

HANDY GUIDE <sup>C#</sup>

TO

PATENT LAW AND  
PRACTICE

BY

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## PREFACE.

SINCE the first edition of this book was placed before the public, experience of the working of the then existing law relating to compulsory licences has stirred up the Legislature to make fresh provision for coping with the dog-in-the-manger policy adopted by many foreign patentees. It certainly seems strange that the British patent laws, intended solely to benefit the British community by encouraging the introduction of new manufactures, should have been wrested from their original purpose and used as a means for preventing the establishment of such manufactures in this country. But so it has been, and there does not appear to have been any case in which the question of a patentee's duty to work his patent, or to allow others to work it, in this country has been raised. The new statutory provisions deal with this matter, and it is to be hoped that its provisions may prove useful; but the author has in the body of the book suggested that there may be a simpler remedy at common law, capable of dealing with the case of a patent either obtained with the sole object of preventing manufacture in this country or obtained without any such express intention, but afterwards used with that object.

✓The author ventures to think that it could be fairly held that a person asking for the grant of a monopoly in a certain manufacture within this realm impliedly

declares his intention of carrying on such manufacture, and that if he has not any such intention, but merely desires to prevent any British subject from competing with a foreign manufacturer, that his application for the grant is a fraud on the Crown. The other case seems to come exactly within the express condition of the grant, providing that if at any time during its term it be made to appear to the Crown, or to any six or more of the Privy Council, that the grant is prejudicial or inconvenient to the subjects in general, all privileges and advantages whatever thereby granted shall determine and become void.

There have been during the last few years few important decisions relating to patents, but among these may be especially mentioned that of the House of Lords in *Moser v. Marsden*, determining that after the amendment of a specification the original cannot be referred to, even though the amendment ought not to have been allowed, thereby throwing on the Patent Office the full responsibility for any amendment.

The decision of a patent action generally depends entirely upon particular facts, and rarely involves any disputed question of law; and, as in the first edition, the author has been careful to resist the temptation to enlarge the book by introducing cases in which courts have decided questions of fact of the highest importance to the parties engaged, and, it may be, also interesting from a scientific standpoint, but entirely without bearing on the decision of any case in which a different patent is involved.

The author believes that he has included all the cases that have any bearing on the law of patents, and that the work, though not so bulky as some other dissertations on the same subject, will be found sufficient to

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meet all the requirements both of the profession and of the public.

The circumstances under which patents are dealt with vary so much that anything approaching an exhaustive treatment of the subject of patent conveyancing would fill a large volume; but in the second Appendix will be found a few precedents relating to patents, which the author hopes will be found useful. The author believes that Form X which, with modifications, he has used to a considerable extent in practice, has not been previously published.

The book has been practically rewritten and brought up to date.

I have again to thank J. H. Taylor, Esquire, of Queen's College, Oxford, and Trinity College, Cambridge, for going through the proofs and verifying the Index, and the Comptroller for information on one or two matters of practice not dealt with by the Rules.

G. F. EMERY.

5 KING'S BENCH WALK, TEMPLE,

1st June, 1904.

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Dunlop Pneumatic Tyre Co. <i>v.</i> Cresswell	1901	18 R.P.C. 473 (101)
Dunlop Pneumatic Tyre Co. <i>v.</i> Excelsior Tyre Co.	1901	18 R.P.C. 209 (133)
Dunlop Pneumatic Tyre Co. <i>v.</i> Green	1900	17 R.P.C. 234 (200)
Dunlop Pneumatic Tyre Co. <i>v.</i> Moseley	1904	C.A. 1 Ch. 612; 73 L.J. Ch. 227 (133, 136)
Dunlop Pneumatic Tyre Co. <i>v.</i> Neal	1899	16 R.P.C. 247 (133)
Dunlop Pneumatic Tyre Co. <i>v.</i> Nev Ixion Tyre Co.	1899	C.A. 16 R.P.C. 16 (196)
Dunlop Pneumatic Tyre Co. <i>v.</i> North British Rubber Co.	1904	C.A. 21 R.P.C. 161 (108)
Dunlop Pneumatic Tyre Co. <i>v.</i> Rimington Bros. & Co.	1900	C.A. 17 R.P.C. 665 (141)
Dunlop Pneumatic Tyre Co. <i>v.</i> Wapshare Tube Co.	1900	17 R.P.C. 433 (205)
<i>Re Eadie</i>	1885	Griff. 279 (79)
<i>Edge v. Harrison</i>	1891	8 R.P.C. 74 (163)
<i>Edgeberry v. Stephens</i>	1691	2 Salk. 447; 1 W.P.C. 35 (4, 33)
Edison-Bell Consolidated Phonograph Co. <i>v.</i> Columbia Phonograph Co.	1900	18 R.P.C. 4 (181)
Edison-Bell Consolidated Phonograph Co. <i>v.</i> Waterfield, Clifford & Co.	1902	19 R.P.C. 329 (205)
Edison-Bell Phonograph Co. <i>v.</i> Edison Phonograph	1894	11 R.P.C. 33 (205)
Edison-Bell Phonograph Co. <i>v.</i> Smith & Young	1894	C.A. 11 R.P.C. 389 (178, 186, 188, 202)
Edison United Phonograph Co. and Edison-Bell Phonograph Co. <i>v.</i> T. Lewis Young	1894	11 R.P.C. 489 (157)
Edison & Swan Electric Light Co. <i>v.</i> Holland	1889	3 R.P.C. 395; C.A. 6 R.P.C. 243 (69, 141, 186, 189, 204)
Edison & Swan United Electric Light Co. <i>v.</i> Woodhouse & Rawson	1887	C.A. 4 R.P.C. 93 (20, 24, 186)
Edlin <i>v.</i> Pneumatic Tyre, etc.	1893	10 R.P.C. 311 (172)



<i>Re</i> Edmunds	1888	Griff. 281 (78)
<i>Ehrlich v. Ihlee</i>	1887	4 R.P.C. 115; 5 R.P.C. 457 (26, 152)
<i>Electric Construction Co. v. Imperial Tramways Co.</i>	1900	C.A. 17 R.P.C. 536 (75)
<i>Electrolytic Plating Apparatus Co. v. Holland</i>	1901	18 R.P.C. 521 (183)
<i>Ellams v. Martyn &amp; Co.</i>	1899	C.A. 16 R.P.C. 28 (175)
<i>Elmslie v. Boursier</i>	1869	L.R. 9 Eq. 217 (33)
<i>English &amp; American v. Gare Machine</i>	1894	11 R.P.C. 627 (172)
<i>English &amp; American Machinery Co. v. Union Boot &amp; Shoe Machine Co.</i>	1896	13 R.P.C. 64 (109, 200)
<i>English &amp; American Machinery Co. v. Union Boot &amp; Shoe Machine Co.</i>	1894	C.A. 11 R.P.C. 367 (183, 200)
<i>Fabriques de Produits, etc. v. Lafitte &amp; Co.</i>	1899	16 R.P.C. 68 (204)
<i>Fairburn v. Household</i>	1884	1 R.P.C. 109 (174)
<i>Fairburn v. Household</i>	1885	C.A. 2 R.P.C. 195 (184)
<i>Fawcett v. Homan</i>	1896	C.A. 13 R.P.C. 398 (203)
<i>Fenner v. Wilson</i>	1893	C.A. 10 R.P.C. 283 (172)
<i>Ferranti's Petition</i>	1901	P.C. 18 R.P.C. 518 (218)
<i>Finch's Patent</i>	1898	15 R.P.C. 674 (212, 213, 221, 225)
<i>Fletcher's Patent</i>	1893	10 R.P.C. 252 (229)
<i>Foxwell v. Bostock</i>	1861	4 De G. J. & S. 313 (72)
<i>Franklin Hocking &amp; Co., Ltd. v. Franklin Hocking</i>	1887	C.A. 4 R.P.C. 442 (132)
<i>Frearson v. Loe</i>	1878	9 Ch. D. 58, 65 (24, 94, 127, 139)
<i>Fusee Vesta Co. v. Bryant &amp; May</i>	1887	34 Ch.D. 458; 4 R.P.C. 71 (112)
<i>Gadd &amp; Mason v. Mayor of Manchester</i>	1892	9 R.P.C. 516; C.A. 67 L.T. 569 (22, 24, 26, 210)
<i>Galloway's Patent</i>	1843	1 W.P.C. 725 (213, 220)
<i>Garrard v. Edge</i>	1889	C.A. 6 R.P.C. 372 (182)
<i>Garnett's Application</i>	1899	S.G. 16 R.P.C. 154 (54)
<i>In re</i> Gaulard & Gibbs' Patent	1887	57 L.J. Ch. 209 (113, 163)
<i>Gaulard &amp; Gibbs' Patent</i>	1888	5 R.P.C. 526; C.A. 6 R.P.C. 215 (161)
<i>Gaulard v. Lindsay</i>	1888	38 Ch. D. 38 (112)
<i>Gavioli v. Shepherd</i>	1899	17 R.P.C. 157 (200)
<i>Geipel's Patent</i>	1904	C.A. [1904], 1 Ch. 239 (165)
<i>Germ. Milling Co. v. Robinson</i>	1885	3 R.P.C. 11 (153, 154)
<i>Gibson &amp; Campbell v. Brand</i>	1841	1 W.P.C. 628 (35)
<i>Gibson v. Brand</i>	1841	Scott N.R. 844, 890; 4 M. & G. 179; 1 W.P.C. 631 (71)
<i>Gillett v. Wilby</i>	1839	1 W.P.C. 270 (74)
<i>Re</i> Glossop	1884	Griff. 285 (79, 80)

Görz & Högh's Patent	1895	W.N. 105 (162)
Goucher's Patent	1865	2 Moo. P.C.C. (N.S.) 532 (213)
Goucher <i>v.</i> Clayton	1864	11 Jur. N.S. 107 (150)
Graham <i>v.</i> Eli	1898	Div. Ct. 15 R.P.C. 259 (228)
Graham <i>v.</i> Fanta	1892	Div. Ct. 5 R.P.C. 164 (124, 228)
<i>Re</i> Grenfell & McEvoy's Patent	1890	7 R.P.C. 151 (53)
Guilbert-Martin <i>v.</i> Kerr	1887	4 R.P.C. 18 (207)
Guyot <i>v.</i> Thomson	1894	11 R.P.C. 511 (104, 107, 139)
Haddan's Patent	1885	Griff. 108; 54 L.J. Ch. 126 (163)
Hall <i>v.</i> Condor	1857	2 C.B. N.S. 22 (91)
Hall's Patent	1888	5 R.P.C. 283 (119)
<i>Re</i> Hall	1888	21 Q.B.D. 137 (110)
Hancock <i>v.</i> Somervell	1851	39 <i>Newton's Lond. Journ.</i> , 158 (23)
Hardy's Patent	1849	6 Moo. P.C.C. 441 (225)
Harrild & Parkin's Application	1900	S.G. 17 R.P.C. 617 (84)
Harris <i>v.</i> Rothwell	1887	C.A. 4 R.P.C. 225 (26)
Harrison <i>v.</i> The Anderston Foundry Co.	1876	1 App. Cas. 577 (18, 72, 73)
Harwood <i>v.</i> Great Northern Railway Co.	1865	11 H.L.C. 682 (17)
Haslam <i>v.</i> Hall	1887	4 R.P.C. 203 (146)
Haslam <i>v.</i> Hall	1888	5 R.P.C. 27 C.A. 144 (204)
Haslam Foundry & Engineering Co. <i>v.</i> Goodfellow	1887	37 Ch. D. 118; 5 R.P.C. 28 (112, 153)
Hassall <i>v.</i> Wright & others	1870	L.R. 10 Eq. 509 (138)
Hastings <i>v.</i> Brown	1853	1 E. & B. 454 (69)
Hattersley <i>v.</i> Hodgson	1903	20 R.P.C. 591 (66)
Haworth <i>v.</i> Hardcastle	1834	1 Webs. R. 484; 1 Bing. N.C. 182 (75, 188)
Haycock <i>v.</i> Bradbury	1887	4 R.P.C. 74 (205)
Hazeland's Patent	1894	11 R.P.C. 467 (222)
Heald's Application	1891	8 R.P.C. 429 (36)
Heap <i>v.</i> Hartley	1889	C.A. 6 R.P.C. 495; 42 Ch. D. 461 (107, 139)
Heath's Patent	1853	2 W.P.C. 247 (222)
<i>Re</i> Heath & Frost	1886	Griff. 311 (80)
Heath <i>v.</i> Unwin	1855	H.L. 2 W.P.C. 314 (130)
Heathfield <i>v.</i> Greenway	1894	11 R.P.C. 17 (179)
Henderson <i>v.</i> Eason	1852	27 Q.B. 701; 21 L.J.Q.B. 82 (102, 103)
Henderson's Patent	1901	P.C. 18 R.P.C. 449 (219)
Henser <i>v.</i> Hardie	1894	11 R.P.C. 421 (147)
Herbert's Patent	1867	L.R. 1 P.C. 399 (225)
Herrburger <i>v.</i> Squire	1888	5 R.P.C. 581 (171)
Hesse <i>v.</i> Stevenson	1803	3 Bos. & P. 565 (230)
Heugh <i>v.</i> Chamberlain	1877	25 W.R. 742 (150)
Hexter <i>v.</i> Pearce	1900	[1900] 1 Ch. 341 (103)

Higgs <i>v.</i> Godwin	1858	E.B. & E. 529; 27 L.J.Q.B. 421 (29)
Hill <i>v.</i> Thomson & Forman	1817	1 W.P.C. 237 (18, 70)
<i>Re</i> Hill	1888	5 R.P.C. 599 (80, 119)
Hill's Patent	1863	1 Mon. P.C.C. (N.S.) 258 (222)
Hills <i>v.</i> Evans	1861	31 L.J. Ch. 460; 4 De G. F. & J. 288 (25, 185)
Hills <i>v.</i> Laming	1853	9 Ex. R. 256 (105, 150)
Hills <i>v.</i> London Gas Light Co.	1860	5 H. & N. 336 (23)
Hinks & Son <i>v.</i> The Safety Lighting Co.	1876	4 Ch. D. 607 (20)
<i>In re</i> Hirschfeld's Patent	1894	11 R.P.C. 515 (162)
Hocking <i>v.</i> Hocking	1887	C.A. 4 R.P.C. 442 (132)
Hoe & Co. <i>v.</i> Foster & Sons	1899	C.A. 16 R.P.C. 33 (22)
Holliday <i>v.</i> Heppenstall	1889	C.A. 6 R.P.C. 320 (181, 183)
Holmes <i>v.</i> L. & N. W. R. Co.	1852	12 C.B. 831 (72)
Hopkinson's Patent	1896	13 R.P.C. 114 (218)
Horse's Patent	1884	1 R.P.C. 225 (218)
Horton <i>v.</i> Mabon	1862	16 C.B. N.S. 141; 31 L.J.C.P. 255 (17)
Houghton's Patent	1871	L.R. 3 P.C. 461 (213, 222)
Househill Co. <i>v.</i> Neilson	1843	H.L. 1 W.P.C. 673 (15)
Household <i>v.</i> Fairburn	1884	1 R.P.C. 109 (174)
Howes <i>v.</i> Webber	1894	11 R.P.C. 586; [1895] 12 R.P.C. 470 (144, 202)
Hubbuck <i>v.</i> Brown	1900	17 R.P.C. 638 (227)
Hughes' Patent	1898	15 R.P.C. 372 (220)
Hutton & Bleakley's Petition	1898	15 R.P.C. 749 (238, 239)
Incandescent Gas Light Co. <i>v.</i> Brogden	1899	16 R.P.C. 179 (92, 101, 134, 136)
Incandescent Gas Light Co. <i>v.</i> Cantelo	1895	12 R.P.C. 262 (92, 101, 134)
Incandescent Gas Light Co. <i>v.</i> Daylight Co.	1899	16 R.P.C. (136)
Incandescent Gas Light Co. <i>v.</i> De Mare	1896	C.A. 13 R.P.C. 301 (127, 136, 139, 195, 204, 210)
Incandescent Gas Light Co. <i>v.</i> Riemer	1900	C.A. 17 R.P.C. 378 (197)
incandescent Gas Light Co. <i>v.</i> Sluce	1900	C.A. 17 R.P.C. 173 (197)
Incandescent Gas Light Co. <i>v.</i> Sunlight Incandescent	1896	13 R.P.C. 333 (195)
Inland Revenue Commission- ers <i>v.</i> Müller	1901	H.L. [1901] A.C. 217 (106)
Innes <i>v.</i> Short	1898	15 R.P.C. 449 (136)
Jandus Arc Lamp <i>v.</i> Arc Lamp	1903	21 R.P.C. 115 (112)
Jandus Arc Lamp <i>v.</i> Johnson	1900	17 R.P.C. 361 (105, 149, 188, 189)
Jardine <i>v.</i> King, Mendham & Co.	1896	13 R.P.C. 411 (205)

Jenkins <i>v.</i> Hope	1896	13 R.P.C. 57 (144)
Job <i>v.</i> Potton	1875	L.R. 20 Eq. 84; 44 L.J. Ch. 262 (103)
Johnasson <i>v.</i> Pálgrave	1880	Lawson, <i>Pat. Pract.</i> , 2nd Edit. 495 (156)
<i>Re</i> Johnson	1896	13 R.P.C. 659 (110)
Johnson <i>v.</i> Edge	1892	C.A. 9 R.P.C. 142 (169)
Johnson's Application	1901	19 R.P.C. 56 (40)
Johnson's Patent	1871	L.R. 4 P.C. 75 (221)
J. & G.'s Application	1902	S.G. 19 R.P.C. 555 (81)
<i>Re</i> Jones		Griff. 313 (113)
Jones' Patent	1840	1 W.P.C. 579 (212)
Joy's Patent	1893	10 R.P.C. 89 (222)
Jupe <i>v.</i> Pratt	1837	1 W.P.C. 146 (132)
Kane <i>v.</i> Guest	1899	16 R.P.C. 433 (208)
Kane & Pattison <i>v.</i> Boyle & Co.	1901	18 R.P.C. 325 (117)
<i>In re</i> Kay's Patent	1894	11 R.P.C. 279 (162)
Kelly <i>v.</i> Batchelar	1893	10 R.P.C. 289 (136)
Kelly <i>v.</i> Heathman	1890	7 R.P.C. 343 (152)
Kenny's Buttonholing Co. <i>v.</i> Somerville		26 W.R. 787; 38 L.T. 878 (93)
Kensington Electric &c. <i>v.</i> Lane Fox Electrical	1891	8 R.P.C. 277 (170)
Kerr & Haegger <i>v.</i> Crompton	1901	Pal. Ct. Lan. 19 R.P.C. 9 (209)
King, Brown & Co. <i>v.</i> Anglo- American Brush Co.	1889	6 R.P.C. 424 (21, 23)
<i>Re</i> Knight	1887	Gr. A.P.C. 35 (120)
Kurtz <i>v.</i> Spence	1887	C.A. 4 R.P.C. 427 (174)
Kynoch & Co. Ltd. <i>v.</i> Webb	1900	H.L. 17 R.P.C. 100 (19, 66, 72, 73, 75)
<i>Re</i> Lake	1887	Gr. A.P.C. 16 (49, 110, 116)
<i>Re</i> Lake	1889	6 R.P.C. 550 (85)
Lake's Patent	1891	8 R.P.C. 227 (221)
<i>Re</i> Lancaster	1884	Griff. 293 (79)
Lane Fox's Patent	1892	9 R.P.C. 411 (222)
Lang <i>v.</i> Whitecross Co.	1889	62 L.T. 119; 89 L.T.J. 351; 6 R.P.C. 570 (112)
Law <i>v.</i> Ashworth	1890	7 R.P.C. 86 (Lanc. Court Case) (173)
Lawson <i>v.</i> Donald Macpher- son & Co.	1897	14 R.P.C. 696 (106)
Leake <i>v.</i> Cordeaux	1856	4 W.R. 806 (102)
Leather Cloth Co. <i>v.</i> American Cloth Co.	1865	11 H.L.C. 523 (227)
Leeds Forge Co. <i>v.</i> Deighton's Patent Flue Co.	1903	20 R.P.C. 185 (211)
Lee's Patent	1856	10 Moo. P.C.C. 226 (213)
Leonhardt <i>v.</i> Kallé	1895	12 R.P.C. 103 (70)
Levinstein's Petition	1898	15 R.P.C. 742 (238, 239)



Lewis <i>v.</i> Marling	1829	4 C. & P. 52; 1 W.P.C. 490; 10 B. & C. 22; 5 R. & M. 66 (70)
Lindon's Patent	1897	14 R.P.C. 643 (218)
Lines <i>v.</i> Usher	1897	C.A. 14 R.P.C. 206 (104)
Lister <i>v.</i> Norton	1885	2 R.P.C. 68 (155)
Livet's Patent	1892	9 R.P.C. 332 (222)
Lovell <i>v.</i> Hicks	1837	5 L.J. (N.S.) Ex. Eq. 101 (104)
Lowe's Patent	1852	8 Moo. P.C.C. 1 (218)
Lucas <i>v.</i> Miller	1900	17 R.P.C. 165 (21, 128)
Ludington Cigarette Machine Co. <i>v.</i> Baron Cigarette Machine Co.	1899	17 R.P.C. 25; C.A. 214; H.L. 745 (112)
<i>Re</i> Luke	1886	Griff. 294 (75)
Lyon's Patent	1894	11 R.P.C. 537 (224, 225)
Lyon <i>v.</i> Goddard	1893	C.A. 10 R.P.C. 344 (20, 21)
Lyon <i>v.</i> Mayor &c. of Newcastle-upon-Tyne	1894	11 R.P.C. 218 (145)
<i>Re</i> Macevoy	1888	5 R.P.C. 285 (80)
<i>Re</i> Main's Patent	1890	7 R.P.C. 13 (247, 249)
Mallet's Patent	1866	L.R. 1 P.C. 308 (225)
Mandleberg <i>v.</i> Morley	1895	12 R.P.C. 35 (209)
<i>In re</i> Manning's Patent	1903	20 R.P.C. 74 (233)
Marsden <i>v.</i> Saville Street Foundry & Engineering Co.	1878	L.R. 3 Ex. D. 203 (32, 34, 35)
<i>In re</i> Marshall & Naylor's Patent	1900	17 R.P.C. 553 (37)
Mathers <i>v.</i> Green	1865	L.R. 1 Ch. 29; 35 L.J. Ch. 1; 34 Beav. 170 (93, 103)
Matthews <i>v.</i> Parmenter	1896	13 R.P.C. 514 (22)
Maxim - Nordenfelt Co. <i>v.</i> Anderson	1897	14 R.P.C. 371 (95)
McDougall Bros. <i>v.</i> Partington	1890	7 R.P.C. 357 (153)
<i>Re</i> Meyer	1899	A.G. 16 R.P.C. 526 (80)
Mica Insulator Co. <i>v.</i> Electrical Co.	1898	15 R.P.C. 489 (75, 181)
Middleton <i>v.</i> Bradley	1895	12 R.P.C. 390, W.N. 123[7] (208)
Miller's Patent	1894	11 R.P.C. 55 (162)
Milligan <i>v.</i> Marsh	1856	2 Jur. N.S. 1083 (34)
Mill's Application	1901	S.G. 18 R.P.C. 322 (84)
Mills <i>v.</i> Carson	1892	9 R.P.C. 338; C.A. 10 R.P.C. 9 (104)
Monforts <i>v.</i> Marsden	1895	C.A. 12 R.P.C. 266 (91, 104)
Montgomerie <i>v.</i> Paterson	1894	Ct. Sess. 11 R.P.C. 221 (135)
Montgomery <i>v.</i> Wallace Jones	1903	H.L. 90 L.T. 1 (194)
Moore <i>v.</i> Thomson	1890	H.L. 7 R.P.C. 325 (149)
Morgan Brown's Patent	1886	3 R.P.C. 212 (226)
Morgan <i>v.</i> Seaward	1836	1 W.P.C. 174; 2 M. & W. 561 (23, 29, 68, 70, 180)

Morris <i>v.</i> Young	1895	H.L. 12 R.P.C. 455 (149, 188, 204)
Moseley <i>v.</i> Victoria Rubber Co.	1887	3 R.P.C. 351; 4 R.P.C. 252 (25, 154)
Moser <i>v.</i> Marsden	1892	C.A. 9 R.P.C. 214 (141)
Moser <i>v.</i> Marsden	1893	C.A. 10 R.P.C. 350 (34)
Moser <i>v.</i> Marsden	1896	H.L. 13 R.P.C. 24 (117)
Muirhead <i>v.</i> Commercial Cable Co.	1895	C.A. 12 R.P.C. 39 (105, 148)
Muntz's Patents	1846	2 W.P.C. 121 (221)
Murray <i>v.</i> Clayton	1872	L.R. 15 Eq. 115 (201)
Myers <i>v.</i> Baker	1858	3 H. & N. 802 (227)
Nadel <i>v.</i> Martin	1903	C.A. 20 R.P.C. 721 (195)
<i>Re</i> Nahnsen	1900	A.G. 17 R.P.C. 203 (80, 84, 85)
Napier's Patent	1861	13 Moo. P.C.C. 543 (223)
Napier's Patent	1881	L.R. 6 App. Cas. 174 (213)
National Company for the Distribution of Electricity <i>v.</i> Gibbs	[1899]	2 Ch. 289; 16 R.P.C. 339; 17 R.P.C. 303 (31, 102)
Neilson <i>v.</i> Harford	1841	1 W.P.C. 355 (75)
Newall <i>v.</i> Elliott	1858	4 C.B.N.S. 269 (61)
Newby <i>v.</i> Harrison	1861	1 J. & H. 393 (104)
New Conveyor Co. <i>v.</i> Edin- burgh Gas Commissioners	1903	(Scotch) 21 R.P.C. 1, 147 (112)
New Ixion Tyre <i>v.</i> Spilsbury	1898	[1898] 2 Ch. 484; 15 R.P.C. 380; 79 L.T. 229 (230)
Newsom <i>v.</i> Mann	1890	7 R.P.C. 310 (208)
<i>Re</i> Newton	1900	A.G. 17 R.P.C. 123 (85)
Newton's Patents	1884	9 App. Cas. 592; 1 R.P.C. 177 (221)
Nickels <i>v.</i> Ross	1850	8 C.B. 679 (33)
Nobel's Explosives Co. <i>v.</i> An- derson	{ 1894 1895	{ 11 R.P.C. 115 (95) H.L. 12 R.P.C. 164 (194)
Nobel's Explosives Co. <i>v.</i> Jones	1882	8 App. Cas. 1 L.T. Ch. 339 (135, 140)
Normandy's Patent	1885	9 Moo. P.C.C. 452 (225)
North British Rubber Co. Ltd. <i>v.</i> Macintosh	1894	11 R.P.C. 484 (194)
North British Rubber Co. <i>v.</i> Gormully & Jeffry Mfg. Co.	1895	12 R.P.C. 17 (145, 157)
Norton's Patent	1863	1 Moo. P.C.C. (N.S.) 339 (221)
Nuttall <i>v.</i> Hargreaves	1891	C.A. 8 R.P.C. 450 (63)
Oldham <i>v.</i> Langmead	1789	3 T.R. 441 (145)
Otto <i>v.</i> Linford	1881	C.A. 46 L.T.N.S. 35 (15, 26, 187)
Otto <i>v.</i> Singer	1890	7 R.P.C. 7 (102)
Otto <i>v.</i> Steel	1886	3 R.P.C. 120 (204)
Otto <i>v.</i> Steel	1886	C.A. 3 R.P.C. 109 (26)
Overton <i>v.</i> Burn, Lowe & Sons	1896	13 R.P.C. 455 (174)
<i>In re</i> Owen's Patent	1898	[1899] 1 Ch. 157; 15 R.P.C. 755 (111, 163)



Owen's Patent	1900	17 R.P.C. 68, 637 (70, 164, 180)
Palmer Tyre Co. <i>v.</i> Pneumatic Tyre Co.	1899	16 R.P.C. 451 (195)
Parker <i>v.</i> Wells	1881	C.A. 18 Ch. D. 477 (155)
Parkinson <i>v.</i> Simon	1894	C.A. 11 R.P.C. 493; [1895] H.L. 12 R.P.C. 403 (194)
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B. & C.	Barnewall and Cresswell's Reports.	Jur. N.S.	Johnson and Hemming's Reports.
Beav.	Beavan's Reports.	K.B.	Jurist, New Series.
Bing.	Bingham's Reports of Common Pleas.	Lev.	King's Bench Reports.
Bos. & P.	Bosanquet and Puller's New Reports.	L.J.	Levinz's Reports
Carpmael Rep.	Carpmael's Patent Cases.	L.J. C.P.	Law Journal.
C.B.	Common Bench Reports.	L.R. Ch.	Law Journal, Common Pleas.
C.B. N.S.	Common Bench Reports, New Series.	L.R. C.P.	Law Reports, Chancery Appeals.
Ch. or L.R. Ch.	Law Reports, Chancery Appeal Cases.	L.R. H.L.	Law Reports, Common Pleas.
Ch. D.	Law Reports, Chancery Division.	L.R. P.C.	Law Reports, House of Lords, English.
C.P.D.	Law Reports, Common Pleas Division.	L.R. Ex.D.	Law Reports, Privy Council.
C. & P.	Carrington and Payne's Reports.	L.R. Eq.	Law Reports, Exchequer Division.
Coke Rep.	Coke's Reports.	L.T.	Law Reports, Equity Cases.
Dan. & Ll.	Danson and Lloyd's Mercantile Cases.	L.T.J.	Law Times Reports.
Dav. P.C.	Davis's Reports.	L.T. N.S.	Law Times Journal.
De G. F. & J.	De Gex, Fisher and Jones's Reports.	M. & G.	Law Times Reports, New Series.
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## CHAPTER I.

### INTRODUCTORY.

FROM an early period in history the Courts of Common Law recognised the right of the Crown by virtue of its prerogative to grant to the inventor or introducer of a new industry the sole right or monopoly of carrying on that industry for a limited time. Such a grant enabled the inventor to obtain the due reward of his labour and ingenuity by preventing for a time the competition of those who had merely to copy his processes, and in this way was a direct incentive to industry; at the same time the monopoly might not be for an unlimited time, for then those who had learned the new trade could have been restrained from earning a livelihood by its practice.

Monopolies  
in ancient  
times.

Under several monarchs, especially Queen Elizabeth, the right of granting monopolies was terribly abused, monopolies being granted in respect of existing trades and causing a great deal of annoyance and loss to the people at large. Finally, in the reign of James I., the matter was made a subject of legislation by Parliament, and the Statute of Monopolies thenceforth prevented any further abuse of the royal prerogative. The first section of this statute contains a declaration of the common law with regard to monopolies in the following language:—

Statute of  
Monopolies,  
21 Jac. I., c. 3.

“ Be it declared and enacted that all monopolies and all commissions, grants, licences, charters and letters patent, heretofore made or granted or hereafter to be made or granted to any person or persons bodies politic or corporate whatsoever of or for the sole buying, selling, making, working or using of anything within this realm or the dominion of Wales or of any other

monopolies . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution."

Trial of monopolies.

Section 2 provided for the trial of all such grants, etc., by and according to the common law and not otherwise. And section 6 made the exception on which our present patent law is based, and is as follows:—

Exception for inventions.

" Provided also and be it declared and enacted that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under hereafter to be made for the sole working or making of any manner of new manufactures within this realm to the true and first inventor or inventors of such manufactures which others at the time of making such letters patent and grants shall not use so as they shall not be contrary to law nor mischievous to the state by raising prices of commodities at home or hurt of trade or generally inconvenient the said fourteen years to be accompted from the date of the first letters patent or grant of such privilege hereafter to be made but that the same shall be of such force as they should be if this Act had never been made, and of none other."

Statute of Monopolies, sect. 6.

Statute does not enlarge exception.

It will be seen that the statute does not authorise any monopoly which would be void at common law, so that if it can be shown that any monopoly would have been bad at common law it will still be bad.

Procedure for granting patents.

The method of granting letters patent for inventions is now regulated by the Patents, Designs and Trade Marks Acts, 1883-1902, and the Patent Rules, 1903: but the test of validity is still (with one exception to be presently noticed) section 6 of the Statute of Monopolies.

Definition of invention Act, 1883, sect. 46.

The Act of 1883 defines an invention, for which alone a patent can be granted under the Act, as meaning any manner of new manufacture, the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies, and as including an alleged invention.

The question "What is an invention?" is considered in the next chapter.

The Statute of Monopolies provided for the grant of letters patent to the first and true inventor only; and, until 1883, if he died without applying for a patent, his

successors could not obtain a valid patent for his invention. It is now provided that the legal representatives, that is the executors or administrators, of a deceased inventor may, within six months of his death, apply for letters patent for any invention of which he died possessed; and if he should die after applying, but before the patent is sealed, it may be granted to his legal representatives, and so not be lost to his estate.

When inventor dies before taking out patent, patent granted to legal representatives. Act, 1883, sect. 34.

The meaning of "First and true inventor" is con-

That part of the section which excludes from its protection any grants, even for new manufactures, that may be "contrary to law or mischievous to the State, by raising prices of commodities at home or hurt of trade or generally inconvenient," has hitherto been a dead letter. In view, however, of the well-known fact that foreign manufacturers have largely made use of British patent rights for the sole purpose of preventing the making and working of new inventions within the realm, and of the fact that the latest statute dealing with patents makes provision for the revocation of patents, "where, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent or to grant licences on reasonable terms, any existing industry or the establishment of any new industry is unfairly prejudiced," it becomes worth considering whether a grant of monopoly to be used to prevent competition between British and foreign producers for the sole benefit of the latter is not voidable at common law as mischievous to the State. Suppose it found as a fact that a patentee, when he applied for a grant of monopoly, had no intention of making or working his invention within the United Kingdom, and only wanted a patent to prevent others for fourteen years from establishing there the new manufacture he had invented, so as to enable him to sell his foreign product at his own price. Could any jury fail

Mischievous to the State.



to find that such a grant was mischievous to the State by preventing the creation of a new home industry, and so prejudicing the trade of the country by preventing competition with foreign labour, and generally inconvenient by making this country dependent upon foreign sources for the supply of an article which might be equally well manufactured at home?

Is there any obligation to work a patent?

It seems hitherto to have been assumed that the grant of a monopoly imposed no obligation on the grantee to work or use his invention within the realm; but is this assumption well founded? The whole object of allowing monopolies at common law was to foster new industries. And it was laid down as long ago as 1691 that the Statute of Monopolies intended to encourage new devices useful to the kingdom.<sup>1</sup> Grants for a limited time of a monopoly in a new industry were for the public good, and therefore were held to be a proper exercise of the royal prerogative; but could any Court have held that it was for the public good to prohibit the creation of a new industry at home for the sole benefit of a foreign manufacturer? Again, it may well be that an application for the sole working or making of a new manufacture within the realm implies an intention to so work and make by the applicant or his assigns, and that where no such intention exists, the Crown, in making the grant, acts on a false suggestion and the grant is consequently *bad ab initio*. This question does not appear to have ever been considered in Court; but the use of patent rights to hinder instead of to promote new industries is of comparatively recent origin, and its propriety at common law might well be impeached.

### *Patent Office.*

The Act of 1883 provided for the establishment of a Patent Office; this is situated in Southampton Buildings,

Act, 1883,  
sect. 82.

<sup>1</sup> *Edgeberry v. Stephens*, 1691, 2 Salk. 447; 1 W.P.C. 35.



Chancery Lane, W.C., and is under the immediate control of an officer, called the Comptroller-General of Patents, Designs and Trade Marks, who acts under the superintendence and direction of the Board of Trade. This official will be frequently referred to hereafter as the Comptroller. The Act<sup>1</sup> also provides that any act or thing directed to be done by or to the Comptroller may be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

The Act also provides for a seal for the Patent Office, with which letters patent are sealed, and this takes the place of the Great Seal formerly used for that purpose.

The Act of 1883 also provides that—

- “(1) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act:—
- “(c) For making or requiring duplicates of specifications, amendments, drawings, and other documents:
- “(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents:
- “(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:
- “(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:
- “(g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.
- “(2) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.
- “(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.
- “(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or if not, then as soon as practicable after the beginning of the

The  
Comptroller.

When Comp-  
troller is  
absent.

Seal of Patent  
Office, sect.  
84.

Sect. 101.  
Power for  
Board of  
Trade to  
make general  
rules for  
regulating  
business of  
Patent Office.

Altering  
forms.

Effect of  
rules.

Rules to be  
laid before  
Parliament.

<sup>1</sup> Sect. 82 (4) as amended by Patents Act, 1902, sect. 3.

next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

Rules may be annulled by Parliament.

“(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule.”

The Board of Trade have issued several sets of rules under this section, and the rules at present in force are the Patent Rules, 1903.

When Patent Office is open. Rule 79.

The Patent Office shall be open to the public every week day except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the day observed as His Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office.

Patent Office Library.

There is at the Patent Office an excellent Public Free Library, which is open daily from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday and Bank Holidays. On Christmas Eve, Easter Eve, Whitsun Eve and the day observed as His Majesty's birthday, the library closes at 4 p.m.

The library contains all the printed specifications, indexes and other publications of the Patent Office, and also a collection of the leading British and foreign scientific journals, transactions of the learned societies and text-books of science and art.

The Act also provides that—

Act, 1883, sect. 40. Official journal.

“(1) The Comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the Comptroller may deem generally useful or important.

Sale branch.

“(2) Provisions shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings (if any).

Publications.

“(3) The Comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.”

Several volumes of these have been published, and, with current specifications, may be obtained at the sale office of the Patent Office.

Before a patent can be granted the inventor or applicant for the patent must disclose to the public full information as to the mode of carrying out his invention, so that at the expiration of the term for which the patent is granted the trade may be open to all alike. This disclosure is made by filing at the Patent Office a complete specification, which is open to public inspection, before the patent is granted, and thenceforth becomes public property. The question of specifications is dealt with in chapter v.

Applicant for patent must make full disclosure of his invention in a complete specification.

### *Form of Grant of Letters Patent.*

The following form of a grant of letters patent to a single inventor will hereinafter be the subject of frequent reference.

#### FORM OF PATENT.

EDWARD VII., by the Grace of God, of the United Kingdom of Great Britain Patent Rules, and Ireland and of the British Dominions beyond the Seas, King, Defender 1903.  
of the Faith, Emperor of India: To all to whom these presents shall come Form W.  
greeting:

WHEREAS  
hath declared that he is in possession of an invention for

Recitals.

that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention:

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

Know ye, therefore, that We of our especial grace, certain knowledge, Grant.  
and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licencees,



and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:

Prohibition  
against  
infringement.

Proviso as to  
revocation.

Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything herein-

Payment of  
fees.

before contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything herein-before contained: Provided also that nothing herein contained shall

Public  
services.

Licences.

prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters

Construction.

patent shall be construed in the most beneficial sense for the advantage of the said patentee.

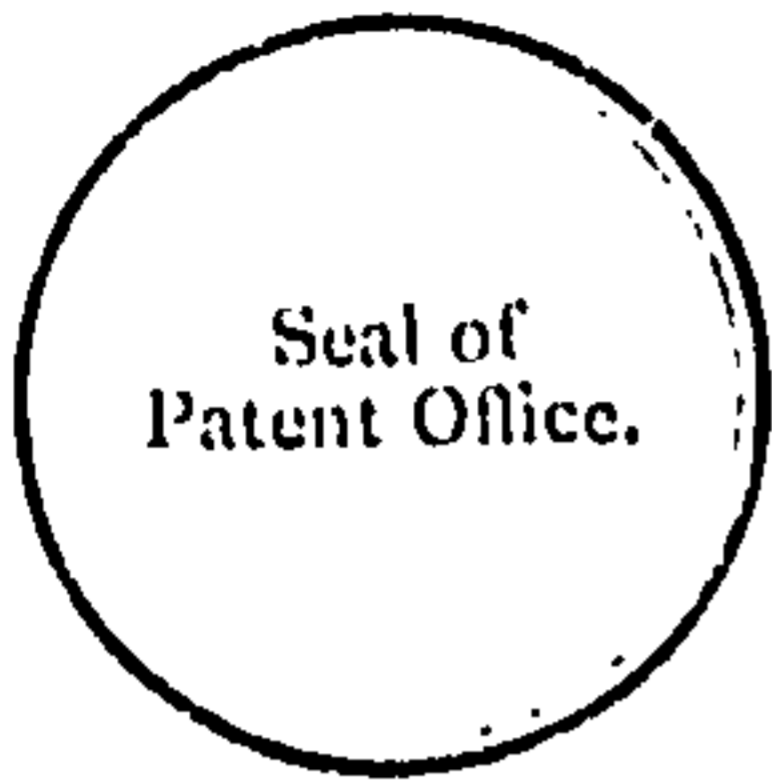
In witness whereof We have caused these our letters to be made patent and to be sealed as of the

one thousand nine hundred

and

\*  
*Comptroller-General of Patents, Designs,  
and Trade Marks.*

\* Here is to be inserted the name of the Comptroller-General.



*Discussion of Grant of Letters Patent.*

In this form of grant of letters patent to a single inventor they are expressed to be granted on the request or application of the inventor made in the prescribed form, in which he represents to the Crown that he is possessed of an invention, of which he gives the title, 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 that being the case, he humbly prays that a patent may be granted to him for the said invention.

Representations of applicant to the Crown

It will be noticed that in the grant all these representations are recited. This recital has the effect of making the applicant warrant the truth of all his representations; the grant is made simply on the strength of these representations being supposed to be true, and is bad at law if any one of them be not true, because the Crown was deceived thereby. The Crown on its part takes no responsibility for the truth or otherwise of any of the representations, and it is further expressly provided, though such provision is really unnecessary, that if the invention is not new, or if the patentee is not the first and true inventor, the letters patent shall determine and be entirely void.

are recited in the grant.

Effect of recital.

Crown takes no responsibility for truth of recitals.



Grant is voluntary on part of the Crown.

The grant is stated to be made "of our especial grace, certain knowledge and mere motion," and it is recited that "We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request". This affirms the principle that there is no right on the part of the inventor to demand the grant of the letters patent, but that the grant is a voluntary act of favour on the part of the Crown.

Crown cannot be compelled to grant a patent.

There are no means for compelling the Crown to grant letters patent for any invention; the Acts and Rules only govern the forms which must be complied with in making the grant; and the Act of 1883 specially provides that—

Sect. 116.

"nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent, or to the withholding of a grant thereof".

But is unlikely to interfere.

There is, therefore, no doubt that the Crown might refuse the grant of a patent on any application, but this power is mainly a matter of historic interest, and in the ordinary course if an application for a patent be made in proper form, and the examiner to whom it is referred should report that—

Act, 1883, sect. 6.

"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 that the title sufficiently indicates the subject-matter of the invention,"

the Act provides that—

Act, 1883, sect. 12. As a rule patent will be granted.

"if there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office".

Act, 1883, sect. 86. Except for illegal or immoral purpose, Comptroller has no discretion as to grant in ordinary cases.

The Comptroller has the power of refusing to grant a patent for any invention of which the use would, in his opinion, be contrary to law or morality; but with this exception he does not appear to have any power of refusing the grant if the examiner gives a favourable report on the formal points referred to him, unless an opposition be decided in favour of the opponent.

Now the grant of a patent can be opposed only on one of three grounds, namely :—

- “(i) That the applicant had obtained the invention within the United Kingdom from the opponent, or from a person of whom he is the legal representative ; or Act, 1883, sect. 11. Grounds on which patent can be opposed.
- “(ii) That the invention has been patented in this country on an application of prior date ; or Act, 1888, sect. 4.
- “(iii) 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.”

Unless, therefore, the patent applied for can be brought within the range of one of these objections there is nothing to prevent any person from obtaining a patent for anything *primâ facie* patentable, even though the patent when obtained will be almost certainly bad. Unless opposed, patent is granted.

As soon as a person has obtained a patent he is, as we shall see later, in a position to bring actions against any persons who may infringe his patent, and also to threaten to bring such actions against infringers ; and even though he utterly fail to establish the validity of his patent, he may still be enabled by such means to injure the business of his rivals in trade, and possibly to reap considerable profits. Patentee can bring actions and threaten.

If a patent is of doubtful validity, but not clearly bad, it may, nevertheless, be a very valuable property, since those desiring to use the invention will often prefer to accept a licence and pay moderate royalties under such a patent rather than incur the cost and risk of a patent action. Bad patent often valuable.

The value of such a patent will be greatly enhanced if it be made the subject of an action for infringement, and a certificate be obtained that its validity has been called in question, since in that case any subsequent infringer may be compelled, if unsuccessful in an action for infringement, to pay the patentee's costs as between solicitor and client. An action enhances value of patent.

Certificate of validity.

The certificate is only that the validity was called in question, and it may be given even when the action is settled upon terms arranged between the parties, so that it may be obtained without there being any actual decision on the question of validity.

Judgment against patent may be reversed on appeal, even by arrangement.

Even if at the trial the patent is held bad, the patentee need not always lose hope, for he may be successful on an appeal; or, if he can arrange matters with his opponents, he can in the Court of Appeal get the judgment against his patent reversed, and an injunction granted upon the terms which he has arranged without his being obliged to disclose those terms.<sup>1</sup>

Skilful management required to work bad patent.

It need hardly be said that in order to make a bad patent valuable it is necessary to have very skilful management; and, to avoid running risks, an intimate knowledge of the law of threats is also needful; but with these conditions a bad patent, backed up by sufficient capital, may sometimes be worked so as to give the patentee, at least for a time, a monopoly nearly as perfect as if the patent were good.

Slight invention often valuable.

It must always be remembered that the profit arising from an invention is not proportionate to the difficulty of making it; many patents of great value protect only very slight improvements on existing machines or processes. Provided an invention be useful and show some ingenuity, the amount of ingenuity is of little consequence, and, as a general rule, it may be said that the smaller the scope of a patent the less is the chance of its being upset. The cost of obtaining a patent is now so low that if the inventor be in a position to get the invention worked at all, a very small royalty will soon repay his outlay and yield him a profit which may be out of all proportion to the amount of time and thought which he has bestowed on the invention.

Cost of patent is small.

On the other hand, it very often happens that a use-

<sup>1</sup> Cheetham v. Oldham, 1891, 8 R.P.C. 168.

ful invention of great ingenuity, which the inventor is not in a position to get taken up, never repays him the fees expended in applying for a patent. There can be no doubt that it is far easier to make an invention than to make it a commercial success; and an inventor who cannot work his own patent will, as a rule, be wise if he be content to accept a small profit for himself and leave the rest to those who undertake the more difficult and risky task of introducing it to the public.



## CHAPTER II.

### SUBJECT-MATTER OF LETTERS PATENT.

VALID letters patent can be granted only in respect of an invention, that is of "a new manufacture within this realm which others, at the time of making such letters patent and grant, shall not use". The word manufacture has received a liberal interpretation; in the words of Lord Westbury "it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition to the thing produced, it will comprehend a new machine or a new combination of machinery; it will comprehend a new process or an improvement of an old process".<sup>1</sup>

Adaptive skill.

The result merely of adaptive skill and judgment in manufacture is not invention, even though the result may be an improved article,<sup>2</sup> nor are special forms produced by the exercise of known arts such as books, pictures, carvings and designs, though these are proper subjects for copyright. Thus, a new design of lace, made by a novel arrangement of well-known machinery, is not patentable, while a new form of machine for making an old design of lace might be proper subject-matter.

Discovery not always invention.

Discovery is not necessarily invention in the patent sense. A man may discover a new law of nature or a new element, but this will not entitle him to a patent to prevent others from taking advantage of the law or making use of the element. If, however, he at the same time

<sup>1</sup> Ralston v. Smith, 1865, 11 H.L.C. 223.

<sup>2</sup> Beavis v. Rylands Glass and Engineering Co., 1899, 17 R. P. C. 93.



should make some practical application of the law, or discover some process for producing the element, he could prevent others from copying his application or following his process.

A patent cannot be granted for a principle,<sup>1</sup> the very statement of what a principle is proves it not to be ground for a patent. It is a first ground and rule for arts and sciences, or, in other words, the elements and rudiments of them. A patent must be for some new production from those elements and not for the elements themselves.<sup>2</sup> Principle not patentable

Although, however, a law of nature, or a principle, cannot be patented, “a patent will be good though the subject of the patent consists in the discovery of a just, general and most comprehensive principle in evidence or law of nature if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained”.<sup>3</sup> except as applied.

“If you have a new principle or a new idea as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new.”<sup>4</sup>

In such a case what is patented is the particular application of the principle or law or idea, so that its application for a different purpose will not be an infringement.<sup>5</sup>

<sup>1</sup> *Pneumatic Tyre v. Tubeless Pneumatic Tyre*, 1899, H.L. 16 R.P.C. 77.

<sup>2</sup> *Boulton v. Bull*, 1795, Dav. P.C. 196.

<sup>3</sup> *Househill Co. v. Neilson*, 1843, 1 W.P.C. 673.

<sup>4</sup> *Otto v. Linford*, 1881, C.A. 46 L.T.N.S. 35; *Ashworth v. English Card Clothing Co.*, 1902, C.A. 19 R.P.C. 463.

<sup>5</sup> *Pneumatic Tyre v. Tubeless Pneumatic Tyre*, 1899, H.L. 16 R.P.C. 77.

*What is a "New Manufacture" ?*

To entitle it to the protection of a patent a manufacture must be new within this realm—that is, within the United Kingdom and the Isle of Man. It is no objection to the novelty of an invention that it has been previously used in a foreign country, or even within a British colony.<sup>1</sup>

Master  
inventions.

Some inventions may be described as master or pioneer inventions, that is, inventions which break fresh ground and open up new industries. In regard to these no question of novelty can arise, and their inventors have always been held entitled to special protection, though, as will be seen subsequently, even a pioneer inventor may very much weaken his position by a badly drawn specification. As instances of master inventions we may take those of the Welsbach Incandescent Mantle, which has revolutionised the whole system of gas lighting, and of the Pneumatic Tyre, which brought about a similar revolution in the cycle industry. As another instance in which the inventor derived little, if any, benefit from his ingenuity, owing to the absence of a patent may be mentioned the invention of the ordinary cycle wheel with light spokes in a state of tension, which almost instantly displaced the original cycle wheel made on the principle of a cart wheel with rigid spokes in a state of compression.

Improvement  
inventions.

The number of master or pioneer inventions is necessarily somewhat limited, and by far the greater number of inventions may be described as improvement inventions. In the case of an improvement invention the question of its novelty is closely bound up with the question of whether it is an invention at all or merely the result of adaptive skill and judgment in manufacture, which, as we have seen, is not sufficient to support a patent.<sup>2</sup>

<sup>1</sup> *Rolls v. Isaacs*, 1881, 19 Ch. D. 268.

<sup>2</sup> *Beavis v. Rylands Glass and Engineering Co.*, 1899, 17 R.P.C. 93.

There is, of course, novelty in doing anything which has never been done before, but the means of doing it, though novel, may be so obvious to any one skilled in the subject that the discovery of it cannot be said to require any such exercise of inventive genius as could rightly entitle the man who first hit upon it to a patent for preventing others from pursuing a like course.

There may be novelty without invention.

Before deciding whether anything is really an invention or not, regard must be had to what is called the state of public knowledge at the time. The question is not what the inventor himself actually knew about the subject, but what an ordinary skilled person might have been expected to know. Thus, if one thing is known to be the mechanical or chemical equivalent of another, the mere substitution of one for the other, even though it may give the same result in a cheaper way, or even a better result, is not an invention for which a patent can be granted; but the discovery that two things are equivalents, and the substitution of one for the other in a manufacture, provided such substitution be useful, may well be the subject of a patent.<sup>1</sup>

Public knowledge must be considered.

Substitution of equivalent not invention,

but discovery of equivalent may be.

“ If, with a particular purpose in view, you take the general principles of mechanics and apply one or other of them to a manufacture to which it has never before been applied, that is sufficient ground for taking out a patent.”<sup>2</sup> There must, however, be some novelty in the application; “ you cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner or to a purpose which is not quite the same, but is analogous to the manner or purpose in or to which it has been hitherto notoriously applied,”<sup>4</sup> or, to put it

New application of a general principle may be invention.

But application must not be analogous to old,

<sup>1</sup> Horton v. Mabon, 1862, 16 C.B.N.S. 141; 31 L.J.C.P. 255.

<sup>2</sup> Dangerfield v. Jones, 1865, 13 L.T.N.S. 142; cf. Ashworth v. English Card Clothing Co., 1902, C.A. 19 R.P.C. 463.

<sup>3</sup> Brook v. Aston, 1857, 8 E. & B. 485.

<sup>4</sup> Harwood v. Great Northern Railway Co., 1865, 11 H.L.C. 682; Rickmann v. Thierry, 1897, H.L. 14 R.P.C. 105.



nor new use  
of old  
machine.

New process  
for old result.

Omission of  
step in  
process.

Combination  
of old parts  
may be  
invention.

Combination  
of old and  
new parts.  
Subordinate  
integers may  
be protected.

Subordinate  
integers.

shortly, "a patent cannot be granted merely for a new use of an old machine."<sup>1</sup>

The invention may consist in a new process for obtaining a known result, as for the manufacture of a well-known substance; and it may none the less be a good invention because it consists only in the omission of a step in the old process of manufacture, since this may effect a considerable saving in the cost of the process.<sup>2</sup>

Again, an invention may consist in a new combination of old materials previously in use for the same purpose, or in a new method of applying such materials;<sup>3</sup> or in a new combination of old parts to produce a new result, or to produce a known result in a more useful and beneficial way,<sup>4</sup> though a patent has been refused for putting together a combination of old parts in which each part is applied only to its old purpose.<sup>5</sup>

A new combination may not consist entirely of old parts, but may contain some parts which are themselves entirely novel; in such a case the patent may be made to protect not only the whole combination, but also these novel parts, or subordinate integers, as they are called.<sup>6</sup>

"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 a certain number of steps so arranged as to form a new combination within the meaning which is attached by the Patent Law to the term 'combination'. Suppose that in a patent you have

<sup>1</sup> *Ralston v. Smith*, 1865, 11 H.L.C. 223; *Case v. Cressy*, 1901, C.A. 18 R.P.C. 419.

<sup>2</sup> *Russell v. Cowley*, 1834, 1 W.P.C. 459.

<sup>3</sup> *Hill v. Thomson & Forman*, 1817, 1 W.P.C. 237.

<sup>4</sup> *Harrison v. The Anderston Foundry Co.*, 1876, 1 App. Cas. 577.

<sup>5</sup> *Bridge's application*. Sir E. Carson, S.-G., 1901, 18 R.P.C. 257.

<sup>6</sup> *Clark v. Adie*, 1877, H.L. 2 App. Cas. 315.



a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C and D; he may at the same time claim that, as to one of those parts, D, it is in 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 them 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 for 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.”<sup>1</sup>

In the case of a combination consisting entirely of old parts, so that the whole invention consists in combining well-known things, the following is the proper test of novelty: Is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of the new apparatus, whereas it had never been effectively obtained by any of the separate portions of the apparatus which have now been combined into one valuable whole for the purpose of effecting the object in view?<sup>2</sup>

In order to be good subject-matter for a patent a new combination need differ only to a very small extent from an old one; it may be merely a slight addition or modification in one part of a machine, which, when once made, looks as if it ought to have been obvious, but, as was said by Jessel, Master of the Rolls, “Where a slight

When invention is only combination of old parts.

Small addition may be invention.

<sup>1</sup> Clark v. Adie, 1877, 2 App. Cas. 320; cf. Kynoch & Co., Ltd., v. Webb, 1900, H.L. 17 R.P.C. 100.

<sup>2</sup> Cannington v. Nuttall, 1871, L.R. 5 H.L. 216.

alteration in a combination turns that which was practically useless before into that which is very useful and very important, judges have considered that, though the invention was small, yet the result was so great as fairly to be a subject of a patent; and, as far as a rough test goes, I know of no better".<sup>1</sup>

Even "the introduction into an old combination of a new shape of one of the old elements of that combination, which involves a law of nature otherwise left on one side, may be good subject-matter for a patent".<sup>2</sup>

In dealing with the case of a combination patent, Chief Justice Tindal, in 1840, said: "We are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent".<sup>3</sup>

This judgment has been frequently followed,<sup>4</sup> and in a well-known case on wire bustles where the fact of invention was hotly disputed, bustles being well known articles, and the materials used by the patentee being also well known, the House of Lords held that the patent was good on the ground that the result was a complete article, light, effective, not likely to get out of order and capable of being manufactured, and therefore sold, cheaply, and that it could not be said that to produce a new thing combining those qualities required no invention.<sup>5</sup>

On the other hand, the same tribunal held invalid a patent for an eyelet with a celluloid face, although no

<sup>1</sup> Hinks & Son v. The Safety Lighting Co., 1876, 4 Ch. D. 607.

<sup>2</sup> Edison & Swan United Electric Light Co. v. Woodhouse and Rawson, 1887, C.A. 4 R.P.C. 93.

<sup>3</sup> Crane v. Price, 1842, 1 W.P.C. 409.

<sup>4</sup> Vickers v. Siddell, 1890, H.L. 7 R.P.C. 306; Lyon v. Goddard, 1893, C.A. 10 R.P.C. 338.

<sup>5</sup> Thompson v. American Braided Wire Co., 1889, H.L. 6 R.P.C. 528.

New shape of element of old combination.

New or better article.

Complete article.

one had ever before made such an eyelet, and it was an enormous improvement on any existing eyelet.<sup>1</sup>

Decided cases may sometimes be of value in helping one to deal with the questions of novelty and invention, but it must always be remembered that the question of invention is one of fact in each case depending on the circumstances, and a decision in another case is no authority.<sup>2</sup> Where there is a jury the question of invention is for them.<sup>3</sup>

### *Anticipation.*

Hitherto the question of novelty has been treated from the point of view of general public knowledge, and it has been assumed that the thing claimed by the patent was in the widest sense of the word novel, that is, that the actual thing patented had never before been made, or, if made, that it had been made only in some way different from that pointed out in the specification of the patent. The next question is also often one of difficulty. A patent may be bad because what is claimed in it has been anticipated by something done, or publicly proposed to be done, before the date of the patent. Letters patent must be for a manufacture which others at the time of making such letters patent and grant do not use, and this has been extended to mean not only that the invention must not be in use at the date of the patent, but that it must not have been in use at any time before the date of the patent,<sup>4</sup> unless such use was merely experimental and was not public. Further than this, the invention must not have been published within the realm, since the knowledge of how to use the invention is equivalent to the actual user; and people must not be pre-

<sup>1</sup> Rickmann v. Thierry, 1897, H.L. 14 R.P.C. 105.

<sup>2</sup> Lyon v. Goddard, 1893, C.A. 10 R.P.C. 344; H.L. 11 R.P.C. 353.

<sup>3</sup> Lucas v. Miller, 1900, 17 R.P.C. 165.

<sup>4</sup> King, Brown & Co. v. Anglo-American Brush Co., 1889, 6 R.P.C. 424.



vented from doing that which they are assumed to have known how to do before the grant of the patent.

Thus the invention may have been anticipated either by prior user or by prior publication; and it now remains to consider what ought to be reckoned as sufficient prior user or publication to invalidate a patent.

Perhaps the simplest kind of anticipation is by prior public user of the invention.

What is prior user.

The user must be public, that is, known to others besides the inventor, and known to them without their being bound to secrecy,<sup>1</sup> so that they might be at liberty to use it themselves. Again, it is not enough that the invention has been put in use by some person other than the inventor who applies for a patent, if such use was only by way of trial or experiment,<sup>2</sup> and was not of a commercial character or openly practised.

Prior user must be commercial.

“The meaning of ‘public use’ is this: that a man shall not, by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right that another man has to a patent for the same invention.”<sup>3</sup>

Public use means use in public, not by the public.

“Public use means a use in public so as to come to the knowledge of others than the inventor, as distinguished from the use of it by himself in his chamber.”<sup>4</sup>

Such use, however, need not be a use by the public, but may be a use by the inventor in public.<sup>5</sup> User, merely to see whether a particular machine is in working order, is not an experimental user of the machine, but is sufficient to anticipate a patent therefor.<sup>6</sup>

In a case in which the defendants to an action for

<sup>1</sup> Gadd v. Mayor of Manchester, 1892, C.A. 9 R.P.C. 514.

<sup>2</sup> Matthews v. Parmenter, 1896, 13 R.P.C. 514.

<sup>3</sup> Carpenter v. Smith, 1841, 1 W.P.C. 534.

<sup>4</sup> *Ibid.*, 542.

<sup>5</sup> *Ibid.*

<sup>6</sup> Hoe & Co. v. Foster & Sons, 1899, C.A. 16 R.P.C. 33.



infringement pleaded that they had used the invention before the date of the patent, Chief Justice Tindal gave the following instruction to the jury:—

“If it was generally known and practised, and not merely as a matter of experiment, and that kept secret by the party, and thrown away as the result of that which was of no use to the public, the patent is gone; or if the defendants have shown that they practised it and produced the same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done.”<sup>1</sup>

It is probable that a patent may be anticipated by the sale or exposure for sale of a finished article produced by the use of the patented invention, even though a mere examination of such product would not disclose the details of the invention, or enable others to use the invention. It has, indeed, been laid down that the public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void,<sup>2</sup> but the cases on this question are not quite consistent.

Sale of finished article may anticipate process.

Prior public user, in order to avoid a patent, need not extend to the date of the patent. “If it is proved distinctly that a machine of the same kind was in existence and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary that it should come down to the time when the patent was granted.”<sup>3</sup>

User need not extend to date of patent.

In a case of prior user it is necessary that the user should have been a user of the actual invention which is the subject of the patent: it is not enough that a machine

The actual invention must have been used.

<sup>1</sup> *Cornish & Sieven v. Keene*, 1835, 1 W.P.C. 510.

<sup>2</sup> *Wood v. Zimmer*, 1815, 1 W.P.C. 82 *n*; *Holt N.P.* 60; *cf.* *Hancock v. Somervell*, 1851, 39 *Newton's Lond. Journ.*, 158; *Morgan v. Seaward*, 1837, 1 W.P.C. 195; *Hills v. London Gas Light Co.*, 1860, 5 H. & N. 336.

<sup>3</sup> *King, Brown & Co. v. Anglo-American Brush Co.*, 1889, 6 R.P.C. 424.

somewhat resembling the patented machine, but inferior to it, should have been used, even though it produced a similar result; for it has been clearly laid down that "a machine which would do the work of the patent machine more or less badly is not an anticipation of the patent".<sup>1</sup>

The user must have been for a similar purpose to that covered by the patent, and a claim for a particular substance arranged in a particular way for a particular purpose is not anticipated, even by a similar arrangement of the same substance for an entirely different purpose.<sup>2</sup>

Even if the prior machine contained some of the parts which the inventor believed to be new, his patent may still be good for an improvement; for "it does not follow that because an inventor thinks he has invented more than he has in fact, and describes the advantages of his invention, and some of these advantages arise from an old portion of the invention, it may not still be a good patent, provided that the invention as claimed is so limited as to fail to cover the actual thing in use, while it covers some of the advantages mentioned; in such a case it may still, no doubt, be a good patent".<sup>3</sup>

What is prior publication.

Lastly, an invention may be anticipated by prior publication. This means publication without any reservation, for the communication of an invention to a person who is aware that it is not intended to be published does not amount to a publication.<sup>4</sup>

Judges do not view anticipations by mere publication, or, as they are termed, "paper anticipations," with much favour, and scrutinise them very narrowly to see whether they are really anticipations. Probably not one in a hundred of the prior publications put forward as such in the pleadings in patent actions are, in fact, anticipations.

<sup>1</sup> Barlow v. Baylis, 1870, Griff. 45.

<sup>2</sup> Edison v. Woodhouse, 1887, 4 R.P.C. 93.

<sup>3</sup> Frearson v. Loe, 1878, 9 Ch. D. 58.

<sup>4</sup> Gadd v. Mayor of Manchester, 1892, C.A. 9 R.P.C. 516; 67 L.T. 569.

The antecedent statement must be such that a person of ordinary knowledge on the subject would be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent.<sup>1</sup>

The law on the question of prior public user and prior public knowledge was, in 1861, summed up by Lord Westbury in these words:—

Anticipation  
must be  
complete.

“The invention must be shown to have been before made known. Whatever is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore much further discovery, are required before the full truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined and pure metal which is extracted from it. . . . Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent, viz., such a knowledge as will enable the public to perceive the very discovery and to carry the invention into practical use.”<sup>2</sup>

Thus the description in an anticipation must be of

<sup>1</sup> Moseley v. Victoria Rubber Co., 1887, 4 R.P.C. 252; see 4 De G. F. & J. 299.

<sup>2</sup> Hills v. Evans, 1861, 31 L.J. Ch. 463; 4 De G. F. & J. 299.



such a character as to enable any competent person to make the machine for which protection is claimed.<sup>1</sup>

Publication may be by book or periodical, whether published in England or abroad.

In the case of a prior publication in a book or periodical published in England it is not necessary to prove anything beyond the date of publication, but an invention may be published in any well-known foreign language, such as French or German, and in the case of a foreign publication it is necessary to show that at least one copy was published in England.

It is not necessary to prove that any one in this country read the account of the invention; it is enough to show that they were in the position of being able to do so.

Book in public library.

Thus the deposition of a German specification in the library at the Patent Office,<sup>2</sup> or presumably the deposition of the anticipation at any public library, where it would be notified in the catalogue and open to inspection without any record being kept of such inspection, or the sale in this country of a foreign periodical containing a description of the patented article,<sup>3</sup> before the date of the patent, is a prior publication of the invention.

But, on the other hand, the mere fact that a foreign book containing a description of the invention is in an inner room of the British Museum is not of itself evidence of publication; it would be necessary to show that some one had looked into it.<sup>4</sup>

The prior publication must be complete in itself; it is not enough for an anticipation to be contained in several independent documents. This may be evidence of public knowledge, and may then be used to show that

<sup>1</sup> Ehrlich v. Ihlee, C.A. 5 R.P.C. 457; Otto v. Linford, C.A. 46 L.T. 39; Betts v. Menzies, 10 H.L.C.; Gadd v. Mayor of Manchester, C.A. 9 R.P.C. 532; Pneumatic Tyre Co. v. Leicester Pneumatic Tyre Co., 1899, C.A. 16 R.P.C. 50, 57; Shrewsbury & Talbot Cab Co. v. Sterck, 1896, C.A. 13 R.P.C. 53.

<sup>2</sup> Harris v. Rothwell, 1887, C.A. 4 R.P.C. 225.

<sup>3</sup> Pickard & Co. v. Prescott, 1892, H.L. 9 R.P.C. 195.

<sup>4</sup> Otto v. Steel, 1886, C.A. 3 R.P.C. 109.



there is no sufficient subject-matter for invention; but the fact that by comparing a number of documents it is possible to get sufficient information to enable one to do that which is described in the specification, is not an anticipation of the patent.<sup>1</sup>

Publication must be complete in itself, and it must not be collected from different places.

An invention forming the subject-matter of an application, made after a date to be fixed by the Board of Trade for the coming into force of section 1 of the Patent Law Amendment Act, 1902, comes under the following provision :—

“ An invention covered by any patent granted on an application to which section 1 of this Act applies, shall not be deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification.”

Patent Law Amendment Act, 1902, sect. 2.

This exception does not affect anticipation by the deposit of any other publication or by past user consequent on, or in carrying out, a specification more than fifty years old, and it, of course, relates only to British specifications, so that a search through those of other countries before the commencement of the fifty year period will still be necessary in some cases.

### *Publication at an Exhibition before Application for Patent.*

Before leaving the consideration of what prior user or publication will defeat a patent, one case must be mentioned in which the exhibition of the invention before application for a patent is made will not affect the subsequent application, provided all the necessary formalities are complied with.

It is provided that—

“ The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition,

<sup>1</sup> Von Heyden v. Neustadt, 1880, 50 L.J. Ch. 128.

Act, 1883,  
sect. 39, pro-  
tection of  
patents  
exhibited at  
industrial  
exhibitions.

or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:

“(a) The exhibitor must, before exhibiting the invention, give the Comptroller the prescribed notice of his intention to do so; and

“(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Act, 1886,  
sect. 3.

“Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of  
patents  
exhibited at  
international  
exhibitions.

“It shall be lawful for His Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibitions mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in such sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely, or upon such terms and conditions as to His Majesty in Council may seem fit.”

Rule 27.  
Notice to  
Comptroller  
of intended  
exhibition.

“Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition or of using the invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Form O of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.”

See App. A.

This notice to the Comptroller must bear a stamp for

*Utility.*

It is necessary that the subject of a patent should be useful, since, if it be not, no public good will result and there will be no consideration for the grant. A very small degree of utility is, however, sufficient, as is shown by the following direction given to a jury by Baron Alderson in 1835:—

Invention must be useful.

How much utility must there be.

“ A question in this case will be whether you think the steam engine was a useful invention; if it was of any use. I think if it was of different construction from any other steam engine, and of any use to the public, then that is sufficient.”<sup>1</sup>

“ The intention to produce a profitable matter is of the essence of a patent.”<sup>2</sup> Utility, in a commercial sense, that is, having a commercial existence as a process of manufacture, being the utility required to support a patent;<sup>3</sup> but the question whether the patent proved profitable or not has no relation to the question of utility in patent law generally, being confined to cases of improvement by reason of cheaper production, where the thing claimed has not really been invented unless that condition is fulfilled.<sup>4</sup>

Commercial expectation essential.

Commercial success has no relation to utility.

The question of utility is one purely of fact in each case, and must, like other questions of fact, be treated without reference to other cases.

Utility is question of fact.

<sup>1</sup> Morgan v. Seaward, 1836, 1 W.P.C. 186.

<sup>2</sup> Higgs v. Godwin, 1858, E.B. & E. 529; 27 L.J.Q.B. 421.

<sup>3</sup> Wilson Bros. v. Wilson, 1903, H.L. 20 R.P.C. 1.

<sup>4</sup> The Badische Anilin v. Levinstein, 1887, 4 R.P.C. 462.



## CHAPTER III.

### WHO MAY APPLY FOR A PATENT.

UNDER the Statute of Monopolies a patent could be granted to the true and first inventor or inventors of a manufacture; and this has been but slightly modified by later statutes. It is still true that a valid patent can be granted only to the true and first inventor or inventors (if living), either alone or in conjunction with others who are not inventors, but the words have been frequently subject to judicial consideration, and their scope has been materially widened from what they at first sight might seem to include.

Later statutes have also affected the class to whom patents may be granted by making provision for cases in which, by the untimely death of an inventor, his estate would have formerly been deprived of the benefit of his invention.

It is now provided that—

Who may  
apply for a  
patent.  
Act, 1883,  
sect. 4.

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

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

The Act of 1885 declares that—

Sect. 5.

“Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful, under the principal Act, to grant such a patent.”

Thus a patent may be applied for by any person or group of persons, whether British subjects or aliens.



Since person includes corporation, there is nothing to prevent a patent being applied for by a joint-stock company, either alone or in conjunction with other corporations or persons; but, as it is obvious that a corporation cannot invent anything, it cannot apply for a patent on Form A1 as the first and true inventor, even though it be a foreign corporation.<sup>1</sup> The inventor, however, may be only an importer; and a corporation can, as the importer of an invention, apply for a patent on the Form A2 provided for that purpose.<sup>2</sup>

In the absence of any agreement between joint applicants for a patent there is some doubt as to their actual rights in respect of the patent when granted. It will be seen that the Act says the patent will be granted to them jointly, and in form the grant is a joint grant. This would naturally give rise to a right of survivorship, as in the case of any other joint holding, and it has been held in a Court of first instance that this result follows from the form of the grant.<sup>3</sup> The Court of Appeal in that case came to the conclusion that there was a partnership in the patent, and that a covenant by the joint patentees as to the validity of the patent was joint and several, and not only a joint covenant;<sup>4</sup> but did not decide whether a partnership is to be presumed in the case of every joint grant, and it seems that this must be determined according to the circumstances of each case.

Until 9th August, 1899, a company could not hold property as a joint tenant, so that any grant made prior to that date to a company and an individual must necessarily have been a grant to them as tenants in common;

<sup>1</sup> *Société Anonyme du Générateur du Temple*, 1896, Webster, A.-G., 13 R.P.C. 54.

<sup>2</sup> *Ibid.*

<sup>3</sup> *National Company for the Distribution of Electricity v. Gibbs*, 1899, 16 R.P.C. 339.

<sup>4</sup> *National Company for the Distribution of Electricity v. Gibbs*, 1900, C.A. 17 R.P.C. 303.

but the Bodies Corporate (Joint Tenancy) Act, 1899,<sup>1</sup> puts a company in the same position as an individual in respect of the joint holding of property. In the case of a joint tenancy between a corporation and another person, it would seem to follow that, on the dissolution of the former, the whole would pass by survivorship to the other joint tenant.

Advantage  
of joint  
application.

The advantage of a joint application is that while each of the applicants has the right of using the invention for which the letters patent are granted, yet, by a simple agreement, requiring only a sixpenny stamp, between the inventor and a co-applicant who is financing his invention, the latter can obtain entire control of the patent without the expense of any deed of assignment or licence.<sup>2</sup>

Joint  
application.

An inventor who has sold his invention and, with the purchaser, made a joint application for a patent, will be restrained from abandoning or withdrawing the application or doing any act or taking any steps to prevent the sealing or issue of the patent.<sup>3</sup>

Inventor  
dying before  
grant of  
patent.

A case having arisen which showed that there might be hardship when an inventor died without having applied for letters patent,<sup>4</sup> it was provided that—

Act, 1883,  
sect. 34.

“(1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

“(2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.”

“In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of his will, or the letters of ad-

<sup>1</sup> 62 & 63 Vict., c. 20.

<sup>2</sup> For forms of agreement, see App. B.

<sup>3</sup> Wool, Hide and Skin Synd. v. Riches, 1902, 19 R.P.C. 127.

<sup>4</sup> Marsden v. Saville Street Foundry and Engineering Co., 1878, L.R. 3 Ex. D. 203.

ministration granted of his estate and effects, or an official copy of such probate or letters, shall be produced at the Patent Office in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require." Application by representative of deceased inventor. Rule 6.

The general power of applying for letters patent is still limited by the rule that the grant must, unless he be no longer alive, be to the true and first inventor, so that it appears finally that the application must be made by the true and first inventor, or the personal representatives of a deceased true and first inventor, either alone or in conjunction with other persons or corporations.

The words true and first inventor soon came under judicial consideration, and were held to include an importer into this realm of a new manufacture, that is, of a manufacture new so far as this realm is concerned. Thus, in 1691, it was declared that— Inventor includes importer.

"A grant of a monopoly may be to the first inventor by 21 Jac. 1.; and, if the invention be new in England, a patent may be granted, though the thing was practised beyond the sea before: for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and, whether learned by travel or by study, it is the same thing."<sup>1</sup>

It is not necessary that the importer should be in England, the importation may be by the application for letters patent; for it has been held that a patent can be granted to an alien resident abroad, including a foreign company,<sup>2</sup> for an invention communicated to him abroad by another alien.<sup>3</sup> Importer may be abroad.

<sup>1</sup> *Edgeberry v. Stephens*, 1691, 2 Salk. 447; 1 W.P.C. 35; see also *Elmslie v. Boursier*, 1869, L.R. 9 Eq. 217; *Nickels v. Ross*, 1850, 8 C.B. 679; *In re Claridge's patent*, 1851, 7 Moo. P.C.C. 394; *Plimpton v. Malcolmson*, 1876, 3 Ch. D. 531.

<sup>2</sup> *Société Anonyme du Générateur du Temple*, 1896, A.-G. 13 R.P.C. 54.

<sup>3</sup> *Re Wirth's patent*, 1879, 12 Ch. D. 303.



Importer may  
be receiver  
only.

Importer  
an agent.

Agent may  
improve on  
invention.

Importer not  
an agent.

May apply  
for patent on  
his own  
account.

Communica-  
tion must be  
from abroad.

Applicant  
must be real  
inventor.

Again, "the first and true inventor" may merely be a receiver of the invention from abroad, and in this case we must distinguish two classes. First, there is the ordinary case in which a foreign inventor communicates his invention to an agent in this country, who applies for a patent for it as on a communication from abroad, and who, when the patent is granted, holds it in trust for his foreign correspondent; this trust existing even where the agent has improved upon the invention as communicated to him.<sup>1</sup>

The second case is where an invention is communicated to a person in this country without any intention of his applying for a patent on behalf of his correspondent. In this case he is entitled to apply for a patent in his own name and on his own account, for it has been held that "Any person not being in a confidential position towards the first inventor, receiving from a person abroad an invention, is entitled, perhaps not in a strictly moral view, but at all events according to law, to take out a patent on his own account for the invention so communicated".<sup>2</sup>

It is, however, absolutely necessary that the communication (except in the case of an application by the personal representatives of a deceased inventor) should be received from some person not in the United Kingdom, since "the communication made in England by one British subject to another does not make the latter a first and true inventor to whom a valid patent can be granted".<sup>3</sup>

Except in the case of an importer, the first and true inventor must be the actual inventor, that is, he must himself have exercised inventive genius in discovering the invention.

<sup>1</sup> Moser v. Marsden, 1893, C.A. 10 R.P.C. 350; but see Milligan v. Marsh, 1856, 2 Jur. N.S. 1083; Beard v. Egerton, 1846, 3 C.B. 97.

<sup>2</sup> Steedman v. Marsh, 1856, 2 Jur. N.S. 391.

<sup>3</sup> Marsden v. Saville Street Foundry and Engineering Co., 1878, L.R. 3 Ex. D. 203.



“A man may publish to the world that which is perfectly new in all its uses, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learned it from a specification, and then the Legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity and ingenuity of another, should be the man who was to receive the benefit of another’s skill.”<sup>1</sup>

It would not, however, be sufficient to destroy a patent to show that learned persons in their studies had foreseen or had found out the discovery that is afterwards made public, or that a man in his private warehouse had, by various experiments, endeavoured to discover it and failed, and had given it up.<sup>2</sup>

Inventive genius may be exercised in developing the suggestions of others, as appears from the following extract from a judgment in the Court of Appeal in the wire bustle case :—

“If a mere suggestion is made upon which the mind of the inventor has to work, and out of which the mind of the inventor produces something that is different from, an improvement upon, and a distinct variation from the suggestion, I apprehend the fact that it has been suggested by the reading of a specification, or by looking at the drawings of a specification, will not prevent his having a right to patent his invention.”<sup>3</sup>

The invention itself may consist entirely in the application of knowledge gained from the works of others, since, “even if it could be shown that a patentee had made his discovery of a consecutive process by studying,

<sup>1</sup> Gibson & Campbell v. Brand, 1841, 1 W.P.C. 628.

<sup>2</sup> Marsden v. Saville Street Foundry and Engineering Co., 1878, L.R. 3 Ex. D. 203.

<sup>3</sup> American Braided Wire Co. v. Thompson & Co., 1888, C.A. 5 R.P.C. 120.

collating and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would”<sup>1</sup>—a rule that often seems to be lost sight of in patent litigation.

In the process of invention the inventor may receive assistance and even important suggestions from others, and yet he may be entitled to describe himself as the true and first inventor; he may employ servants to carry out experiments for him, and even to work on their own account on comparatively slight suggestions from him, and yet he may be entitled to a patent for the result of their labours. In an old case the law on this subject was stated with great clearness as follows:—

“I take the law to be that if a person has discovered an improved principle, and employs engineers, agents or other persons to assist him in carrying out that principle, and they, in the course of the experiments arising from that employment, make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent.”<sup>2</sup>

The employer, however, must have some claim to be described as the inventor; he must have exercised some inventive genius, even though it may not have been much: if the servant alone by his own ingenuity makes the invention, the fact that in working it out he was using his master’s property and time is not enough to deprive him of the right to a patent, or to entitle the master to obtain a patent for the invention of his servant.<sup>3</sup>

A servant in confidential relation to his employer

<sup>1</sup> Von Heyden v. Neustadt, 1880, 50 L.J. Ch. 128, per James, C.J.

<sup>2</sup> Allen v. Rayson, 1845, 1 C.B. 566.

<sup>3</sup> Heald’s application, 1891, 8 R.P.C. 429.

Inventor  
may have  
assistants.

Applicant  
must exercise  
some inven-  
tion.

may, however, be trustee of an invention for that employer, and, if he should patent it, the employer may be entitled to a declaration that the patent is held in trust for him.<sup>1</sup>

In one case the directors of a company employed a workman to invent a tap for a stated purpose, and paid him for the time spent by him in working up the invention. They then took out a patent for the tap invented by the workman, and it was revoked on the ground that they were not the true and first inventors, and the Court declared that the workman was the true and first inventor and that the patent had been taken out in fraud of his rights.<sup>2</sup>

There is, lastly, the very important question of rival inventors. If two persons, wholly unconnected with one another, at different times make the same invention, which of them is entitled to call himself the true and first inventor?

The law on this subject is quite clear: the person entitled to a patent for an invention is the person who first goes to the Crown and applies for a patent. This law was declared in the following terms:—

“There may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first who comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and to enjoy its benefits.”<sup>3</sup>

Since patents are dated as of the date and in the order of application, this now may be taken as equivalent to stating that the man whose application for a patent first reaches the Patent Office is the true and first inventor, and is entitled to the patent.

<sup>1</sup> Worthington Pump Co. v. Moore, 1903, 20 R.P.C. 41.

<sup>2</sup> Marshall & Naylor's patent, *In re*, 1900, 17 R.P.C. 553.

<sup>3</sup> Cornish v. Keene, 1835, 1 W.P.C. 508, per Tindal, C.J.

Re-discovery  
may be  
invention.

Provided an earlier inventor has not published his invention, the fact that the applicant for a patent has only re-discovered what had been first discovered by another, does not in any way affect his right to a patent. This question arose in a very early case which was afterwards referred to in the House of Lords in the following terms :—

“ Dollond was patentee of a new method of making object-glasses, but it was objected that one Dr. Hall had made the same discovery before him. Dr. Hall, however, had confined it to his closet, and the public were not acquainted with it. Dollond was held to be the true and first inventor.”<sup>1</sup>

<sup>1</sup> Dollond's case, 1758, 2 H. Bl. 470.



## CHAPTER IV.

### HOW TO OBTAIN A PATENT.

THE next matter for consideration is, what must a duly qualified party in possession of a patentable invention do in order to obtain a patent?

The grant of a patent in this country is very much a <sup>Grant a</sup> formal matter; every application is referred to an exam-<sup>formal matter.</sup>iner, whose duty it is to report to the Comptroller whether the application is in proper form and the invention fairly described by the applicant. And in the case of applications made after a date to be fixed by the Board of Trade,<sup>1</sup> whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application and deposited in the Patent Office, pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application. The discovery of such a claim or description does not, however, entitle the Comptroller to refuse the application, but only enables him to order an amendment to be made, or a reference to the earlier specification to be inserted. And it may be taken to be the rule that a patent will be granted upon an application which passes the prescribed stages and is unopposed, whether the invention be novel or not.

The Comptroller has power to refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality; and this power

<sup>1</sup> Patent Law Amendment Act, 1902, section 1 (11).

Act, 1883,  
sect. 86.  
Immoral  
patent may  
be refused.

has been exercised in the case of an application for a patent for a lottery machine.<sup>1</sup> A patent may also be refused on the ground that what is sought to be patented is not an invention within the meaning of section 46 of the Act of 1883.<sup>2</sup>

Grant may  
be opposed.

In some cases the grant may be opposed by persons whose rights would be affected by the grant of the patent as applied for; and, if their opposition be upheld, the grant may be refused, or certain conditions may be imposed on the applicant.

Comptroller  
must hear  
applicant.

In any case, before exercising any discretionary power adversely to the applicant, the Comptroller must, if required so to do, hear the applicant, and his decision is subject to appeal to the law officer.

Usual course.

With these exceptions the rule is that an application made in due form is accepted, and when a complete specification has been filed a patent is sealed in due course. Except as above stated, no examination as to whether the invention is novel, or as to whether it is proper subject-matter for a patent, is made by the Patent Office, the whole responsibility of this being thrown on the applicant.

No examina-  
tion as to  
validity.

Who makes  
the applica-  
tion.

An application for a patent may be made by the applicant or applicants to the Patent Office direct, or through an agent; in the latter case the agent is entitled to sign all the necessary papers, with the exception of the application form, which must in every case be signed by the applicant or applicants.

Patent agents.

Any person, except as provided by rule 81 (see p. 124), may act as agent for obtaining a patent, but only registered Patent Agents are allowed to describe themselves as Patent Agents. A list of Patent Agents is published by Messrs. Eyre & Spottiswoode, price (including postage) 1s. 1d.

<sup>1</sup> Griff. 20.

<sup>2</sup> Johnson's application, 1901, 19 R.P.C. 56; Cooper's application, 1901, 19 R.P.C. 53.

Three forms are provided, on one of which an application for a patent must be made. Forms of application.

Patent Form A is for an application by the true and first inventor or inventors, or their personal representatives, either alone or in conjunction with others. See App. A.

A corporation cannot apply on Form A as sole applicant.<sup>1</sup>

Patent Form A<sub>1</sub> is for an application made in respect of an invention communicated from abroad by an agent on behalf of his foreign correspondent. See App. A.

Patent Form A<sub>2</sub> is to be used in making an application under the foreign and colonial arrangements, and must be accompanied by two copies of a complete specification. See App. A.

[For method of obtaining these forms, see App. A.]

Whichever form is used, the application must bear an impressed stamp for £1, must be filled in with the names and addresses of the applicants and the title of the invention, and must be signed by the applicant, or, if there be more than one, by each of the applicants. An application on behalf of a firm must be signed by every member of the firm; that on behalf of a corporation or company should be under its corporate seal. How to fill up application form.

“Every application for a patent shall be accompanied by a statement of an address (hereinafter referred to as “the address for service”) to which all notices, requisitions and communications of every kind may be sent by the Comptroller, or by the Board of Trade, and such statement shall thereafter be binding upon the applicant until a substituted address for service shall be furnished by him to the Comptroller. The Comptroller may, in any particular case, require that the address for service be in the United Kingdom.” Address for service. Rule 7.

On the backs of Forms A and A<sub>1</sub> will be found two forms of statement as to the address to which notices are

<sup>1</sup> Société Anonyme du Générateur du Temple, 1896, A.-G. 13 R.P.C. 54.

<sup>2</sup> Patent Office Circular.



Address to which notices may be sent.

to be forwarded: the first is for use when application is made through an agent, and contains an authority to the agent to act in the matter; the second is for use when the application is made direct. In every case one of these forms must be filled in and signed by the applicant or each of the applicants as the case may be.<sup>1</sup>

Change of address.

Any change of the address to which notices are to be sent must be notified to the Comptroller on Patent Form R, which must bear a stamp for 5s.

See App. A.

How the form of application is to be dealt with.

The form of application, when duly filled up, may be left by hand at the Patent Office or sent by a prepaid letter through the post,<sup>2</sup> addressed to the Comptroller, Patent Office, Southampton Buildings, Chancery Lane, London, W.C.

For full details, see chap. v.

It must be accompanied by two copies of either a provisional specification or a complete specification, and in the latter case one copy must bear an impressed stamp for £3.

Act, 1883, sect. 5 (3).

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

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

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

Drawings with provisional specification. Act, 1886, sect. 2. Rule 24.

It is not usual for drawings to accompany a provisional specification, but, if any are sent, others like them need not be sent a second time with the complete specification, and in it they may be referred to as the drawings left with the provisional specification.

### *Preparing Specifications for Filing.*

Rule 17.

See App. A.

"A provisional specification must be commenced on Patent Form B, and a complete specification must be

<sup>1</sup> Rule 81, and *vide* Forms.

<sup>2</sup> Rule 80, and *vide* p. 252.



commenced on Patent Form C; the rest of the specification- See App. A.  
 tion in each case must be on strong paper, of size 13 inches by 8 inches, with a margin of 2 inches on the left-hand side. All specifications must be in the English language, and must be written or printed in large and legible characters on one side only, and the signatures must be in a large and legible hand."

Patent Forms B and C are issued in duplicate with Application Forms A, A1 and A2.

Form B does not require any stamp, but one copy of Form C must bear an impressed stamp for £3.

Each copy of the specification must be signed by the agent through whom the application is made,<sup>1</sup> or, if made without an agent, by the applicant or applicants. Each copy must be signed.

*Sizes and Methods of preparing Drawings accompanying Provisional or Complete Specifications. (Rules, 1890, 18 to 24.)*

"Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 24. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself. General. Rule 18.

"Drawings must be made on pure white, hot-pressed, rolled or calendered drawing paper of smooth surface, good quality and medium thickness. Mounted drawings, and drawings on toned paper or Bristol or other board, must not be used. Requirements as to paper. Rule 19.

"Drawings must be on sheets which measure 13 inches from top to bottom, and are either 8 inches or 16 inches wide, the narrower sheets being preferable. Each sheet should be provided with a border line half an inch from Size of drawings and arrangement of figures.

<sup>1</sup> Rule 81.

the edge of the paper, and the figures should be placed in an upright position.

“ If there are more figures than can be shown in one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary, and the figures should be numbered consecutively throughout.

Drawings to  
be suitable for  
reproduction.  
Rule 20.

“ Drawings must be of such a character as to be suitable for reproduction on a reduced scale. To meet this requirement—

“ (a) They must be executed with absolutely black Indian ink.

“ (b) Each line must be firmly and evenly drawn, sharply defined and of the same strength throughout.

“ (c) Section lines, lines for effect and shading lines should be as few as possible, and must not be closely drawn.

“ (d) Shade lines must not contrast too much in thickness with the general lines of the drawing.

“ (e) Sections and shading should not be represented by solid black or washes.

“ (f) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, etc., should appear as effects this purpose. If the scale is given, it should be drawn and not denoted by words.

“ Reference letters and figures, and index numerals, used in conjunction therewith, must be bold, distinct, not less than one-eighth of an inch in height: the same letters should be used in different views of the same parts. Where the reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines.

" Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings. Drawings to bear name of applicant, etc., but no descriptive matter. Rule 21.

" A facsimile or "true copy" of the original drawings must be filed at the same time as the original drawings, prepared strictly in accordance with the above rules (except with regard to the reference letters and figures, which should be in blacklead pencil). Copies of drawings. Rule 22.

" The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet. Marking of originals and true copies.

" Drawings must be delivered at the Patent Office free from folds, breaks or creases. Delivery of drawings. Rule 23.

" If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them in the complete specification as those left with the provisional specification." Provisional drawings used for complete specifications. Rule 24.

#### *Procedure after Application is sent.*

" Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post." Order of recording applications. Rule 8.

" Applications left at the Patent Office, otherwise than through the post, shall be in like manner numbered in the order of their receipt at the Patent Office."

It is provided that an application by prepaid letter sent through the post shall be deemed to have been left



Act, 1883,  
sect. 97.  
Postal appli-  
cations, when  
deemed re-  
ceived.

at the Patent Office at the time when the letter containing the same would be delivered in the ordinary course of post. Thus, if for any reason the delivery be delayed beyond the time when it would have taken place in the ordinary course of post, the applicant can claim to have his application dated and treated as having been received at the time at which, but for the delay in transmission, it would have reached the Patent Office.

Application  
lost in post.

Even if an application should never reach the Patent Office at all, the loss may be made good by leaving fresh copies of the application and specifications, and it is submitted that the applicant ought not to be allowed to suffer in any way except inconvenience by the default of the post office.

No discrimination is made between inland and foreign post.

It is provided that—

Application to  
be referred to  
an examiner.  
Act, 1883,  
sect. 6.

“The Comptroller shall refer every application to an examiner, who shall ascertain and report to the Comptroller whether the nature of the invention has been fairly described, and the application, specification and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

When report  
of examiner  
is unsatis-  
factory.  
Sect. 7.

“(1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or may require that the application or specification or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.”

Act, 1902,  
sect. 1.  
Examination  
of previous  
specifications  
in United  
Kingdom on  
applications  
for patents.  
46 & 47  
Vict., c. 57.

“(1) Where an application for a patent has been made and a complete specification has been deposited by the applicant, the examiner shall forthwith, in addition to the inquiries which he is directed to make by the Patents, Designs and Trade Marks Act, 1883 (in this Act referred to as the principal Act), make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

“(2) If on investigation it appears that the invention has been wholly



or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

"(3) The examiner shall report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct.

"(4) The provisions of sub-section 5 of section 9 of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section.<sup>1</sup>

"(5) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

"(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public. reference.

"(7) An appeal shall lie from the decision of the Comptroller under this section to the law officer.

"(8) Section 8 of the principal Act and section 3 of the Patents, Designs and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a complete specification), shall have effect as if references therein to the period of nine months were references to the period of six months. 48 & 49 Vict., c. 63.

"(9) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon. No guarantee of validity.

"(10) The Board of Trade, with the sanction of the Treasury, may prescribe an additional fee not exceeding one pound in respect of the investigation mentioned in this section, which shall be payable on the sealing of the patent. Fee on sealing.

"(11) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

"An invention covered by any patent granted on an application to which section 1 of this Act applies, shall not be deemed to have been anticipated by reason only of its publication in a specification deposited in the Patent Office pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification." Act, 1902, sect. 2. Limitation as to anticipation.

<sup>1</sup> See p. 54.

No fee for amendment before acceptance.

When the Comptroller exercises his power to require an amendment before acceptance, no fee can be charged for making the amendment.<sup>1</sup> The provisional specification and application may be amended in this way; and it is doubtful whether the title can be amended in any other way.

Sect. 13. Patent to be for one invention only.

The Act of 1883 provides that a patent shall be granted for one invention only, though it may contain more than one claim; but that if a patent has been granted which comprises more than one invention, that fact shall not affect its validity.

Where application comprises more than one invention.

The fact that an application comprises more than one invention is a ground on which the Comptroller may refuse to accept the application; and this case is provided for by the following rule:—

Application for separate patents by way of amendment. Rule 9.

“Where a person making application for a patent includes in his specification by mistake, inadvertence or otherwise, more than one invention, he may, with the consent of the Comptroller, at any time before the date allowed for the acceptance of his complete specification, amend the same so as to apply to one invention only, and may make application for a separate patent for each such invention accordingly.”

“Every such application shall, if the applicant notify his desire to that effect to the Comptroller, bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these rules, as if every such application had been originally made on that date.”

Exercise of Discretionary Power by Comptroller. Rule 28.

“Before exercising any discretionary power given to the Comptroller by the said Acts or these rules adversely to the applicant for a patent or for amendment, the Comptroller shall give ten days’ notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.”

<sup>1</sup> *R. v. Dart, Gr. P.C. 307.*

“ Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.”

Notice of hearing.  
Rule 29.

This notification to the Comptroller need not be in any particular form, and no fee is payable for the hearing.

“ Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.”

Rule 30.  
Explanations by applicant.

“ The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby.”

Rule 31.  
Decision to be notified.

“ Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.”

Act, 1888, sect. 2 (2).  
Appeal to law officer.

“ The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.”

Act, 1888, sect. 2 (3).

The Comptroller neither gives nor receives costs of an appeal to the law officer.<sup>1</sup>

Costs of appeal.

“ The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.”

Notice of acceptance, sect. 2 (4).

“ On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every complete specification in the official journal of the Patent Office.”

Advertisement.  
Rule 11.

It may happen that more than one application is made in respect of the same invention, and for some reason a patent on a later application may be sealed before the

More than one application for the same invention.

<sup>1</sup> *Re Lake*, 1887, Gr. A.P.C. 16.



first application is complete, so that when a patent would naturally be sealed on the first application the invention is already patented on a later one. To meet such a case it is provided that—

Act, 1883,  
sect. 13.

“in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application”.

But in order to allow the later applicant to avoid the expense of litigation with the earlier applicant, it is also provided that—

Later appli-  
cant may  
withdraw.  
Act, 1883,  
sect. 7 (5),  
as amended.  
Act, 1888,  
sect. 2 (5).

“If after an application has been made, but before a patent has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.”

This last provision enables the second applicant to avoid the expense either of opposition, when his patent has not been sealed, or of a Petition of Revocation when his patent has been sealed.

### *Provisional Protection.*

Act, 1883,  
sect. 14.

“Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.”

Effect of  
provisional  
protection.

Protection by  
acceptance of  
provisional  
specification.

The effect of such provisional protection varies somewhat according as a provisional or complete specification has accompanied the application. It is only where a provisional specification is filed that the protection is what is generally spoken of as provisional protection; this enables the applicant (or his legal representatives), at any time within nine months<sup>1</sup> (or on payment of a fine of £2 within ten months),<sup>2</sup> or in the case of applica-

<sup>1</sup> Act, 1883, sect. 8.

<sup>2</sup> Act, 1885, sect. 3.



tions made after the date to be fixed by the Board of Trade, under section 1 of the Patent Law Amendment Act, 1902, within six or seven months respectively<sup>1</sup> of the date on which his application was received at the Patent Office, to leave a complete specification and obtain a patent for his invention, and the patent so granted will bear the date of his first application.

In this complete specification he can embody any improvement of his original invention which can be brought within the terms of the provisional specification, and during the interval he can use his invention in public and make any experiments and trials which may be deemed advisable, without thereby affecting his patent. At the same time he cannot describe his invention as patented, and cannot prevent others from using it until a complete specification has been accepted, so that if the patent is for an article which is in immediate demand, he is not in such an advantageous position as if he had filed his complete specification at first and obtained full protection for his invention.

When an application, accompanied by a complete specification, has been accepted, the protection is precisely similar to that which is afforded by the acceptance of a complete specification filed after a provisional, and is practically equal to the protection of an actual patent for every purpose except the taking of legal proceedings; it is as though both the specifications had been accepted on the same day, and does not here require any separate consideration.

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.

The Court can order the production of the provisional specification of an abandoned application for a patent.<sup>2</sup>

<sup>1</sup> Act, 1902, sect. 1 (8).

<sup>2</sup> Pneumatic Tyre Co. v. English Cycle and Tyre Co., 1897, Wills, J., 14 R.P.C. 851.

*Completion of Application by Complete Specification.*

Act, 1883,  
sect. 8. A  
complete  
specification  
may be left  
after the  
application.

Rule 10, see  
App. A.

How and  
where  
complete  
specification  
must be left.  
Sect. 98.

After the application, accompanied by a provisional specification, has been accepted, the applicant can complete his application by handing in at the Patent Office, or by sending by post to the Comptroller, at any time within nine calendar months of the date of his application (or, in proper cases, on payment of a fine of £2, for which Patent Form U must be used, within ten months of his application), or in the case of applications made after a date to be fixed by the Board of Trade, under section 1 of the Patent Law Amendment Act, 1902, within six or seven months respectively of his application, two copies of a complete specification.

These must be handed in, or posted in due time to be received in the ordinary course of post, at the Patent Office before midnight on the same day of the ninth or tenth, or sixth or seventh months, as the case may be, from the date of application. If this day should fall on Christmas Day or Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, which are called excluded days, the complete specification need not reach the Patent Office until the day next following such excluded day, or days, if two or more of them occur consecutively.

If the office is closed, the policeman in charge will take documents up till midnight.

Preparation  
of complete  
specification  
for filing,  
see App. A.

The complete specification must be prepared in the manner above described for preparing specifications, using Form C for the first sheet, and must be sent to the Patent Office in duplicate, one copy bearing an impressed stamp for £3; each copy must be dated and signed by the applicant or applicants, or, where application is made through an agent, by the agent.<sup>1</sup>

<sup>1</sup> Rule 81.

A patent is not invalid because the complete specification is signed by some only of the applicants; but the patent in that case will be granted only to those who sign, and the others will be taken to have retired from the application.<sup>1</sup>

Patent not invalid if all applicants do not sign the complete specification.

If joint applicants disagree as to the form of the complete specification, the Comptroller will not decide the question between them, but they must settle it themselves.<sup>2</sup> When two complete specifications are lodged neither will be accepted.

“(1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.”

Act, 1883, sect. 9. Specifications, etc., referred to an examiner.

[N.B.—The fact of an examiner not having found any difference in the inventions described in the two specifications is no evidence that no such difference exists.]

“(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the Comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.”

Appeal to law officer.

“(3) The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

“(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall (subject to an extension of time being obtained) at the expiration of those twelve months become void.”

Time for acceptance is limited.

It is the duty of the applicant to frame his specification in such a way that a patent may be properly granted, and it is not a matter of course, if a specification be presented in such a form, that a patent cannot be granted without amendment, that the necessary amendment will

<sup>1</sup> *Re Grenfell & McEvoy's patent*, 1890, 7 R.P.C. 151.

<sup>2</sup> *Apostoloff & Frendenberg's Application*, 1896, Webster, A.-G., 13 R.P.C. 275.



be allowed.<sup>1</sup> Amendments may be made in the discretion of the Comptroller or law officer, but they are made somewhat sparingly.<sup>2</sup>

Where the Comptroller requires an amendment to be made, a reasonable time will be allowed for complying with his requisition; but delay in so doing, caused by inadvertence, is no ground for extending the period within which a patent must be sealed.<sup>3</sup>

In the case of applications made after a date to be fixed by the Board of Trade, the provisions of section 1 of the Patent Law Amendment Act, 1902, apply. For these, see p. 46.

The applicant may, in proper cases, get the time for acceptance enlarged for three months by making application to the Comptroller on Patent Form V, properly stamped. The stamp required is £2, £4 or £6, respectively, according as the extension sought does not exceed one, two or three months.

“Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding other than an appeal to the law officer under this Act, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.”

On the acceptance of the complete specification, the Comptroller advertises the acceptance in the official journal; and, upon the publication of such acceptance, the application and specification, or specifications with the drawings (if any), may be inspected at the Patent Office upon payment of a fee of one shilling.

Only after a complete specification has been accepted may articles made in accordance with the invention be marked patent.<sup>4</sup>

<sup>1</sup> Thomas & Prevost's application, 1809, Finlay, S.-G., 16 R.P.C. 69.

<sup>2</sup> Garnett's application, 1899, Finlay, S.-G., 16 R.P.C. 154.

<sup>3</sup> A. & B.'s application, 1896, Finlay, S.-G., 13 R.P.C. 63.

<sup>4</sup> Registrar v. Townsend, 1896, Pal. Ct. 13 R.P.C. 265.

Act, 1885,  
sect. 3.  
Enlargement  
of time for  
acceptance.  
Rule 10, see  
App. A.

Act, 1883,  
sect. 9 (5).  
Reports of  
examiners not  
published.

Advertise-  
ment of  
acceptance  
of complete  
specification.  
Sect. 10, Rule  
12.  
Specification  
may be  
inspected  
after  
acceptance.  
Use of word  
patent.



The specifications and drawings are printed three weeks after the complete specification has been accepted, and may be purchased at the sale branch of the Patent Office at the uniform price of 8d. This includes the price of inland postage, and, in case of an application by post, the cost of the postage stamp required on the application.

Printing and sale of specifications.

A postal application for a specification should be made on Patent Form C1, which may be obtained at any money order office, but is kept in stock only at certain principal offices.

How to obtain a specification by post. See App. A.

Within two months from the date of the advertisement of the acceptance of a complete specification, the grant of the patent may be opposed upon certain grounds (full particulars of opposition are given in chapter vii.).

Grant of patent may be opposed within two months of acceptance.

"(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office.

How patent is sealed. Act, 1883, sect. 12.

"(2) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

"(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say:

Sealing must be within fixed time from application.

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

In the case of applications made after the date fixed by the Board of Trade, under section 1 of the Act of 1902, a further fee not exceeding £1 is payable on the sealing of the patent.<sup>2</sup>

Where the Comptroller requires an amendment to be made, a reasonable time will be allowed for complying with his requisition, but delay in so doing, caused by inadvertence, is no ground for extending the period within which a patent must be sealed.<sup>3</sup>

<sup>1</sup> Patent Office Circular.

<sup>2</sup> Act, 1902, sect. 1 (11).

<sup>3</sup> A. & B.'s application, 1896, S.-G., 13 R.P.C. 63.

Where an opposition has been entered and persisted in merely for the purpose of delay, the law officer has no jurisdiction under this section, and will not direct the patent to be sealed out of time.<sup>1</sup>

Act, 1885,  
sect. 3.

Extension of  
time for  
sealing.

If the time for leaving the complete specification, or for the acceptance of the complete specification, has been extended, a further extension of four months after the expiration of the fifteen months is allowed for the sealing of the patent.

If there is no opposition, the patent is usually sealed about ten weeks after the date of the acceptance of the complete specification.<sup>2</sup>

Date of  
patent.  
Act, 1883,  
sect. 13.

“Every patent shall be dated and sealed as of the day of application provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.”

No legal pro-  
ceedings can  
be commenced  
before sealing.  
Act, 1883,  
sect. 15.

Proceedings for infringement can be commenced only after the patent is sealed, but may refer back to the date of publication of the complete specification.

Lost patent  
may be  
replaced.  
Act, 1883,  
sect. 37.

“If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Comptroller, the Comptroller may at any time cause a duplicate thereof to be sealed.”

See App. A.

Application for a duplicate to be sealed must be made on Patent Form N, and the application must bear an impressed stamp for £2.

Where appli-  
cant dies  
before sealing.  
Act, 1883,  
sect. 12 (3, b).

“If the person making the application die before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant.”

In the case of the applicant dying before the complete specification has been left at the Patent Office, the legal representatives should produce the Probate or Letters of Administration to the Comptroller, who will allow the subsequent stages of the application to be carried out in their names.

The personal representatives are entitled to send the

<sup>1</sup> A. & B.'s application, 1902, S.-G., 19 R.P.C. 556.

<sup>2</sup> Patent Office Circular.

complete specification in due course, but there is no special provision as to the time within which this must be done, and according to the practice of the Patent Office they have no further time than the applicant would have had. If the death should take place near the expiration of the time the personal representatives may be unable to comply with the requirements of the Office, but if the invention has not been published they would probably be able to abandon the application and make a fresh one within six months after the death under the provisions of section 34 of the Act of 1883,<sup>1</sup> though these apply strictly only where the deceased inventor has not made any application. An incomplete application rendered abortive by death might well be treated as no application in order to prevent the loss of the invention to the inventor's estate. The safest course is to file the complete specification within the time, and, if necessary, obtain a month's extension in the usual way.

Where the application has been made through an agent, a further authorisation is needed before he can proceed with the application.

If the complete specification has been filed and nothing is done, the patent will be sealed in the name of the deceased applicant; but if the legal representatives produce the Probate or Letters of Administration to the Comptroller, the patent will be granted to them instead.

<sup>1</sup> See p. 32.

## CHAPTER V.

### SPECIFICATIONS.

Two kinds of  
specification,  
provisional  
and complete.

IN the preceding chapter the form was considered in which specifications must be prepared for accompanying or following an application for a patent to the Patent Office, and it was noticed that there are two kinds of specification, either of which may accompany the application. It was also seen that if only a provisional specification accompanies the application, it is necessary, in order to obtain a patent, to supplement it by sending to the Patent Office, within a limited time after the date of the application, a complete specification of the invention for which the protection of a patent is sought.

The present chapter is concerned with the substance of the specifications, and only in very small degree with their form; it deals with the draft only.

#### *The Title of a Specification.*

Specification  
must com-  
mence with  
the title.  
Sect. 5 (5).

The Act of 1883 provides that a specification, whether provisional or complete, must commence with the title; so that the first thing to be decided upon in drafting a specification is the title.

See p. 7.

Title must be  
suitably  
chosen,

It will be seen that in the form of grant it is recited that the inventor has represented that he is in possession of an invention for . . . (*here follows the title of the invention*). Now, if this title is not one which ought to be applied to the invention for which protection is sought, the applicant has made a misrepresentation,



or, as it is sometimes called, "a false suggestion"; and the effect of this will be that the patent, when granted, will be of no effect. Therefore it is very important that the specification should commence with a suitable title. or patent will be void.

There have been cases in which the title has been considered to be more general than the invention warranted, and it has been made clear that if the title embraces more than the actual invention, so as to make the invention seem greater than it really is, then the patent will be invalid. Title may too general

Thus, in one case where the title conveyed the intelligence that by the invention an instrument gave "new notes" which had never before been produced, while, as a matter of fact, the instrument only produced "one new note," the patent was held bad for a false suggestion in the title.<sup>1</sup>

In another case, the accuracy of the judgment in which was afterwards questioned by a higher court, a patent for "an improved mode of lighting cities, towns and villages," which contained only a description of an improved street lamp, was held to be invalid on the same ground.<sup>2</sup>

It is sometimes rather difficult to know what ought to be made the title of an invention; for instance, in the case of a machine it is dangerous to call it a "machine," since that may make the invention appear wider than it really is. What may be called a machine. In an old case the following directions were given to a jury as to the effect of describing an invention as "a machine for the manufacture of bobbin lace or twist lace": "If you think that he has invented an engine which consists of a perfectly new conformation of parts, though all the parts were used before, yet he will be entitled to support his patent for a new machine. If a

<sup>1</sup> *Bainbridge v. Wigley*, 1810, Parl. Rep. 197; *cf.* also *Bloxam v. Elsee*, 1827, 6 B. & C. 178; 3 L. J. (O.S.) Q.B. 93.

<sup>2</sup> *Cochrane v. Smethurst*, 1816, 1 Stark. 205; questioned in *Cook v. Pearce*, 1843, 8 Q.B. 1063.

combination of a certain number of parts up to a given point existed before, and Mr. Brown's invention sprung from that point, and added other combinations to it, then I think his specification stating the whole machine as his invention is bad."<sup>1</sup>

"Machine" generally too broad.

Thus the title "machine" by itself is only applicable to what is an entirely new machine, and in most cases the title should be in somewhat narrower terms; for instance, as "an improved machine," or "improvements in machines".

New or improved method or machine is a safe description.

The judgment of Justice Cresswell, in a case where an invention had been described as "a new or improved method," seems to apply as well to a machine as to a method, and gives a very safe title for use where any doubt exists as to how an invention ought to be described. He said: "If a part of the method be new, so as to produce a result that, as a whole, is new, surely it may be called a new or improved method. If the method be altogether new, surely it may be called an improved method. They seem to be convertible terms."<sup>2</sup>

It is thus a safe rule to use the words "new or improved" when in doubt as to which an invention really is, and this should always be borne in mind in deciding upon the title for a patent.

### *Provisional Specification.*

Act, 1883, sect. 5 (3).

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

Drawings are unusual.

It is, as has been already pointed out, unusual for drawings to accompany a provisional specification.

Object of provisional specification.

"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; other-

<sup>1</sup> Bovill v. Moore, 1815, Dav. P.C. 361.

<sup>2</sup> Beard v. Egerton, 1846, 3 C.B. 123.

wise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed, the statute itself indicates this distinction between the provisional and the final specification; for it calls the latter the complete specification, implying that the former is, or may legally be, in some respects, executory and incomplete. Moreover, it enacts that the provisional specification is to describe the nature of the invention and no more; but, when the statute comes to speak of the complete specification, its language is altogether different. It enacts that the complete specification shall describe not only the nature of the invention, but also the manner in which it shall be performed, and not only describe but particularly ascertain it.”<sup>1</sup>

If a patentee gives, in his provisional specification, a wide enough description of the nature of his invention, he is entitled to fill that up and even to take advantage of knowledge which may come to him between the dates of the provisional specification and the final specification, in order to cover by his final specification matters of detail which he may not have known at the time when he drew up his provisional specification, but which are covered by the description he has given of the nature of his invention.”

It is not, however, any objection to a patent if the provisional specification does describe a mode of carrying out the invention, even though the mode shown in the complete specification should be a different and a better one. Provisional may describe a mode of carrying out the invention.

“A patentee, putting in a provisional specification showing the nature of his invention, is not bound to describe a way in which that can be carried into effect

<sup>1</sup> *Newall v. Elliott*, 1858, 4 C.B. (N.S.) 269, adopted by H.L. in *Pneumatic Tyre Co. v. Leicester Pneumatic Tyre Co.*, 1899, 16 R.P.C. 531, see p. 541; *cf.* *Penn v. Bibby*, 1866, L.R. 2 Ch. 132.

<sup>2</sup> *Pneumatic Tyre Co. v. Leicester Pneumatic Tyre Co.*, 1899, H.L. (per Lord Shand) 16 R.P.C. 543.



Complete may describe different method from that in provisional.

and operation; but, if he does describe a way of doing it, and, before he files his complete specification, he either finds out improvements in that way, or a different way of carrying into effect that which is described as his invention in the provisional specification, he is bound to give the public the benefit of what he has discovered as regards the mode of carrying the invention, the nature of which must be described in the provisional specification, into effect, even although there may be improvement, and even invention, which was not known to him at the time."<sup>1</sup>

Details should be avoided in provisional,

and general language used instead.

Thus the inventor may please himself about giving details in his provisional specification; as, however, details are not required, it would seem better not to give them, but in the provisional specification to use general terms sufficiently wide to cover any improvements which are likely to occur during the time of provisional protection, and just sufficiently definite to enable the inventor to point out what part of the provisional specification describes the invention detailed in the complete specification. If this rule be followed there will not be much fear of the patent being upset upon the ground of disconformity, and this is all that really needs to be guarded against in framing a provisional specification.

### *The Complete Specification.*

Should be as perfect as possible.

Although it is very important to have the provisional specification well drawn, it is of supreme importance to have the complete specification as perfect as possible, since it is to the complete specification that reference must be made to see in what the invention really consists and what the patentee claims as his monopoly.

Act, 1883, sect. 5 (4).

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

<sup>1</sup> Woodward v. Sansum, 1887, C.A. 4 R.P.C. 175.



If a provisional specification has been left with the application, it is necessary that the complete specification should describe the same invention as is described in the provisional specification.<sup>1</sup>

Must describe same invention as provisional.

The patent is granted on the application, and is for the invention which is described in the provisional specification, although the patent is not sealed until the complete specification, giving a more perfect description of the invention, has been filed; and if anything is not within the provisional specification the patent cannot protect it. This was clearly laid down by Lord Blackburn in the House of Lords, as follows:—

Nothing outside provisional specification can be protected.

“Look at the nature of the invention described in the provisional specification and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described. In that case you are protected; but, if it is a new and separate invention, and a different one, then you are not protected.”<sup>2</sup>

“The provisional and complete specifications may describe different modes of carrying out an invention; but if both are really within the same invention described not minutely, but in general terms in the provisional specification, this will not render the patent bad, even though the complete may contain an improvement on what is described in the provisional.”<sup>3</sup>

Mode of carrying out invention may differ in specifications.

But, although the complete specification may contain an improvement on what is described in the provisional specification, the improvement must not be anything in the nature of an independent invention.<sup>4</sup>

Improvements in complete specification.

The law on this point was also very clearly stated in the House of Lords, in the same case, as follows:—

<sup>1</sup> Vickers v. Siddell, 1890, H.L. 7 R.P.C. 303; Nuttall v. Hargreaves, 1891, C.A. 8 R.P.C. 450.

<sup>2</sup> Bailey v. Robertson, 1878, 3 App. Cas. 1075.

<sup>3</sup> Woodward v. Sansum, 1887, C.A. 4 R.P.C. 166.

<sup>4</sup> Watling v. Stevens, 1886, C.A. 3 R.P.C. 147.

“ I cannot but think 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 with respect to the mode in which the operation is to be performed—a thing which is very likely to happen—still the nature of the 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 is described in the provisional specification really workable.

“ If nothing more is done than that, I think it is good; but, as soon as it comes to be more than that, and the patentee says in the provisional specification I describe my invention as A, and in the complete specification he says, I describe A and also B, then, as far as regards B, it is void, because the letters patent were granted for the invention that was described in the provisional specification, and do not cover the invention that is described in the other.”<sup>1</sup>

Definition of  
disconformity.

If the complete specification contains something not foreshadowed in the provisional, the patent is bad, and the defect is known as disconformity. The question whether there is disconformity or not is one of law, since it arises out of the construction of the specifications.<sup>2</sup>

Complete  
specification  
may describe  
what it could  
not claim so  
as to publish  
it.

It is no objection to a patent if the complete specification describes something not in the provisional, simply for the sake of publishing it, and does not attempt to claim it as part of the invention protected by the patent; indeed, it is sometimes advisable to take this course in order to prevent any one from taking out a

<sup>1</sup> Bailey v. Robertson, 1878, 3 App. Cas. 1075.

<sup>2</sup> Pneumatic Tyre Co. v. Leicester Pneumatic Tyre Co., 1899, C.A. 16 R.P.C. 50.

patent for some minor detail which the original applicant does not wish to make the subject of a separate application. This is often advisable.

Since the complete specification must contain details of the invention described in the provisional specification, it acts as a definer of what the provisional specification had stated to be the subject-matter of the application; and it is no objection to a complete specification that the invention described in it is smaller than what appeared from the provisional specification to be in prospect, provided the invention be not so narrowed as to make the title too general, and so render the patent void for a false suggestion in the title. Complete defines provisional, and may narrow its scope.

Thus far the complete specification has been considered with reference to the provisional specification, which may not have any existence; what follows applies to any complete specification, whether it accompanies the application or follows it.

A complete specification—

- (a) Must commence with the title;
- (b) Must particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed;
- (c) Must be accompanied by drawings (or must refer to drawings already sent with the provisional specification) if required; and—
- (d) Must end with a distinct statement of the invention claimed.

Act, 1883,  
sect. 5.  
Requirements  
of complete  
specification.

Nothing further need be said about (a), since what has been already said applies equally to all specifications, whether provisional or complete.

(b) and (c) may be considered together; the drawings and the letterpress together form the specification, any deficiency in the one being supplemented by the other; and their relative importance varies according to the class of invention which it is sought to protect. In some cases drawings may be not only unnecessary, but quite out Drawings supplement letterpress.



of the question, and in such cases the wording of the specification is all-important; while in others the drawings by themselves may be sufficient to show what the invention is, though the letterpress should always contain some descriptive reference to them.<sup>1</sup>

No rule can be given as to how far the applicant should rely on the letterpress, and how far on drawings; but, as a rule, where drawings are of any use, the more they are used the better.

Only what is described is protected.

The letters patent contain a recital that "the inventor hath, by his complete specification, particularly described the nature of his invention," and the letters patent are granted only for the invention so described.

Consideration for grant.

This is a recital of very great importance, since it is a recital of what the applicant has done in order to entitle himself to the grant of a patent; it is a recital of the consideration for the grant, and, if it be not true, there is a failure of the consideration and the patent is of no effect.

Especially in a combination of old parts must the specification describe and ascertain the invention with such certainty as not to deter the public from using what is old by including it in the claim for monopoly.<sup>2</sup>

Applicant must not keep back any useful information for working the invention.

The applicant must give the public the full benefit of his invention; he must not attempt to keep back anything which he knows to be of value in working the invention, in the hope of combining the advantages of a patent with those of a trade secret.

To whom a specification is addressed.

"It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for

<sup>1</sup> *Hattersley v. Hodgson*, 1903, 20 R.P.C. 591.

<sup>2</sup> *Kynoch v. Webb*, 1900, H.L. 17 R.P.C. 100, 108.



which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee uses it.”<sup>1</sup>

It is thus very important to know how much it is necessary for the applicant to go into details of his invention, and to ascertain this one must consider the class of persons to whom a specification is supposed to be addressed.

A concise statement of this has been recently given in the House of Lords in the following words:—

“The object and purpose of a specification is that it is to enable not anybody, but a reasonably well-informed artisan, dealing with a subject-matter with which he is familiar, to make the thing, so as to make it available for the public at the end of the protected period.”<sup>2</sup>

More lengthy explanations have been given in other cases, of which the following are useful examples:—

“It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. If it is a mechanical invention you have, first of all, scientific mechanics of the first class, eminent engineers; then you have scientific mechanics of the second class, managers of great manufactories, great employers of labour, persons who have studied mechanics; . . . and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints and still more imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the first two classes, which I will call the scientific classes. The other class

Specification must be such as ordinary skilled workman can understand.

<sup>1</sup> *Rex v. Arkwright*, 1785, 1 W.P.C. 66, per Buller, J.

<sup>2</sup> Per Halsbury, L.C., *Tubes v. Perfecta Seamless Steel Tube Co.*, 1903, H.L. 20 R.P.C. 77.

consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected of 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.”<sup>1</sup>

Specification may assume matters of common knowledge.

“ The specification ought to be framed so as not to call upon a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon him to exercise all the existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention.

Specification must not leave room for experiments.

“ The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect, so as to save a party the trouble of making experiments and trials.”<sup>2</sup>

The sufficiency of a specification must be tested by the state of public knowledge at the time it is filed.<sup>3</sup>

Must not be ambiguous or misleading.

The specification must not be misleading or ambiguous; it must not describe an elaborate method of making materials, forming part of a new mixture, when such materials can be readily purchased;<sup>4</sup> it must not direct the use of a substance under an ordinary description when the ordinary commercial article answering to the description will not answer, but a special prepara-

<sup>1</sup> *Plimpton v. Malcolmson*, 1876, 3 Ch. D. 568, per Jessel, M.R.

<sup>2</sup> *Morgan v. Seaward*, 1836, 1 W.P.C. 174, per Alderson, B.

<sup>3</sup> *Badische Anilin v. Levinstein*, 1885, 24 Ch. D. 156.

<sup>4</sup> *Savory v. Price*, 1823, 1 R. & M. 1.

tion, sold only by the patentee, is required;<sup>1</sup> it must not lead a person, attempting to put the invention in practice, into a course of futile experiments by suggesting the use of alternatives, which, to the knowledge of the patentee, will not answer.<sup>2</sup>

“It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any unnecessary ambiguity affectingly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void.

. . . If the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void. It is certainly of consequence that the terms of a specification should express the invention in the clearest and most specific manner, so that a man of science may be able to produce the thing intended without the necessity of trying experiments.”<sup>3</sup>

Process described must produce right result.

The rule that *no experiments* may be required does not, however, apply to every case.

“The specification must be sufficiently clear to enable a person, conversant in the subject, without invention to carry out the invention; but not necessarily to enable him to do the work without any trial or experiment, which, when it is new or especially delicate, may frequently be necessary, however clear the description may be.”<sup>4</sup>

In some cases trial may be needed to carry out specification,

But, although experiment may be still needed in order to put the invention in practice, . . . be nothing to put the public on a wrong . . . the specification, upon a fair interpretation, . . . al it is insufficient.<sup>5</sup>

but it must not be equivocal.

<sup>1</sup> *Sturtz v. De la Rue*, 1828, 1 W.P.C. 83.

<sup>2</sup> *Crompton v. Ibbotson*, 1828, Dan. & Ll. 33.

<sup>3</sup> *Turner v. Winter*, 1787, 1 W.P.C. 80, 81.

<sup>4</sup> *Edison & Swan Electric Light Co. v. Holland*, 1889, C.A. 6 R.P.C. 243; see also *Beard v. Egerton*, 1849, 8 C.B. 206.

<sup>5</sup> *Hastings v. Brown*, 1853, 1 E. & B. 454.



False statement.

A false suggestion as to the utility of parts of a process described in the specification will invalidate the patent;<sup>1</sup> but the fact that a patentee misconceives and mistakes the theory of his invention does not invalidate his patent.<sup>2</sup>

Specification need show only one method,

The applicant is not bound to describe every way known to him of carrying out his invention; it is sufficient if he shows one useful way, even though it may turn out not to be the most beneficial way.

but may give more provided they will all work.

He may give several ways, but must be careful only to give ways that will give the required result; for, "If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad".<sup>3</sup>

Generic term not always sufficient.

"It is not sufficient to describe a material by a generic term comprising many species, the majority of which would be unsuitable";<sup>4</sup> but if a patent be for a process which may be applied to a large class of substances, it is no objection to prove that it is only some of these substances which will give a useful result.<sup>5</sup>

Nature of chemical product need not be given.

In a chemical patent it is not necessary to state what is the exact chemical nature of the product produced by a process; it is the commercial, not the chemical, value of the product that is the subject of the patent.<sup>6</sup>

Mistakes should be avoided. What mistakes will render patent bad.

The applicant should be careful to avoid mistakes in his directions or drawings; but a mistake will not necessarily render the patent bad unless it be likely to mislead the public, or should amount to a false suggestion.

<sup>1</sup> Owen's patent, 1900, 17 R.P.C. 68; *cf.* Morgan *v.* Seaward, 1836, 2 M. & W. 561; Travell *v.* Carteret, 1683, 3 Lev. 134; Alcock *v.* Cooke, 1829, 5 Bing. 340; Hill *v.* Thomson, 1817, 1 W.P.C. 237; Brunton *v.* Hawkes, 1821, 4 B. & A. 550; Lewis *v.* Marling, 1829, 4 C. & P. 52.

<sup>2</sup> Atkins & Applegarth *v.* The Castner-Kellner Alkali Coy., Ltd., 1901, 18 R.P.C. 281.

<sup>3</sup> Beard *v.* Egerton, 1846, 19 L.J. 39.

<sup>4</sup> Wegmann *v.* Corcoran, 1879, 13 Ch. D. 65.

<sup>5</sup> Badische Anilin *v.* Levinstein, 1887, H.L. 4 R.P.C. 449.

<sup>6</sup> Leonhardt *v.* Kallé, 1895, 12 R.P.C. 103.



“ The statement that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, is true only of such errors as 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. The reason is because such errors cannot possibly mislead; but it is not true of errors which are discoverable only by experiment and further inquiry, nor of an erroneous statement amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject.”<sup>1</sup>

### *Claims.*

A complete specification must end with a distinct statement of the invention claimed. Act, 1883, sect. 5.

After the invention has been described at length in the specification, and by means of references to the drawings accompanying it, the applicant must state shortly what it is that he claims to have invented. This is done by means of a claiming clause, containing one or more claims, which must define clearly what it is that the patent is meant to protect. These claims are means for warning the public what they must avoid doing if they do not wish to incur the risk of an action for infringement.<sup>2</sup> Warning the public.

A usual form of preface to the claims is—

“ Having now particularly described the nature of my invention, and in what manner the same is to be performed, I declare that what I claim is . . . ” Form of claim clause.

Although the Act of 1883 requires a complete specification to end with a distinct statement of the invention

<sup>1</sup> *Simpson v. Holliday*, 1866, 15 N.R. 340; L.R. 1 H.L. 315, per Ld. Westbury.

<sup>2</sup> *Campion v. Benyon*, 1821, 3 B. & B. 10; *Gibson v. Brand & Scott*, 1841, N.R. 890.

Absence of claims does not make patent bad.

claimed, and it would be the duty of the Comptroller to refuse to accept, or, at any rate, to require the amendment of a specification that did not comply with this requirement, it has happened that a complete specification without any distinct claiming clause has been accepted; and, a patent having been granted, it was held that the omission of a claiming clause did not of itself render the patent invalid.<sup>1</sup>

Claim for combination.

Where there is a claim for a combination, and the combination is the novelty, the patentee need not point out how far he claims novelty for particular portions; <sup>2</sup> but, where there is only an improvement in some part, the patentee must claim the improvement only and not the whole combination as improved.<sup>3</sup>

A claim for new means of bringing about an old result is confined to the actual means described, and does not prevent the same result being attained by other means.<sup>4</sup>

New and old distinguished in claims.

In a patent for an improvement on an existing machine or process the specification must distinguish what is new from what is old;<sup>5</sup> and the claim for an improvement must be strictly confined to the actual improvement described, and must not cover anything known or in use before the date of the patent.<sup>6</sup>

Disclaiming clauses.

If the claims themselves are not sufficient to distinguish what is new from what is old, this may often be conveniently done by means of what is called a dis-

<sup>1</sup> *Vickers v. Siddell*, 1890, H.L. 7 R.P.C. 306.

<sup>2</sup> *Harrison v. Anderston Foundry Co.*, 1876, 1 A.C. 574; *Proctor v. Bennis*, 1887, 36 Ch. D. 740, 4 R.P.C. 333.

<sup>3</sup> *Perry v. Société des Lunetiers*, 1896, 13 R.P.C. 664.

<sup>4</sup> *Ticket Punch Register Co. v. Colley's Patents, Ltd.*, 1895, C.A. 12 R.P.C. 171; *Curtis v. Platt*, 1863, 3 Ch. D. 135 *u*; *Proctor v. Bennis*, 1887, 36 Ch. D. 740; 4 R.P.C. 333.

<sup>5</sup> *Foxwell v. Bostock*, 1861, 4 De G. J. & S. 313, approved in *Kynoch v. Webb*, 1900, H.L. 17 R.P.C. 100; *Holmes v. L. & N.W.R. Co.*, 1852, 12 C.B. 831.

<sup>6</sup> *Brown v. Jackson*, 1895, P.C. [1895], A.C. 446, 12 R.P.C. 311.

claiming clause, which either precedes the claiming clause or is made to form a part of it.

A disclaiming clause usually commences by stating that the applicant knows that certain things have been either done, or proposed to be done, and that he does not claim them, and then he proceeds to state what he does claim.

If the applicant knows of any machine or process which might be put forward as an anticipation, or if his invention differs but slightly from what is described in some earlier specification or book, he should always insert a disclaimer in his specification; he will thus avoid, or at least considerably lessen, any chance of opposition, and also the danger of getting his patent upset on the ground of its being anticipated. Often advisable to avoid an anticipation.

A disclaimer of something claimed in an earlier patent should follow the words of the claim of the earlier specification, even though it may not specifically refer to it.<sup>1</sup> In many cases there seems no objection to inserting a specific reference to the prior patent, and thus obviating all risk of opposition.

It is necessary to distinguish what is new from what is old only when the invention consists in an improvement on an old machine or process; where the invention consists of a combination, and where the claim is clearly only for a combination, it is not necessary to distinguish what part of the combination (if any) is new from what is old;<sup>2</sup> so that where the claim is for a combination, even though every part be old, there will be no need for a disclaimer. New and old must be distinguished in an improvement, but not in a new combination.

“Every patent shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.” Act, 1883, sect. 33. Multiple claims.

<sup>1</sup> Webster, A.-G., 1899, 17 R.P.C. 123.

<sup>2</sup> Harrison *v.* The Anderston Foundry Co., 1876, 1 App. Cas. 574; see also Proctor *v.* Bennis, 1887, 36 Ch. D. 740; but *cf.* Kynoch *v.* Webb, 1900, H.L. 17 R.P.C. 100.



Redundant  
claims.

Specifications are frequently loaded with a number of claims, often for exactly the same thing, but expressed in slightly different language. Such repetition should be avoided as much as possible, since it is always a source of danger. Any one claim, if bad, invalidates the patent, and in construing a specification, as in construing any other document, the Court tries to avoid treating any part as mere surplusage, and may attach some distinct meaning to a duplicate claim which will endanger an otherwise good patent.

Frequently one finds claims for mere applications of the invention following the claim for the invention itself. Such claims do not invalidate the patent,<sup>1</sup> but they are unnecessary and useless, always a possible source of danger, and should therefore be avoided.

Claims for  
subordinate  
integers in  
combination.

Since a patent for a new combination may also be made to cover any new parts, or subordinate integers, which form part of the whole combination claimed, a single patent may be made to cover several distinct improvements in a machine, as well as the whole machine, each of these improvements being made the subject of a separate claim. The inventor should be very careful to claim only those parts which are really novel, for, if it should turn out that one or more of these supposed improvements were not new, the whole patent would be invalidated.<sup>2</sup>

Application  
claims.

In some cases it might be unreasonable to sever claims for parts of a combination from the rest of the invention, and treat them as definite claims for such parts, even if used for an altogether different purpose.<sup>3</sup> If, however, upon a fair construction of a specification,

<sup>1</sup> *Pneumatic Tyre Co. v. Casswell*, 1896, 13 R.P.C. 164; *British Dynamite v. Krebs*, 1879, H.L. 13 R.P.C. 190.

<sup>2</sup> *Brunton v. Hawkes*, 1821, 4 B. & A. 550; *Gillett v. Wilby*, 1839, 1 W.P.C. 270.

<sup>3</sup> *Plimpton v. Spiller*, 1876, *Lawson Pat. Pract.*, 497; *British Dynamite v. Krebs*, 1879, H.L. 13 R.P.C. 190.



it claims matters that are not new, effect must be given to it, and it must not receive a forced construction on the ground that it was foolish or suicidal of the patentee to claim something that was old.<sup>1</sup>

Claims for the use of parts of a combination which, though new so far as the application is concerned, are not new in themselves, are thus useless and dangerous, since, if they should be held to be claims for subordinate integers, they would invalidate the patent,<sup>2</sup> while at the best they do not give the patentee anything which he has not already obtained in his principal claim.

A subordinate claim is usually taken to apply to the subject-matter of the main invention, and the Court will not 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 by including things in such general use that the patentee must have known that they were old.<sup>3</sup>

The proper framing of claims and of any necessary disclaimer is a matter of the utmost importance, as upon them the value, and it may be the very existence, of the patent depends. Importance  
of wording  
of claims.

Especially in the case of a master or pioneer invention must the greatest care be exercised; if the claim be too wide the patent may be bad as claiming a principle, and a claim for every method of carrying out an invention would bring it into this category;<sup>4</sup> if, on the other hand, the claim be too narrow, the patent may be utterly worthless, because its evasion is thereby rendered easy. The real invention may be the result, and, if this be the case, care must be taken not to lay too much stress on

<sup>1</sup> *Kynoch v. Webb*, 1900, H.L. 17 R.P.C. 100, per Ld. Davey.

<sup>2</sup> *The Electric Construction Co v. Imperial Tramways Co.*, 1900, C.A. 17 R.P.C. 536; *Tubes v. Perfecta Seamless Steel Tube Co.*, 1901, C.A. 18 R.P.C. 339, rev. by H.L.

<sup>3</sup> *Haworth v. Hardcastle*, 1834, 1 Webs. 484, quoted by Halsbury, L.C., in *Tubes v. Perfecta Seamless Steel Tube Co.*, 1903, H.L. 20 R.P.C. 77, 97.

<sup>4</sup> *Neilson v. Harford*, 1811, 1 W.P.C. 355.

the means for attaining it, or the use of what are really equivalent means may be rendered possible. In other cases the exclusion of all that is old and the inclusion of all that is new is the object, and a knowledge of what has been already done and of the existing state of public knowledge on the subject is essential.

It may, perhaps, be better to claim too much than too little, as a wide claim can always be made narrower by amendment, while a narrow claim cannot possibly be enlarged. Amendment is, however, a somewhat tedious process, besides being a matter of additional expense; and, further, wherever it is necessary, all damages from infringements committed prior to amendment must be regarded as irrecoverable.

## CHAPTER VI.

### OPPOSITION TO THE GRANT OF A PATENT.

“(1) Any person may, at any time within two months from the date of Act, 1883, the advertisement of the acceptance of a complete specification, give notice sect. 11. at the Patent Office of opposition to the grant of the patent on the ground Notice of of the applicant having obtained the invention from him, or from a person of grounds for whom he is the legal representative; or on the ground that the invention opposition. has been patented in this country on an application of prior date; or on the ground that the complete specification describes or claims an invention other Act, 1888, than that described in the provisional specification, and that such other in- sect. 4. vention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification; but on no other ground.

“(2) Where such notice is given the Comptroller shall give notice of Act, 1883, the opposition to the applicant, and shall, on the expiration of those two sect. 11. months, after hearing the applicant and the person so giving notice, if Notice to desirous of being heard, decide on the case, but subject to appeal to the law applicant. officer.

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

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

“A notice of opposition to the grant of a patent shall Rule 32. be on Form D, and shall state the ground or grounds on See App. A. which the person giving such notice (hereinafter called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.”

First ground  
of opposition.

The Comptroller may allow an unsigned notice to be signed subsequently.<sup>1</sup>

Under the first ground of opposition the obtaining must have been within the United Kingdom. There need not be any fraud in the obtaining of the invention from the opponent, but, of course, in some cases there may have been fraud, and in such cases evidence of the fraud should be given before the Comptroller, since, if no evidence of fraud is given before the Comptroller, it will not be possible to introduce the subject before the law officer.<sup>2</sup>

Who may  
oppose.

The opponent on this ground must be the actual person from whom the applicant obtained the invention, or his legal representative.<sup>3</sup> This latter term appears to apply only to the legal personal representative of a deceased person, who, as we have seen, has much the same rights, so far as the inventions of such person are concerned, as the inventor himself would have had if he had lived.

Thus, this ground is practically confined to persons who could themselves have properly applied for the patent which they are opposing.

Rule 33.  
Evidence as to  
the obtaining  
must be given.

“Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within fourteen days after the expiration of the two months from the date of the advertisement of the acceptance of the applicant’s complete specification, the opposition shall be deemed to be abandoned.”

See p. 49.

Rule 34.  
Attendance of  
declarant on  
Comptroller.

“Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, the Comptroller may request or allow any

<sup>1</sup> *Re Codd*, 1884, Griff. 305.

<sup>2</sup> *Re Bairstow*, 1888, 5 R.P.C. 286.

<sup>3</sup> *Re Edmunds*, 1888, Griff. 281.



person who has made a statutory declaration in the matter to which the opposition relates to attend before him at the hearing of the case and make oral explanations with respect to such matters as the Comptroller may require."

Where the opponent proves that the applicant obtained a substantial part of his invention from him, but the applicant has also made improvements of merit, the patent may be sealed, subject to an agreement being filed at the Patent Office for securing to the opponent the full rights of a joint patentee;<sup>1</sup> or the patent may be sealed to the applicant and opponent as joint inventors.<sup>2</sup>

The second ground of opposition is "that the invention has been patented in this country on an application of prior date". Second ground of opposition.

"Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice." Rule 35. Number and date of prior patent required.

The prior patent need not have been actually sealed, but the complete specification must have been accepted; and it does not matter whether the prior patent is an existing or an expired patent. Prior patent need not be actually sealed.

It was at one time thought that it was not material whether the prior patent relied on in an opposition was valid or invalid,<sup>3</sup> but this is not a correct view of the law, since an invalid grant does not necessarily defeat a grant made on a subsequent application.<sup>5</sup>

Notwithstanding the somewhat general words of the Act that "any person may give notice of opposition," Who may oppose.

<sup>1</sup> *Re Luke*, 1886, Griff. 294.

<sup>2</sup> *Re Eadie*, 1885, Griff. 279.

<sup>3</sup> *Re Lancaster*, 1884, Griff. 293; *re Glossop*, 1884, Griff. 285.

<sup>4</sup> *Re Thornborough & Wilks*, 1896, S.-G. 13 R.P.C. 115.

<sup>5</sup> *Mica Insulator Co. v. Electrical Co.*, 1898, 15 R.P.C. 489.

the class of persons who are able to oppose on the second ground has been restricted by the law officers, through the exercise of their discretionary power of determining whether any person is entitled to be heard in opposition. The Comptroller is bound to hear only such persons as would be entitled to be heard by the law officer,<sup>1</sup> so that it is useless for any one to give notice of opposition unless he can bring himself within the prescribed limits.

Opponent  
must be  
interested in  
prior patent.

“The only class of persons who are entitled to be heard in opposition before the law officer are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it.”<sup>2</sup>

A person who had owned an expired patent and has worked under it is entitled to oppose,<sup>3</sup> and though it was formerly held that the mere fact of manufacturing under an expired patent gave no *locus standi*,<sup>4</sup> this is no longer the rule. It is now the rule that a *bona fide* attempt to carry out the invention sought to be protected by a person who desires to oppose the grant, and proof that he may be damnified by the application which he desires to oppose, entitles such person to oppose the grant.<sup>5</sup>

A licensee under a prior patent may be heard in opposition.<sup>6</sup>

An opponent with a *locus standi* under the second head may oppose on the ground of the existence of other patents in which he is not interested,<sup>7</sup> but a person

<sup>1</sup> Registrar v. Comptroller-General, *c. p.* Tomlinson, C.A. [1899], 1 Q.B. 909; 16 R.P.C. 233.

<sup>2</sup> *Re Heath & Frost*, 1886, Griff. 311.

<sup>3</sup> *Re Glossop*, 1884, Griff. 285, approved *re Nahnsen*, 1900, A.-G. 17 R.P.C. 203.

<sup>4</sup> *Re Macevoy*, 1880, 5 R.P.C. 285.

<sup>5</sup> *Re Meyer*, 1899, A.-G. 16 R.P.C. 526.

<sup>6</sup> *Re Hill*, 1888, 5 R.P.C. 599.

<sup>7</sup> *Re Stewart*, 1896, A.-G. 13 R.P.C. 629.

opposing on the first ground may not also allege a prior patent in which he is not interested.<sup>1</sup>

An opponent who desires his prior patent to be construed as a master patent for a pioneer invention, must give evidence before the Comptroller as to the state of public knowledge concerning the subject-matter of his invention at the date of his application.<sup>2</sup>

Questions of mechanical equivalents may be considered in deciding an opposition on the ground of a prior grant for the same invention.<sup>3</sup>

The last ground of opposition was introduced in 1888 to meet the danger of an earlier applicant stealing his invention from a later applicant, who had either filed a complete specification or otherwise published his invention during the term of the earlier applicant's provisional protection. Third ground of opposition.

The evidence used before the Comptroller must be given by statutory declaration or affidavit. Evidence before Comptroller.

Care should be taken that statutory declarations filed in the Patent Office are confined to matter relevant to the issue.<sup>4</sup>

### *Statutory Declarations and Affidavits.*

“ The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate and shall be drawn up in the first person, and shall be divided into paragraphs, consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written or printed Form, etc., of statutory declaration and affidavit. Rule 25.

<sup>1</sup> J. & G.'s application, 1902, S.-G. 19 R.P.C. 555.

<sup>2</sup> *Re Southwell & Head*, 1899, A.-G. 16 R.P.C. 361.

<sup>3</sup> *Re Ambrose Hudd Smith*, 1896, A.-G. 13 R.P.C. 200.

<sup>4</sup> Official notice by Comptroller, 19th Jan., 1895, *re Brand*, 1895, S.-G., 12 R.P.C. 102; see P.R. 11, 17 and 17A.



bookwise and shall bear the name and address of the person leaving it, and shall state on whose behalf it is left."

Manner in which, and persons before whom, declaration or affidavit is to be taken.  
Rule 26.

"The statutory declarations and affidavits required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows :-

"(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

"(b) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

"(c) If made out of His Majesty's Dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul or other person exercising the functions of a British Consul, or before a notary public, or before a judge or magistrate."

Opponent's evidence.  
Rule 36.

"Except in the case provided for in rule 33, statutory declarations need not be left in connection with an opposition, but the opponent may, within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof."

Applicant's evidence.  
Rule 37.

"Within fourteen days from the delivery of such copies, the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent copies thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and

Evidence in reply.



on so leaving shall deliver to the applicant copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply."

"If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do), within three months from the date of the advertisement of the acceptance of his complete specification, leave at the Patent Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof."

Applicant's evidence if opponent does not leave statutory declarations. Rule 38.

"Within fourteen days from the delivery of such copies, the opponent may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the applicant copies thereof, and within fourteen days from such delivery the applicant may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the opponent copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply."

Opponent's evidence. Rule 39.

Evidence in reply.

"No further evidence shall be left on either side except by leave, or on the requisition, of the Comptroller."

Closing of evidence. Rule 40.

"On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard, he shall, as soon as possible, notify the Comptroller to that effect. If either party desires to be heard he must leave Form E at the Patent Office. The Comptroller may refuse to hear either party who has not left Form E prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he

Hearing. Rule 41.

See App. A.

intends to refer. After hearing the party, or parties, desirous of being heard, or if neither party desires to be heard, then, without a hearing, the Comptroller shall decide the case and notify his decision to the parties.”

A patent, the grant of which is opposed, may be sealed with a claim entirely different from that originally made;<sup>1</sup> but an applicant whose claim, as originally drawn, is anticipated by the patent relied on by the opponent, will not be allowed to amend his claim by substituting claims for other distinctive matter contained in the specification.<sup>2</sup>

From the decision of the Comptroller an appeal lies to the law officer: the procedure on appeal in an opposition, either to a grant or to an amendment, is the same, and is dealt with in a separate chapter (chapter xi.).

The hearing before the law officer is by way of re-hearing, and *visâ voce* evidence may be given, so that the witnesses may be cross-examined.

In order to actually prevent a patent being sealed, it is necessary for the opponent to have an extremely strong case. If the grant is refused, the applicant is left entirely without remedy; while, if the patent is sealed, it is always open to impeachment in the Courts, and if proved to have been wrongly sealed it can always be revoked; it is, therefore, comparatively seldom that the grant is wholly refused.

A patent has been refused for putting together a combination of old parts in which each is applied only to its old purpose.<sup>3</sup>

A patent for a particular mixture will not be stopped because such mixture may be covered by a general claim in a prior patent.<sup>4</sup>

<sup>1</sup> Per Sir E. Carson, S.-G., Harrild & Parkin's application, 1900, 17 R.P.C. 617.

<sup>2</sup> Mill's application, Sir E. Carson, S.-G., 1901, 18 R.P.C. 322.

<sup>3</sup> Bridge's application, Sir E. Carson, S.-G., 1901, 18 R.P.C. 257.

<sup>4</sup> *Re Nahnsen*, 1900, A.-G. 17 R.P.C. 203.

Appeals to  
law officer.

When  
opposition is  
likely to  
succeed.

A patent will not be stopped on general grounds of want of novelty, and where there is a strongly controverted question of scientific anticipation the patent will be granted.<sup>1</sup> General grounds of anticipation insufficient.

The following rule has been laid down as a general guide on the question of refusing a grant, viz., that the issue of a patent should be refused by the officer only if, having examined the evidence, he is so clearly of opinion that the opponent has made out his case, that he would, if a jury were to find in favour of the applicant, refuse to accept it, and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence.<sup>2</sup> Rule for refusing a grant.

As a general rule an opposition is entered, not so much for the purpose of stopping the patent as for forcing the applicant to make an amendment, by way of disclaimer, of something in which the opponent is interested.<sup>3</sup> Disclaimer may be ordered.

Disclaimers are of two kinds, specific and general.

In a specific disclaimer the applicant mentions some prior patent, and states that he does not claim anything described therein, or something to that effect. Varieties of disclaimer.

A specific disclaimer will be required only in very special cases where the prior patent is a master patent, or the later invention is simply a modification of the earlier one. If the applicant can prove that there was any public knowledge on the subject of the application at the date of the prior application, he will, as a rule, be compelled to insert only a general disclaimer, not mentioning the prior patent, but only disclaiming what had been before claimed. Such disclaimer may be ordered to be made in the terms of the claim of a prior patent without a specific reference thereto.<sup>3</sup>

To obtain a specific disclaimer the opponent must

<sup>1</sup> *Re Nahnsen*, 1900, A.-G. 17 R.P.C. 203; *re Lake*, 1889, 6 R.P.C. 550.

<sup>2</sup> *Re Stuart*, 1892, 9 R.P.C. 452.

<sup>3</sup> *Re Newton*, 1900, A.-G. 17 R.P.C. 123.



give evidence of the state of public knowledge in order to get his patent construed as a master patent.<sup>1</sup>

Re-opening  
an opposition.

When an opposition has been disposed of, it can only be reopened under very special circumstances. The mere fact that the opponent wishes to withdraw his opposition is not sufficient.<sup>2</sup>

### *Collusive Opposition.*

It has sometimes happened that an opposition has been entered simply to delay the sealing of a patent, in view of obtaining priority of time in the sealing of foreign patents. The sealing of a patent must be completed within fifteen months from the date of the application, except where the sealing is delayed by an appeal to the law officer, or by opposition to the grant, in which case the law officer may extend the time for sealing. Proceedings in opposition, especially if followed by an appeal to the law officer, may take a considerable time, and if the Comptroller or the law officer has any suspicion that the opposition is not *bona fide*, but is for the purpose of delay, the time for sealing will not be extended unless the applicant can clearly prove the absence of any collusion in the opposition. Such a collusive opposition is an abuse of the process of the Patent Office, and any patent agent who assists in such an abuse will be reported to the Board of Trade,<sup>3</sup> while the law officer will not give directions for sealing the patent out of time, and consequently the patent will be lost.<sup>4</sup>

<sup>1</sup> *Re Southwell & Head*, 1899, A.-G. 16 R.P.C. 361.

<sup>2</sup> *Re Thomas & Prevost*, 1898, S.-G. 15 R.P.C. 257.

<sup>3</sup> A. & B.'s application, 1902, S.-G. 19 R.P.C. 403.

<sup>4</sup> A. & B.'s application, 1902, S.-G. 19 R.P.C. 556

## CHAPTER VII.

### KEEPING UP A PATENT.

WHEN a patent has been sealed the applicant becomes the patentee, and in all matters connected with the patent the patentee is the person concerned.

The Act of 1883 defines the "patentee" as the person, for the time being, entitled to the benefit of the patent. Thus, if a patentee assigns his patent to any person or persons (including corporations), he ceases at once to be patentee, and the assignee or assignees become patentee or patentees in their turn. Now, as any act or thing which may be required to be done in connection with a patent is always left to the patentee, it must be remembered that in all that follows relating to patents the patentee for the time being, and not the original patentee, is referred to under the term "patentee".

Patentee defined.  
Sect. 46.

"(1) The term limited in every patent for the duration thereof shall be fourteen years from its date.

Term of patent.

"(2) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times."

Act, 1883,  
sect. 17.

The fees of £1 and £3, paid with the application and complete specification, and the further fee, if any, paid on sealing under section 1 of the Act of 1902, keep the patent in force until the expiration of the fourth year from the date of the application.

Fees must be paid to keep patent in force.

The fees payable in respect of a patent, and the manner of payment of such fees, are regulated by the

Fees, how fixed.  
Act, 1883,  
sect. 24.

Payment of fees for continuance of patent.  
Rule 66.

See App. A.

Date for payment of renewal fees.

Act, 1883,  
sect. 98.

Payment by post.  
Act, 1883,  
sect. 97.

Enlargement of time for payment.

Board of Trade, and they have been altered from time to time by that authority. The present scale of fees, with the times of payment, will be found at pp. 257, 258.

“ If a patentee intends, at the expiration of the fourth year from the date of his patent, to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.”

The Form J, in the Second Schedule, duly stamped, should be used for the purpose of this payment.

The latest day for payment of a renewal fee in any year is the date for which the patent was sealed, that is, in ordinary cases the date on which the application for the patent was made.

This must be sent to the Patent Office so as to be received before midnight on the day on which the payment falls due, unless that day should fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving. These are called excluded days, and a payment due on an excluded day may be made up to midnight on the day next following such excluded day, or days, if two or more of them occur consecutively.

Payment may be made by prepaid letter through the post, and if so made will be deemed to have been made at the time when the letter containing the same would be delivered in the ordinary course of post. It is thus sufficient to prove that the letter was properly addressed, prepaid and put into the post, even though it should never reach the Patent Office. It will be seen that there is no distinction between inland and foreign post.

If payment be not made in time, the time may be extended for not more than three months on payment of a fine. The Act of 1883 provides as follows:—



“If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment. Sect. 17 (3).”

“Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:— Sub-sect. (4).”

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

“(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.” No damage for infringements during enlargement of time.

“An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.” Patentee must show why fee was not paid in time. Rule 67.

“On due compliance with the terms of rule 66, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively, duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.” Certificate of payment. Rule 68.

Application for enlargement of the time for payment of a renewal fee must be made on Patent Form K, duly stamped. The fees are £3, £7 and £10 for enlargements of one, two or three months respectively. See App. A.

## CHAPTER VIII.

### RIGHTS AND OBLIGATIONS OF PATENTEE.

SUBJECT to the due payment of the fees as they become due, the patent gives protection for fourteen years from the date of application, and the legal position of a patentee that is the owner of a patent, whether a grantee or an assignee, will now be briefly considered.

Range of patent.  
Act, 1883,  
sect. 16.

“Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.”

An English patent does not extend to the Channel Islands, nor to any colony or foreign possession; for these separate patents must be obtained as for foreign countries.

Assignment of patent.  
Act, 1883,  
sect. 36.

“A patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man as effectually as if the patent were originally granted to extend to that place or part only.”

Thus a patent may be assigned for any limited area.<sup>1</sup> And, of course, it may be assigned for the whole of the United Kingdom and Isle of Man.

Assignment must be by deed.

A patent is personal property, but an assignment must be by deed; in order to be effectual it must be duly stamped and registered at the Patent Office; and from the date of such registration the assignee, whether of part or of the whole of the patent, takes, so far as what is assigned to him is concerned, the place of the assignor. If the patent is assigned for any part of the

<sup>1</sup> Actien Gesellschaft v. Temler, 1900, 18 R.P.C. 6.

kingdom the assignee becomes the patentee for that part, with all the rights of a patentee, so far as his district is concerned. Assignee becomes patentee.

When a person sells a patent, he must, of course, warrant that he has a good title to sell it; but he sells it for what it is, and does not by so selling it in any way warrant its validity.<sup>1</sup> The same is true in the case of a contract to sell, so that the vendor can maintain an action for the purchase money, even though the patent turn out to be invalid.<sup>2</sup> A sale may, of course, be subject to a covenant on the part of the vendor to hold himself responsible if the patent should be declared bad, but this is exceptional, and usually *caveat emptor* is the rule.<sup>3</sup> Assignor does not warrant validity.

It is sometimes made a term of a contract for sale that the vendor or assignee should litigate the patent usually to a final judgment or settlement, and in such case the condition is not fulfilled so long as an appeal is pending.

On the sale of a patent the vendor often agrees to assign any improvements and any patents granted to him therefor, and such an agreement is perfectly valid.<sup>4</sup> For forms of assignment, see Appendix B. Future patent rights.

On referring to the form of grant it will be seen that the Crown doth by the letters patent— What is granted to the patentee.

“give and grant unto the said patentee our especial licence, full power, sole privilege, and authority that the said patentee by himself, his agents or licencees, and no others, may at all times hereafter during the terms of years herein mentioned make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee *shall have and enjoy* the whole profit and advantage from time to time accruing by reason of the said invention”.

See p. 7.

<sup>1</sup> *Monforts v. Marsden*, 1895, 12 R.P.C. 266.

<sup>2</sup> *Hall v. Condor*, 1857, 2 C.B.N.S. 22; *Smith v. Scott*, 1859, 6 C.B.N.S. 771; *cf. Cutler v. Bower*, 1847, 11 Q.B. 973.

<sup>3</sup> *Commercial Development Corporation v. Atkins & Applegarth*; *Atkins v. Castner-Kellner Alkali Co.*, 1902, C.A. 19 R.P.C. 93.

<sup>4</sup> *Printing, etc., Co. v. Sampson*, L.R. 19 Eq. 462; *Pneumatic Tyre Co. v. Dunlop*, 1896, 13 R.P.C. 553.



Patentee has a monopoly.

May sell subject to conditions as to user.

but must give notice of restrictions before sale.

Co-owners of a patent.

A co-owner can work invention alone.

This gives to the patentee a monopoly of the invention for the term of the patent, that is, he may, during that time, make and sell the patented article at his own price without any risk of lawful competition, and he may also sell or supply the article subject to any conditions as to the manner or locality in which it may be used.<sup>1</sup>

If the patentee wishes to restrict the manner in which the patented article may be used, clear notice of the restriction must be given to the purchaser before the article is sold; <sup>2</sup> for, when an article is sold without any restriction on the buyer, the sale gives an absolute right as against the seller to use the article in any way the buyer may think fit. This will include using or selling the article in any country where the vendor owns a patent for the article at the time of sale.<sup>3</sup> /

We have seen that a patent may be granted to several persons jointly; and even if originally granted to a single person the grantee may assign it to more than one person, and thus several persons may become co-owners, or, as they may then be called, co-patentees, and this either as joint owners or as owners in common.

When there are several co-owners of a patent, each of them is at liberty, unless he is bound by some agreement to the contrary, to work the patent on his own account; he can manufacture and sell articles made under it without the consent of his co-owners, and, in the absence of any agreement to the contrary, he need not account to them for any profits which he may so make.<sup>4</sup>

Where a patent is partnership property, though granted to one of the partners, neither partner can assign it without the consent of the other; but, on a dissolution,

<sup>1</sup> *Incandescent Gas Light Co. v. Brogden*, 1899, 16 R.P.C. 179.

<sup>2</sup> *Incandescent Gas Light Co. v. Cantelo*, 1895, 12 R.P.C. 262.

<sup>3</sup> *Société Anonyme de Glaces v. Tilghman's Sand Blast Co.*, 1883, 25 Ch. D. 1.

<sup>4</sup> *Steers v. Rogers*, 1893, 11 L. 10 R.P.C. 245.

each will, in the absence of any agreement thereon, be entitled to work under the patent for his own benefit.<sup>1</sup>

Whether the part-owner of a patent can grant licences and receive royalties without accounting to his co-owners for the sums so received, does not appear to have ever been decided.<sup>2</sup> A co-owner can, however, sell a part of his share, and the purchaser will then be entitled to work the patent on his own account. As the price of such a share might be paid in the form of an annuity, and thus might practically amount to a royalty, there really seems no reason why the vendor should not also have power to grant a licence.

Whether joint owner can grant licences on his own account. Joint owner may sell part of his share.

Besides joint owners, there may be persons who, though they are not owners, are entitled to share in the profits of the patent; thus, an owner may assign a share of the profits while remaining sole proprietor. In such a case the assignee of profits can claim an account from a licensee; but the account must be taken in the presence of the assignor and of all persons interested, so as to bind them.<sup>3</sup>

Persons not owners entitled to benefit.

Accounts of licences where joint owners.

The use in the grant of the word "licences" implies that not only may the patentee by himself and his agents work his invention, but that he may license others to do so, and this is often the most valuable right attaching to the possession of a patent. The subject of licences is considered further in chapter ix.

Licences.

The grant continues:—

See p. 8.

"And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents, for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in any wise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof without the consent,

Infringement forbidden.

<sup>1</sup> Kenny's Buttonholing Co. v. Somerville, 26 W.R. 787.

<sup>2</sup> Mathers v. Green, 1865, L.R. 1 Ch. 29.

<sup>3</sup> Bergmann v. Macmillan, 1881, 17 Ch. D. 423.

licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

Liability of infringers.

If any person breaks this royal command he is said to have infringed the patentee's monopoly, and the patentee is entitled to bring against such person an action for infringement to restrain future breaches and to recover damages in respect of past offences. The subject of actions for infringement is dealt with later. If any person threatens to infringe the patentee's monopoly without actually doing so, the patentee may bring an action against such person to prevent him from carrying his threat into execution.<sup>1</sup> For the consideration of what amounts to infringement, see chapter xiii.

Threatened infringements.

Threats.

Besides bringing actions against infringers a patentee may endeavour to prevent infringements taking place by frightening intending infringers with threats of actions, and this right of threatening is often extremely effective, as the costs of a patent action are almost invariably very great for both parties, whichever side may ultimately be successful.

This question is dealt with in chapter xvi.

The Act of 1883 provides that—

Patent binds the Crown. Act, 1883, sect. 27 (1).

"A patent shall have to all intents the like effect as against His Majesty the King, his heirs and successors, as it has against a subject."

But in cases where the Crown is concerned the patentee has not the same freedom as to the terms on which his invention shall be used as he has generally. It will be seen that, by the terms of the grant,—

Patentee must supply articles for public service.

"If the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted, shall determine and become void, notwithstanding anything hereinbefore contained."

<sup>1</sup> *Fearson v. Loe*, 1878, 9 Ch. D. 65.



And the Act of 1883 provides that—

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

Sect. 27 (2).  
Terms on which Crown may use invention.

By the grant of letters patent for an invention the Crown is not in any way bound to admit their validity. If any department should make use of the invention, such use will very probably be without any agreement with the patentee, and the patentee must take some action to obtain any compensation to which he may consider himself entitled.

Crown need not admit validity.

If he believes that any department is using, or intends to use, his invention, he should write to that department pointing out what his patent is for, and inquiring whether they wish to use his invention. He should also ask, in the event of their admitting user of his invention, that they should come to an agreement with him as to the terms upon which they are to use it.

Procedure if Crown infringes.

If they admit the fact of user, and do not dispute the validity of his patent, but fail to come to terms with him, he should apply to the Treasury to settle the terms.

If they deny user, or deny the validity of his patent, he should apply to the Treasury to nominate some person against whom he may bring any action he may be advised to bring, and who shall defend on behalf of the Crown.<sup>1</sup>

Where Crown disputes validity.

This course has been adopted more than once, and has proved very satisfactory, as it enables all matters in dispute to be determined in an ordinary action for infringement; if it were not adopted, the patentee would have to proceed by way of a petition of right.

<sup>1</sup> Maxim-Nordenfelt v. Anderson, 1897, 14 R.P.C. 371; Nobel's Explosives Co. v. Anderson, 1894, 11 R.P.C. 115.

Patentee has full inspection.

The patentee will be allowed full inspection of what the department is actually doing, so as to be able to establish the fact of infringement, if such should really exist.

Procedure when validity is established.

When the validity of the patent and the fact of infringement have been established in any action that may be taken by the patentee against the nominee of the Treasury, he should again apply to the department to agree upon the terms on which the invention shall be used, and, in default of their coming to an agreement with him, he must apply to the Treasury to fix the terms.

The Act of 1883 provides that- -

Use of invention on foreign vessels. Sect. 43.

"A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

Provision must be mutual.

"But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state."

Reasonable requirements of the public.

There is another condition attached to the grant of a patent, which, though never formulated, probably existed at common law, and which now attaches under the provisions of the Patent Act, 1902. The grant of a patent for a monopoly, being an exercise of the royal prerogative, could not be made to the detriment of any of the subjects of the Crown. The grant itself recites that it is made because the Crown is willing to encourage all inventions which may be for the public good, and this recital seems to imply that there has been a representation to the Crown that it will be for the public good to grant the particular patent containing the recital. Now, if the result of granting the monopoly is that the

reasonable requirements of the public, whatever they may be, are not satisfied, it seems clear that the grant is not for the public good, and that, therefore, in making it the Crown has not done what it intended to do, with the result that the grant is bad in law.<sup>1</sup>

Reasonable  
requirements  
of the public.

In order to render the grant bad in law on this ground, it would, perhaps, be necessary to prove that the applicant, when he applied for the grant, intended to use it in a manner contrary to the public good, and the mere user itself might not be sufficient to enable a court of law to find that the Crown had been deceived. Thus, in an action for infringement it might be very difficult for the defendant to succeed on the above ground, and the defence does not appear to have ever been put forward.

The Statute of Monopolies does not allow validity to any monopoly, even one granted to a true and first inventor, which is contrary to law or mischievous to the State by raising prices of commodities at home, or hurt of trade, or which is generally inconvenient; but as this statute is merely declaratory of the common law, it does not carry the matter any further. It will be seen, however, that one of the conditions of the grant itself is that it shall determine and be void, to all intents and purposes, if at any time it shall be made to appear to six or more members of the Privy Council that the grant is prejudicial or inconvenient to the subjects in general.

This condition appears to cover the case of a grant becoming prejudicial or inconvenient by reason of the way in which it is used, as well as that of a grant which was void *ab initio*. By section 2 of the Statute of Monopolies the force and validity of every patent is to be tried by a court of law, and the words in the grant giving power to the Privy Council to determine a patent may have been regarded, perhaps wrongly, as having no effect.

<sup>1</sup> Alton Woods' case, 1600, Coke, 1 Rep. 40b *vide* 46a.



Reasonable  
requirements  
of the public.

The words themselves are a relic of times previous to the Statute of Monopolies, and it does not appear that since the passing of the statute any application has been made to the Privy Council to terminate a grant; but the evil of user for the sole benefit of the foreign producer is one of comparatively modern growth, and there seems no reason why, to remedy this evil in any case, a petition at common law should not lie to the Privy Council to enforce the condition of the grant that it should not be prejudicial or inconvenient to the subjects in general.

There is now a statutory right to apply to the Privy Council, under certain circumstances, to revoke a patent on the ground of misuser, which may be regarded as giving effect to the ancient condition.

Revocation  
for non-user.

The Act of 1883 made provision, by section 22, for the granting, under certain conditions, of a compulsory licence, the Board of Trade being the body charged with carrying this part of the Act into effect. During recent years there have been several applications under that section, some of which have succeeded and some of which have failed. There was, however, no statutory power to revoke a patent where the grant of a licence was an insufficient remedy, though, as the terms on which licences might be granted were not restricted, and only a nominal royalty need have been reserved, the absence of the more summary method of relief was probably not of very great consequence. There was one great objection, however, to the old procedure, namely, that the successful party had to bear its own costs, the Board having no power over costs. Section 22 of the old Act has now been repealed by the Patents Act, 1902, and by the same Act fresh provision has been made for the granting of compulsory licences, the Judicial Committee of the Privy Council being substituted for the Board of Trade as the tribunal, and full power being given to it to deal with the costs of the proceedings.

An applicant for a compulsory licence may now, in

the alternative, ask for the revocation of the patent; but an order for revocation cannot be made within three years from the date of the patent, nor unless the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences.

This question is dealt with further in chapter xxv.

### *Design of Patent Article.*

The fact that an article is the subject-matter of an application for a patent does not affect the registrability of its design.<sup>1</sup>

<sup>1</sup> *Werner v. Gamage*, 1903, 21 R.P.C. 137.

## CHAPTER IX.

### LICENCES.

See p. 8.

THE letters patent provide that the patentee by himself, his agents or licencees, and no others, may, etc., and go on to forbid any person using the invention without the consent, licence or agreement of the patentee in writing under his hand and seal. Later on it is provided that nothing in the grant shall prevent the granting of licences in such manner and for such considerations as they may by law be granted.

Patentee may grant licences.

A licence should be by deed,

but one not under seal will be enforceable.

This shows that the patentee may grant licences to others to use his invention. From the earlier part it would appear that a licence, to be effective, must be in writing under the hand and seal of the patentee; but, on the other hand, the last proviso makes the power of granting licences very considerably wider. When the patentee sells a patented article to any one unconditionally, he thereby impliedly licenses the use of that article, so that it seems clear that in some circumstances even a parol licence can be good. If a licence be granted not under seal, the Courts will enforce it against the licencee, since "to grant a licence not under seal may be a contempt of the Crown, but does not exempt the man to whom it is granted, and who derives a benefit from it, from paying the price of it".<sup>1</sup>

A parol licence is *prima facie* revocable,<sup>2</sup> but the

<sup>1</sup> Per Baron Alderson, *Chanter v. Dewhurst and another*, 1844, 12 M. & W. 823.

<sup>2</sup> *Coppin v. Lloyd*, 1898, Channel, J., 15 R.P.C. 373.



presumption of revocability may be easily rebutted. For instance, the unconditional purchase of a patented machine from the patentee confers on the purchaser the right to use the machine for his own advantage, in any way he may think fit, and the patentee has no power to put an end to this right, which, as has been already said, is tantamount to a *parol licence*.<sup>1</sup>

Correspondence containing the main terms of a licence, forming part of negotiations for a formal licence which was never granted, followed by the payment of royalties, constitutes a binding licence.<sup>2</sup> Licence by correspondence.

A licence under seal may either be delivered, in which case it becomes a deed, or it may be under seal without delivery, in which case it is not a deed,<sup>3</sup> and does not appear to be subject to any stamp duty. An agreement to grant a licence is enforceable in equity, and for many purposes as good as a licence.<sup>4</sup> Licences under seal.

There may be a valid licence to construct a machine without any right of using it when made;<sup>5</sup> and if a patented article be sold with an express limitation as to the manner in which it may be used, any user beyond that so limited will subject the purchaser to the penalties of an infringer.<sup>6</sup> So also a person licensed only to make articles of a particular description becomes an infringer if he goes beyond his licence.<sup>7</sup> Rights of licencees.

Unless specially required by his licence, a licensee is not bound to complete the article made under the licence before selling it; he may leave the purchaser to complete it ready for use.<sup>8</sup>

Unless there be an express provision to the contrary.

<sup>1</sup> *Incandescent Gas Light Co. v. Cantelo*, 1895, 12 R.P.C. 262.

<sup>2</sup> *Tweedale v. Ashworth*, 1896, 13 R.P.C. 522.

<sup>3</sup> *Chanter v. Johnson*, 1845, 14 M. & W. 411.

<sup>4</sup> *Postcard Automatic Supply Co. v. Samuel*, 1889, 6 R.P.C. 562.

<sup>5</sup> *Basset v. Graydon*, 1897, H.L. 14 R.P.C. 701.

<sup>6</sup> *Incandescent Gas Light Co. v. Brogden*, 1899, 16 R.P.C. 179.

<sup>7</sup> *Soci t  Anonyme, etc., v. Midland Lighting Co.*, 1897, 14 R.P.C. 419

<sup>8</sup> *Dunlop Pneumatic Tyre Co. v. Cresswell*, 1901, 18 R.P.C. 473.

a licence to manufacture implies a licence to use or sell, and the purchaser from a licensee has all the privileges of a purchaser, including that of being entitled to resell.<sup>1</sup>

The rights of a licensee under his licence, like those of the patentee under his patent, are local, and where patents for more than one country are owned by the same patentee, the fact that an article is made in one country, under licence from him, does not authorise its sale in any other country for which he may have patent rights. Thus, an English patent is infringed by the sale in England of an article made abroad by a licensee under a foreign patent.<sup>2</sup>

Time for  
granting.

A licence may be granted even before the complete specification is filed.<sup>3</sup>

Licences by  
co-owners.

In the absence of agreement to the contrary, each of two or more co-owners of a patent has power to make use of the invention, for his own advantage, without accounting to the others for any profits he may make thereby.<sup>4</sup> This applies equally in the case of original patentees, who are at law joint owners of the patent,<sup>5</sup> and in that of persons who are owners in common.

Now, if a part-owner of a patent can sell an article made under it, he can impliedly license the purchaser to use the article he has purchased; and if a part-owner of a patent can thus grant an implied licence under it, there seems no reason why he should not be able to grant any other kind of licence without the consent of his co-owners. The grant of a licence by a part-owner of a patent seems, indeed, somewhat analogous to the grant of a lease of mining rights by a part-owner of

<sup>1</sup> *Thomas v. Hunt*, 1864, 17 C.B.N.S. 183.

<sup>2</sup> *Société Anonyme, etc., v. Tilghman*, 1883, C.A. 25 C.D. 1; 53 L.J. Ch. 1.

<sup>3</sup> *Otto v. Singer*, 1890, 7 R.P.C. 7.

<sup>4</sup> *Henderson v. Eason*, 1852, 17 Q.B. 701; 21 L.J. Q.B. 82; but see *Leake v. Cordeaux*, 1856, 4 W.R. 806.

<sup>5</sup> *National Company for the Distribution of Electricity v. Gibbs* [1899], 2 Ch. 289.

mineral property, and such a lease is undoubtedly valid.<sup>1</sup> It is not, however, clear what is the position of the part-owner of a patent who has granted a licence, and of his licences, with regard to any royalties that may have been reserved. It has been suggested, but not decided, that the part-owner would have to account to his co-owners for their shares in such royalties,<sup>2</sup> and, by analogy with the position of co-owners of other property, this would be the case.<sup>3</sup> It may be, however, that the licensee of a part-owner would be liable to account to the co-owners for the profits made by him on the share attributable to such co-owners, of any articles made or sold by him under the patent,<sup>4</sup> paying royalty to his licensor only on the share attributable to him.

A licensee is entitled to have an account of royalties due from him taken in the presence of all parties interested.<sup>5</sup>

A licence may be granted wholly or partly in consideration of a lump sum, but it is more usual to reserve a royalty, either fixed or varying.

Licence usually reserves royalty.

When royalties are reserved, it is generally stipulated that, if at any time the patent shall be declared invalid, the payment of royalties shall cease; but in such a case a declaration of invalidity, that is reversed on appeal, even by consent, does not affect the licence.<sup>6</sup> If this be not stipulated for by the licensee, a declaration of invalidity will not affect the payment of royalty, at least until the patent be revoked; and, in case of the licence being for a fixed term, the licensee may be bound to pay the royalties during that term, notwithstanding the revocation of the patent.<sup>7</sup> A sum paid as royalty under

Effect of declaration of invalidity on royalty.

<sup>1</sup> *Hexter v. Pearce* [1900], 1 Ch. 341.

<sup>2</sup> *Mathers v. Green*, 1865, 1 Ch. 29.

<sup>3</sup> *Henderson v. Eason*, 1852, 17 Q.B. 701; see also 4 Anne, c. 16 s. 27.

<sup>4</sup> *Job v. Potton*, 1875, L.R. 20 Eq. 84; 44 L.J. Ch. 262.

<sup>5</sup> *Bergmann v. Macmillan*, 1881, 17 Ch. D. 423.

<sup>6</sup> *Cheetham v. Nuthall*, 1893, 10 R.P.C. 321.

<sup>7</sup> *African Gold Recovery Co. v. Sheba Gold Mining Co.*, 1897, 14 R.P.C.



an invalid patent, which has not been revoked, cannot be recovered from the patentee<sup>1</sup> unless there has been fraud.<sup>2</sup>

Term of licence.  
Licence by deed, when irrevocable.

Licence for indefinite term is revocable.

Licence does not warrant validity.

Licensors' duty to keep up patent.

Licencee may not dispute validity.

A licence is very usually granted for the remainder of the term of the patent and any extension thereof; and in such a case, if it be under seal, it cannot be revoked by the licensor.<sup>3</sup> It may, however, be for a shorter definite period, or it may be for an indefinite time; in the last case, unless the licence required some definite notice to be given, it would, like a mere parol licence,<sup>4</sup> be revocable at any time by the licensor.<sup>5</sup>

The grant of a licence does not impliedly warrant that the patent is valid, nor that in working under such licence the licencee does not infringe an earlier patent.<sup>6</sup>

There is no implied warranty, on the part of the patentee, in granting a licence, even though it be an exclusive licence, that he will keep up the patent by paying the necessary fees; and if the licencee covenant to pay royalties for a fixed term they will be payable, even though the patent be allowed to lapse.<sup>7</sup> If, however, the licensor has agreed to protect and defend the patent from infringements, and the licence provides for the cessation of royalties in default thereof, the licensor is bound to keep up the patent, and any royalty paid after lapse of the patent, and in ignorance thereof, is recoverable by the licencee as money paid under a mistake of fact.<sup>8</sup>

A licencee under a patent is, during the continuance of the licence, estopped from disputing the validity of the patent, and, while he is paying royalties, is not at

<sup>1</sup> Taylor v. Hare, 1805, 1 W.P.C. 292.

<sup>2</sup> Lovell v. Hicks, 5 L.J. (N.S.), Ex. Eq. 101.

<sup>3</sup> Guyot v. Thomson, 1894, 11 R.P.C. 541.

<sup>4</sup> Coppin v. Lloyd, 1898, 15 R.P.C. 373.

<sup>5</sup> Wood v. Leadbitter, 1845, 13 M. & W. 845; *vide* also Newby v. Harrison, 1861, 1 J. & H. 393.

<sup>6</sup> Monforts v. Marsden, 1895, 12 R.P.C. 266.

<sup>7</sup> Mills v. Carson, 1892, 9 R.P.C. 338, C.A. 10 R.P.C. 9.

<sup>8</sup> Lines v. Usher, 1897, C.A. 14 R.P.C. 206.

liberty to deny the title of his licensors; <sup>1</sup> but he may, if sued for royalties, show that the licensor's right has expired. Thus, though the licensee could not say that the patent had been declared invalid, he could show that it had been revoked or had lapsed through non-payment of fees. <sup>2</sup>

Licensee may show that licensor's right has ceased.

A licensee can also show that what he has been doing is outside his licence and outside the patent, but unless there be an ambiguity in the specification he cannot refer to other specifications in order to limit the scope of the patent. <sup>3</sup>

A licensee can, in the absence of provision to the contrary, at any time repudiate his licence, and from the date of such repudiation the licence terminates; <sup>4</sup> the repudiation dates from the time when the licensee gives notice to the licensor. <sup>5</sup>

Licensee may repudiate licence.

Sometimes a licence is really a lease, with or without an option of purchase, of machinery at a royalty rent or a fixed rent, and the fact that such a lease is called a licence does not entitle the lessee or licensee to escape his liability for the rent by repudiation. <sup>6</sup>

To prevent the licensee repudiating his licence, and thereby becoming able to dispute the validity of the patent, it is usual for the licence to contain a covenant on the part of the licensee not at any time, either directly or indirectly, to dispute the validity of the patent.

Licensee usually covenants not to dispute validity.

<sup>1</sup> *Hills v. Laming*, 1853, 9 Ex. R. 256; *Crossley v. Dixon*, 1863, 10 H.L.C. 304.

<sup>2</sup> *Muirhead v. The Commercial Cable Company*, 1895, C.A. 12 R.P.C. 39; but see *African Gold Recovery Co. v. Sheba Gold Mining Co.*, 1897, 14 R.P.C. 660, where the revocation of a patent was held to be no defence to an action for royalties.

<sup>3</sup> *Jandus Arc Lamp v. Johnson*, 1900, 17 R.P.C. 361.

<sup>4</sup> *Redges v. Mulliner*, 1893, 10 R.P.C. 21; *Crossley v. Dixon*, 1863, 10 H.L.C. 293.

<sup>5</sup> *Redges v. Mulliner*, 1893, 10 R.P.C. 21; *Crossley v. Dixon*, 1863, 10 H.L.C. 293; *Cheetham v. Nuthall*, 1893, 10 R.P.C. 321.

<sup>6</sup> *Cutlan v. Dawson*, 1897, C.A. 14 R.P.C. 249.

Licence is property.

A licence to work under a patent is property within the meaning of the Stamp Act, 1891, section 59; so that a contract for the sale of a licence requires an *ad valorem* stamp.<sup>1</sup> It seems clear that such a licence is property locally situate in the district to which it extends.<sup>2</sup>

Licence is not necessarily assignable.

A licence is not assignable unless it is made so in distinct terms, and it is usual to make a licence to work under a patent assignable only with the business of the licensee, and to bind the licensee not to part with his business without compelling the purchaser to accept a transfer of the licence.

Licence to company promoter.

Sometimes a licence is granted for the purpose of being transferred to a company to be promoted by the licensee; but such a grant does not give rise to any privity of contract between the licensor and the company when the licence has not been actually transferred to the latter, even though the company has worked under the licence,<sup>3</sup> and a better method of procedure is one which the author believes he originated, by which the patentee agrees with the promoter to grant a licence to the company when formed, and appoints him his attorney to execute such licence. (*Vide* Form X, App. B.)

If a patentee accepts royalties from the assignee of a licensee, he cannot afterwards dispute the validity of the assignment.<sup>4</sup>

Licence to use several patents.

A licence is often made to extend to more than one patent, and in such a case the royalties are usually made payable until the expiration of the term of the latest patent; in such a case the royalty must be paid without deduction during the whole period, even though the principal patents have expired.<sup>5</sup>

<sup>1</sup> *Smelting Co. of Australia v. Commissioners of Inland Revenue*, C.A. [1897], 1 Q.B. 175.

<sup>2</sup> *Inland Revenue Commissioners v. Müller*, H.L. [1901], A.C. 217, but see 2 above.

<sup>3</sup> *Bagot Pneumatic v. Clipper*, 1901, C.A. 19 R.P.C. 69.

<sup>4</sup> *Kawson v. Donald Macpherson & Co.*, 1897, 14 R.P.C. 696.

<sup>5</sup> *Siemens v. Taylor*, 1892, 9 R.P.C. 393.



In an old case, where there was a licence granted to use six patents on payment of an annuity of £400, it was held that the consideration was entire, and if it failed partially, by reason of one of the patents being invalid, it failed entirely, and no action could be maintained for the money;<sup>1</sup> so that it is well to be careful in framing a licence to use more than one patent to avoid the risk of this occurring.

If a patentee grants an exclusive licence for the remainder of the term of the patent, without reserving any royalty, he has parted with his entire interest, and the licensee can probably claim to be registered as owner and to sue in his own name; but, where an exclusive licence has been granted for a limited area and a limited time, the licensee cannot sue without joining the licensor.<sup>2</sup>

In granting an exclusive licence it is usual to give the licensee the right to bring actions in the patentee's name, upon indemnifying him against the costs; it is possible that an exclusive licensee could bring an action in his own name, though the point does not appear to have ever been decided.<sup>3</sup> It has, however, been held that an exclusive licence is not a conveyance within the meaning of section 7 of the Conveyancing Act, 1881.<sup>4</sup>

An assignee of a patent, in consideration of a royalty, is not impliedly bound to manufacture or to renew the patent.<sup>5</sup>

A full licence to use and exercise an invention enables the licensee to do anything he likes under the patent. Thus, he may employ an independent agent to manufacture for him articles that he wishes to sell under the licence.<sup>6</sup>

<sup>1</sup> *Chanter v. Leese*, 1839, 5 M. & W. 701.

<sup>2</sup> *Heap v. Hartley*, 1889, C.A. 6 R.P.C. 495, 42 Ch. D. 461.

<sup>3</sup> *Renard v. Levinstein*, 1865, 2 H. & M. 629.

<sup>4</sup> *Guyot v. Thomson*, 1894, 11 R.P.C. 554.

<sup>5</sup> *Railway Electrical Appliances, in re*, 1876, 3 Ch. D. 597.

<sup>6</sup> *Dunlop Pneumatic Tyre Co. v. North British Rubber Co.*, 1904, C.A. 21 R.P.C. 161.

For forms of licences, see Appendix B.

Registration  
of licence.  
Rule 63.

“ An attested copy of every licence granted under a patent, or of any other document purporting to affect the proprietorship of a patent, shall be left at the Patent Office with a request on Form M that a notification thereof may be entered in the register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall, at the same time, be produced and left at the Patent Office, if required, for further verification.”

## CHAPTER X.

### AMENDMENT OF SPECIFICATIONS.

It may happen that, after filing his complete specification, the applicant discovers that some clerical error has been made which it would be advisable to correct. Correction of clerical errors.

In such a case he should apply to the Comptroller, upon Patent Form P (bearing a stamp of £1 or 5s., See App. A. according to whether the patent has or has not been sealed).

The application must be accompanied by a certified copy of the specification with the correction made in red ink.

It may be, however, that after the complete specification is filed, the applicant, or, if the patent has been sealed, the patentee, may discover that there is something in the specification which renders the patent invalid, or, at any rate, which it would be safer to alter. Invalidity of patent may be cured by amendment. For instance, he may find that his claims cover something which, without his knowledge, existed before the date of his patent, and it may be possible to alter the specification and so narrow the claim as to exclude that which would, unless the specification were amended, be an anticipation of the invention. When claim covers something old. Although the applicant for a patent is expected to examine into what has gone before, so as not to claim anything that is old, there is provision made for enabling a patentee, at any time, to so amend the specification as to make the patent, if possible, a valid one.

The original specification may be capable of two con-



Ambiguity  
may be  
cleared up,

structions, and in such a case the patentee may limit it by amendment to one of these;<sup>1</sup> but he may not amend solely to turn an insufficient description into a sufficient description, nor may he introduce knowledge subsequent in date to the patent.<sup>2</sup>

Act, 1883,  
sect. 18 (1).

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

Amendment  
must not en-  
large claim.  
Act, 1883,  
sect. 18 (8).

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

It used to be the custom to allow an amendment when there was any doubt as to its effect,<sup>3</sup> but now an amendment will be closely examined to see that it does not infringe the above rule, and, if it would make the claim wider than in the original specification, the amendment will be refused.<sup>4</sup>

The amendment must not make the patent extend to anything which was not discovered at the date of the original specification.<sup>5</sup> Nor must the patentee strike out an original claim for a complete combination and insert a new claim for a subordinate part only.<sup>6</sup>

#### *Amendment during Patent Action.*

Act, 1883,  
sect. 18 (10),  
as amended  
Act, 1888,  
sect. 5.

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

A pending action for threats does not interfere with the amendment of a specification.<sup>7</sup>

<sup>1</sup> *Re Rylands*, 1888, 5 R.P.C. 665.

<sup>2</sup> *Re Johnson*, 1896, 13 R.P.C. 659.

<sup>3</sup> *Re Lake*, 1887, Gr. A.P.C. 16.

<sup>4</sup> *Re Parkinson*, 1896, S.-G. 13 R.P.C. 509.

<sup>5</sup> *Re Beck & Justice*, 1886, Gr. A.P.C. 10.

<sup>6</sup> *Re Serrell*, 1889, 6 R.P.C. 101.

<sup>7</sup> *Re Hall*, 1888, 21 Q.B.D. 137.

The action or petition must be pending at the time when the application for leave to amend is made;<sup>1</sup> but an action withdrawn from the list and standing over generally is pending. A pending appeal is not a pending action.<sup>2</sup>

In the case of a patent being held bad in a petition for revocation, the Court will delay the registration of the order for a limited time, in order that the patentee may amend his specification, if this would save the patent; and, in the case of such amendment being made, the order will not be registered.<sup>3</sup>

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

Leave to apply to amend may be given more than once in the same action.<sup>4</sup>

Amendment, when an action is pending, is limited to disclaimer.<sup>5</sup>

Leave to apply to amend in an action for infringement may be made conditional, on abstaining from the use of threats, until the question of amendment is disposed of,<sup>6</sup> or it may be made a condition that the amended specification should not be used at the trial,<sup>7</sup> though the latter condition would generally necessitate the discontinuance of the action, and is unusual. Leave is usually granted on the terms that the plaintiff should,

<sup>1</sup> *Woolfe v. Automatic Picture Gallery Co.*, 1902, 19 R.P.C. 425; C.A. 20 R.P.C. 177; *Brooks v. Lycett*, 1904, 1 Ch. 512.

<sup>2</sup> *Cropper v. Smith*, 1884, 28 Ch. D. 151.

<sup>3</sup> *Deeley v. Perkes*, 1896, 11 L. [1896], A.C. 496, 13 R.P.C. 581.

<sup>4</sup> *Chatwood's Patent Safe v. Mercantile Bank of Lancashire*, 1900, 17 R.P.C. 23.

<sup>5</sup> *In re Owen's patent*, 1898 [1899], 1 Ch. 157; 15 R.P.C. 755.

<sup>6</sup> *Chatwood's Patent Safe v. Ratner Safe Co.*, 1899, 16 R.P.C. 449.

<sup>7</sup> *Bray v. Gardner*, 1887, C.A. 4 R.P.C. 40.

in any event, pay the costs of the application and the costs of the action up to, and occasioned by, the disclaimer, except only so far as the proceedings might be utilised for the purposes of the amended action; the plaintiff undertaking to amend his pleadings, so as to confine the action to the specification as amended, or to consent to the action being dismissed with costs.<sup>1</sup>

The plaintiff may be required to waive all claim to damages for infringement prior to the amendment,<sup>2</sup> and in special circumstances, this may be extended to the user after amendment of machines previously made though this is unusual.<sup>3</sup>

The terms on which application for leave to amend should be allowed,<sup>4</sup> and whether it should be allowed at all,<sup>5</sup> are in the discretion of the judge, and will not be interfered with by the Court of Appeal, unless that Court is of opinion that such discretion has been exercised on a wrong principle.<sup>6</sup>

In a petition for revocation, leave to apply to amend by disclaimer will be granted on the terms that the respondent should pay the costs of the application for leave to apply, and the costs of the petition down to the date of such application, except so far as what has been already done may be utilised in subsequent proceedings; and should the petitioner, after amendment, not con-

Terms of amendment pending petition.

<sup>1</sup> Haslam Foundry and Engineering Co. v. Goodfellow, 1888, 37 Ch. D. 118; see also Fusee Vesta Co. v. Bryant & May, 1887, 34 Ch. D. 458, 4 R.P.C. 71.

<sup>2</sup> Gaulard v. Lindsay, 1888, 38 Ch. D. 38; Lang v. Whitecross Co., 1889, 62 L.T. 119, affirmed H.L. 89 L.T.J. 351.

<sup>3</sup> Ludington Cigarette Machine Co. v. Baron Cigarette Machine Co., 1899, 17 R.P.C. 25, C.A. 214; cf. Deeley v. Perkes, 1896, H.L. [1896], A.C. 496; 13 R.P.C. 581; Jandus Arc Lamp v. Arc Lamp, 1903, 21 R.P.C. 115.

<sup>4</sup> New Conveyor Co. v. Edinburgh Gas Commrs., 1903 (Scotch), 21 R.P.C. 1, 147.

<sup>5</sup> Lang v. Whitecross Co., 62 L.T. 112, App. H.L. 89, L.T.J. 351.

<sup>6</sup> Yates v. Armstrong, 1898, C.A. 77, L.T. 267; Allison's patent *in re* 1900, C.A. 17 R.P.C. 513; Ludington Cigarette Machine Co. v. Baron Cigarette Machine Co., *In re* Pitt's patent, 1898, H.L. 17 R.P.C. 745.



time, that the respondent should pay all the petitioner's costs.<sup>1</sup>

An application for leave to apply to amend is usually made by summons, but, in the Chancery Division, may be by motion.<sup>2</sup>

"A request for leave to amend a specification must be signed by the applicant, and shall contain an address for service in the United Kingdom. When not made in pursuance of an order of the Court, or a judge, the request must, where a patent has been sealed, also contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. The request must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct."

Request to amend, how made.  
Rule 42.

The application for leave to amend must be made on Patent Form F, which must bear a stamp for £1 10s. or £3, according as the application be made before or after the sealing of the patent. See App. A.

An application for leave to amend a complete specification, before acceptance, must be made in this way.<sup>3</sup>

"Where a request for leave to amend is made in pursuance of an order of the Court or a judge, an office copy of the order shall be left with the request at the Patent Office."

Request during action.  
Rule 43.

"At any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment. Where such notice is given, the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer."

Opposition to amendment.  
Act, 1883, sect. 18 (2).  
Notice to patentee.

<sup>1</sup>*In re* Chatwood's patent, 1899, 16 R.P.C. 370; *In re* Gaulard & Gibbs' patent, 1887, 57 L.J. Ch. 209; see also *In re* Delwick's patent [1896], 2 Ch. 705.

<sup>2</sup>*In re* Delwick's patent [1896], 2 Ch. 705.

<sup>3</sup>*Re* Jones, Gr. P.C. 313.

Notice of  
opposition.  
Rule 44.  
See App. A.

“ A notice of opposition to the amendment shall be on Form G, and shall state the ground, or grounds, on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.”

Copy for the  
applicant.

A notice of opposition to an amendment must bear an impressed stamp for 10s.

If the notice of opposition be not signed by the opponent, the Comptroller may allow him to sign it subsequently.

Opponent's  
evidence.  
Rule 45.

“ Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and, on so leaving, shall deliver to the applicant copies thereof.”

Further  
proceedings.  
Rule 46.

“ Upon such declarations being left, and such copies being delivered, the provisions of Rules 37, 40 and 41 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.”

For these, see pp. 82, 83.

Applicant's  
evidence if  
opponent does  
not leave  
statutory  
declarations.  
Rule 47.

“ If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do), within two-months from the date of the first advertisement of the application for leave to amend, leave at the Patent Office statutory declarations in support of his application, and, on so leaving, shall deliver to the opponent copies thereof.”

Care should be taken to confine the declarations to relevant matter.<sup>1</sup>

The filing of declarations is optional, and the oppon-

<sup>1</sup> Official notice by Comptroller, 19th Jan., 1895, *re* Brand, 1895, S.-G. 12 R.P.C. 102.

ent may be able to rely on the reasons which he has given in his notice of opposition.

The rules regarding the forms of such declarations are given on pp. 81 *et seq.*

“ Upon such declarations being left, and such copies being delivered, the provisions of Rules 39, 40 and 41 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.”

Further proceedings.  
Rule 48.

For these, see p. 83.

The decision of the Comptroller is subject to an appeal to the law officer, which must be made according to the law officers' rules (see next chapter).

It is provided that—

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

Act, 1883,  
sect. 18 (4).  
Law officer to hear parties.

There does not appear to have been any case in which the law officer has refused to hear the opponent. The decision of the law officer is final on any question coming before him in proceedings for amendment of a specification.

Law officer's decision final.

Special terms as to actions for infringement are imposed only in very special cases.<sup>1</sup>

“ Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether and subject to what conditions (if any) the amendment ought to be allowed.”

Act, 1883,  
sect. 18 (5).  
When opponent does not appear.

“ Before exercising any discretionary power given to the Comptroller adversely to the applicant for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.”

Act, 1883,  
sect. 94.  
Exercise of discretionary power by Comptroller.  
Rule 28.

“ Within five days from the date when such notice would be delivered in the ordinary course of post, or such

Notice by applicant.  
Rule 29.

<sup>1</sup> Allison's patent, Finlay, S.-G., 1898, 13 R.P.C. 408; Pitt's patent, Carson, S.-G., 1901, 18 R.P.C. 478.



longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.”

Comptroller may require statements, etc.  
Rule 30.

“ Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.”

Decision to be notified to parties.  
Rule 31.

“ The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby.”

Act, 1883, sect. 18 (6).  
Refusal of leave to amend.  
Sect. 18 (7).

“ When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.”

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

In case of an appeal against the Comptroller, the Comptroller neither gives nor receives costs, whatever the result, except in very special circumstances.<sup>1</sup>

If an application to amend be refused by the Comptroller, and not appealed against, no appeal will be allowed from a similar refusal, made on a second application, for substantially the same amendment.<sup>2</sup>

Requirements when leave is given to amend.  
Rule 49.

“ Where leave to amend is given, the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings, as amended, to be prepared in accordance with Rules 17 to 23.”<sup>3</sup>

Advertisement of amendment.  
Rule 50.

“ Every amendment of a specification shall be advertised forthwith by the Comptroller, in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct.”

<sup>1</sup> *Re Lake*, 1887, Gr. A.P.C. 16.

<sup>2</sup> *Re Arnold*, 1887, Gr. A.P.C. 5.

<sup>3</sup> See pp. 42 *et seq.*

“Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.”

Act, 1883,  
sect. 18 (9).  
Leave to  
amend con-  
clusive of right  
to amend.

When a patent has been amended, the specification, as amended, takes the place for all purposes of the original specification; the latter can only be looked at (if at all) to assist in construing the amended specification, and the validity of the patent is not affected by the fact that the amendment makes the claim wider than it was originally, except in case of fraud.<sup>1</sup>

So far as the bringing of actions is concerned, amendment is complete as soon as conditional leave to amend has been obtained, and the condition has been assented to by the patentee.<sup>2</sup>

If no conditions are imposed, it would appear that the amendment is complete, for this purpose, as soon as leave to amend is given.

An amendment made without leave of the Court while an action or petition is pending is null and void.<sup>3</sup>

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

Act, 1883,  
sect. 20.  
Effect of  
amendment  
on damages.

When a patentee, suing on an amended specification, desires to claim damages for infringement prior to the date of amendment, he should do so in his pleadings and give evidence that he is entitled to such damages.<sup>4</sup>

<sup>1</sup> *Moser v. Marsden*, 1896, H.L. 13 R.P.C. 24.

<sup>2</sup> *Andrew & Co. v. Crossley Brothers*, 1891, C.A. [1892], 1 Ch. 492; 9 R.P.C. 165.

<sup>3</sup> *Brooks v. Lycett*, 1904, 1 Ch. 513.

<sup>4</sup> *Boyle & Co. v. Kane & Pattison*, 1901, 18 R.P.C. 325.

## CHAPTER XI.

### PROCEEDINGS BEFORE LAW OFFICERS.

It has been seen that the decision of the Comptroller is always subject to an appeal to the law officer, that is, to the Attorney- or Solicitor-General.

Decision of  
law officer  
is final.

The decision of the law officer, whether he be Attorney-General or Solicitor-General, is final on every matter before him; and he is not a Court to which a prohibition can go, and there is no means of testing the correctness of his decision,<sup>1</sup> which, however, cannot be referred to in Court as an authority on any question decided by him.<sup>2</sup>

Notice of  
appeal.  
L.O.R. 1.

“When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within fourteen days from the date of the decision appealed against file in the Patent Office a notice of such his intention.”

See App. A.

The notice of intention to appeal must be on Patent Form T, which must bear a stamp for £3, and must be sent to the Comptroller at the Patent Office.

The notice of appeal need not be signed by the appellant himself; signature by his authorised agent is sufficient.<sup>3</sup>

The fourteen days run, in case of leave being given to amend, from the day of forwarding to the opponent a copy of the amendment as approved by the Comptroller.<sup>4</sup>

<sup>1</sup> *Re Van Gelder*, 1889, 6 R.P.C. 28.

<sup>2</sup> *Siddell v. Vickers*, 1888, 5 R.P.C. 436.

<sup>3</sup> *Re Anderson & McKinnell*, 1887, Gr. A.P.C. 23.

<sup>4</sup> *Re Chandler*, 1886, Gr. 270.



"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." L.O.R. 5.

When notice has been given, just before the fourteen days expire, and the party receiving it desires to give a counter notice, the time for giving it will be extended.<sup>1</sup>

"Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so, what part of such decision." Form of notice. L.O.R. 2.

When notice of appeal is given as to part only of the Comptroller's decision, and the party receiving such notice desires to question other parts, he must give a counter notice.<sup>2</sup> Law officer will only hear arguments on points mentioned in notice.

The law officer will hear the parties only on the points raised by the notice or counter notice,<sup>3</sup> and, except on such points, no alteration will be made in the Comptroller's decision on the application of one party without the consent of the other.<sup>4</sup>

"A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officer's clerk at room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant." Notice of appeal, to whom sent. L.O.R. 3.

When the appeal is by an opponent, he need not give notice to the applicant,<sup>5</sup> but the law officer provides for giving such notice.<sup>6</sup>

"Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officer's clerk all the papers relating to the matter of the application in respect of which such appeal is made." L.O.R. 4.

"Seven days' notice, at least, of the time and place appointed for the hearing of any appeal shall be given by the law officer's clerk, unless special leave be given by the law officer that any shorter notice be given." Notice of hearing. L.O.R. 6.

<sup>1</sup> *Re Bairstow*, 1888, 5 R.P.C. 289.

<sup>2</sup> *Ibid.*

<sup>3</sup> *Ibid.*

<sup>4</sup> *Hall's patent*, 1888, 5 R.P.C. 283.

<sup>5</sup> *Re Anderson & McKinnell*, 1887, Gr. A.P.C. 23.

<sup>6</sup> *Re Hill*, 1888, 5 R.P.C. 601.

L.O.R. 7.

“Such notice shall in all cases be given to the Comptroller and the appellant; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.”

Whom law officer must hear.

Act, 1883, sects. 11 (3) and 18 (4).

Sects. 9 (3) and 18 (7).

In case of opposition to either the grant of a patent or the amendment of a specification, the law officer is only required to hear the opponent if he is, in the opinion of the law officer, a person entitled to be heard in opposition; but he must, in any case, hear the applicant, and, when the Comptroller is respondent, he also is entitled to be heard.

Appellant not appearing

If the appellant does not appear at the hearing, the appeal will be dismissed with costs.<sup>1</sup>

or withdrawing.

If the appeal be withdrawn, without sufficient reason being assigned for the withdrawal, the appellant will have to pay the costs.<sup>2</sup>

Respondent not appearing.

If the respondent does not appear, but explains his non-appearance to the satisfaction of the law officer, another day will be appointed for hearing the appeal, and the respondent will be ordered to pay the costs of the day.<sup>3</sup>

In case of opposition to the grant of a patent—

Law officer may employ expert.

Act, 1883, sect. 11 (4).

Evidence on appeal.

L.O.R. 8.

“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”.

“The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.”

Evidence before Comptroller is documentary.

The evidence before the Comptroller is entirely documentary, and, therefore, in a complicated case, the proceedings before him are somewhat unsatisfactory; the

<sup>1</sup> *Re Dietz*, 1889, 6 R.P.C. 297.

<sup>2</sup> *Re Knight*, 1887, Gr. A.P.C. 35.

<sup>3</sup> *Re Ainsworth*, 1885, Gr. 269.

real contest being an appeal to the law officer, who may examine witnesses on oath and administer oaths for that purpose.

Law officers may take *viva voce* evidence. Act, 1883, sect. 38.

"The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer there is good ground for not making such order."

Attendance of witnesses may be ordered. L.O.R. 9.

"Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money."

L.O.R. 10.

The Comptroller has no power to award any costs to either party, directly or indirectly; but the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court (*i.e.*, of the High Court of Justice).

No costs before Comptroller. Law officer may give costs. Act, 1883, sect. 38.

"Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs; and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained."

Law officer may fix amount of costs. L.O.R. 11.

As a rule the law officer fixes the costs; the amount awarded is quite an arbitrary one, often five guineas, but sometimes double that sum, or even more, will be awarded when the evidence is of an expensive kind.

A note of the fees paid on an appeal should be handed in by the appellant.<sup>1</sup>

"If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act (*i.e.*, to make the order a rule of the Court)."

Recovery of costs. L.O.R. 12. Act, 1883, sect. 38.

"All documentary evidence required or allowed by the law officer to be filed shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary."

Form of documentary evidence. L.O.R. 13.

"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."

Fresh evidence. Rule 39.

<sup>1</sup>Sielaff's application, 1888, 5 R.P.C. 487.



Notice to  
leave fresh  
evidence.

Rule 40.

Notices to law  
officer's clerk.  
L.O.R. 14.

"Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application."

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

**The Act of 1883 provides that—**

Sect. 38.

"The law officers may from time to time make, alter and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act."

The rules referred to above were made under this provision.

## CHAPTER XII.

### PROFESSIONAL ASSISTANCE IN PATENT MATTERS.

To aid intending applicants for patents, and to enable them to make their applications in proper form, the Patent Office publishes a circular of information which will be found very useful. This circular is supplied gratis at the Patent Office. Patent Office Circular.

A careful examination of this, and of a few specifications, will often be sufficient to enable an intelligent person to make an application for a patent, on a provisional specification, without professional aid, without making any serious mistakes, though, even at this stage, skilled assistance should not lightly be dispensed with. Professional assistance advisable but not indispensable.

The choice of a suitable title and the drafting of a provisional specification do not generally present any great difficulty, and, provided the title is applicable to the invention and not too wide, and the provisional specification gives a fair outline of the invention, sufficiently general to cover all probable improvements, the applicant is not likely to go far wrong. When, however, it becomes a question of the complete specification and its claims, the greatest care and skill are required, and, as a rule, it is advisable for the applicant to obtain professional assistance. Title must be applicable to invention. Complete specification requires great care.

Before settling the claims it is very important to know what has been done before in the same connection, so as to be able to make the claims cover all that is really new and nothing that is old. For this purpose it is often advisable to supplement the applicant's know- Knowledge of what has gone before is essential.

Searches.

ledge by making a search through the specifications of previous patents. Such a search involves considerable expenditure of time, and the applicant may not feel prepared to spend several days at the Patent Office, or elsewhere, on work of this description; besides which, one who is accustomed to the work is more likely to carry it out effectively than one who has had little or no experience in such matters.

Patent agents.

Such work should, therefore, be entrusted to a patent agent, of whom there are many in London and other places; their business consists in conducting all kinds of work, other than that which appertains to solicitors, in connection with patents. Formerly any person, however ignorant of patent business, could style himself a patent agent; but the Act of 1888 provided that---

Who may call themselves patent agents. Sect. 1 (1).

"A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent."

Penalty for using the name patent agent improperly. Sub-sect. 4.

"If any person describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds."

Any one may act as agent in patent matters, but employment of patent agent is advisable.

Providing he does not describe himself as being a patent agent, any person can act as agent for another in patent business; and the signing of a specification as agent for the applicant is not sufficient to render him liable to the fine;<sup>1</sup> but it would be certainly unwise, in ordinary circumstances, for an applicant to employ as his agent any person whose name was not on the register.

A list of registered patent agents is published by Messrs. Eyre & Spottiswoode, East Harding Street, Fleet Street, E.C., and may be obtained through any bookseller, or from them direct, for 1s. 1d., post free.

"With the exception of the signing of the following

<sup>1</sup>Graham v. Fanta, 1892, Div. Ct. 9 R.P.C. 164.



documents, namely, applications for patents, requests for leave to amend applications, specifications or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, notices of abandonment of or of intention not to proceed with applications, surrenders of letters patent, and petitions for compulsory licence and revocation of patent, all communications to the Comptroller under the said Acts and these Rules may be signed by, and all attendances upon the Comptroller may be made by or through an agent, duly authorised, to the satisfaction of the Comptroller, and, if he so require it, resident in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents, kept under the provisions of the Patents, Designs and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent or other person.”

A patent agent cannot undertake the conduct of an action for infringement, or for restraining threats, or of a petition for revocation or prolongation, which must be conducted by the party in person, or through a solicitor, like any other legal proceeding; but, in all proceedings before the Comptroller and the law officers, it is unusual to employ a solicitor as such, and his place is generally taken by a patent agent, though, as has been said, the Acts and Rules do not require that the person who acts as agent for an applicant, patentee or opponent should be a patent agent.

At a hearing before the Comptroller, or a law officer, the parties may be represented by an agent or by counsel,

Agency.  
Rule 81.

Patent agent  
cannot do  
solicitor's  
work.

Counsel may  
be employed.

and, in such proceedings, counsel take their instructions from the agent without the intervention of a solicitor.

Non-contentious business.

Besides the contentious proceedings in which professional assistance is generally absolutely necessary, there are many matters in which it is inadvisable for a patentee to trust to his own unaided powers. For settling the complete specification, amendments or licences, professional aid is generally essential. Many a patent, which might have been of great value, has been ruined by bad drafting, and the complete specification should, if possible, have the finishing touches given by a good patent agent or experienced counsel.

Proceedings on sale of a patent.

When a patent is sold, the vendor does not usually in any way warrant its validity, and the intending purchaser usually requires some search to be made by a qualified patent agent to see if the patent has been anticipated, and frequently requires the result of any such search to be laid before counsel, and makes the purchase conditional on obtaining a favourable opinion thereon.

Counsel's opinion usually required by purchaser.

Value of official searches.

The provisions for an official search, in the case of applications made after the prescribed date, may somewhat affect the necessity for a search through British specifications, in the case of patents granted thereon; but the need for a search through foreign specifications will still remain, and purchasers may, for a time at least, be inclined to doubt the value of the official search, and to require a further search to be made, even through British specifications.

## CHAPTER XIII.

### INFRINGEMENT.

LETTERS patent confer upon the patentee, his agents and licencees, the sole right to make, use, exercise and vend the invention in the United Kingdom and the Isle of Man in such manner as to him or them may seem meet.

If any person, without the licence of the patentee, makes, uses, exercises or vends the invention within the prescribed limits, such person is said to have infringed the letters patent; and the patentee is entitled to bring an action for infringement against him. In such an action, unless the patent is held bad, if he prove that the infringement has taken place, the patentee will be entitled to judgment against the infringer for an injunction to restrain any future infringements, for an account of the profits which the infringer has made by his wrongful acts, or, in the alternative, for an inquiry into the damages which the patentee has suffered by the infringements, and, lastly, for an order requiring the delivery up upon oath to the patentee or the destruction of all the infringing articles which may be at the time in the possession of the infringer.

The patentee is not obliged to wait until his patent has been actually infringed; if any person threatens to do what the patentee considers will be an infringement of his patent, he can bring an action to restrain the threatened infringement; <sup>1</sup> of course, in such a case there

<sup>1</sup> *Frearson v. Loe*, 1878, 9 Ch. D. 65; *Incandescent Gas Light v. De Mare*, 1896, C.A. 13 R.P.C. 301.



is no question of damages, and the only relief possible is an injunction. In order to succeed, the patentee must show that his patent is valid, and that the defendant has threatened, and continues to threaten, to do something which would actually infringe the patent.

Generally better to wait for infringement to take place.

Except when it is very clear that what is threatened will be an infringement, it is safer to wait until the infringement takes place, and, in the meantime, to threaten to proceed against infringers (see *Threats*, p. 166).

What constitutes infringement.

The question of what constitutes an infringement is one of great importance, not only to the patentee, but also to the public; since the latter are entitled to know what they may do without infringing and so becoming liable to the severe penalties inflicted on infringers.

Construction of specification.

The first question that arises in respect of any alleged infringement is, "Does the article or process, alleged to be an infringement, come within the scope of the invention described and claimed in the complete specification?" since this alone is protected by the patent. This depends on the meaning of the specification, and this is a matter of law for the consideration of the Court. When, however, the meaning of the specification is ascertained, the question of infringement becomes one of fact, and, if the case be tried by jury, will be left to them to answer.<sup>1</sup>

Is the user complained of an infringement.

A second question which may arise is, whether, granted that the article or process would otherwise be an infringement, the facts of the case are such that what the defendant did was done under an implied licence from the patentee, and, therefore, did not amount to an infringement. In such a case there may, of course, be questions of what actually happened, but, when these are answered, the question of infringement becomes a matter of law for the Court to decide.

The question as to whether the alleged infringement does or does not come within the scope of the invention

<sup>1</sup> *Lucas v. Miller*, 1900, 17 R.P.C. 165.

protected by a patent is sometimes one of considerable difficulty, even after the meaning of the complete specification is ascertained. Where the infringer has simply taken the invention as described no difficulty arises, but this is not by any means usual. More often, at least in what may be termed wilful cases, the infringer, starting with the invention described in the specification, disguises it by making slight alterations here and there, by using something which is different from what is described in the specification, but which will produce the same effect, or by adding or subtracting something, perhaps in itself of considerable importance, so that at first sight what he does may appear to be quite different from what is described in the specification, and only after careful examination, and with full knowledge of all the particulars, does the fact of infringement become clear.

Does alleged infringement come within scope of patent.

Effect of alterations from invention described in specification.

Perhaps the simplest alteration that an infringer can make in an invention, described by a specification, is to substitute for the method described an equivalent method which will produce the same result. This, according as the invention is mechanical or chemical, is called using a mechanical or chemical equivalent. In his specification an applicant is not bound to describe every method of carrying out his invention, and if he describes one practical method, this will be sufficient to prevent others from using anything which, at the date of his specification, was known to be an equivalent. A patent will not, however, protect the patentee against the use of any method which, though really equivalent to that described in the specification, was not, at the date of the specification, known to be an equivalent.

Substitution of an equivalent.

What is an equivalent.

“The specification must be read as persons acquainted with the subject would read it at the time it was made; and, if it could be construed as containing any chemical equivalents, it must be such as are known to such persons at that time; but those which are not known at the time as equivalents, and afterwards are

Equivalent must be known at date of patent.

found to answer the same purpose, are not included in the specification. They are new inventions.”<sup>1</sup>

Substitution of equivalent in combination may not be an infringement.

It is not, however, in every case that the introduction of an equivalent fails to secure immunity from infringement. In the case of a patent for a combination, all depends on whether the substitution takes place in an important or unimportant part. As a general rule, a patent for a combination protects only the actual thing described, and is not infringed by the use of a different combination, even though the same results are produced in similar ways by each. Thus, “where there is a well-known machine, and there is an improvement in a part of that machinery for effecting the old object, though in a better way, you must confine the patentee to the improvement which he claims in effecting that particular object. It does not come to the question whether this is or is not a mechanical equivalent; it is, ‘Have you really taken in substance that which was the invention of the plaintiff, protected by his patent?’”<sup>2</sup>

But this is not always true.

Even in the case of a patent for a combination the question of equivalents may be of importance. “A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact, every patent, or almost every patent, is a patent for a new combination. The patent is for the entire combination; but there is, or may be, an essence or substance of the invention underlying the mere accident of form, and that invention, like every other invention, may be appropriated by a theft in a disguised or mutilated form; and it will be in every case a question of fact whether the alleged piracy is the same in substance and in fact, or is a substantially new or different combination.”<sup>3</sup> From this it

<sup>1</sup> *Heath v. Unwin*, 1855, H.L. 2 W.P.C. 314.

<sup>2</sup> *Boyd v. Horrocks*, 1889, C.A. 6 R.P.C. 159; see also *Brown v. Jackson* [1895], A.C. 446. *Consol. Car. Heating Co. v. Caine*, 1903, P.C., 20 R.P.C. 745.

<sup>3</sup> *Clark v. Adie*, 1875, L.R. 10 Ch. 675.



follows that a patent for a combination may be infringed by taking the essential part with mechanical equivalents for some of the parts.<sup>1</sup>

Besides the use of mechanical or chemical equivalents, there are many ways in which an infringer may endeavour to conceal the fact of infringement. As a general statement of the law on this subject we may take the following words of Chief Justice Tindal in a case decided in 1841 :—

“ Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, either to obtain a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right; and, therefore, what you have to look at upon the present occasion is not simply whether in form or in circumstances, that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff’s patent, but to see whether in reality, in substance and in effect the defendants have availed themselves of the plaintiff’s invention in order to make that fabric.”

“ There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object. There may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent

<sup>1</sup> Peckover v. Rowland, 1895, 7 A. 10 R.P.C. 234.

for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbour's book, for he must be contented to rest upon his own skill and labour for the discovery, and he must not avail himself of that which had before been granted exclusively to another."<sup>1</sup>

Infringement must be of what is described, but may be altered so as to conceal fact of infringement.

This statement of the law has been repeated by numerous judges in different words. Thus, Lord Chancellor Cairns puts it as follows: "That which is protected by a patent is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree that it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding."<sup>2</sup>

Infringement is matter of fact depending on evidence.

In every case the question of fact whether a machine or process is an infringement, is one to be decided on the evidence, and other cases afford little guide to the right answer; but the above statements of law show to what points attention must be devoted in order to arrive at the correct result on the evidence. As has been said: "You must ask yourself whether the substance and pith of the invention is taken substantially. A mere addition to the original machine will not prevent the new machine from being an infringement; nor will diminishing or subtracting this or that part of the original machine necessarily prevent an infringement of it from taking place. You must recall yourself, after making allowance for the subtraction, to the question whether in substance the invention has been borrowed."<sup>3</sup>

To this rule nothing need be added, except that the

<sup>1</sup> *Walton v. Potter*, 1841, 1 W.P.C. 586.

<sup>2</sup> *Dudgeon v. Thompson*, 1877, 3 App. Cas. 44; *cf. Jupe v. Pratt*, 1837, 1 W.P.C. 146; *Automatic Weighing Machine v. Knight*, 1889, C.A. 6 R.P.C. 304.

<sup>3</sup> *Franklin Hocking & Co., Ltd., v. Franklin Hocking*, 1887, C.A. 4 R.P.C. 442.

substance and pith of the invention must be determined from the specification and its claims, and not from the opinions of expert or other witnesses.<sup>1</sup>

The adoption for a new purpose of machinery patented for another purpose is an infringement.<sup>2</sup> By use for new purpose.

The mere making of parts, which are subsequently fitted by another person in an infringing machine, is no infringement;<sup>3</sup> but it is an infringement for a person to make all the parts of a patented machine, and to supply these parts to others in a form in which they can be easily put together, and thus enable the patented invention to be used.<sup>4</sup> Infringement by selling parts of invention.

The repair of a patented article may be an infringement if it is substantially the making of a new article.<sup>5</sup> By repairing.

There may be infringement by making without either selling or using, for the patentee has a monopoly in manufacture. Thus, where a patent was about to expire, and defendant had made a large number of the patented articles, so as to throw them on the market as soon as the monopoly had expired, an injunction was granted to restrain the sale of such articles, both before and after the time limited by the patent.<sup>6</sup> Others may not prepare to flood market on expiration of patent.

Apart from making or selling, there may be infringement by user, and this may be in one of two ways. There is infringement by user every time that an infringing article is used, and this is a necessary provision for enabling the patentee to stop the manufacture and sale of infringing articles by persons from whom he would be unable to obtain compensation in damages. Infringement by user of infringing article.

<sup>1</sup> Brooks v. Steel, 1897, C.A. 14 R.P.C. 46; Pneumatic Tyre Co. v. Tubeless Pneumatic Tyre Co., 1899, H.L. 16 R.P.C. 77.

<sup>2</sup> Pneumatic Tyre Co. v. East London Rubber Co., 1897, 14 R.P.C. 103, quoting Cannington v. Nuttall, L.R. 5 H.L. 230.

<sup>3</sup> Savage v. Brindle, 1895, 13 R.P.C. 265; Dunlop Pneumatic Tyre Co. v. Moseley, C.A. (1904), 1 Ch. 612.

<sup>4</sup> United Telephone Co. v. Dale, 1884, 25 Ch. D. 778.

<sup>5</sup> Dunlop Pneumatic Tyre Co. v. Excelsior Tyre Co., 1901, 18 R.P.C. 209; Dunlop Pneumatic Tyre Co. v. Neal, 1899, 16 R.P.C. 247.

<sup>6</sup> Crossley v. Beverley, 1829, 1 R. & M. 166n.



By breach of limited right to use.

There may, however, be infringement by an improper user of an article, which is not itself an infringement, but which may have been actually made and sold by the patentee himself. When a patentee sells an article, made under his patent, he can do so subject to restrictions either as to the locality or the manner in which it may be used, provided such restriction be brought to the notice of the purchaser before the sale.<sup>1</sup> In these cases the patentees upheld their right to prevent the use of their patent incandescent mantle for gas lighting, except on burners supplied by themselves, though they had no monopoly in the manufacture and sale of such burners.

Machines are frequently supplied, either by way of sale or on hire, upon condition of a royalty being paid for user. A machine let out on hire may be taken under distress for rent due from the hirer, but the landlord cannot give to a purchaser in such a case any rights in respect to the user of the machine, and any such user by the purchaser will be an infringement from which he will be restrained by injunction.<sup>2</sup>

Purchaser may be an infringer.

It will be readily understood that a patentee, who had a patent only in this country, would be prepared to supply articles made under his patent for export at a cheaper rate than for home use, since the exported articles would have to face the competition of makers abroad, and the use at home of such an article, sold for export only, would affect the profits of his monopoly in the same way as the importation of similar articles made abroad, and will be restrained. Where a person has patent rights in two countries, and manufactures in both, the sale of an article in one country, in the absence of a clear indication to the contrary, implies a licence to use it in the other; but if a patentee has sold his foreign patent he cannot any

<sup>1</sup> Incandescent Gas Light Co. v. Cantelo, 1895, 12 R.P.C. 262; Incandescent Gas Light Co. v. Brogden, 1899, 16 R.P.C. 179.

<sup>2</sup> British Mutoscope v. Homer, 1901, 18 R.P.C. 177.

longer sell the invention for use in such foreign country so as to defeat the rights of his assignee.<sup>1</sup>

The importation of an infringing article is an infringement,<sup>2</sup> even though such importation be immediately followed by exportation without any use in this country.<sup>3</sup> But custom house agents for the importers are not liable as infringers, since they take no active part in the infringement.<sup>4</sup>

The importation of an article made abroad, in the production of which a patented process has been used, is an infringement of the patent for such process.<sup>5</sup>

In order to constitute an infringement of an English patent there must be some act done within the prescribed territorial limits; the mere posting of a parcel of an infringing substance at a foreign post office, addressed to a person in England, is not an infringement.<sup>6</sup>

The making, in this country, of a contract for the sale of a patented article, to be delivered abroad, is not an infringement of the patent.<sup>7</sup>

The exhibition, as part of an article offered for sale, of an infringing article, which is excluded from the sale, is an infringement by user.<sup>8</sup>

A person who merely licenses another to infringe a patent is not an infringer;<sup>9</sup> but a person who causes or

<sup>1</sup> *Betts v. Wilmot*, 1871, 6 Ch. 239; *cf. Société Anonyme de Glaces v. Tilghman's Sand Blast Co.*, 1883, C.A. 25 Ch. D. 1.

<sup>2</sup> *Von Heyden v. Neustadt*, 1880, 14 Ch. D. 230; *Walton v. Lavater*, 1860, 8 C.B.N.S. 162; *Wright v. Hitchcock*, 1870, L.R. 5 Ex. 37.

<sup>3</sup> *British Motor Syndicate v. John Taylor & Sons, Ltd.*, 1900, 17 R.P.C. 189, C.A. 723.

<sup>4</sup> *Nobel's Explosives Co. v. Jones*, 1882, H.L. 8 App. Cas. 1.

<sup>5</sup> *Saccharine Corporation, Ltd. v. Anglo-Continental Chemical Works, Ltd.*, 1900, 17 R.P.C. 307.

<sup>6</sup> *Badische Anilin, etc. v. Johnson & Co.*, 1897, C.A. 14 R.P.C. 405, H.L. 919.

<sup>7</sup> *Saccharine Corporation, Ltd. v. Reit, Meyer & Co.*, 1900, 17 R.P.C. 606.

<sup>8</sup> *Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co.*, 1901, 18 R.P.C. 313.

<sup>9</sup> *Montgomerie v. Paterson*, 1894, Ct. Sess. 11 R.P.C. 221.

assists another to do so is in a different position. Thus, the directors of a company are liable as infringers in respect of infringements by the company, and are frequently made defendants in infringement actions against the company of which they are directors.<sup>1</sup>

So also the receiving of a commission from an infringer, on orders for infringing articles forwarded to, and executed by, the infringer, is itself an infringement.<sup>2</sup>

The sale, in a suitable form, of a substance not itself capable of being patented expressly for use in a patented process, has been held to be an infringement,<sup>3</sup> though the correctness of this decision, which was not appealed from, may well be doubted.<sup>4</sup>

Patentee  
must not  
cause in-  
fringement.

The patentee must not in any way be instrumental in causing the infringement to be committed; thus, the making of an infringing article, under the instructions of the patentee's agent, is not an infringement; for the patentee must not lay a trap for any one so as to entangle an innocent party in litigation.<sup>5</sup> The sale of an infringing article to the patentee's agent is, however, constantly relied on as the specific act of infringement alleged in the particulars of breaches.

<sup>1</sup> *Betts v. De Vitre*, 1864, 11 Jur. N.S. 9; 3 Ch. 129; *Incandescent Gas Light Co. v. De Mare*, 1896, 13 R.P.C. 301; *Incandescent Gas Light Co. v. Daylight Co.*, 1899, 16 R.P.C.

<sup>2</sup> *Incandescent Gas Light Co. v. Brogden*, 1893, 16 R.P.C. 179.

<sup>3</sup> *Innes v. Short*, 1898, 15 R.P.C. 449; *cf. Townsend v. Haworth*, 1875, 12 Ch. D. 830; *Dunlop Pneumatic Tyre Co. v. Moseley*, C.A. (1904), 1 Ch. 612.

<sup>4</sup> *Ibid.*

<sup>5</sup> *Kelly v. Batchelar*, 1893, 10 R.P.C. 289.



## CHAPTER XIV.

### ACTIONS FOR INFRINGEMENT.

If a patentee believes that any person has made use of his invention without licence from him—that is, that any person has infringed his monopoly—he may bring against such person an action for infringement of his patent.

An action for infringement in England must be brought in the High Court of Justice or in the County Palatine Court of Lancaster. In the High Court the action may be commenced in either the Chancery or Queen's Bench Division, and the choice of plaintiffs is divided nearly equally between the two.

An action for infringement of a patent, however small the amount of damage may be, cannot be tried in a county court.<sup>1</sup>

The Act of 1883 provides that—

“The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents, or to designs, or to trade marks; and with reference to any such proceedings in Scotland the term ‘the Court’ shall mean any Lord Ordinary of the Court of Session, and the term ‘Court of Appeal’ shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms ‘the Court’ and ‘the Court of Appeal’ respectively mean the High Court of Justice in Ireland and His Majesty's Court of Appeal in Ireland.”

<sup>1</sup> Registrar v. Judge of County Court of Halifax, 1891, C.A. 8 R.P.C. 338.

No action till patent is sealed, relates back to acceptance. Act, 1883, sect. 13.

An action for infringement cannot be commenced until the patent is actually sealed; but it may relate back to all infringements committed after the date of publication of the complete specification.

### *Parties.*

Registered owner can sue.

The registered owner of the patent is usually a plaintiff, even though he may only be in the position of a trustee; but it appears that a *cestui que trust* may sue in his own name.<sup>1</sup> This would enable an equitable assignee to sue; but the assignment ought to be by deed, and it is better to have the assignment registered before commencing the action.

Registration not necessary, but advisable.

If the plaintiff is a registered owner, he usually describes himself in the statement of claim simply as registered proprietor.

A joint owner may sue alone.

When there are co-owners of a patent, any one of them can sue for infringement without the rest;<sup>2</sup> if the defendant wishes to avoid the possibility of having several actions against him in respect of the same infringement, he should at once apply to join the other owners as parties.<sup>3</sup>

Formerly registration necessary before action.

Formerly an assignee of a patent could not sue for infringement until the assignment had been registered;<sup>4</sup> but, when the assignment was registered, the registration had relation back, and gave a right to sue as from the date of the assignment.<sup>5</sup>

Mortgagor may sue alone.

A mortgagor in possession of a patent can sue for infringement without joining the mortgagee; but if it appear to the judge desirable that the mortgagee should be a party he ought to join him.<sup>6</sup>

<sup>1</sup> Speckhart v. Campbell, C.A., *Times*, 13th March, 1884.

<sup>2</sup> Anderson v. Patent Oxonite Co., 1886, 3 R.P.C. 279.

<sup>3</sup> Sheehan v. G. E. Rail. Co., 1880, 16 Ch. D. 59.

<sup>4</sup> Chollet v. Hoffman, 1857, 7 E. & B. 686.

Hassall v. Wright and others, 1870, L.R. 10 Eq. 509.

<sup>6</sup> Van Gelder v. Sowerby Bridge Flour Co., 1890, C.A. 7 R.P.C. 41 208, 44 Ch. D. 374.

A licensee, even when his licence is an exclusive one, cannot sue in his own name without joining the patentee.<sup>1</sup> An exclusive licence to work a patent is not a conveyance within the meaning of section 7 of the Conveyancing Act, 1881.<sup>2</sup>

Licensee cannot sue alone.

The writ usually claims—

Form of writ.

(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's letters patent (usually adding the title, date and number of the patent).

(2) Damages, or, at the option of the plaintiff, an account of profits.

(3) Delivery up to the plaintiff, or destruction, of all articles in the defendant's possession made in infringement of the said letters patent.

(4) When a certificate of validity has been obtained in a previous trial, costs between solicitor and client. (This is not necessary, but may induce settlement.)

An action for an injunction may be commenced before the defendant has actually infringed if he has threatened to do so,<sup>3</sup> and in this case only (1) and possibly (4) will be required.

An injunction may be granted to restrain infringement where there is an intention to infringe, and no actual infringement; but an injunction will not be granted where there is no intention to infringe, even though there may have been a past infringement.<sup>4</sup>

Any party who is alleged to have infringed, directly or indirectly, may be made a defendant. Thus, it has been held right to commence an action against carriers who have in their possession infringing articles, and on discovery to add the owners as defendants;<sup>5</sup> but custom-

Who may be defendants.

<sup>1</sup> *Heap v. Hartley*, 1889, C.A. 42 Ch. D. 461; 6 R.P.C. 495.

<sup>2</sup> *Guyot v. Thomson*, 1894, 11 R.P.C. 554.

<sup>3</sup> *Frearson v. Loe*, 1878, 9 Ch. D. 65; *Incandescent Gas Light Co. v. De Mare*, 1896, 13 R.P.C. 301.

<sup>4</sup> *Proctor v. Bailey*, 1889, C.A. 6 R.P.C. 538.

<sup>5</sup> *The Washburn and Moen Manufacturing Co. v. Q.*, 1889, 6 R.P.C. 398.



house agents for foreign importers are not liable to be thus attacked.<sup>1</sup>

Directors of a company may be joined.

Directors of a company may be liable for infringements by the company, and, since the infringement of letters patent is a tort, they will, if made defendants, be liable jointly and severally for both damages and costs.<sup>2</sup> It is very usual to thus join the directors as defendants in an action against an infringing company.

Where, before the trial of an action for infringement, brought against a company and its directors, the company has transferred its business to a new company with the same directors, an injunction will not be granted so as to affect the directors in their management of the new company. The new company ought to be added as a party to the action.<sup>3</sup>

A foreign company exhibiting an infringing article in this country, on a stand in charge of a representative employed by them, are liable as infringers, and may be served with a writ at such stand as persons carrying on business there.<sup>4</sup>

When defendant is out of the jurisdiction.

If the defendant be an importer, resident out of the jurisdiction, the plaintiff must not delay the commencement of his action until the term of his patent has nearly expired, as he will then have no ground for claiming an injunction, and will be unable to obtain leave to serve the defendant out of the jurisdiction; or, if he obtains leave to serve, the service will be liable to be set aside. In such a case his only remedy is to sue the persons who, in this country, have purchased infringing articles, since he has no right of action abroad against an infringer in this country only.

<sup>1</sup> *Nobel's Explosives Co. v. Jones*, 1882, 8 App. Cas. 1.

<sup>2</sup> *Betts v. De Vitre*, 3 Ch. 149, 11 Jur. 9.

<sup>3</sup> *Welsbach Incandescent Gas v. New Incandescent (Sunlight Patent) Gas*, 1900, 17 R.P.C. 237.

<sup>4</sup> *Dunlop Pneumatic Tyre Co. v. Actien Gesellschaft für Motor, etc.*, 1902, C.A. (902), 1 K.B. 342.

To make a person liable as an infringer, there must be some act on his part taking effect within the United Kingdom, since nothing done abroad can be an infringement of a British patent. A person selling infringing articles abroad, for importation into this country, even though he assist in despatching the same to the purchaser here, is not liable as an infringer. Thus, where a manufacturer abroad transmits infringing articles by post to purchasers in England, the patentee has no remedy against the manufacturer, but must sue the purchaser.<sup>1</sup>

The manufacturer and purchaser of an infringing machine may be sued together,<sup>2</sup> but the manufacturer cannot claim to be added as a defendant in an action against the purchaser;<sup>3</sup> if, however, he has given the purchaser an indemnity, he may be allowed to defend as a third party, and, in such a case, if unsuccessful, he will be liable for the plaintiff's costs.<sup>4</sup>

Manufacturer  
when third  
party.

A patentee who has failed to prove infringement in one action, is not debarred from bringing an action against another party for an exactly similar alleged infringement, and such second action will not be stayed pending an appeal in the first, unless it be clearly proved that the second defendant would be bound by the result of the first action.<sup>5</sup>

#### *Action Under Several Patents.*

Actions are frequently brought for infringement of several letters patent, and there is no reason why the infringements of several should not be, in some cases, included in the same action, even though the acts com-

<sup>1</sup> *Badische Anilin v. Johnson*, 1897, H.L. 14 R.P.C. 405, 919.

<sup>2</sup> *Proctor v. Bennis*, 1887, 36 Ch. D. 740.

<sup>3</sup> *Moser v. Marsden*, 1892, C.A. 9 R.P.C. 214; *Edison v. Holland*, 1886, 3 R.P.C. 395.

<sup>4</sup> *Edison & Swan Electric Light Co. v. Holland*, 1889, C.A. 6 R.P.C. 287.

<sup>5</sup> *Dunlop Pneumatic Tyre Co. v. Rimington Bros. & Co., Ltd.*, 1900, C.A. 17 R.P.C. 665.

plained of in respect of one patent may be quite distinct from those in respect of the other or others; but in such cases the action may be tried as though it were two or more distinct actions, in order to prevent the confusion of trying two distinct matters at the same time.<sup>1</sup> If the cases under several patents are distinguishable, and are tried together, the costs will be taxed as if a separate action had been brought on each patent.<sup>2</sup> In some cases the owner of a group of patents might be able to succeed in an action brought under all the patents of the group, where he would fail if he brought a separate action under each patent. Such an action has been tried, and has been successful where the plaintiff proved that its patents covered every known commercial method of manufacturing the substance, the sale or use of which was the cause of complaint.<sup>3</sup> But a similar action by the same plaintiff was held to be oppressive, and the plaintiff was limited to alleging infringement of three selected patents,<sup>4</sup> so that in future, unless a plaintiff can prove which patent has been infringed, he is not likely to be successful, and in any such action the grant of an injunction is doubtful, even though damages may be recovered.<sup>5</sup>

If, in such a case, an injunction be granted, it will be limited to the time when the earliest of the patents under which the goods can be made expires.<sup>6</sup>

### *Interim Injunctions.*

If the plaintiff intends to apply for an interim injunction, he should do so as soon as possible after the defendant has entered an appearance; or he may, with special leave in an urgent case, do so before appearance.

<sup>1</sup> *Pneumatic Tyre v. Casswell*, 1896, 13 R.P.C. 164.

<sup>2</sup> *Brooks v. Lamplugh*, 1898, C.A. 15 R.P.C. 33.

<sup>3</sup> *Saccharine Corporation, Ltd., v. Annand*, 1900, 17 R.P.C. 1.

<sup>4</sup> *Saccharine Corporation, Ltd., v. Wild*, 1903, C.A. 20 R.P.C. 243.

<sup>5</sup> *Saccharine Corporation, Ltd., v. Quincey*, 1900, 17 R.P.C. 337.

<sup>6</sup> *Saccharine Corporation, Ltd., v. Dawson*, 1902, 19 R.P.C. 169; followed in *Saccharine Corporation, Ltd., v. Jackson*, 1903, 20 R.P.C. 611.

Group of patents.

When to be applied for.



The application is made by motion or summons, according to the division in which the action is commenced, and asks for an injunction to restrain the defendant, his servants and agents from making, using, exercising or vending the invention for which the letters patent were granted. Application,  
how made.

Upon the hearing the plaintiff must be prepared with evidence of the infringement, of the intention to continue the infringement, of the validity of the patent and also of his title. Evidence on  
application  
for interim  
injunction.

Affidavits on a motion for an interim injunction, made on information and belief, ought to show what are the sources of the information;<sup>1</sup> but an affidavit which showed on its face that it was founded on information obtained as the result of inquiries made by the deponent, on behalf of the plaintiff, has recently been admitted, though it would appear on its face to be merely hearsay.<sup>2</sup>

The fact that a certificate of validity has been granted is, as a rule, a *prima facie* ground for granting an interlocutory injunction where the infringement is clear;<sup>3</sup> but is not sufficient where validity is attacked on the ground of a prior user not set up in the action in which the certificate of validity was granted.<sup>4</sup>

If the defendant does not appear on a motion for an interim injunction, an injunction will be granted upon the plaintiff filing an affidavit stating that the defendant is infringing, and that the patent is good and valid, and has not been anticipated.<sup>5</sup> Defendant  
not  
appearing.

If the defendant appears and does not dispute the

<sup>1</sup> *Saccharine Corporation, Ltd., v. Chemical & Drugs Co.*, 1898, 15 R.P.C. 33.

<sup>2</sup> *Badische Anilin Fabrik v. Thompson*, 1902, 19 R.P.C. 502.

<sup>3</sup> *Welsbach Incandescent Gas Light Co., Ltd., v. Vulcan Incandescent Light Synd.*, 1901, 18 R.P.C. 279.

<sup>4</sup> *Welsbach Incandescent Gas Light Co., Ltd., v. General Incandescent Gas Co.*, 1901, C.A. 18 R.P.C. 533.

<sup>5</sup> *Clarke v. Nichols*, 1895, 12 R.P.C. 310.

Validity not  
disputed.

validity of the patent, and there is good evidence of intention to infringe on his part, an injunction will be granted.<sup>1</sup>

Defendant a  
licencee.

An interlocutory injunction will be granted, even under a new patent, against a licencee who goes outside his licence, since he cannot dispute the validity of the patent; but if the plaintiff denies his right to work under the patent at all, an injunction will not be granted, since, in that case, the fact that he claims to be a licencee will not put him in a worse position than that occupied by a stranger.<sup>2</sup>

An interlocutory injunction will not be granted against a defendant who can show a *prima facie* title to work under the patent as owner of a share, or as licencee of a part-owner.<sup>3</sup>

When  
injunction  
is resisted.

Plaintiff  
must have  
*prima facie*  
evidence of  
validity.

Plaintiff  
must show  
account  
insufficient.

If the defendant appears and resists the injunction, the plaintiff will not obtain an interim injunction unless he can show that for many years the validity of the patent has been unquestioned, and his monopoly has been complete and free from infringement, or that the validity of the patent has been upheld in a previous trial; and also that he will not be sufficiently protected if the defendant keeps an account of all the profits made by the alleged infringements.

Inadvertent  
infringement.

Where the defendant alleged that he had infringed in ignorance of the plaintiffs rights, and that the amount of his infringement was small, and undertook not to repeat the infringement, an injunction was refused.<sup>4</sup>

Purchaser  
undertaking  
not to use.

Where a patentee had obtained judgment against a manufacturer, and in consequence a purchaser had offered to undertake not to use the machine he had pur-

<sup>1</sup> Howes v. Webber, 1894, 11 R.P.C. 586.

<sup>2</sup> Wapshare Tube Co. v. Hyde Imperial Rubber Co., 1901, C.A. 18 R.P.C. 374.

<sup>3</sup> Wapshare Tube Co. v. Hyde Imperial Rubber Co., 1901, C.A. 18 R.P.C. 374.

<sup>4</sup> Jenkins v. Hope, 1896, 13 R.P.C. 57.

chased during the existence of the patent, but the patentee commenced an action and moved for an interim injunction, on the defendant undertaking not to use the machine till trial or further order, the motion was dismissed with costs.<sup>1</sup>

Where an injunction has been refused upon terms against a vendor of alleged infringing articles, a motion for an interim injunction against a customer will be dismissed with costs.<sup>2</sup>

If there is any reasonable doubt as to whether what the defendant is doing amounts to infringement, or if the defendant seriously disputes the validity of the patent, an injunction will not be granted; but, as a rule, the defendant will be ordered to keep an account of his profits, and the motion or summons will be ordered to stand over until the trial of the action or further order.

When infringement doubtful no injunction granted.

Account may be ordered to be kept.

Where the defendant resisted an order to keep an account in an action on a comparatively new and unfought patent, the order for an account to be kept was prefaced by the words: "The defendant not admitting the validity, but, on the other hand, contending that the patent is invalid".<sup>3</sup>

If the defendant undertakes not to infringe until the trial of the action or further order, the motion will stand over with liberty to apply.<sup>4</sup>

Defendant undertaking not to infringe.

Where there is good evidence of infringement, the strongest ground for an injunction is that the validity of the patent has been established in a previous trial; but where the defendants offered to pay a reasonable sum into Court, and to keep an account, an interim injunction was refused, though the patent had been so upheld.<sup>5</sup>

Previous action on validity is useful.

Defendant giving security and keeping an account.

<sup>1</sup> Lyon v. Mayor of Newcastle, 1894, 11 R.P.C. 218.

<sup>2</sup> Pneumatic Tyre Co. v. Goodman & Son, 1896, 13 R.P.C. 723.

<sup>3</sup> Pneumatic Tyre Co. v. Friswell, 1896, 13 R.P.C. 15.

<sup>4</sup> Lyon v. Mayor of Newcastle, 1894, 11 R.P.C. 218.

<sup>5</sup> The North British Rubber Co., Ltd., v. The Gormully and Jeffry Manufacturing Co., 1895, 12 R.P.C. 17.



Plaintiff  
must give  
undertaking  
in damages.

When an interim injunction is granted, the plaintiff must give the defendant an undertaking in damages in case he should not succeed in the action.

### *Statement of Claim.*

The Act of 1883 provides that—

Sect. 29 (1).

“In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.”

Form of  
statement  
of claim.

The statement of claim is usually a formal document which states the title of the plaintiffs to the letters patent, alleges that the said letters patent are good and valid, and that the defendant has infringed in the manner shown in the particulars of breaches delivered with it; and if it be the case “that a certificate that the validity of the letters patent had been in question was granted by Mr. Justice (—), on the            day of           , in an action entitled           ”.

It is irregular, on a writ claiming the usual relief for infringement, to include in the statement of claim a new and wholly different cause of action such as a claim for damages for misrepresentation.<sup>1</sup>

### *Particulars of Breaches.*

The particulars of breaches must be the best that the plaintiff is able to give, but it is obvious that without full discovery the plaintiff cannot give very full particulars. He should give any instances of which he is aware, and may add a general statement as to other infringements. Where the patent has more than one claim the plaintiff should state which claims are alleged to have been infringed.<sup>2</sup>

The particulars should say in what way the de-

<sup>1</sup> United Telephone Co. v. Tasker, 1888, 6 R.P.C. 38.

<sup>2</sup> Haslam v. Hall, 1887, 4 R.P.C. 203.

defendant has infringed, or threatened to infringe, *i.e.*, Should state kind of infringement complained of. by manufacture, sale or user, and the plaintiff is bound by these particulars, so that if he has not alleged infringement by manufacture in the particulars, he cannot complain of manufacture at the trial.<sup>1</sup> In cases where the plaintiff is unable to give particulars as to what part of his patent has been infringed, he may apply for an order for liberty to inspect the defendant's alleged infringement before delivery of the statement of claim.<sup>2</sup> Inspection before statement of claim.

Where the alleged infringement is at all complicated, the particulars should specify which part of the article complained of is alleged to infringe. Complicated machine.

No general rule can be given as to how explicit the particulars need be, except that they must be such as to leave no reasonable doubt in the mind of the defendant as to what is the case he has to meet. Particulars must show what plaintiff complains of.

It is not necessary for the plaintiff, when alleging that a certain claim has been infringed, to tell the defendant what he considers to be the meaning of that claim.<sup>3</sup> Particulars need not interpret claim.

In an action for infringement, and not to restrain threatened infringement, evidence of acts by the defendants after the date of the writ is inadmissible.<sup>4</sup> Infringement after writ.

The particulars of breaches usually state that the plaintiff will claim full compensation in respect of all infringements committed by the defendant up till the date of the judgment. Compensation claimed for all infringements.

The particulars of breaches form part of the pleadings in the action, and are usually settled by counsel.

If the defendant admits some infringements, but denies all others, the plaintiff can move for judgment on the pleadings; but the inquiry into damages must, Defendant admitting infringement.

<sup>1</sup> Henser v. Hardie, 1894, 11 R.P.C. 421.

<sup>2</sup> Drake v. Muntz's Metal Co., 1886, 3 R.P.C. 43.

Wenham Co. v. Champion Co., 1891, 8 R.P.C. 22.

<sup>3</sup> Welsbach Incandescent Gas Light Co., Ltd., v. Dowle, 1899, 16 R.P.C.

301 Shoe Machinery Co. v. Cutlan, 1895, 12 R.P.C. 342.

in such a case, be confined to the admitted cases of infringement.<sup>1</sup>

### *Defence.*

Three courses are open to the defendant in an action for infringement, success in any one of which will entitle him to judgment in the action. He may show—

(1) That the plaintiff is not entitled to sue under the patent;

(2) That he has not infringed, or threatened to infringe, the patent; and

(3) That the patent is bad.

The first course is open to him except when he is a licensee under the plaintiff, and continues to pay royalties to him; for, as long as he is paying royalties, he may not dispute his licensor's title;<sup>2</sup> but, provided he does not continue to pay royalties, it is open to a licensee to show that his licensor's title has expired.<sup>3</sup>

It is, of course, a complete answer to the plaintiff's claim if the defendant can show that he has not done, or threatened to do, anything in infringement of the patent.

### *Defendant a Licensee.*

The fact that a man has taken a licence under the patent does not involve any assumption that the interpretation put on the specification by the patentee is to be accepted by him as the true one.

“A licensee is entitled to have it ascertained what is the ambit, what is the field which is covered by the specification as properly construed; and he is entitled to say, ‘Inside of that field I have not come; so far as I have worked, I have worked outside the limit which is

<sup>1</sup> *United Telephone Co. v. Donohoe*, 1886, 31 Ch. D. 399.

<sup>2</sup> *Crossley v. Dixon*, 1863, 10 H.L.C. 304.

<sup>3</sup> *Muirhead v. The Commercial Cable Co.*, 1895, 12 R.P.C. 39.

Forms of  
defence.

Licensee may  
not dispute  
validity,

but may  
show that  
plaintiff has  
no title.

No infringe-  
ment is a  
complete  
defence.

Licensee  
need not  
admit inter-  
pretation of  
patentee.



covered by it as properly construed, and therefore I am not bound to make any of those payments which are stipulated in my licence as payments to be made for working the patent'.<sup>1</sup>

Thus a licensee, although he may not dispute the validity of the patent, is entitled to have the specification construed by the Court; and if it is ambiguous, or requires explanation, but not unless,<sup>2</sup> he may give evidence of the state of public knowledge at the date of the patent to show that the patentee could not be taken to have intended to include what he is doing.<sup>3</sup>

Licencee may have ambiguous specification construed by Court.

### *Special Cases.*

There are several cases in which the defendant is not allowed to dispute the validity of the plaintiff's patent.

Defendant may not always dispute validity.

If the question of validity has been determined in a previous action to which he was a party, or if in such an action he has submitted to an injunction, he may not afterwards dispute the validity of the patent.<sup>4</sup>

Estoppel by record.

If the defendant has formerly been an owner of the patent, and has assigned his share to the plaintiff, or his predecessor in title, he cannot dispute the validity of the patent, for that would be to derogate from his own grant.<sup>5</sup>

By being an assignor.

The assignment must have been by the defendant in order to thus bind him; for if the assignment was only by his trustee in the bankruptcy, he is at liberty to dispute the validity of the patent on the ground of want of

Actual party only is estopped by assignment or by record.

<sup>1</sup> Clark *v.* Adie (No. 2), 1877, 2 App. Cas. 426.

<sup>2</sup> Jandus Arc Lamp *v.* Johnson, 1900, 17 R.P.C. 361.

<sup>3</sup> Crosthwaite *v.* Steel, 1889, 6 R.P.C. 190; *cf.* Appleby *v.* Albert Eadie Chain, 1899, 16 R.P.C. 318; Morris *v.* Young, 1895, H.L. 12 R.P.C. 455.

<sup>4</sup> Moore *v.* Thomson, 1890, H.L. 7 R.P.C. 325; Shoe Machinery Co. *v.* Cutlan, 1896, 13 R.P.C. 141.

<sup>5</sup> Chambers *v.* Crichley, 1864, 33 Beav. 374; Walton *v.* Lavater, 1860, 8 C.B.N.S. 162; Oldham *v.* Langmead, 1789, 3 T.R. 441.

novelty, or insufficiency of the specification,<sup>1</sup> or presumably on any other ground.

An assignment by the defendant only binds him, it does not bind his partner;<sup>2</sup> and a like rule applies where the defendant has been the defendant in a previous action.<sup>3</sup>

Licencee is estopped from disputing validity, but may repudiate licence.

Repudiation must precede defence.

Equitable licencee may be estopped.

Licencee only is estopped.

If the defendant be a licencee under the patent he cannot dispute its validity;<sup>4</sup> he can, however, at any time repudiate the licence, and from the time of such repudiation the licence terminates;<sup>5</sup> so that a licencee, even by deed, may give notice to the plaintiff that he repudiates the licence, and then, unless he is under covenant not to dispute the validity of the patent, he may raise the question in his defence. It is not, however, sufficient for him simply to plead in his defence that the licence has been abandoned,<sup>6</sup> since this is not notice that such is the case, and until the notice be given he may not dispute the validity of the patent.

The rule that a licencee may not dispute validity may in some cases apply also to persons who are only equitable licencees; thus it has been held that the defendant in an infringement action cannot both claim to be an equitable licencee and also question the validity; he must choose one or the other alternative.<sup>7</sup>

It is only the actual licencee who is unable to dispute the validity; the fact of a person having been a licencee does not prevent his partner raising the question.<sup>8</sup>

Subject to these limitations, the defendant in his

<sup>1</sup> *Smith v. Cropper*, 1885, 10 App. Cas. 249.

<sup>2</sup> *Heugh v. Chamberlain*, 1877, 25 W.R. 742.

<sup>3</sup> *Goucher v. Clayton*, 1864, 11 Jur. N.S. 107.

<sup>4</sup> *Hills v. Laming*, 1853, 9 Ex. R. 256.

<sup>5</sup> *Redges v. Mulliner*, 1893, 10 R.P.C. 21; *Crossley v. Dixon*, 1863, 10 H.L.C. 293.

<sup>6</sup> *Cheetnam v. Nuttall*, 1893, 10 R.P.C. 321.

<sup>7</sup> *Postcard Automatic Supply Co. v. Samuel*, 1889, 6 R.P.C. 560; and see *Crossley v. Dixon* 1863, 10 H.L.C. 293.

<sup>8</sup> *Goucher v. Clayton*, 1864, 11 Jur. N.S. 107.

defence usually raises as many of these issues as can be raised with any hope of success. He does not admit the plaintiff's title, he denies that he has infringed, and he alleges that the patent is invalid. Usual  
defence.

The Act of 1883 provides that—

“The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof. Particulars of  
objections to  
validity must  
be given.

“If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.” Sect. 29,  
(2), (3).

The defence is usually a formal document, and all objections to the validity of the patent are left to be dealt with in the particulars, which are usually settled by counsel. Form of  
defence.

The particulars of objections in an action for infringement are similar to those in a petition for revocation, and to those required in an action for threats where the validity of the patent is put in issue; and the subject is dealt with in a separate chapter. Form of  
particulars  
of objection.

In an action against two defendants an injunction will be granted against one who submits to an injunction, although the other may obtain judgment on the ground of invalidity of the patent;<sup>1</sup> but if one of two joint-defendants defends and the other does not, judgment in default of pleading will not be given against the latter pending the decision of the action.<sup>2</sup> Thus in an action for infringement where there is more than one defendant, one of them may have no defence because he cannot either deny infringement or dispute the patent, and yet the plaintiff may not be entitled to judgment, since another defendant disputes the validity of his More than  
one de-  
fendant.

<sup>1</sup> *Savage v. Brindle*, 1900, 17 R.P.C. 228.

<sup>2</sup> *Actien Gesellschaft für Cartonnagen Industrie v. Rennes*, 1895, 12 R.P.C. 94.



patent; while, if this defence succeeds, it will enable the other defendant to escape judgment.<sup>1</sup>

Both plaintiff and defendant must be careful to give particulars of all that they intend to put in evidence at the trial, for the Act of 1883 provides that—

“At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.”

This rule is strictly enforced,<sup>2</sup> unless leave to amend is asked for, and, as will be seen, this may prove a costly remedy for a defendant.

“Particulars delivered may be from time to time amended by leave of the Court or a judge.”

Leave to amend will be given at practically any stage of the action upon terms as to costs.

As a rule the conditions for amending the particulars of objections are, that the defendant shall pay any costs incurred between the delivery of the original and the amended particulars, in case the plaintiff should discontinue within a given time after the delivery of the amended particulars,<sup>3</sup> and that he should pay the costs of the amendment in any event.

Amendment during the trial of the action has been allowed on similar terms.<sup>4</sup>

An application to amend particulars should not be adjourned to the trial.<sup>5</sup>

After trial particulars may be amended pending an appeal, by leave of the Court of Appeal.<sup>6</sup>

<sup>1</sup> *Cropper v. Smith*, 1885, H.L. 2 R.P.C. 17.

<sup>2</sup> *Perry v. Société des Lunetiers*, 1896, 13 R.P.C. 670.

<sup>3</sup> *Ehrlich v. Ihlee*, 1887, 4 R.P.C. 115; *Wilson v. Wilson*, 1899, C.A. 16 R.P.C. 315; *Woolley v. Broad*, 1892, 9 R.P.C. 429.

<sup>4</sup> *Chadburn v. Michan*, 1895, 12 R.P.C. 120, 131; *Crosthwaite v. Moorwood*, 1894, 11 R.P.C. 558; *Badische Anilin v. La Société Chimique*, 1898, 15 R.P.C. 359.

<sup>5</sup> *Kelly v. Heathman*, 1890, 7 R.P.C. 343.

<sup>6</sup> *Shoe Manufacturing Company v. Cutlan*, 1895, C.A. 12 R.P.C. 330 (R.S.C., O. 58, r. 4); *Pirrie v. York Street Flax Spinning Co.*, 1894, 11 R.P.C. 431.

No evidence of matter not in particulars. s. 29 (4).

Particulars may be amended. Act, 1883, sect. 29 (5). Conditions for amendment.

An order as to amendment of particulars is not appealable as to costs.<sup>1</sup>

### INTERLOCUTORY PROCEEDINGS.

#### *Inspection.*

The Act of 1883 provides that—

“In an action for infringement of a patent, the Court or a judge may, Orders during on the application of either party, make such order for an injunction, inspection, action. or account, and impose such terms and give such directions respecting Sect. 30. the same and the proceedings thereon as the Court or a judge may see fit.”

The plaintiff can, in general, obtain an order entitling Plaintiff can him to inspect the defendant's works, if such inspection obtain would assist him in proving his case,<sup>2</sup> even before de- inspection. livery of his statement of claim.<sup>3</sup> But there is no absolute right to such an order, the granting of it being a matter of judicial discretion to be exercised with due regard to the interests of the parties.<sup>4</sup>

Mere suspicion of infringement does not entitle a plaintiff to an order for inspection,<sup>5</sup> a *primâ facie* case must be made out, and the order will be confined to those of the defendant's processes as to which such *primâ facie* case is made out.<sup>6</sup>

Where the plaintiff has been supplied with specimens of the infringing articles, inspection of the defendant's premises will be refused.<sup>7</sup>

The defendant may answer the plaintiff's application Defendant for inspection by alleging that it would disclose trade may allege secrets, and in such a case the Court will appoint an trade secret. independent expert to make a secret report to it on the

<sup>1</sup> *Wilson v. Wilson*, 16 R.P.C. 315.

<sup>2</sup> For Form of Order see *Haslam v. Goodfellow*, 1887, 5 R.P.C. 28.

<sup>3</sup> *Drake v. Muntz's Metal Co.*, 1885, 3 R.P.C. 43.

<sup>4</sup> *McDougall Bros. v. Partington*, 1890, 7 R.P.C. 357.

<sup>5</sup> *Germ. Milling Co. v. Robinson*, 1884, 1 R.P.C. 217.

<sup>6</sup> *Cheetham v. Gidham*, 1888, 5 R.P.C. 617.

<sup>7</sup> *Sidebottom v. Fielden*, 1891, 8 R.P.C. 267.

question. An expert appointed for this purpose may not be called as a witness by either side, or at least if called must only be asked such questions as are approved by the judge.<sup>1</sup>

Inspection by defendant.

Samples may be ordered.

The plaintiff may also be ordered to give inspection to the defendants of what is being done by him, or under him, under his patent, to put machinery to regular work before them, and to supply samples of what is being made under the patent.<sup>2</sup> If the defendant gives evidence that the plaintiff could procure inspection at the works of a specified third party, the plaintiff will be ordered to apply for such inspection, and, in case of being unsuccessful, to embody the result of his application in an affidavit.<sup>3</sup>

Inspection is generally required by the defendant when utility is in issue to show that the plaintiff himself does not work according to his patent.

Inspection may also be given in case a prior user be alleged.

### *Discovery.*

Discovery of documents, and by means of interrogatories, is open to both parties as in any other action.

Communications between patentee and patent agent are not privileged, and, where the patent agent is also the plaintiff's solicitor, the plaintiff must, in giving discovery of documents, distinguish between communications between himself and his solicitor as such, and those between himself and his solicitor when acting as his patent agent.<sup>4</sup>

Interrogatories.

Interrogatories must not depend for their relevancy on the construction of the specification.<sup>5</sup>

<sup>1</sup> *Plating Co. v. Farquharson*, 1883, Griff. 187, 17 Ch. D. 49.

<sup>2</sup> *Germ. Milling Co. v. Robinson*, 1885, 3 R.P.C. 11 (where a form of order will be found); *Cheetham v. Oldham*, 1888, 5 R.P.C. 617; *Peters v. Owen*, 1888, 5 R.P.C. 622.

<sup>3</sup> *Rylands v. Ashley's Patent Bottle Co.*, 1890, C.A. 7 R.P.C. 175.

<sup>4</sup> *Moseley v. Victoria Rubber Co.*, 1886, 3 R.P.C. 351.

<sup>5</sup> *Delta Metal v. Maxim-Nordenfelt Co.*, 1891, 8 R.P.C. 169.



The plaintiff is entitled to ask the defendant whether he uses the specific processes described in the specification, taking them one by one, though he may not ask him generally what process he uses.<sup>1</sup>

A defendant must answer an interrogatory asking from whom he obtained goods alleged to infringe.<sup>2</sup>

In an action against a licensee for an account, the plaintiff is entitled on interrogatories to the names of some customers to whom the defendant has sold goods alleged to be made under the licence, although the defendant claims that they were made by a secret process.<sup>3</sup>

Where general prior user is alleged, the defendant must give the names and addresses of the users, and the places and dates of user, on interrogation.<sup>4</sup>

A defendant who denies infringement may be asked if he sold certain specified articles to specified persons, but he cannot, until after judgment, be made to disclose the names of customers in a general way,<sup>5</sup> since if he admits the sale of certain goods, but denies that they are infringements, the question of who purchased them may be irrelevant.

The defendant may interrogate the plaintiff as to whether he has succeeded in using his patented invention without any alterations or additions; but not as to what those alterations or additions are, since this is not necessarily relevant to the matter in dispute.<sup>6</sup>

In an action with a limited company the opposite party is not entitled to interrogate particular officers or agents of the company, because they have knowledge of the subject-matter of the action acquired otherwise than through, or on behalf of, the company; nor can the

<sup>1</sup> *Benno Jaffé v. Richardson*, 1893, 10 R.P.C. 136.

<sup>2</sup> *Saccharine Corporation, Ltd., v. Haines, Ward & Co.*, 1898, 15 R.P.C. 344.

<sup>3</sup> *Ashworth v. Roberts*, 1890, 7 R.P.C. 451.

<sup>4</sup> *Alliance Pure White Lead Synd. v. MacIvor's patents*, 1891, 8 R.P.C. 321.

<sup>5</sup> *Lister v. Norton*, 1885, 2 R.P.C. 68; *Parker v. Wells*, 1881, C.A. 18 Ch. D. 477.

<sup>6</sup> *Rylands v. Ashley's Patent Bottle Co.*, 1890, C.A. 7 R.P.C. 175.

secretary be compelled to ask for information from the officers and agents of the company, except as to knowledge which they had acquired in the course of their employment by the company.<sup>1</sup> Thus, a reconstruction may be used to obliterate evidence against a patent in the knowledge of a company, since the reconstructed company is, in law, a different person, and has none of the knowledge of the old company.

### *Consolidation of Actions.*

Under the rules of the Supreme Court—

“Causes or matters pending in the same division of the High Court may be consolidated by an order of the Court or a judge in the manner formerly in use in the courts of Common Law.”<sup>2</sup>

Consolidation must be on application of defendants.

In these courts actions could be consolidated only at the instance of the defendants;<sup>3</sup> and, if the defendants applied for and obtained an order for consolidating the actions, the plaintiff had to choose which he would proceed with first, and proceedings in the others were stayed until the first had been disposed of.

Defendants only bound by order.

If, in the one tried, the plaintiff was successful, the other defendants were bound by the result; but, if the plaintiff was unsuccessful, he could, unless he had consented to be bound by the result of the first, proceed with the others.

Where first defendant fails to defend.

The orders made in various cases are so worded as only to bind the defendants; but there might be a great hardship inflicted on the other defendants if the one selected for attack did not appear and defend the action, and provision is usually made for such a case.<sup>4</sup>

Appeals.

When several actions have been consolidated, and

<sup>1</sup> *Welsbach Incandescent Gas Light Co. v. New Sunlight Incandescent Gas Co.*, 1900, C.A. 17 R.P.C. 401.

<sup>2</sup> R.S.C., O. 49, r. 8.

<sup>3</sup> *Amos v. Chadwick*, 1877, 4 Ch. D. 869; *Lush's Practice*, 3rd ed., p. 965.

<sup>4</sup> See *Bovill v. Ainscough*, 1867, *Plimpton v. Spiller*, 1876, *Johnasson v. Palgrave*, 1880, *Lawson, Pat. Pract.*, 2nd edit., pp. 495 *et seq.*

the defendant in the representative case refuses to appeal against an adverse judgment, the Court may substitute one of the other defendants who are bound by the decision to prosecute an appeal.<sup>1</sup>

Although true consolidation applies only when there are several defendants sued by one plaintiff, when several plaintiffs have brought actions against the same defendant the Court may, under its general jurisdiction, extend the time for taking the next step in the rest of the actions until a test action has been tried; and where the first action fails to be a real trial of the issue, a second may be substituted as a test action.<sup>2</sup>

Where an order has been made in one action that another should be treated as a test case, and at the trial the defendant does not appear, this does not affect the binding nature of the test case.<sup>3</sup>

It often happens that there are a large number of infringements by purchasers, and, in such a case, it is oppressive to commence actions against them all if such a course can be reasonably avoided. If an action on the patent is being fought, it has been laid down that the proper course for the patentee to pursue is to write to each infringer and inform him that he is infringing, but that if he will agree not to raise any objection on the ground of delay proceedings will not be commenced till the pending action has been tried; while, if this be not done, a writ will be issued forthwith asking for the usual relief.<sup>4</sup>

<sup>1</sup> Briton, etc., Life Assurance v. Jones, 1889, 60 L.T. 637.

<sup>2</sup> Amos v. Chadwick, 1877, 4 Ch. D. 869; Bennet v. Lord Bury, 1880, 5 C.P.D. 339.

<sup>3</sup> The Edison United Phonograph Company and The Edison Bell Phonograph Company, Limited, v. T. Lewis Young, 1894, 11 R.P.C. 489.

<sup>4</sup> N. B. Rubber Co. v. Gormully & Jeffry Mantg. Co., 1895, 12 R.P.C. 21.



## CHAPTER XV.

### REVOCATION OF LETTERS PATENT.

It will be seen that the letters patent are granted subject to the condition—

See p 8.

“that if at any time during the said term it be made to appear to us, our heirs or successors, or our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes”.

The Act of 1883 provides that—

“Revocation of a patent may be obtained on petition to the Court.”

Form of proceedings for revocation.

Sect. 26 (1).  
Sect. 44 (9).  
See p. 251.

This does not apply to a patent which has been assigned to the Secretary of State for War, and in relation to which he has certified that it is his opinion that in the interest of the public service the particulars of the invention, and of the manner in which it is to be performed, should be kept secret.

In Scotland.  
Sect. 109.

“Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

“Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.”

The Act of 1883 provides that—

“ Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement, and shall also be a ground of revocation.”

Grounds for  
revocation.  
Sect. 26 (3).

These grounds will be fully discussed in the chapter on Particulars of Objections, and need not be here further mentioned.

In one case it was suggested that a patent for a medicinal preparation which contained poison was bad (presumably as prejudicial or inconvenient to subjects in general), because it was taken out to defeat the provisions of the Pharmacy Acts; but this was declared not to be a ground upon which it could be revoked.<sup>1</sup>

“ A petition for revocation of a patent may be presented by—

Who may  
present  
petitions for  
revocation.  
Sect. 26 (4).

“ (a) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

“ (b) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

“ (c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :

“ (d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :

“ (e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.”

When a person petitions under (c), (d) or (e), he must state in his petition under which head or heads he is petitioning; and, until he has proved that he has a *locus standi* under one of the heads mentioned in the petition, the Court will not entertain any evidence as to the validity of the patent.<sup>2</sup>

Petitioner  
must prove  
his *locus  
standi*,  
or petition  
will not be  
heard.

Under (c) the person who presents the petition must show that the patent was obtained in fraud of his rights, that is, that the patentee has been guilty of dishonest and culpable acts in obtaining it; the petition must be in the

<sup>1</sup> Vaisey's patent, 1894, 11 R.P.C. 592.

<sup>2</sup> Avery's patent, 1887, C.A. 4 R.P.C. 322, 36 Ch. D. 307.

name of the person so defrauded, it cannot be presented by his attorney in his own name.<sup>1</sup> It is more advantageous to present a petition under the head (c) than any of the others, since—

Where there is fraud patent may be granted to person defrauded. Act, 1883, sect. 26 (8).

When Attorney-General's fiat must be obtained.

How to obtain fiat.

“Where a patent has been revoked on the ground of fraud, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.”

Unless the person petitioning can bring himself under (c), (d) or (e), he must obtain the fiat of the Attorney-General authorising him to present the petition.

A person who desires to obtain the Attorney-General's fiat, must send to the law officer's clerk, at room 549, Royal Courts of Justice, the following documents:—

- (1) Memorial to the Attorney-General asking for his authority, and stating all the circumstances. (On judicature paper.)
- (2) Statutory declaration verifying the statements in the memorial. (On judicature paper.)
- (3) Two copies of the proposed petition, and of the particulars of objections proposed to be delivered.
- (4) Certificate by a barrister that the petition is proper to be authorised by the Attorney-General. (On foolscap.)
- (5) Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.
- (6) Declaration by the applicant that the validity of the patent cannot be disputed in any legal proceedings then pending. (On foolscap.)

<sup>1</sup> Avery's patent, 1887, C.A. 4 R.P.C. 322, 36 Ch. D. 307.



Usually the Attorney-General grants or refuses his fiat *ex parte*, but sometimes he directs notice to be given to the patentee, or persons interested, that they may appear before him and oppose the granting of his fiat. Fiat may be granted *ex parte*.

The Attorney-General has no power to award costs to any person on an application for his fiat,<sup>1</sup> and, unless by consent they be made costs in the cause, they will not be allowed to a successful petitioner at the trial of the petition.<sup>2</sup> No costs for proceedings to obtain fiat.

A petition for revocation is a proceeding on behalf of the public, and it is so far not a proceeding *inter partes* that neither party is estopped from raising anew points which have been already decided in a previous action for infringement by the respondent against the petitioner.<sup>3</sup> Petition is not *inter partes*.

“The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered. Particulars of objection must be delivered. Petitioner bound by particulars. Act, 1883, sect. 26 (5), (6).”

“Particulars delivered may be from time to time amended by leave of the Court or a judge.”

The particulars of objections in a petition for revocation are similar to those in an action for infringement.

No certificate as to the reasonableness of the particulars is required in a petition for revocation in order to obtain the costs thereof.<sup>4</sup>

The petitioner may obtain directions from the Court as to what persons are to be served with the petition; all parties beneficially interested in the patent should be made respondents to the petition.<sup>5</sup>

There is no power to serve a petition of revocation out of the jurisdiction; but if ample notice be given to the respondent the Court will make an order *nisi* for the Respondent out of jurisdiction.

<sup>1</sup> Griff. 320.

<sup>2</sup> Rendell's patent, 1894, Lanc. Ct., 11 R.P.C. 277.

<sup>3</sup> Deeley's patent, 1895, C.A. 12 R.P.C. 199.

<sup>4</sup> Gaulard & Gibbs' patent, 1888, 5 R.P.C. 526; C.A. 6 R.P.C. 215.

<sup>5</sup> Avery's patent, 1887, 4 R.P.C. 152, C.A. 322.

petition to be set down for trial in the list of witness actions.<sup>1</sup>

First hearing of petition. The petition is usually filed in the Chancery Division, and comes into the ordinary petition list, when directions should be applied for as to the mode of trial, a summons for such directions being unnecessary.<sup>2</sup>

A patentee abroad must have notice of the petition before the patent can be revoked,<sup>3</sup> and notice by registered letter will be ordered, and is sufficient.<sup>4</sup>

An unopposed petition will be granted with costs,<sup>5</sup> except in the case of a foreign respondent who has not appeared, when no order will be made as to costs.<sup>6</sup>

When revocation is unopposed. When the respondent appears and consents to the revocation, an order for revocation will be made with costs without evidence being taken.<sup>7</sup> And the respondent may save costs by going to Chambers to consent to an order with costs, and so avoid having the petition set down.<sup>8</sup>

When opposed usually tried as witness action. As a general rule, when the respondent appears and opposes the revocation, he applies for the petition to be tried on *vivâ voce* evidence, and in that event the Court will make an order that either party shall be at liberty to set it down in the witness list after a certain day.<sup>9</sup>

No security for costs by respondent. If a foreign respondent applies to have a petition for revocation tried on *vivâ voce* evidence, he will not have to give security for costs.<sup>10</sup>

<sup>1</sup> Drummond's patent, 1889, 43 Ch. D. 80, 6 R.P.C. 576, 50 L.J. Ch. 576; *cf.* Görz & Högh's patent [1895], W.N. 105; Allison's patent, 1900, 17 R.P.C. 297.

<sup>2</sup> Miller's patent, 1894, 11 R.P.C. 55.

<sup>3</sup> *In re* Kay's patent, Stirling, J., 1894, 11 R.P.C. 279; La Compagnie Generale d'Eaux, etc., 1891, 8 R.P.C. 446; [1891] 3 Ch. 451; Drummond's patent, 1889, 43 Ch. D. 80, 6 R.P.C. 576.

<sup>4</sup> *In re* Hirschfeld's patent, 1894, 11 R.P.C. 515; *In re* Allison's patent, 1900, 17 R.P.C. 297.

<sup>5</sup> Wallace's patent, 1895, 12 R.P.C. 444.

<sup>6</sup> *In re* Cercel's patent, 1898, 15 F.P.C. 500.

<sup>7</sup> Sleight's patent, 1893, 10 R.P.C. 447.

<sup>8</sup> Scott's patent, 1903, 20 R.P.C. 604.

<sup>9</sup> *In re* Borrowman's patent, 1902, 19 R.P.C. 159.

<sup>10</sup> Miller's patent, 1894, 11 R.P.C. 55.

A petition for revocation almost exactly resembles an action in the manner in which it is conducted; interrogatories may be administered, and discovery and inspection ordered, as in an action for infringement.<sup>1</sup> These should be asked for when the petition comes on in the ordinary petition list.<sup>2</sup> Conduct of petition before trial.

The petition may be sent for trial to the assizes, and when fraud is alleged the trial may be ordered to be by jury.<sup>3</sup> See chapter xviii. on Trial. Trial may be at assizes.  
Jury.

At the trial—

"the defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply."<sup>4</sup> Respondent commences. Act, 1883, sect. 26 (7).

The costs of a petition of revocation usually follow the event. While the petition is pending, the patentee may apply to the Court for leave to apply to amend his specification by disclaimer, but not in any other way,<sup>5</sup> and the petition will be stayed pending the amendment being made. Costs. Amendment pending petition. Act, 1883, sect. 19.

The usual terms on which leave to apply to amend is granted are, that the respondent should pay the costs of the application for leave to apply, and the costs of the petition down to the date of such application, except so far as what has been already done may be utilised in subsequent proceedings; and, should the petitioners after amendment decide not to continue the petition, that the respondent should pay all the petitioner's costs of the petition.<sup>6</sup>

An application for leave to apply to amend is usually made by summons, but may be made by motion.<sup>6</sup>

<sup>1</sup> Haddan's patent, 1885, Griff. 108; 54 L.J. Ch. 126.

<sup>2</sup> Scott's patent, 1902, 19 R.P.C. 273 (per Buckley, J.).

<sup>3</sup> *Edge v. Harrison*, 1891, 8 R.P.C. 74.

<sup>4</sup> *In re Owen's patent*, 1898 [1899], 1 Ch. 157, 15 R.P.C. 755.

<sup>5</sup> *In re Chatwood's patent*, 1899, 16 R.P.C. 370; *In re Gaulard & Gibb's patent*, 1888, 57 L.J. Ch. 209; *In re Deeley's patent*, 1894, 11 R.P.C. 72; see also *In re Delwick's patent* [1896], 2 Ch. 705.

<sup>6</sup> *In re Delwick's patent* [1896], 2 Ch. 705.



Successive amendments possible.

Leave to apply to amend may be given more than once in the course of an action,<sup>1</sup> and, no doubt, the same would apply to a petition.

If the petitioner succeeds at the trial, the Court will declare the patent invalid and order its revocation. This is carried out by registration of the order at the Patent Office.

The Court can and will stay registration of the order for revocation pending an appeal.<sup>2</sup>

Where a patent has been revoked in the Court of first instance, and the Court of Appeal has ordered security to be given for the costs of the appeal, the Court can order the appeal to be dismissed, unless the security be given before a fixed date.<sup>3</sup>

Where invalidity might be cured by amendment.

If the invalidity of the patent is curable by amendment, the Court will, on the application of the respondent, suspend for a time the registration of the order for revocation, in order that the patentee may apply for leave to amend his specification, and, if such leave be obtained, suspend registration altogether, or it may make the order conditional<sup>4</sup> on leave to amend not being obtained on an application to be made within a limited time. A conditional order of this nature has hitherto been made where amendment by disclaimer only was necessary; but, since a pending appeal is not a pending action,<sup>5</sup> there seems no reason why the amendment in such a case should be restricted to disclaimer.

<sup>1</sup> *Chatwood's Patent Safe v. Mercantile Bank of Lancashire*, 1900, 17 R.P.C. 23.

<sup>2</sup> *In re Armstrong's patent*, 1897, C.A. 14 R.P.C. 747.

<sup>3</sup> *In re Owen's patent*, 1900, C.A. 17 R.P.C. 637.

<sup>4</sup> *Deeley v. Perkes*, 1896, H.L. 13 R.P.C. 581; *Scott's patent*, 1903, 20 R.P.C. 264.

<sup>5</sup> *Cropper v. Smith*, 1884, 28 Ch. D. 151.

*Petition Pending Amendment.*

A petition for revocation commenced after an application has been made to amend the specification will be adjourned till after the proceedings for amendment,<sup>1</sup> the latter not being in any way affected by the petition.<sup>2</sup>

In making such a conditional order the Court has a discretion as to the terms which it will impose as a condition for the indulgence; and an exercise of this discretion will not be reviewed by the Court of Appeal except in an exceptional case.<sup>3</sup>

<sup>1</sup> Deeley's patent, 1894, 11 R.P.C. 72.

<sup>2</sup> Woolfe v. Automatic Picture Gallery, 1903, C.A. 20 R.P.C. 177.

<sup>3</sup> *Re Geipel's patent*, C.A. (1904), 1 Ch. 239.