arrive at a main portion of the invention. The chemist had pointed out to the patentee that the end desired would be attained if the limewater in the bleaching liquor were constantly agitated. This proved to be so.

(c) *Minter v. Wells* (1834), 1 W. P. C. at p. 134; 1 C. M. & R. 505; *Kurtz v. Spence* (1888), 5 R. P. C. 161, 57 L. J. Ch. 238.

(d) *Dollond's Patent* (1758), 1 W. P. C. 43, cited in *Boulton v. Bull*, 2 H. Bl. at pp. 470, 487; *Lewis v. Marling* (1829), 1 W. P. C. 493; 10 B. & C. 22.

(e) 1 W. P. C. 97, n. See also the

remarks of Jessel, M. R., in *Plimpton v. Malcolmson* (1876), 3 Ch. Div. at p. 556.

(f) (1834) 1 W. P. C. 127.

(g) 1 C. & P. 558; 1 W. P. C. 132, n. And see *Barker v. Shaw*, 1 W. P. C. 126, n.

(h) 1 W. P. C. 125, n.; Dav. P. C. 429.

In *Elias v. Grovesend Tin Plate Co.* (i) P. had an idea which was susceptible of being utilised to improve certain machinery. This idea he communicated to T., but did not state any means of putting it into practice. T. sent for H. and asked H. to draw a plan, and when the plan was drawn T. showed it to P. T. ordered H. to make the machine as per plan, and T. paid the cost. The Court of Appeal decided that P. was not the first and true inventor (i).

If the invention is wholly or in part the work of a servant, the master cannot get a patent alone, if at all (l). The case is otherwise when the part of the workman is confined to suggestions as to mere details. If a workman employed by an inventor to make a model for the purpose of carrying out the invention, suggests improvements in details of the machine which are adopted in the machine or model as completed, these suggestions are the property of the employer, and the workman cannot afterwards take out a patent for them (m).

The law was thus laid down by Tindal, C. J., in *Allen v. Russon* (n):—"It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend on its own merits. But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of experiments of something calculated more easily to carry into effect the conceptions of the inventor should render the whole patent void."

Summary of the law relating to the assistance of servants.

A servant, if really the inventor, may often patent his invention, though it be made in his employer's time, with the use of the employer's materials, and at the expense of the employer; for in such case the invention is not necessarily the property of the employer (o).

Servant as an inventor.

A person who imports into the realm (p) an invention not

An importer is an inventor.

(i) (1890) 7 R. P. C. 455.

(l) See also *Siddell v. Vickers* (1888), 23 Ch. Div. 92; 5 R. P. C. 81, 416; *Earts v. Spence* (1888), 5 R. P. C. 161; *Ex Norwood's Patents* (1895), 12 R. P. C. 214.

(m) See, e.g., *Barber v. Walduck* (1823), 1 Carp. P. C. 438 (reported as *Barker v. Shaw*, 1 W. P. C. 126).

(n) Per Davey, S.-G., in *David and*

Woodley's Application (1884), Griff. A. P. C. 26.

(o) (1845) 1 C. B. 551.

(p) Per Clarke, S.-G., in *Heald's Patent* (1891), 8 R. P. C. 429; and see *Saxby v. Gloucester Waggon Co.* (1883), Griff. A. P. C. at p. 56.

(p) Scotland is within the realm: *Plimpton v. Malcolmson* (1876), 3 Ch. Div. at p. 555.

previously in use therein is a true and first inventor. It is stated in *Edgeberry v. Stephens* (q) that "if the invention be new in England, a patent may be granted, though the thing was practised beyond the sea before, for the statute speaks of new manufactures within the realm, so that, if it be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing."

This was the law prior to the Statute of Monopolies. The reported cases of the time of Elizabeth and James I. relate to imported articles, and not to entirely novel inventions (r). And the law has never been different (s), for though the wording of sect. 5 of the Patent Act, 1883, compared with the prior Act, might cause some doubt (t), the definition of "invention" in the Act is "any manner of new manufacture the subject of letters patents and grant of privilege within the meaning of sect. 6 of the Statute of Monopolies."

Sir George
Jessel's
criticisms.

In *Marsden v. Saville Street Co.* (u) Jessel, M. R., said: "It is difficult to say on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the Judges as being the first and true inventor. I have never been able to discover the principle, and although I have often made inquiry of others, . . . I could never get a satisfactory answer. The only answer was, 'It has been decided, and you are bound by the decision.' But it is an anomaly, as far as I know, not depending on any principle whatever. It has never been declared by any Judge or authority that there is such a principle, and not being able to find one, all I can say is that I must look upon it as a sort of anomalous decision which has acquired by time and recognition the force of law."

Note on Sir
George
Jessel's
criticisms.

It is submitted that the protection of those who have imported novelties is founded on grounds much less arbitrary than Sir George Jessel seems willing to allow. If it be true that the

(q) (1691) 1 W. P. C. 35.

(r) See, e.g., *Hastings Case*; *Matthey's Case*; *Darcy v. Allin*, ante, pp. 6 et seq., and the dicta in *The Clothworkers of Ipswich Case*, 1 Godb. 252, 254.

(s) See, e.g., *Walton v. Bateman* (1842), 1 W. P. C. 613; *Beard v. Egerton* (1846), 15 L. J. C. P. 270; 3 C. B. 97; *Plimpton v. Malcolmson* (1876), 3 Ch.

Div. at p. 555; 45 L. J. Ch. 505; *Moser v. Marsden* (1890), 10 R. P. C. at p. 358.

(t) See *Edmunds's Patent* (1886), Griff. P. C. at p. 283.

(u) (1878) 3 Ex. D. at p. 205. And see the remarks of the same learned Judge in *Plimpton v. Malcolmson* (1876), 3 Ch. Div. at pp. 555—556.

Statute of Monopolies (sect. 6) does but preserve the common law in regard to the grant of monopolies for meritorious inventions (and the reasons for so supposing have already been stated (x)), the meaning of "invention" as used in that statute must be sought not in a modern dictionary, but in the old authorities; and the fact that in all the reported cases dated before or about the time of the Statute of Monopolies invention includes importation is reason for supposing that in the statute, as at common law, the importer was always intended to receive the same protection as the new manufacturer. Importers were more important than inventors (using the word in its strict sense). The original object of the Crown in granting monopolies, and the reason which led the common lawyer to recognise the grant, was the introduction here of new trades and of manufactures in use amongst foreigners. This the researches of Mr. Wyndham Hulme (y) prove to demonstration. It is the divergence of modern policy from that which governed in ancient times, which has caused the apparent anomaly to which Sir George Jessel refers.

An invention communicated from abroad may be patented, and not infrequently patent agents make applications and take out in their own names letters patent for foreigners. A special form of application (z) is prescribed for these cases, though what would be the effect of using the ordinary form of application does not seem to be yet settled (a). Probably the patent would be good (b). The patent will be good though it be held in trust for the foreigner (c):

Communi-
cated inven-
tions.

Use may be made of information acquired from abroad, and a practical way of carrying out a novel foreign idea can be patented, the patentee being in such case a true and first inventor; a man may import a foreign invention and improve it himself (d).

(z) See *ante*, Chap. II.

(y) See some early grants quoted in a paper on "The History of the Patent System" by E. Wyndham Hulme, *Law Quarterly Review*, April, 1896. It will suffice to quote this statement: "The Elizabethan policy aimed beyond question . . . at the introduction of those industries the products of which had hitherto figured most prominently in the list of imports, viz. alum, glass, soap, oil, saltpetre, latten, &c., &c. Now the proof of a single sale is held to be de-

structive of the novelty of the invention."

(z) See *post*, p. 806, Form A 1.

(a) *Re Avery's Patent* (1887), 36 Ch. Div. 307; 56 L. J. Ch. 586, 1007; 4 R. P. C. at p. 163.

(b) See *Moser v. Marsden* (1893), 10 R. P. C. at p. 359.

(c) *Beard v. Egerton* (1846), 15 L. J. C. P. 270; 3 C. B. 97.

(d) *Nickels v. Ross* (1849), 8 C. B. 679; *Milligan v. Marsh* (1856), 2 Jur. N. S. 1083; *Moser v. Marsden*, 10 R. P. C. at p. 359.

Communi-
cation by one
foreigner to
another.

In *Re Wirth's Patent* (e) it was decided that letters patent could be granted to an alien resident abroad for an invention communicated to him by another alien who was also resident abroad. But now the Form A 1 (f) is so drafted as impliedly to prevent a foreign resident from using it. A secret communication by one person in England to another in England does not make the latter an inventor within the meaning of the patent law (g).

Invention ob-
tained abroad
by fraud.

In *Re Edmunds's Patent* (h) it was alleged that the person importing the invention had improperly obtained it abroad. Webster, A.-G., said: "Prior to the passing of the Act of 1883 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."

2. Persons who may apply for a Patent.

It is now proposed to consider the question, Who may apply for a patent? (i).

Definition of
patentee.

Assuming that the applicant (or if there be several, one of the applicants) is the true and first inventor (j), he will seldom find difficulty arising from his status. It may be laid down as a general rule that any person (including a married woman) may be an applicant for letters patent. The following cases are noteworthy:—

Generally
any person
may be an
applicant.

Infants.

(1) *Infants*.—Sect. 99 of the Act of 1883 provides for the making of declarations or the doing of other things requisite on behalf of persons who may be incapacitated by infancy (k).

Lunatics.

(2) *Lunatics*.—Sect. 99 applies to lunatics as well as to infants.

Aliens.

(3) *Aliens*.—The Patents, &c., Act, 1883 (sect. 4), provides

(e) (1879) 12 Ch. Div. 303.

(f) *Post*, p. 806

(g) *Marsden v. Saville Street Co.* (1878), 3 Ex. Div. 203.

(h) (1886) Griff. P. C. 281.

(i) A person may be a "patentee" within the meaning of the Patents, &c., Acts, although not qualified to apply

for a patent, the definition of a "patentee" being "the person for the time being entitled to the benefit of a patent": 1883, sect. 46.

(j) See *supra*.

(k) See *Cheavin v. Walker* (1877), per V.-C. B., 5 Ch. Div. 858; 46 L.J. Ch. 265.

that any person, whether a British subject or not, may make application for a patent; and it has been held that letters patent may be granted to an alien resident abroad for an invention communicated to him by another alien resident abroad (l) but this is no longer encouraged (m).

It is possible that no patent would be granted to an alien enemy. The point was raised in *Bloxam v. Elsee* (n), but not decided, the patent being held invalid upon another ground. It has been doubted, says Webster (o), referring to this case, whether letters patent taken out on a secret trust to be held for the benefit of a real inventor who was an alien enemy were void or not. To hold that such a trust could not exist would appear contrary to the spirit and policy of the patent law in recognising communications from foreigners as good subject-matters for letters patent; but no action could be maintained by such alien, or by the trustee on his behalf, on any contract, on the ground that the resulting moneys might be employed against the country.

Alien enemy.

Query, whether alien enemy can be patentee.

International and colonial arrangements are dealt with hereafter (at p. 533).

(4) *Corporations*.—The term “person” includes a body corporate (p), and therefore a body corporate may make application for a patent. But whether it can be a true and first inventor is another matter. It is generally considered that a corporation can apply only as one of two or more joint applicants, or perhaps also as the recipient of a communication from abroad. It seems that, under sect. 103, foreign corporations may apply for a patent (q).

Corporations.

(5) *Beneficed Clergymen*.—It may be doubtful whether the exercise of a patent privilege by a *beneficed clergyman* would not be a trading, and therefore prohibited. And if that be so, it may be that the grant of a patent privilege to such a clergyman would not be void, because the Queen’s intent—namely, that the patentee should derive a profit from the exercise of the privilege—cannot take effect (r).

Clergymen.

(6) *The legal personal representatives*.—They may apply for letters patent for an invention of which the inventor died

Personal representatives.

(l) *Re Wirth* (1879), 12 Ch. Div. 303.
 (m) See Form A 1, *post*, p. 806.
 (n) (1825-27) 6 B. & C. 169; 1 C. & P. 553; and see Webster P. C. 418, n.
 (o) Letters Patent for Inventions, p. 23.

(p) 1883, sect. 117.
 (q) *Carez’ Application* (1889), 6 R. P. C. 552.
 (r) Hindmarch, p. 35.

possessed without having made application for the patent. But the representative must apply within six months of the decease, and must declare that he believes the deceased to be the true and first inventor (s). If the death takes place after application, but before the patent is sealed, a patent may be sealed to the personal representatives at any time within twelve months after the death (t). The practice in such cases is prescribed in the Patent Rules, 1890, rule 20 (u).

The sovereign.

(7) The sovereign cannot grant a patent to itself, says Hindmarch (x); but the Secretary of State may take an assignment under the Patents, &c., Act, 1883 (sect. 44).

Joint applicants.

(8) Two or more persons may make a joint application, and the patent may be granted to them jointly, provided that at least one of them is the true and first inventor (y).

(9) A person who has obtained knowledge of an invention whilst acting in a public capacity cannot take out a patent for it (z).

II. NATURE OF THE GRANT.

Characteristics of a royal grant.

The grant of letters patent is made by the Crown (a). Therefore it possesses certain characteristics which are peculiar to royal grants, viz.: (1) if made on a false suggestion by the applicant, though he be acting *bonâ fide*, it is void; (2) the recitals do not bind the Crown (b); (3) the grant is not construed most strongly against the grantor, as in ordinary cases: on the contrary, it is construed most favourably to the Crown; (4) if the intention which the Crown has in making the grant be stated, and the grant obviously contradict that intention, the grant is void; (5) the grant is void if it be made upon several considerations, and any one of such considerations fail (c): the grant cannot be made if it be contrary to law, whether to the common law or a statute, nor is it good if it be uncertain; (6) the grant must be under seal; in the case of patents for inventions, under seal of the Patent Office (d).

(s) 1883, sect. 34.

(t) 1883, sect. 12 (3) (b).

(u) *Post*, p. 690; and see notes to sect. 34 of the Act of 1883, *post*, p. 629.

(x) P. 34.

(y) 1883, sect. 4 (2), and 1888, sect. 5.

(z) *Patterson v. Gas-light and Coke Co.* (1876), 2 Ch. Div. 812; 3 App. Ca. 239; 45 L. J. Ch. 843; 47 L. J. Ch. 402.

(a) It has recently been decided that the grant of a patent for an invention

is a franchise: *R. v. Halifax County Court Judge* (1891), 1 Q. B. 793; 3 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 338; but there are strong arguments against this view.

(b) *R. v. Bushopp* (1600), Co. Rep. Part I. 40.

(c) *Hill v. Thompson* (1818), 8 Taunt. 375; 1 W. P. C. 239.

(d) Sect. 12.

The Crown cannot derogate from any previously made valid grant: it cannot, when a patent has been granted to one person, grant a patent for the identical subject-matter to others. Under the Act of 1852 this principle was the cause of some difficulty. In *Ex parte Bates and Redgate* (e) an inventor left a provisional specification; a second independent inventor of a similar invention within six months did the same, and obtained his patent before the earlier inventor. The Lord Chancellor refused a patent to the earlier applicant, on the ground that to do so would be to derogate from the grant already given to the later applicant; the former applicant should have opposed the sealing of the later applicant's patent (f). This decision was criticised by Lord Cairns in *Re Dering's Patent* (g). Under the present Act every patent shall be dated and sealed as of the day of application; and it is further provided that in the case of more than one application for a patent for the same invention the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application (h). And another section provides that a patent granted to the true and first inventor shall not be invalidated by an application in fraud of him or by provisional protection obtained thereon (i).

The Crown cannot derogate from its own previous grant.

Patents date back to application.

Hence if an application be made, and prior to the publication of the specification another inventor applies for a patent for the same invention, the former applicant's patent, if his application be not abandoned, will eventually bear a date anterior to that of the latter applicant; and so far as such latter patent covers the same subject-matter as that covered by the former grant, it will be bad, as being in derogation of the former grant.

The patent grant is incorporeal personal property, and as such devolves on the executors or administrators on the death of the patentee (k). It is sometimes seized in execution under a *fi. fa.*; and at the request of the sheriff, and on his responsibility, the register is altered accordingly. Whether in law the sheriff is entitled to seize seems very doubtful (l). He is directed to seize

A patent is personal property.

(e) (1869) 4 Ch. 577; 38 L. J. Ch. 501.

(f) See also *Ex parte Bailey* (1872), 8 Ch. 60.

(g) (1879) 13 Ch. Div. at p. 395. See also *Kurtz v. Spence* (1880), 5 R. P. C., per Kekewich, J., at p. 178.

(h) 1883, sect. 13.

(i) *Ibid.* sect. 35. See, under the old

Act, *Ex parte Scott and Young* (1870), 6 Ch. 274.

(k) The patent is by its terms a grant to the patentee, his executors, administrators, and assigns. As to application by executors, &c., see *supra* p. 269.

(l) *Coleman v. Rawlinson* (1858), 1 F. & F. 330; *Harley v. Harley*, 11

the goods and chattels of the debtor, and *semble* a patent right is not a chattel (*m*). It is assignable by the terms of the grant itself; but for this, it would be merely a personal licence (*n*).

Devolution on bankruptcy of grantor.

In the event of the bankruptcy of the patentee, the grant devolves upon his trustee in bankruptcy (*o*). The reputed ownership clause cannot apply: patents are not goods (*p*).

III. FORM AND TERMINOLOGY OF THE GRANT.

Every patent must be under seal (*q*), and may be in the form in the First Schedule to the Patents, &c., Act, 1883 (*r*). It may be granted for one invention only, though the specification may contain more than one claim (*s*).

Forms of grant.

Variations in the form of patent.

The use of the form given is not obligatory; and inasmuch as it is only applicable to the case of a single inventor, considerable alterations must be made in the recitals and the details of the wording of the patent in the very various forms which a grant may take. If there be several joint inventors or several joint applicants, one or more of whom only are inventors, or in the case of applications by agents as importers, or where one of the applicants dies, or where an inventor dies before application, in all these cases alterations in the recitals and text of the patent must be made. It has, however, always been customary to vary the formal parts of the patent in the Office as required; and several forms are printed for use, which meet all the commoner cases. To meet rarer cases, one of the printed forms is altered in ink. There are kept in the Patent Office in stock eight forms, viz.: grants to (1) single inventors; (2) joint inventors; (3) importers; (4) joint applicants of whom some or one only

Ir. Ch. Rep. 451, are cited as authorities, though they are not directly in point. But the patent grant is in practice available under an execution for the creditor.

(*m*) See remarks of Lord Herschell in *Steers v. Rogers* (1893), App. Ca. at p. 235; 62 L. J. Ch. 671; 10 R. P. C. 245.

(*n*) *Duvergier v. Fellows* (1830), 10 B. & C. 826; 1 C. & F. 39.

(*o*) *Hesse v. Stevenson* (1803), 3 B. & P. 565; *Bloxham v. Elsee* (1827), 6 B. & C. 169. As to estoppel between the bankrupt and an assignee from the trustee, see *Cropper v. Smith* (1885), 10 App. Ca. 249; 2 R. P. C. 17; 55 L. J. Ch. 12. As to the trustee's rights to

royalties on an invention patented after bankruptcy, but before discharge, see *Re Graydon* (1896), 1 Q. B. 417; 65 L. J. Q. B. 328.

(*p*) See per Lord Herschell in *Steers v. Rogers* (1893), App. Ca. at p. 235; 62 L. J. Ch. 671; 10 R. P. C. 245.

(*q*) Formerly the Great Seal, now the seal of the Patent Office: 1883, sect. 12 (1).

(*r*) *Post*, p. 667.

(*s*) It is not competent for any person in an action or other proceeding to object to a patent on the ground that it comprises more than one invention: 1883, sect. 33.

are inventors; (5) deceased inventors; (6) executors of an inventor; (7) female inventor; (8) joint applicants one of whom dies between application and grant. The main point in which these various forms differ from the scheduled form will be found *post*, pp. 670 *et seq.* Several old forms are set out in the Appendix, *post*, pp. 883 *et seq.*

Observations on the various clauses of the grant will be found in the notes to the form, *post*, pp. 670 *et seq.* In this place it will suffice to mention the following:—

Observations on some clauses in the grant.

Letters patent commence in the name of the sovereign, because, although issued formerly from the Court of Chancery and now from the Patent Office, they are made by the sovereign as the head of the executive Government, acting, with the advice of her Ministers, on behalf of the whole community; and the grant is made in her name in order that the authority by which the privilege is created and granted may be thus announced to all those who reside within that part of the United Kingdom to which the patent privilege extends (*t*). They are directed to all persons to whom they shall come, are public records, and all persons are bound to take notice of the grants which they contain.

The recitals are important. They show that the patent is granted at the request of the inventor, and on the understanding that the invention described in the specification is one for the public good. The recitals are (1) a recital that the patentee has represented that he is in possession of an invention, that he is the true and first inventor, and that, to the best of his knowledge and belief, the same is not in use; (2) a recital that the inventor hath "humbly prayed" for a patent; (3) a recital that the inventor has particularly described the invention in his complete specification; and (4) a recital that the Crown grants the request, "being willing to encourage all inventions which may be for the public good."

Recitals.

After the recitals comes the grant, expressed to be made of "our especial grace, certain knowledge, and mere motion." These words were introduced to enable the grant to be construed more favourably to the grantee than would be the case ordinarily in view of the fact that the Crown was the grantor. The words "of our especial grace" import that the grant proceeded solely from the grace and bounty of the Crown, and not from any right or

The terms of the actual grant.

"Especial grace."

(*t*) Hindmarch, p. 40.

"Certain knowledge."

"Mere motion."

title inherent in the grantee (*u*). The words "certain knowledge" imply that the sovereign has knowledge of the subject-matter of the grant (*x*); but their scope is limited and almost annihilated by the clause in the recital making the grant dependent on the representations of the grantee (*x*). The words "mere motion" import that the grant proceeded from the bounty of the sovereign, without any suggestion or suit by the grantee (*y*). It is, however, the duty of every applicant for letters patent to see that the sovereign is correctly informed respecting the subject-matter of the grant (*z*); and the recital in the patent showing that the grant was made upon the petition of the patentee diminishes the force of the words of grace, and prevents a patent from being reduced to the same standard of construction as the grant of a subject (*a*). What, then, is the practical effect of the words of grace and bounty? It seems they may cure many defects and irregularities which would otherwise vitiate the grant (*b*). Possibly, when taken along with the proviso for favourable construction, they provided that a patent should be valid notwithstanding it did not contain a full and certain description of the invention (*c*). They do not, and did not, however, cure a false suggestion on the part of the grantee (*d*), nor have they ever authorised any construction against the plain intent and purpose of the grant (*e*). In modern times, it would appear that these words limit the effect of immaterial mistakes (*f*).

The sealing.

Before 1878, all letters patent for inventions as well as for other matters (*g*) were issued under the Great Seal. The Crown

(*u*) *Brunton v. Hawkes* (1821), 4 B. & Ald. 541.

(*x*) At one time the Crown, in fact, had this knowledge: the Crown ordered the introduction of industries on its own motion. See Mr. E. W. Hulme's paper in *Law Quarterly Review*, April, 1896.

(*y*) 10 Co. 112 b; *Vin. Abr. Prerog.*; *Bac. Abr. Prerog.* This often was so at one time; see preceding note.

(*z*) 1 Co. R. 52 a.

(*a*) *R. v. Capper* (1817), 5 Price, 217; 1 Co. R. 46 a, 46 b.

(*b*) Webster's *Letters Patent for Inventions, Practical Forms*, p. 76, n. (*d*), and 1 *Web. P. C.* at p. 41; *R. v. Mussary* (1738), *ibid.*; 1 Co. R. 53 a.

(*c*) Hindmarch, pp. 72, 73. But now the specification must contain a proper description.

(*d*) *Legal's case*, 10 Co. R. 109; *Barwick's case*, 5 Co. R. 94; *Cholmley's*

case, 2 Co. R. 54; *Auditor Curle's case*, 11 Co. R. 4; *Earl of Devonshire's case*, 11 Co. R. 89; *Travell v. Carteret*, 3 *Lev.* 135; *Alcock v. Cooke* (1829), 5 *Bing.* 340; *Morgan v. Seaward* (1837), 1 *Web. P. C.* at p. 196.

(*e*) *Alton Wood's case*, 1 Co. R. 49 a, 52 b, 59 a.

(*f*) "The deed of grant swells with imposing terms which are but the shadows of majesty. The 'certain knowledge and mere motion' turns out to be *clausula clericorum*, the prohibition useless to the infringer, the proviso for favourable construction useless to the patentee" (*Turner, Remarks upon Patent Law*, 19). This sweeping criticism appears to have been unjust. See, however, *Needler v. Bishop of Winchester*, *Hob.* 221, 222.

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

Office Act, 1877 (sect. 5) (h), 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 (i), 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 (k).

A patent is sealed as soon as may be, and not after the expiration of fifteen months (l) 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 before the expiration of the fifteen months aforesaid (l). 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 from the applicant's death (m).

Time within which patent must be sealed.

If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed (n).

Sealing a duplicate on loss of original.

IV. EXTENT OF THE GRANT.

The patent when sealed is to have effect in the United Kingdom and the Isle of Man (o). The present Act does not extend the monopoly to the Channel Isles; but grants already

Geographical area.

(i) 40 & 41 Vict. c. 41.

(h) These rules came into operation on March 1, 1878, and are published in the "London Gazette" for March 5, 1878.

(i) Act of 1883, sect. 12, sub-sects. 1 & 2.

(j) 1883, sect. 12 (3). The Act of 1885, sect. 3, empowers the comptroller to extend an extension of four months.

(k) Act of 1883, sect. 12 (3).

(l) *Ibid.* sect. 37.

(m) 1883, sect. 16. Letters patent in England prior to 15 & 16 Vict. c. 83,

frequently included the Colonies and plantations abroad; but such grants did not extend to the East Indies, that territory not being regarded in law as a colony or plantation; Report on Letters Patent, 1872, Appendix A. at p. 157. Patents for Ireland and Scotland had to be taken out under the Great Seal of those countries respectively. Letters patent granted under the Patent Law Amendment Act, 1852, extended to the United Kingdom of Great Britain and Ireland, the Channel Islands, the Isle

made at the commencement of the Act and prolonged, extend to and have effect in the Channel Islands (*p*).

Duration of the grant.

The normal period of duration is fourteen years from the date of the patent (*q*), that is, from the day of application (*r*); and it has been decided that the actual day of application is to count (*s*). If the grant be made in pursuance of the international arrangements provided for by sect. 103, the fourteen years count from the date of application in the foreign state (*t*). Sect. 104 makes similar provisions in colonial cases.

A patent may be avoided by non payment of fees.

But, notwithstanding the above, every patent will cease if the patentee fail to make the prescribed payments (*u*) within the prescribed times (*u*), or within such period—not exceeding three months—to which the comptroller may enlarge the time on proof that the non-payment was caused by accident, mistake or inadvertence (*v*). The application for enlargement of time must state in detail the circumstances, and the comptroller may require the applicant to substantiate the statements by such proof as the comptroller may think necessary (*y*). In calculating the time for payment of the fees, the day of date of the patent is excluded (*z*), the fees being payable at the end of the years “from” the date of the patent.

Enlargement of time for paying fees.

Prolongation of time.

On the other hand, the period may be prolonged beyond the period of fourteen years; this is dealt with in Chap. XVI., and see sect. 25, *infra*.

of Man, and, in case Her Majesty, by warrant under her royal sign manual so directed, to her colonies and plantations abroad (sect. 18). The power, hereby reserved to the Sovereign, of including the Colonies in letters patent granted after the Act of 1852, was not exercised; and in January, 1853, a letter was addressed on behalf of the Secretary of State to the colonial authorities, making inquiries of the colonial governments on the subject, the result of which was the passing of the various Acts and ordinances under which patents are issued in British India and the Colonies. The usual custom was, when an invention was supposed to be applicable to the Colonies as well as to England, that the parties petitioned the Crown for letters patent in England and the Colonies; and the Crown granted a patent according to the prayer of the petition. It also granted a further privilege through the Privy Council of

enabling the patentee in the Crown Colonies to deposit official or authenticated copies of the patent and the specification, so that they should be as good evidence as the production of the original documents: Report, 1851, p. 65. Ans. 390.

(*p*) 1883, sect. 113; and see *Re Brandon* (1884), 1 R. P. C. 154. The 116th section might enable the Crown to grant a patent to cover the Channel Islands.

(*q*) 1883, sect. 17.

(*r*) 1883, sect. 13.

(*s*) *Russell v. Ledlam* (1845), 14 M. & W. 574, 582; 14 L. J. Ex. 359.

(*t*) 1883, sect. 103; 1885, sect. 6.

(*u*) P. R. 1892, Schedule. When the time ends on Christmas Day, Good Friday, Saturday, Sunday, &c., see 1883, sect. 98.

(*x*) 1883, sect. 17.

(*y*) P. R. 1890, r. 49.

(*z*) *Williams v. Nash* (1859), 23 L. J. Ch. 886; 28 Beav. 93.

V. CO-OWNERS.

As has already been pointed out (*a*), a grant may be made to several persons jointly; or the patent originally granted to one person may become by subsequent assignment or devolution vested in several co-owners. The position of co-owners requires some consideration.

The law as to the rights in ordinary cases of co-owners of a patent is laid down in Lindley on the Law of Partnership (*b*). 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, "in the case of a patent belonging to several persons in common, each co-owner can assign his share and sue for an infringement, and can also work the patent himself and give licences to work it, and sue for royalties payable to him for its use; and it is now settled that even if he be a mortgagee of the other share, he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is still, perhaps, open to question whether he is not liable to account for what he receives in respect of the licences" (*c*).

Rights of
co-owners
generally.

In *Mathers v. Green* (*c*), 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

(*a*) *Ante*, p. 270.

(*b*) 6th ed. p. 36.

(*c*) *Mathers v. Green* (1866), 1 Ch. 29;
35 L. J. Ch. 1; *Steers v. Rogers* (1893),

App. Ca. 232; 62 L. J. Ch. 671; 10
R. P. C. 245. Contrast *Copyright Law*:
Powell v. Head (1875), 12 Ch. Div. 686.