

he was in possession of a *machine* for making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation the patent was granted. The consideration for the grant was the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration had failed in part, and the grant was consequently void, and a defendant in an action for infringement had a right to say that it was so. If the representation was (as the learned Chief Justice thought it was) that paper of various widths might be obtained from one and the same machine, the evidence must be looked to to discover whether the patentee was possessed of a machine, or of the invention of a machine, capable of accomplishing that object, and, unfortunately the evidence showed that he was not. The patentee was at the time possessed of one machine, and one only, and that adapted to one degree of width and one degree only. And he was not then possessed of any method by which different degrees of width might be manufactured by that machine, or by any other.

A patent, the title of which was, "improvements in steam engines, and in machinery for propelling vessels, which improvements are applicable to other purposes" was declared void by the Court of Exchequer on the ground that, upon the face of the patent as set out in the record, it appeared that an improvement in steam engines was suggested by the patentee, and that the jury having found that the invention was not an improvement in steam engines, though it was an improvement in machinery for propelling vessels, the grant was void for false suggestion.⁽ⁱ⁾

Again, in another case in the Court of Exchequer, Lord Abinger, C.B., directed the jury to consider whether an invention of improvements in wheels for railway carriages was worth a patent or not, or whether the improvements were, as the defendant alleged, only trifling and insignificant alterations. The jury found that there were substantial improve-

(i) *Morgan v. Seaward*, 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187.

ments in the invention, but, had they come to the opposite conclusion, the Court would no doubt have declared the patent bad on the ground of false suggestion.

If an invention is useful for the generality of purposes for which it is stated in the specification so to be, the fact that it is altogether useless for one purpose falling within the statement will not vitiate the patent.

Thus, in *Haworth v. Hardeastle*,^(k) the patent was for "certain machinery, or apparatus adapted to facilitate the operation of drying calicoes, linens, or other similar fabrics," and on a motion for a nonsuit and to set aside a verdict given for the plaintiff on the finding of a jury that the invention was new and useful on the whole, but that the machine was not useful in some cases for taking off goods, the Court consisting of Tindal, C.J., Parke, Gaselee, and Bosanquet, JJ., held that they would not be justified in setting aside a verdict given on such a finding, and in holding that the patent was void on the ground that the machine was altogether useless for one of the purposes described in the specification.

If an entire machine or subject is, as a whole, useful, a want of utility in a part or parts, provided that the useless part or parts form no part of the consideration in respect of which the patent was granted, will not vitiate a patent in respect of such machine or subject.^(l)

If an invention as a whole is useful, it is not necessary that each part of it should possess the same amount of utility.^(m)

A patent is void if an essential part of the invention is impracticable and useless,⁽ⁿ⁾ but if part of an invention, as described in a specification, turn out not to be necessary, the inutility of that part will not vitiate the patent unless it is claimed as *essential*.^(o)

In the case of *Lewis v. Marling*,^(p) the patent was for improve-

^(k) 4 M. & Sc. 720; 1 Bing. N. S. 182; 1 W. P. C. 480.

^(l) *Morgan v. Seaward*, 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187; *Lewis v. Marling*, 1 W. P. C. 490; *United Horsenail Co. v. Stewart*, 2 P. O. R. 122, 131.

^(m) *Ehrlich v. Ihlee*, 5 P. O. R. 103.

⁽ⁿ⁾ *United Horsenail Co. v. Stewart*, 2 P. O. R. 122, 132.

^(o) *Lewis v. Marling*, 10 B. & C. 22; 1 W. P. C. 493; *Morgan v. Seaward*, 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153; *United Horsenail Co. v. Stewart*, 2 P. O. R. 132.

^(p) 10 B. & C. 22; 4 Car. & P. 57; 1 W. P. C. 493.

Invention generally useful.

Haworth v. Hardeastle.

Want of utility in a non-essential part.

Lewis v. Marling.

ments in shearing machines, for shearing or cropping woollen and other cloths. And it appeared in evidence that a brush, described in the specification, and intended to raise the wool, was unnecessary and useless. The Court of King's Bench held that the inutility of this brush, which was not claimed as *essential*, did not render the patent bad. Tenterden, C.J., saying: "As to the objection on the ground that the application of a brush was claimed as part of the invention, adverting to the specification, it does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent they had made a machine to which the brush was affixed, but before any machine was made for sale they discovered it to be unnecessary. I agree, that if the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and thereby misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiff's claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful." Bayley, J., saying: "Now, at the period when this specification was made, the brush was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material; and I am of opinion that the subsequent discovery that the brush was unnecessary is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad, on the ground that this was deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection."

Want of utility
in prior inven-
tion.

In the case of a patent for an invention which is an improvement on a former invention, the want of utility in the former invention will not vitiate a patent, for the improvement which will be perfectly valid as regards utility, if the machine manufactured according to it is useful.^(g)

^(g) *Lewis v. Davies*, 3 Car. & P. 502; 1 W. P. C. 488; per Lord Tenterden,

The case of *Bloxam v. Elsee*(*r*) at first sight appears to be a decision contrary to the above proposition, but it must be observed that *Bloxam v. Elsee* was decided on the ground that the subsequent patent was granted on the strength of the suggestion contained in the prior patent, which turned out to be false.

In the case of a patent for an invention which is an improvement on a former patented invention, the question always is, What is the representation on the strength of which the second patent was granted? If the second patent was granted on the same representation as rendered the first void, it is bad also; but if the second patent was granted on a true representation, the fact that the first patent was bad will not vitiate the second.

C.J. ; *Tetley v. Easton*, Macr. P. C. 56 ; *Murray v. Clayton*, L. R. 7 Ch. 581 ; *Morgan v. Windover*, 5 P. O. R. 303 ; *Jones v. Pearce*, 1 W. P. C. 121, 122 ; *Shaw v. Jones*, 6 P. O. R. 336.

(*r*) 1 Car. & P. 558 ; 9 Dowl. & Ry. 215 ; 6 B. & C. 169 ; 3 L. J. (O. S.) Q. B. 93 ; see p. 135 *ante*.

CHAPTER V.

THE SPECIFICATIONS.

ORIGIN AND DEVELOPMENT OF SPECIFICATIONS—TITLE—PROVISIONAL SPECIFICATION—COMPLETE SPECIFICATION—CLAIMS—CONSTRUCTION OF SPECIFICATIONS.

Origin and Development.

Important that the invention should be defined.

WHEN a person becomes the recipient of the exclusive privilege of exercising any particular art under a grant of letters patent from the Crown, it is of the utmost importance, in the interests of the rest of the community, that definite information should be given as to what it is they are, without the sanction of the patentee, prohibited from doing during the existence of the monopoly. It is also very essential in the interests both of the patentee himself, and the public, that the exact invention which forms the subject of the grant of letters patent should be clearly defined. An invention without the knowledge of the means of putting it into practical operation is of no use to its possessor, and part of the bargain between the patentee and the Crown is that the former shall disclose the means of putting the invention into practice for the benefit of the public, so that after the expiration of the time for which the patent is granted all may alike enjoy the benefits of the discovery, if minded so to do.^(a)

Early practice.

It was formerly the practice to insert in the letters patent a recital, amounting to a description of the invention, which was the subject of the grant, and this recital, which was usually very meagre, was the only source of information as to what the invention really was and how it was to be performed.

Great inconvenience was found to arise from this practice,

^(a) p. 88 *ante*.

and during the reign of Queen Anne the Attorney-General devised a plan to obviate this objection. This plan consisted in making it a condition that the patentee should, within six months, particularly "describe and ascertain the invention, and the manner in which it was to be performed," and in inserting in the letters patent a declaration that an omission to do this would render the grant null and void. This was the origin of the modern instruments generally known as specifications. Before this period of six months had elapsed, as well as before the adoption of the specification, it must have been a question of evidence as to what was the invention for which the patentee went to the Crown, and for which the Crown granted a monopoly.^(b)

Origin of specifications.

The Patent Act of 1852 introduced a further improvement by providing that when persons applied for letters patent they should deposit a provisional specification, a very different instrument to that required under the former practice. Instead of requiring that the patentee should, in the provisional specification, "particularly describe and ascertain the nature of the invention, and in what manner the same shall be performed," the Act of 1852 only insisted that in the provisional specification, which the applicant was to leave with the law officer of the Crown when he applied for a patent, he should state the nature of the invention, and further provided that when the law officer of the Crown had looked at the specification, if he were of opinion that it did not state the nature of the invention, he should be competent to require the document to be amended in that particular, but if he thought it properly stated the nature of the invention, he could grant a certificate authorising the applicant to use the invention publicly without thereby making a publication which would render the patent, if granted afterwards, invalid.

Practice under Patent Act of 1852.

The provisional specification was introduced for the benefit of the patentee, who during the period of protection from the effects of publication which the certificate of the law officer of the Crown secured, was enabled to make further experiments and improve the means of carrying out his invention

Object of provisional specification.

(b) *Bailey v. Robertson*, 3 App. Cas. 1074, per Lord Blackburn.

before filing his second and complete specification, in which he was required not only to "describe the nature of his invention," but to "state in what manner the same shall be performed." It was, moreover, under the Act of 1852, competent for the applicant, if he thought fit, to file his complete and final specification on making application for the grant of letters patent, instead of putting in a provisional specification, but it would clearly not be his interest as a rule to do so, for he would thereby deprive himself of the right to make further legitimate improvements before obtaining the great seal.

Practice under Patents, Designs, and Trade Marks Act, 1883.

The practice in this matter under the Patents, Designs, and Trade Marks Act, 1883, is practically the same as that under the Act of 1852, excepting that the leaving of a complete specification is now always a condition precedent to the grant of a patent, for it is enacted that an application for a patent must be accompanied by either a provisional or a complete specification, and that a provisional specification must describe the nature of the invention, whilst 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 a provisional or complete specification must, if required, be accompanied by drawings.^(c) The Act of 1883 also especially provides that 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 the Act referred to as provisional protection.^(d)

Effect of provisional protection.

This provisional protection only protects the patentee against the consequences of his own publication of the invention, and thus enables him to employ workmen and assistants in helping him to perform experiments and exercise the invention with a view to bringing it to a state of perfection before filing the complete specification.^(e) It does not confer on the patentee

(c) 46 & 47 Vict. c. 57, s. 5, ss. 2, 3, 4; P. R. 1890, ss. 26-33, see Appendix.

(d) 46 & 47 Vict. c. 57, s. 14.

(e) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577.

any rights against the public, and it is expressly provided that he shall not institute any legal proceedings for infringements committed before the publication of the complete specification. (*f*)

The Title.

A specification, whether provisional or complete, must commence with the title, (*g*) which is virtually a short and concise statement of the invention, (*h*) and must conform to the following rules:—

- I. *The title must not be too extensive so as to embrace more than the patentee has really discovered, for this will make the patent void on the ground that it has been granted for more than the patentee is entitled to.* Must not be too extensive.

Thus, in *Cochrane v. Smethurst*, (*i*) where a man had invented a glazed street lamp, and obtained a patent for it under the title “an invented method of more completely lighting cities, towns and villages,” he was nonsuited in an action for infringement of his patent on the ground that he had obtained it, not for an improved street lamp, but for an improved method of lighting streets, towns, and villages. (*k*) And in *Felton v. Greaves*, (*l*) where a man took out a patent under the title “a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments,” and the machine, as described in the specification, was not capable of giving an edge to scissors, the patent was held to be bad for want of sufficiency. Examples: Cochrane v. Smethurst. Felton v. Greaves.

In *Campion v. Benyon* (*m*) a rule *nisi* to set aside the verdict for the plaintiff, and to enter a nonsuit, was made absolute by the Court of Common Pleas. The title of the patent in question was “an improved method of making and manufacturing double canvas and sail-cloth with hemp and flax, or either of them, *without any starch whatever*.” It was sought, on the part of the plaintiff to show from the specification that Campion v. Benyon.

(*f*) 46 & 47 Vict. c. 57, s. 13.

(*g*) 46 & 47 Vict. c. 57, s. 5, ss. 5.

(*h*) *Househill Co. v. Neilson*, 1 W.P. C. 678.

(*i*) 2 Coop. Ch. Cas. 57; 1 Stark. R. 205.

(*k*) See remarks of Tindal, C.J., *Cook v. Pearce*, 8 Q. B. 1054, 1062; 13 L. J. Q. B. 189.

(*l*) 3 Car. & P. 611.

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

the omission of the use of starch (which was old) was no part of what the plaintiff claimed. Dallas, C.J., delivering his judgment, said: "With respect to patents, every patent being a monopoly, that is, an infringement of public right, and having for its object to give public warning of the precise extent of the privilege conferred on the patentee, the Court (without going into the controversy, whether it is politic that such privileges should be conferred or not) is bound to require that such warning should be clear, and accurately describe what the inventor claims as his own. If the instrument contain an ambiguity on a material point that is a ground on which it may be avoided altogether. From the first time I read this patent down to the present day, I thought that the object of the patent was to make cloth without starch. Then, as to the specification, if that be different from the patent, the whole is void; if it coincides it is open to the same objection as the patent. Whether we look to the patent or the specification, I have no doubt that the claim of the plaintiff is too extensive; it is not confined to an improved method of weaving the cloth, or twisting the threads, but also comprehends another mode of proceeding, which is not a new discovery."

"Improvements in the manufacture," &c.

It has been held, on the other hand, that where the title was "improvements in the manufacture of plaited fabrics," the objection that only one improvement was disclosed by the specification was not sufficient to upset the patent, Tindal, C.J., remarking: "This is, certainly, a most subtle objection; if the term improvement had been used, it would have been *nomen collectivum*, and would have covered any number of improvements. I cannot see why the variance, if it be one, should vitiate the patent, the objection being merely to the title of the patent, without fraud upon the Crown or detriment to the public.(n)

And, again, where the word "improvements" being in the plural number, was relied on as an objection to the patent in question, Lord Abinger, C.B., thought that it was of no consequence, because the plaintiff might mean every part of his process to be treated as an improvement, forming, together, a series.(o)

(n) *Nickels v. Haslam*, 7 M. & G. 378; 8 Scott, N. R. 97; 13 L. J. C. P. 146.

(o) *Derosne v. Fairie*, 5 Tyr. 393; 2 Cr. M. & R. 476; 1 W. P. C. 154.

II. *The title must not be too narrow, so as to exclude something which the patentee has invented, for, if it be so, he will not obtain protection in respect of that to which he may be justly entitled.* Must not be too narrow.

Thus, in *Croll v. Edge*,^(p) a patent was granted under the title "improvements in the manufacture of gas for the purpose of illumination, and in apparatus used when transmitting and measuring gas." From the specification it appeared that the patentee had invented an improved method of making retorts. In that instrument it was stated that the invention consisted in "improvements in the manufacture of gas for the purpose of illumination, and apparatus used therein, and when transmitting and measuring gas," but the Court held that the patentee was not entitled to protection in respect of the retorts, as the title did not profess to comprehend improvements in any apparatus used in making gas, and that the insertion of the words "therein and" amounted to a substantial extension of the grant of the Crown. Examples:
Croll v. Edge.

In *Oxley v. Holden*,^(q) in which the title of the patent was "improvements in the doors and sashes of carriages," the specification stated that the patentee had shown the invention, as applied to railway carriage doors and window fittings, although it was equally applicable to the doors and windows of any other description of carriage, or in any case where windows and doors are subject to jar and vibration. The Court held that the invention claimed was not larger than the title, and the judgment of Erle, C.J., contained the following passage: "The invention specified and claimed is truly an improvement in the doors and windows of carriages, not the less because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined, accordingly, to the doors and windows of carriages. The present case has no analogy to the decision of this Court in *Croll v. Edge*,^(p) where the patent was, in effect, for improvements in the apparatus for the manufacture, and also in that of the transmission, of Oxley v.
Holden.

^(p) 9 C. B. 479; 19 L. J. C. P. 261.

^(q) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

gas. The specification, therefore, related to an apparatus, additional to and beyond that referred to in the title. Here the title and the specification relate to one and the same apparatus."

Must not be vague or ambiguous.

III. *The title should not be vague or ambiguous; and there is authority for saying that the mere vagueness or ambiguity of the title is an objection which may well be taken on the part of the Crown—that is to say, by the Comptroller-General,(r) before a patent is granted, but it affords no ground for avoiding the patent after it has been granted, provided that the ambiguity is explained by the specification, and the title is not at variance with it.(s)*

Examples: Sturz v. De la Rue.

Thus, in *Sturz v. De la Rue (t)* a patent for a method of fixing folding shutters in carriages in which German shutters were used, was upheld, notwithstanding the objection that the title "improvements in carriages" was too vague.

Neilson v. Harford.

And in *Neilson v. Harford (u)* a patent for the application of the hot blast in the smelting of iron, under the title "an improved application of air," was upheld.

Must not contain a misdescription.

IV. *The title must not contain a misdescription of the invention, for this has been held to be a fatal objection.*

Examples: Rex v. Metcalf.

Thus, in *Rex v. Metcalf,(x)* a patent under the title "a tapered hair or head brush," was upset, on the ground that from the description in the specification it appeared that the brush invented by the patentee did not taper, but was only unequal.(y)

Bainbridge v. Wrigley.

In *Bainbridge v. Wrigley,(z)* Lord Ellenborough held a patent void which was for "certain improvements in the flageolet or English flute, whereby the fingering will be rendered more easy, and notes produced that were never before produced," on the ground that the instrument described, as a matter of fact, produced only one new note.

Fisher v. Dewick.

In *Fisher v. Dewick (a)* the title of the patent in question was "improvements in machinery for the manufacture of

(r) Chap. VII.

(s) *Cook v. Pearce*, 8 Q. B. 1044; 13 L. J. Q. B. 189.

(t) 5 Russ. 322; 7 L. J. (O. S.) Ch. 47.

(u) 1 W. P. C. 295; 8 M. & W. 806; 2 Coop. Ch. Cas. 61; 11 L. J. Ex. 20.

(x) 2 Stark. R. 249.

(y) See also *Neilson v. Harford*, 1 W. P. C. 333.

(z) Parl. Rep. 197.

(a) 4 Bing. N. C. 706.

bobbin net lace," and the defendant objected that the title misdescribed the subject-matter, the invention being only for making a spot during a particular part of the process, and being useless when that addition was not wanted, and that the title should have been "for a mode of making spots in bobbin net lace." Coltman, J., ruled that the invention was inapplicable to anything but the making of bobbin net lace, and that it was an improvement. The Court of Common Pleas supported the ruling of the Court below, Tindal, C.J., observing that it could not, without great refinement, be said that the invention was not an improvement in the manufacture of bobbin net lace.

V. *A false suggestion in the title will be fatal to the validity of the patent, for the Crown will have been deceived in its grant.* Must not contain a false suggestion.

Thus, in *Morgan v. Seaward*,^(b) the case of Galloway's patent for "improvements in steam engines and in machinery for propelling vessels," the defendants in an action for infringement obtained a verdict on the issue that the invention was not an improvement in steam engines. Examples: Morgan v. Seaward.

In *Bloxam v. Elsee*^(c) the patent was held void on the ground of false suggestion, it appearing that the patentee had by the title represented that he was in possession of "an invention of making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length" whereas from the evidence it appeared that the machine he claimed to have invented would only make paper of one particular degree of width and length. Bloxam v. Elsee.

It is not uncommon to find the titles of patents commencing with the words "a new or improved method or process" and it would appear that if the method or process be partly new, so as to produce a result which as a whole is new, or if the method or process be entirely new, it may properly be called a new or improved method or process; ^(d) whereas, if the method "New or improved method or process."

^(b) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.

^(c) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

^(d) Beard v. Egerton, 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

or process be not new, but improved, the patent with such a title will be bad.(e)

Must be comprehensive enough to include the invention.

VI. *If the title insufficiently or inaccurately describe what is really the invention, it will not render the patent void, if it is comprehensive enough to include the actual invention.*

Examples:
Hill v. The London Gas Light Co.

In *Hill v. The London Gas Light Company* (f) the title as amended was "an improved method of purifying coal-gas," and it appeared from the specification that the invention really consisted in a method of removing the sulphuretted hydrogen which occurs as an impurity in coal-gas. The Court of Exchequer overruled the objection that the invention specified was different from that for which the patent was granted, Watson, B., saying: "The patentee made a mistake in stating for what he wanted his patent, but in reality he wanted a patent for his invention, it has been granted to him for that and the title comprehends it. If, indeed, the jury had found either that when he applied for the patent he had not invented the thing specified, or that, in truth, he did not apply for it, a different question might have arisen; but the jury must be taken to have found that, although he has inaccurately or insufficiently described what he was asking for, in reality, he was asking for a patent for this invention."(g)

The Electric Telegraph Co. v. Brett.

In *The Electric Telegraph Company v. Brett*,(h) the defendant objected that the plaintiffs' patent being described in the title as an "Invention of improvements in giving signals and sounding alarums in distant places, *by means of electric currents transmitted through metallic circuits*," it was impossible for them, the defendants, to infringe as long as the circuit they used was not metallic throughout, but to a substantial extent *non-metallic*. The jury, however, found a verdict for the plaintiffs, which was upheld by the Court of Common Pleas, Creswell, J., saying: "Now the patentees, by their specification, do not make any claim to metallic circuits. What they claim is improvements in giving signals by means of electric currents transmitted

(e) *Gibson v. Brand*, 1 W. P. C. 634.

(f) 29 L. J. Ex. 409; 5 H. & N. 312.

(g) See also *Regina v. Mill*, 10 C. B. 389; 14 Beav. 312; 20 L. J. C. P. 16.

(h) 10 C. B. 838; 20 L. J. C. P. 123.

through metallic circuits, and the improvements, as appears by the specification, consist entirely in the methods and instruments for using the electric current. The circuit used by the defendant is metallic in all that part which operates in giving signals, and it is no condition necessary to the existence of the improvements that the circuit should be metallic in any other part than that which contains the coils, and operates on the needles. It appears to us reasonable to hold that a claim for a patent for improvement in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed, and their application."

The title and the specifications are always to be read together, and the one may be explained by reference to the other.

The title and the specifications are to be read together.

Thus, in *Newton v. Vaucher*,⁽ⁱ⁾ on the hearing of a motion for a new trial, Parke, B., was in doubt as to whether from reading the specification itself the plaintiff's invention was simply for the application of soft metal for the purpose of preventing friction when there is pressure and motion, or whether it was also for the application of soft metal in cases of stuffing rods for the purpose of excluding air, water or other fluid. The determination of this fact materially affected his decision in this matter, and on reading the specification and title together, as was proper, he had no doubt that the plaintiff's claim was confined to cases where there is pressure and motion.^(k)

Since the passing of the Act of 1883, defective titles have not been, nor are they likely to be, so frequent as they were formerly, for it is expressly provided by the 6th sec. of that Act that the Comptroller shall refer every application to an Examiner, who is required to examine the specification and to ascertain that the title sufficiently indicates the subject-matter of the invention. Still, if the title after it has passed the Examiner, or after amendment remains defective, it is an

Defective titles are not likely to be common now.

(i) 6 Exch. 866; 21 L. J. Ex. 305.

(k) See also *Neilson v. Harford*, 1 W. P. C. 312, 373; *Lister v. Norton*, 3 P. O. R. 203.

objection to the validity of the patent, and it must not be forgotten that under the practice before the Act of 1883, an examination of the title was supposed to be made by the Patent Clerks of the Law Officers of the Crown before the Great Seal was obtained, and that, notwithstanding this precaution, it was not uncommon for patents to be vitiated through defects in their titles.

The Provisional Specification.

Application must be accompanied by a specification.

Generally a provisional specification.

Difference between provisional and complete specifications.

An applicant for a patent is required to accompany his application by a specification, but it is optional whether this shall be provisional or complete.^(l) It is, however, in virtue of the difference in the requisites of the provisional and complete specifications, very rarely to the interests and advantage of a would-be patentee to depart from the general practice of accompanying his application by a provisional specification, and availing himself of the time allowed him under the Act wherein to consider and fulfil the obligations which the necessity of filing a complete specification imposes upon him.

The provisional differs from the complete specification in that the former must describe the nature of the invention, and the latter must *particularly* describe and ascertain the nature of the invention and *in what manner it is to be performed.*^(m) It thus appears that, as regards the description of the invention, there is a difference in the accuracy with which this is required to be given by the two specifications. The provisional specification need not enter in detail into all the means by which the invention is to be carried out,⁽ⁿ⁾ and it was never intended to be more than a mode of protecting an inventor until the time for filing the complete specification; or to contain a complete description of the discovery so as to enable any workman of ordinary skill to carry it out.^(o) It is quite sufficient if the provisional specification inform the Comptroller-General roughly what the invention is, for which the protection of letters patent

(l) 46 & 47 Vict. c. 57, s. 5, ss. 2; for forms of provisional and complete specification, see P. R. 1890, Form B and Form C.

(m) 46 & 47 Vict. c. 57, s. 5, ss. 3, 4.

(n) *Re Newall v. Elliot*, 4 C. B. N. S. 269; 1 H. & C. 797; 32 L. J. Ex. 120;

10 Jur. N. S. 954; *Penn v. Bibby*, L. R. 2 Ch. 127, 132; *Lucas v. Miller*, 2 P. O. R. 155; *Moseley v. Victoria Rubber Co.*, 4 P. O. R. 241; *Morgan v. Windover*, 4 P. O. R. 422; 5 P. O. R. 295.

(o) *Stoner v. Todd*, L. R. 4 Ch. D. 58.

is sought; but it must do this fairly and honestly, and must indicate the whole invention of which the would-be patentee is in possession at the date of his application, and for which he desires to obtain protection.(p)

The object of this is to show that the invention subsequently fully specified is the same as that which is presented to the Comptroller in the first instance.(q)

Object of the provisional specification.

In cases of subsequent dispute, the question is not whether the provisional specification is defective, but whether the complete specification is excessive.(r)

In the language of Lord Chelmsford, L.C.,(s) "it seems clear that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officers" (now the Comptroller-General) "what is to be the subject-matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes carried out. That is left to the complete specification."(s)

Per Lord Chelmsford, L.C.

The effect of filing the provisional specification is to secure nine months' provisional protection,(t) and the object of this protection evidently is to enable the patentee to perfect his invention by experiments which, although open and known, will not be a use, and publication to the prejudice of letters patent to be afterwards granted, so that he may be in a condition to describe in the complete specification, as the result of experience, the best manner of performing the invention. It clearly appears, therefore, that the complete specification is in a sense supplemental to the provisional specification, not going beyond nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional specification, as to the manner in which the invention is to be performed.(u)

Provisional protection.

(p) *Stoner v. Todd*, L. R. 4 Ch. D. 58; *United Telephone Co. v. Harrison*, L. R. 21 Ch. D. 718, 747; *Woodward v. Sansum*, 4 P. O. R. 166, 174; *Siddell v. Vickers*, L. R. 39 Ch. D. 92.

(q) *Newall v. Elliot*, 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; 4 C. B. N. S. 269.

(r) *Siddell v. Vickers*, L. R. 39 Ch. D. 92, 97; *Curtis v. Platt, Grill*, L. O. C. 53; 5 P. O. R. 87 n.

(s) *Penn v. Bibby*, L. R. 2 Ch. 127.

(t) 46 & 47 Viet. c. 57. s. 5.

(u) *Ibid.*

The provisional protection granted to the patentee on lodging his provisional specification applies only to the consequences of publication on the validity of the patent subsequently granted, and does not give any right of action against any other person using the invention in the meantime.(x) If, therefore, the complete specification, after having been accepted by the Comptroller-General, describe and claim any invention different from that described in the provisional specification, it is evident that the patentee has never applied for a patent or received provisional protection in respect of that different invention, and the whole grant is void, because the specification claims that which has never been granted, and consequently that to which the patentee has no right—viz., the monopoly of the invention which differs from that described in the provisional specification.(y)

Lord Blackburn,(z) commenting on the effect of experiments made during the period of provisional protection, pointed out that the proper process is to say: "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." The learned lord also pointed out that it becomes pretty clear, when the nature of an invention has been described in the provisional specification, if something were found out during the period of provisional protection to make the invention work better, or with respect to the mode in which the operation may be performed—a thing which is very likely to happen when, in carrying out his invention, the inventor finds that some particular will not work as smoothly as he expected, and that it is necessary to supplement it—still the nature of his invention remaining the same, it is no objection that in the complete

(x) 46 & 47 Vict. c. 57, s. 13.

(y) *Watling v. Stevens*, 3 P. O. R. 151; *Newall v. Elliott*, 10 Jur. N. S. 955, 4 C. B. N. S. 269; *Foxwell v. Bos- tock*, 4 De G. J. & S. 298; *Siddell v.*

Vickers, L. R. 39 Ch. D. 92; 5 P. O. R. 81, 416.

(z) *Bailey v. Robertson*, L. R. 3 App. Cas. 1074.

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, so as to make the invention which he has described in the provisional specification really workable. If there is nothing more done than that, in the opinion of the learned lord, the patent 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 I hereby describe A. and also B., then as far as regards B., it is void, because the patent was granted for the invention that was described in the provisional specification and does not cover the invention that is described in the other.(a)

It will be seen hereafter(b) that in such a case so long as B. remains in the complete specification it renders the whole grant bad, but the defect is one which may be amended by excision, so as to secure to the patentee protection in respect of A.

Improvements in the arrangement of the machinery, of the relative position and adaptation of the different parts with a view of producing the same results, the substitution of mechanical equivalents, and modifications and developments within the scope of the invention set out in the provisional specification, are allowable, and cannot be successfully relied on for the purpose of invalidating a patent on the ground of disconformity.(c)

Improvements during period of provisional protection.

If the provisional specification describe a method of carrying the invention into effect, and a totally different method is described in the complete specification, the latter document will not be void for disconformity, if the two methods are within the invention described in the two specifications.(d) The reason of this is that the patentee is bound to describe the best and latest method known to him of carrying out the invention.(e)

Provisional and complete specifications describing different methods within the invention.

The provisional specification must contain a description of

The description of the in-

(a) See also *Crompton v. Patents Investments Co.*, 5 P. O. R. 382, 393; *Siddell v. Vickers*, 5 P. O. R. 81, 426; *Woodward v. Sansum*, 4 P. O. R. 178.

(b) Chap. VI.

(c) Per Lopes, L.J., *Woodward v. Sansum*, 4 P. O. R. 178.

(d) *Woodward v. Sansum*, 4 P. O. R. 175; *Lucas v. Miller*, 2 P. O. R. 155; *Moseley v. Victoria Rubber Co.*, 4 P. O. R. 241; *Morgan v. Windover*, 4 P. O. R. 422; 5 P. O. R. 295.

(e) p. 154 *post*.

vention in the provisional specification must be honest, fair, explicit, and wide enough to include all that is described and claimed in the final specification.

the invention for which the patentee desires protection, and though his description may be a mere rough outline, it is absolutely essential that it shall be honest, fair, explicit, and wide enough to comprise all that is described and claimed in the final specification when that instrument is filed, and speaking generally, the two specifications ought not so to differ that the nature of the invention described in the one is materially different from that described in the other.(f)

Examples of patents rendered void by disconformity of the specifications.

There are many instances in which patents have been rendered void because the patentee has in his final specification described and claimed inventions which the Courts have held were not included in the description given in the provisional specification. The following two cases may be taken as illustrations of patents which have been so vitiated.(g)

Bailey v. Robertson.

In *Bailey v. Robertson*,(h) the patent related to a method of preserving meat. The patentees in the provisional specification stated: "We dissolve the ordinary commercial gelatine in boiling water, using about 2 lbs. of gelatine to 10 lbs. of water. We then add, while hot, a volume equal to the volume of solution of gelatine of a solution of bisulphite of lime (CaO_2SO_2) in water of about the specific gravity 1.070. While the solution of gelatine and bisulphite of lime is still warm and liquid, we coat the substance to be preserved with it, either by dipping the substance in it, or by brushing it over with two or three coats of the solution." The complete specification described a solution consisting of bisulphite of lime alone, and laid claim to the use of this solution by itself for preserving animal substances. The House of Lords held that the patent was invalid on the ground that the claim to the use of bisulphite of lime alone was not foreshadowed by the provisional specification. Lord Cairns, L.C., pointed out that it could not be doubted that the invention, which those who wrote out the provisional specification conceived, was not an invention merely of the chemical application of bisulphite of lime to animal substances, such as meat and fish, but was a mode of applying a coating or film to

(f) *Foxwell v. Bostock*, 4 De G. J. & S. 298.

(g) See also *Horrocks v. Stubbs*, 3 P. O. R. 233, 236; *Hutchison v. Patullo*,

5 P. O. R. 351; *King, Brown & Co. v. Anglo-American Brush Corporation*, 6 P. O. R. 414.

(h) L. R. 3 App. Cas. 1055.

the outside of animal substances, which coating or film was to consist of gelatine, or some substance of the same kind mixed with a solution of bisulphite of lime. The patentees could only claim the use of the solution of bisulphite of lime separately by claiming an invention through the medium of the complete specification which was not mentioned in the provisional specification, and as to the mode of exercising or applying which they could not, in that specification, point out any claim, or any information given to the public.

In *United Telephone Co. v. Harrison*⁽ⁱ⁾ Edison's patent for the telephone under the title "improvements in instruments for controlling by sound the transmission of electric currents, and the reproduction of corresponding sounds at a distance," was held invalid by Fry, J., and afterwards by the Court of Appeal, one of the grounds for so doing being the fact that the final specification described and claimed the phonograph whilst it was not disclosed in the provisional specification, although it was admitted that portions of the provisional specification explained, or might be held to refer to, an instrument like the phonograph. Fry, J., after stating the fact that Edison had discovered an instrument of the highest ingenuity, the phonograph, which is purely mechanical, and has nothing to do with electric or magnetic science, and nothing necessarily to do with the transmission of sound to a distance observed: "Has that remarkable invention so made by Edison been in any manner described in the provisional specification? . . . Now, no doubt some of these words do explain or might be held to refer to an instrument like the phonograph, but when I ask myself whether they in any manner describe the nature of the invention, I am bound to say that they do not. . . . I agree that the provisional specification need not describe the manner in which an invention is to be carried into effect—I agree that it need not describe the nature of the invention otherwise than roughly; but it ought to do so fairly and honestly; and if Mr. Edison was at the time at which these letters patent were granted in possession of that very remarkable mechanical invention by which speech could be reproduced, not necessarily at a distance,

(i) L. R. 21 Ch. D. 743.

but in the same room as that in which it was uttered, I do not think the provisional specification was an honest statement of the nature of the discovery. On that ground I come to the conclusion that Mr. Edison's patent cannot be upheld."

Examples of patents not so rendered void.

The following two cases may be taken as instances where the objection was not sustained that the final specification described and claimed inventions not foreshadowed by the provisional specification.^(k)

Newall v. Elliott.

Newall v. Elliott ^(l) was a case in which the validity of Newall's patent for "improvements in apparatus for laying down submarine telegraph wires" was questioned on the ground of disconformity. The provisional specification described the nature of the invention in the following words: "The cable or rope containing this insulated wire or wires is passed round a cone, so that the cable, in being drawn off the coil, is prevented from kinking by means of the cone, and there is a cylinder on the outside which prevents the coil from shifting in its place." The complete specification, besides containing words to the above effect, continued the description in the following terms: "When the cable is to be laid down I place over the cone an *apex* or top which is conoidal, as shown (the drawing showed a short conoidal head placed on the flat top of the truncated cone) and around this I suspend *several rings* of iron by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed. The two rings nearest the coil are lowered to about six and twelve inches respectively from the coil (the drawing showed four rings arranged in gradations of size, the smallest being at the top, and acting as a mouthpiece, for the exit of the cable which was thus carried close over the conoidal top of the cone)." The claims included one for the use of rings in combination with a cone as described. The matters in dispute were referred to an arbitrator, who made an award, and stated a special case for the

^(k) See also *Penn v. Bibby*, L. R. 2 Ch. 127, 135; *Lucas v. Millar*, 2 P. O. R. 155; *Watling v. Stevens*, 3 P. O. R. 37, 42; *Moseley v. Victoria Rubber Co.*, 4 P. O. R. 241; *Gaulard & Gibbs' Patent* 5 P. O. R. 533; *Horrocks*

v. Stubbs, 3 P. O. R. 221; *King, Brown & Co. v. Anglo-American Brush Corporation*, 6 P. O. R. 414; *Crampton v. The Patent Investment Co.*, 6 P. O. R. 294.

^(l) 4 C.B. N. S. 269; 27 L. J. C. P. 337.

opinion of the Court, in which one of the questions for decision was: "Whether there was a fatal variance between the provisional and complete specification, in that the former omitted all mention of the rings claimed by the latter document." The Court gave judgment for the plaintiff, and the judgment of Byles, J., contained the following passage: "The second objection was, that the provisional specification contained no mention of the rings claimed in the full specification. But the office of the provisional specification is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out; otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed, the statute itself (*m*) indicates this distinction between the provisional and the final specification; for it calls the latter the *complete* specification, implying that the former is, or legally may be, in some respects executory and incomplete. Moreover, it enacts (sec. 6) 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 (sec. 9) 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 describe but particularly ascertain it. We, therefore, think that this provisional specification in the case under consideration sufficiently describes the nature of the invention though it does not enter into a detail of all the means by which it is to be accomplished."

In *Wright v. Hitchcock* (*n*) the patent was for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The provisional specification stated: "The invention relates to a peculiar manufacture of frills and ruffles, and to a peculiar combination of mechanism," &c., whilst the complete specification stated: "The invention relates to a peculiar manufacture of frills, ruffles, or *trimmings*, and to a peculiar combination of mechanism to be applied to a

*Wright v.
Hitchcock.*

(*m*) 15 & 16 Vict. c. 83; cf. 46 & 47 Vict. c. 57, s. 5.

(*n*) L. R. 5 Ex. 37; 39 L. J. Ex. 97.

sewing machine for producing the same." It was objected on behalf of the defendants that there was an inconsistency between the provisional and final specification, the word *trimming* being added in the latter. Kelly, C.B., overruled this objection, and held that by whatever name it was described the thing was in substance identical.

Patent is void if final specification comprises an invention which is not comprehended by the provisional.

We have seen (*o*) that one of the objects of the provisional specification is to determine that the invention described and claimed by the final, is really one and the same as that described by the provisional specification. The patent is altogether void if the final comprise an invention which is not comprehended by the provisional specification. (*p*)

Details.

It is not, however, necessary that all the details of the invention described by the final specification should be identical with those indicated by the provisional specification, provided that the invention remain substantially the same. The complete specification is, in a sense, supplemental to the provisional specification, not going beyond, nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional specification as to the manner in which the invention is to be performed. (*q*)

May be abandoned in the final specification.

Any subordinate matter, or point, or detail, may be abandoned in the final specification without affecting the validity of the patent, provided always that such abandonment does not change the nature of the invention, and make it really a different one to that described in the provisional specification; and such an abandonment is a notification to the public that the inventor could not work it, or thought it useless, and consequently, omitted it altogether. (*r*)

In *Thomas v. Welch* (*s*) the defendant contested the validity of the plaintiff's patent for a sewing machine on the ground that the complete specification omitted some of the inventions put forward in the provisional specification. It

(*o*) p. 147 *ante*.

(*p*) *Bailey v. Robertson*, L. R. 3 App. Cas. 1055; *Crossley v. Potter*, Macr. P. C. 240.

(*q*) Per Chelmsford, L.C., *Penn v. Bilby*, L. R. 2 Ch. 127.

(*r*) *Stoner v. Todd*, L. R. 4 Ch. D.

58; 46 L. J. Ch. 32; *Hutchison v. Pattullo*, 5 P. O. R. 351; *Thomas v. Welch*, L. R. 1 C. P. 192; *Penn v. Bibby*, L. R. 2 Ch. 127; 134; *Everitt's Patent*, Griff. L. O. C. 27.

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

appeared that the provisional specification described a certain instrument, and then went on to say that "this, or another acting therewith, acts to hold the work during the insertion of the needle." It was contended that the complete specification contained nothing corresponding to this second alternative. The Court of Common Pleas overruled this objection, and Erle, C.J., in his judgment said: "Assuming that this is so, I do not think the objection ought to prevail. The difference is a slight one, and injured nobody; and it may be that the patentee had something in his mind when he filed his provisional specification, which he found afterwards would be useless. As he could not disclaim, formally, part of the provisional specification, he might, I think, in such a case as the present, have omitted it from his complete specification. It may be, however, that one form if mentioned in the complete specification, which is in two parts, is what was referred to in the expression, '*and another acting therewith.*'"

If, however, the patentee omits in the complete specification anything which is described in the provisional specification, he cannot afterwards read the provisional to supply a defect in the final specification.

The provisional specification cannot be read to supply a defect in the complete.

Thus, in *Mackelcan v. Rennie*,^(t) the patent related to "improvements in floating docks;" and the provisional specification stated: "I construct a pontoon or vessel of iron-framing, sheeted over entirely with *plate-iron*, so as to form an air-tight chamber subdivided into compartments." And the complete specification stated: "Having in a provisional specification described the nature of my invention, I will now proceed particularly to describe the same," and went on to explain the arrangement of parts, and the method of employing the dock, but said nothing about its being constructed of iron. The claim was "the arrangement and combination of all the parts of any floating dock as represented and described."

Examples.

It appeared at the trial that floating docks, constructed of timber, were well known before the patent, and that the plaintiff's invention consisted in constructing such docks of iron. There being, however, no mention of iron in the

(t) 13 C. B. N. S. 52.

complete specification, Erle, C.J., held that the provisional specification could not be produced in aid for the purpose of supplying a deficit in the complete specification, and the plaintiff was nonsuited. The Court of Common Pleas refused a motion for a new trial, and approved the course the learned Chief Justice had taken in the Court below; and indicated an opinion that even if the defect had been supplied, the alleged invention could not properly be the subject of a patent.

Drawings.

It must not be forgotten that a provisional, like a complete, specification, must be accompanied by drawings, if required,^(u) and from a consideration of the foregoing pages, it will be apparent that great skill and care must be expended in the preparation of the instrument, so as to make it comprehensive enough to cover all that the patentee, after developing the discovery, may possibly wish to include and claim in the final and complete specification.

The Complete Specification.

The complete specification must particularly describe and ascertain the nature of the invention and in what manner it is to be performed.

The Patents, &c., Act, 1883, like the previous Act of 1852, enacts that the patentee shall in the complete specification particularly describe and ascertain the nature of the invention and in what manner it is to be performed, and further requires that this instrument shall be accompanied by drawings, if necessary.^(x)

The patentee is required to particularly describe and ascertain the nature of his invention so that the public may know what they are prohibited from doing without his leave or licence, during the continuance of the patent, and he is required to state in what manner the invention is to be performed, in order that the rest of the public may, when the patent expires, be able to put the invention into practice, and thus enjoy the benefit of the discovery.^(y)

In fact, the price which the patentee pays for his monopoly is the fulfilment of the obligation he is under of lodging such an account of his discovery as will enable the public at the expira-

(u) 46 & 47 Vict. c 57, s. 5, ss. 3.

(x) S. 5, ss. 44; see P. R. 1890.

(y) *Young v. Rosenthal*, 1 P. O. R. 31; *Macfarlane v. Price*, 1 Stark, N. P. 201.

tion of the time for which the grant is made, to have as free and unreserved use of the invention as he himself. (z)

The title and provisional specification (a) are sufficient if they give a mere rough and incomplete description of the invention; from them the public, except in the case of very simple inventions, obtain but little information of the real nature of the manufacture they are prohibited from using, and unless some specific and detailed information were given respecting what they are commanded by the terms of the grant to refrain from doing, during the continuance of the monopoly, it would be unfair to punish them for any violation of the patent right committed without the means of ascertaining its nature and extent.

Sufficiency of title and provisional specification.

It is apparent that, in every case in which an action for infringement is brought against a member of the public in respect of a particular patent, it is necessary to ascertain whether the act complained of is described in the complete specification, and claimed by implication, or otherwise, and whether the exclusive privilege of carrying out that particular operation is conferred upon the patentee.

If the specification does not sufficiently describe some art of manufacture which is substantially the same as that used by the alleged infringer, no action lies against him.

The complete specification requires the exercise of the greatest skill and care in drafting it, and is by no means easy to draw. The reason of this is that the conditions and tests which the law requires the document to satisfy are very numerous, and a failure in any one of them will not only make the specification bad, but will render the whole grant void.

It must be borne in mind that the object for which the complete specification exists is to give sufficient and complete information to the public of what they are prohibited from doing, without the sanction of the patentee, during the continuance of the patent, and what they will be able to do after it has expired. The following are the chief conditions which the law requires the complete specification to satisfy:—

Object of the complete specification.

(z) *Gibson v. Brand*, 1 W. P. C. 627; 4 M. & G. 179; 4 Scott, N. R. 844; 11 L. J. C. P. 177; *Wood v. Zimmer*, Holt, N. P. 58; 1 W. P. C. 82 n.

(a) *ante*.

Conditions which the law requires the complete specification to satisfy.

- I. The complete specification must be framed with the utmost good faith, and must not contain any false representation or misdescription of the invention or any material part of it.
- II. The complete specification must be intelligible to an ordinary workman, possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates.
- III. It is not necessary that a complete specification should describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.
- IV. The complete specification must particularly describe and ascertain the nature of the invention.
- V. The complete specification must be perfectly intelligible to the class of persons to whom it is addressed, so as to communicate to them what the art or invention is to which the patent applies, and that no person may be deceived or misled, but may be enabled to perceive the nature of the invention and also to put it into practical operation. If the invention consist of more than one part, the specification must contain a full, accurate, and intelligible description of every such part, and the means of carrying it into effect.
- VI. The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.
- VII. The complete specification need not describe any step or process which is necessarily implied.
- VIII. The complete specification need not describe minutely any known thing to which it refers.
- IX. The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.
- X. The complete specification must describe the best method known to the patentee of performing the invention and all his knowledge relating thereto.
- XI. The complete specification must give any information

relating to the best means of performing the invention, which the patentee may have acquired during the period of provisional protection prior to the date of filing the complete specification.

XII. The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.

XIII. If the complete specification describe anything which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.

I. *The complete specification must be framed with the utmost good faith, and must not contain any false representation or misdescription of the invention or any material part of it.* I. *Bona fides.*

A patent is to be considered as a bargain with the public, and the specification ought to be construed on the same principle of good faith as that which regulates all other contracts. (b) If any statement in the specification turn out to be untrue, or of a nature calculated to mislead or puzzle the public, the grant of the letters patent will thereby be rendered void, either on the ground that the untruth is part of the representation on the strength of which the grant was made, or that the patentee has not properly described and ascertained the nature of the invention and in what manner the same is to be performed. Patent is considered as a bargain with the public.

It was stated by Buller, J., in *R. v. Arkwright* (c) that if the specification, in any part of it, be materially false and defective, the patent is against law and cannot be supported. His lordship further held that if certain things mentioned in the specification were of no use, and merely thrown in to puzzle, the patent was void. If there is anything introduced into the specification which tends to mislead the public, or if the process as directed by the specification does not produce that which the patent professes to do, the patent itself is void. (d)

(b) Per Lord Eldon, *Cartwright v. Eames*, 14 Ves. 131, 136; *Sturz v. De la Rue*, 5 Russ. 322; 7 L. J. O. S. Ch. 47.

(c) Dav. P. C. 61; 1 W. P. C. 64.
(d) *Turner v. Winter*, 1 T. R. 602; 1 W. P. C. 77; *Palmer v. Wagstaff*, Newtons' L. J. vol. xliii. p. 131.

LETTERS PATENT FOR INVENTIONS.

Must not direct the use of things which will not answer;

must not suppress information or mislead.

A description of a method which will not produce the effect claimed.

Distinction between a false description of a method and a claim to something useless.

Neilson v. Harford.

If the patentee can make the article, which is the subject of the patent, with two or three of the ingredients specified, and he insert others which will not produce the effects stated, the patent will be void.(e)

If the patentee suppress anything, or mislead, his specification is bad—*e.g.*, if he say there are many modes of doing a thing, when in fact there is only one, this will avoid the patent. If he maintain that as an essential ingredient in the patent article which is not so, nor even useful, and thereby misleads the public, his patent may be void.(f)

If the specification describe two ways of doing a thing, and it turns out that by one of the ways specified it cannot be done, the specification is bad and the patent void.(g)

A false description of a method of performing the invention, or a part of it, must not be confused with a claim to something which turns out to be useless. In the latter case, if the useless part is a non-essential, the patent may be perfectly good notwithstanding the claim;(h) but in the former the patent cannot be sustained.

In *Neilson v. Harford*,(i) Parke, B., at the trial, said that his strong opinion, as then advised, was that a certain statement in the specification was incorrect and untrue, and that it being clearly untrue, it vitiated the specification, and prevented the patent from being a good patent. The jury, by their verdict, agreed with the view the learned baron took of the statement in question; but the Court of Exchequer, of which he was also a member, construed it differently, and Parke, B., is reported to have said :(k) “ At the trial, I construed this passage as meaning that the shape was immaterial to the degree of effect in making the blast; and, if this were so, the jury having by their finding negatived the truth and accuracy of this statement, the specification would be bad, as containing

(e) *Ibid.* see *Bickford v. Skewes*, 1 W. P. C. 211.

(f) *Lewis v. Marling*, 1 W. P. C. 493.

(g) *Beard v. Egerton*, 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270 19 L. J. C. P. 36; *R. v. Culler*, Macr. P. C. 137; *Savory v.*

Price, Ry. & M. 1; 1 W. P. C. 83; *Kurtz v. Spence*, 5 P. O. R. 161, 184.

(h) *R. v. Cutler*, Macr. P. C. 137; *Lewis v. Marling*, 10 B. & C. 22; 1 W. P. C. 493.

(i) 1 W. P. C. 313; 8 M. & W. 806.

(k) 1 W. P. C. 371.

a false statement in a material circumstance of a nature that, if literally acted upon by a competent workman, would mislead him, and cause the experiment to fail. . . . But my lords and my brothers, after considerable hesitation, are of opinion that a construction may be reasonably put upon this clause which will support the patent; and though I myself still entertain great doubt whether such is the true construction, I am not prepared to say that it is not."

In *Savory v. Price* (l) the patent was for the "invention of a neutral salt, under the name of *Scidlitz* powder," and the specification set out three distinct recipes for making the ingredients of the powder—viz., (1) Rochelle salt (*i.e.*, a double tartrate of potash and soda); (2) carbonate of soda; (3) tartaric acid—all of which were well-known substances before the date of the patent. It further stated the proportions in which these ingredients were to be mixed for compounding the *Scidlitz* powder. The plaintiff was nonsuited, Abbott, C.J., saying: "It is the duty of any one to whom a patent is granted to point out the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported."

Savory v. Price.

As has been said by Jessel, M.R. (m): "You must not mislead people by telling them to do something wrong, and leaving them to find out the mistake. . . . You must not give people mechanical problems and call them specifications."

The case of *Bloxam v. Elsee* (n) is an instance of a specification which was rendered void, because the patentee thereby represented that the machine described was capable of doing

Misstatement of capability.

(l) Ry. & M. 1; 1 W. P. C. 83.

(m) *Plimpton v. Malcolmson*, L. R. 3 Ch. D. 576.

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

more than it really could do—viz., making paper of different widths, whereas it was in reality only suited to paper of one definite width. And in *Crossley v. Potter* (o) the patent was declared bad, on the ground that the specification represented that the machine as described was applicable to the weaving of carpets as well as of coach lace, whereas such was not in reality the case. The direction of Pollock, C.B., to the jury contained the following instructive passage: "In my mind, the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves specifically to one good thing; and a jury will always take care that, if it be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of their genius."

If the specification contain what amounts to a false suggestion on the part of patentee—*c.g.*, if the title be "a machine for sharpening knives, scissors, and razors," and the body of the specification disclose only a machine which will sharpen knives; (p) or if the specification give only an insufficient description of the invention and the manner of performing it, the patent will in each case be equally bad. In the former it will be void on the same principle that an ordinary grant of lands or tenements from the Crown is by a false suggestion of the grantee rendered inoperative, not merely against the Crown, but in a suit against a third person; (q) and in the latter it will be bad, because the statutory requirements have not been complied with. (r) But a statement in a specification to the effect that an invention is applicable to other purposes than that specified will not vitiate the patent, as there is no objection to a patentee stating that what he has invented with reference to one particular machine may be applicable to other machines. (s)

Statement that an invention is applicable to other purposes than those specified.

Statement that something is important,

A statement in a specification to the effect that a certain thing is important which is in fact not so, (t) or that something

(o) Macr. P. C. 240.

(p) Felton v. Greaves, 3 C. & P. 611.

(q) Travell v. Carteret, 3 Lev. 135; Alcock v. Cooke, 5 Bing. 340; Morgan v. Seward, 2 M. & W. 544.

(r) See 1 W. P. C., and cases there referred to.

(s) Cole v. Saqui, 5 P. O. R. 494.

(t) Huddart v. Grimshaw, 1 W. P. C. 85.

is immaterial which is in reality material,^(u) will, it is submitted, amount to an attempt to deceive, and so render the patent void.

which is not so, or that something is immaterial which is material.
Examples:
R. v. Metcalf.

In *R. v. Metcalf* ^(x) the patentee, both in the title and body of the specification, described the object for which the patent was obtained to be the manufacture of "a tapered hair or head brush," and the method of manufacture to consist in cutting hair in lengths of about one inch and a quarter, and then mixing it by hand and shaking it together as unevenly as possible, and finally attaching the hairs so cut and mixed to the stock by means of wires. At the trial it appeared that the patented brushes had bristles of unequal length mixed indiscriminately together. Lord Ellenborough, C.J., held that the invention was improperly described, and said: "Tapering means gradually converging to a point. According to the specification the bristles would be of an unequal length, but there would be no tapering to a point which the description assumes. If the word 'tapering' be used in its general sense, the description is defective—there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical consideration can be removed." After further evidence his lordship advised the jury to find that it was not a *tapering*, but only an unequal brush, which they accordingly did. A rule for a new trial was refused.

In *Felton v. Greaves*,^(y) the plaintiff had obtained his patent for "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments," and it appeared that the invention, which was stated in the specification to consist in a machine for sharpening various cutting instruments by passing their cutting edges backward and forward in the angle formed by the intersection of two or more circular files in the manner explained, was suitable for sharpening knives, but it would not do for sharpening scissors. The files were stated to be in the form of cylinders, and at the

Felton v. Greaves.

^(u) Neilson v. Harford, 1 W. P. C. 313.
^(x) 3 Car. & P. 611.

^(y) 2 Stark. N. P. 249.

trial it appeared in evidence that in order to adapt the instrument to the sharpening of scissors it was necessary to have one of them smooth, which the specification did not describe, and Lord Tenterden, C.J., on this ground directed a nonsuit.

Bainbridge v.
Wigley.

In *Bainbridge v. Wigley*,^(z) the specification stated that the invention consisted in certain improvements in the English flute, whereby the fingering was rendered more easy, and certain notes produced that were never before produced, whilst it appeared in evidence that, as a matter of fact, only one new note was produced. Lord Ellenborough held that this was fatal to the patent, the consideration on which it was granted not being truly set forth. The patentee had stated that, by his improvement, he gave new notes, when in fact he had given but one new note.

II. Must be
intelligible to
ordinary work-
men.

II. *The complete specification must be intelligible to ordinary workmen possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates.*

In *Morgan v. Seaward*,^(a) Alderson, B., told the jury that a specification is addressed to all the world: and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification, and the specification should be such as to enable a workman of ordinary skill to make the machine.^(b) Parke, B., in *Neilson v. Harford*,^(c) laid down the law in the following terms: "You are not to ask yourselves the question whether persons of great skill—a first-rate engineer or a second-class engineer—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may

^(z) Parl. Rep. 192; 1 Carp. P. C. 270.
^(a) 2 M. & W. 544; 1 W. P. C. 167;
6 L. J. Ex. 153.

^(b) See also *Gibson v. Brand*, 1 W.
P. C. 631; *Sturz v. De la Rue*, 1 W.

P. C. 83; 5 Russ. 327; *Beard v. Eger-*
ton, 8 C. B. 165; *Bickford v. Skewes*,
1 W. P. C. 218.

^(c) 1 W. P. C. 295; 8 M. & W.
806; 11 L. J. Ex. 20.

be supposed to be addressed—it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity on the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, whatever its shape was, according to the terms of this specification, then I think that this specification is good, and that the patent may be supported so far as it relates to that.”

The following passage, from the judgment of Jessel, M.R., in *Plimpton v. Malcolmson*,^(d) has been approved of in recent cases as a correct statement of the law as to whom a complete specification must be intelligible^(e): “It is plain that the specification is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But there are various kinds of people who know something about it. 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 factories, 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, from imperfect descriptions, and would be able to supplement so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. . . . It will be a bad specification if the first

Statement by
Jessel, M.R.,
as to whom
the complete
specification
must be in-
telligible.

^(d) L. R. 3 Ch. D. 531, 568; 44 L. J. Ch. 257. 4 P. O. R. 242; *Bray v. Gardner*, 4 P. O. R. 400, 406; *Edison v. Holland*, 6 P. O. R. 243

^(e) *Edison v. Woodhouse*, 4 P. O. R. 79; *Moseley v. Victoria Rubber Co.*,

two classes only understand it, and if the third class do not." (*f*)

Must define the invention so that an ordinary skilful workman can carry it out.

The complete specification must define the invention so that an ordinary skilful workman may carry it out. (*g*) Maule, J., said, in reference to the specification of an invention relating to photography: "If so much nicety of description is required it would be impossible to draw a specification at all. It is enough if it be so explicit as to enable a man of ordinary competent skill, and willing to learn, to perform the operation. A competent workman must be taken to know the known properties of iodine, of silver, and of nitric acid, or else the specification should have included a statement of the properties of each of these substances." (*h*)

Definition of ordinary skilful workman.

Every inventor capable of sustaining a patent for his invention adds, it is clear, something to what was known before, and it is submitted that the ordinary skilled workman, to whom it may be supposed that his specification is addressed, must be interpreted to mean a person having a reasonably competent knowledge of what was known before on the subject to which the patent relates, and a reasonably competent skill in the practical mode of doing what was then known. (*i*)

If it appear in evidence that a person possessed of the highest scientific knowledge might be left in doubt as to the exact meaning of a direction contained in the complete specification, whereas a person possessing merely ordinary knowledge on the subject has no difficulty in interpreting the machine, the patent will be upheld with respect to the sufficiency of the specification. (*k*)

(*f*) See also Neilson *v.* Harford, 1 W. P. C. 314.

(*g*) Wallington *v.* Dale, 7 Exch. 888; 23 L. J. Ex. 49.

(*h*) Beard *v.* Egerton, 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 30; see also Otto *v.* Linford, 46 L. T. N. S. 35; Badische Anilin und Soda Fabrik *v.*

Levinstein, L. R. 12 App. Cas. 710, 713; 4 P. O. R. 449; Moseley *v.* Victoria Rubber Co., 4 P. O. R. 241, 253.

(*i*) See Edison *v.* Holland, 6 P. O. R. 243, 280.

(*k*) Badische Anilin und Soda Fabrik, *v.* Levinstein, 12 App. Cas. 710; 4 P. O. R. 449.

III. *It is not necessary that a complete specification should describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.*

III. Need not instruct persons wholly ignorant of the subject-matter.

The specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufacture to which it relates.^(l)

Lord Loughborough, in *Arkwright v. Nightingale*,^(m) stated that a specification is addressed to persons having skill in the subject, and not to men of ignorance, and if it be understood by those whose business leads them to be conversant in such subjects it is sufficient.

Arkwright v. Nightingale.

In *Rex v. Arkwright*,⁽ⁿ⁾ a case in which the patent called in question related to a mechanical invention, Buller, J., said, that if the specification be such that mechanical men of common understanding can comprehend it, so as to make a machine by it, it is sufficient; but then it must be such that mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

Rex v. Arkwright.

When it is said that the meaning of the specification is that others may be taught to do the thing for which the patent is granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no sort of specification would, probably, enable a ploughman, utterly ignorant of the whole art, to make a watch; and a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions.^(o)

Per Lord Ellenborough.

The patentee must not leave the description of the way in which the invention is to be performed in such a state that persons desirous of carrying it out would find that they had virtually to solve a problem before they could do so. The person reading the specification is called upon to bring to bear,

Knowledge common to the trade must be brought to bear.

^(l) *Huddart v. Grimshaw*, 1 W. P. C. 85, 87; *Bickford v. Skewes*, 1 W. P. C. 218; *Hornblower v. Boulton*, Dav. P. C. 221, 228; *Edison v. Holland*, 6 P. O. R. 243, 277, 278, 280.

^(m) Dav. P. C. 39; 1 W. P. C. 60.
⁽ⁿ⁾ Dav. P. C. 61; 1 W. P. C. 64.
^(o) *Per Lord Ellenborough, C.J.*, in *Harmar v. Playne*, Dav. P. C. 318; 11 East, 181.

in interpreting the specification, all the existing knowledge common to the trade; and he must not be called upon to exercise anything more. The specification must be drawn in such a manner as not to call on a person reading it 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.(p)

IV. Must particularly describe and ascertain the nature of the invention.

IV. *The complete specification must particularly describe and ascertain the nature of the invention.*

This was specially enacted by the Act of 1883, s. 114; but before that statute the public had a common-law right to a fair, full, and true description;(q) and it was laid down by Ashurst, J.,(r) that 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 that it is of consequence that the terms used should express the invention in the clearest and most specific manner. Buller, J.,(s) declared that where attempts were made to evade a fair patent, he was strongly inclined in favour of the patent, but when the discovery is not fully made the Court ought to look with a very watchful eye, to prevent any imposition on the public.

Whilst, in order to support a patent, it is necessary that the patentee should make a full disclosure to the public, yet, if he make a full and fair disclosure *as far as his knowledge at the time extends*, he has done all that is required.(t)

Reason for full disclosure.

Cresswell, J., stated the reason why a full disclosure is required, is that a party who obtains a patent is bound clearly to define in his specification what it is he claims as his invention, in order that the public may know with certainty what they may, or may not, do without incurring the risk of an action for infringement of the patent,(u) and Alderson, B.,(x) laid it down

(p) *Morgan v. Seaward*, 1 W. P. C. 174.
 (q) *R. v. Arkwright*, Dav. P. C. 61;
Macfarlane v. Price, 1 Stark. N. P. 199;
 1 W. P. C. 74 r.; *Gibson v. Brand*, 1
 W. P. C. 640.
 (r) *Turner v. Winter*, 1 W. P. C. 77,
 1 T. R. 602.

(s) *Ibid.*
 (t) *Lewis v. Marling*, 10 B. & C. 22;
 1 W. P. C. 496.
 (u) *Gibson v. Brand*, 1 W. P. C. 627.
 (x) *Morgan v. Seaward*, 1 W. P. C.
 174, 179.

that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect.

It is a condition, without the fulfilment of which the patent is void, that the patentee shall state the nature of his invention, in order that persons reading his specification shall know, and shall know with reasonable clearness and facility, what they are prohibited from using by the letters patent without permission or licence.(y)

In the case of patents for improvements on existing inventions Improvements. the patentee must be specially careful to claim only the improvement and not the old invention.(z)

V. *The complete specification must be perfectly intelligible to the class of persons to whom it is addressed, so as not only to communicate to them what the art or invention is to which the patent applies, but so that no person may be deceived or misled, but may be enabled thereby to perceive the nature of the invention, and also to put it into practical operation. If the invention consist of more than one part, the specification must contain a full, accurate, and intelligible description of every such part, and the means of carrying it into effect.* V. Must contain a full description of every part, and the means of carrying it into effect.

In *Hill v. Thompson*,(a) Lord Eldon, L.C., approved of the statement of the law on the subject of patents to the jury by the judge in the Court below, who declared that the specification must be intelligible. Indeed, it is very evident that such must be the case, for it would be absurd to enact that a specification must be enrolled, and then to hold that one not intelligible will satisfy the conditions of the act. Hill v. Thompson.

In *Turner v. Winter*,(b) it appeared that in carrying out the invention in dispute it was necessary that during the process the materials used should be fused, though the specification only alluded to calcination. The specification mentioned the use, as Turner v. Winter.

(y) *Philpot v. Hanbury*, per Grove, J., 2 P. O. R. 33; see also *Fairburn v. Household*, 3 P. O. R. 128; 3 P. O. R. 263; *Rowcliffe v. Morris*, 3 P. O. R. 17.

(z) *Eades v. Starbuck Waggon Co.*, W. N. 1881, p. 160; p. 59 *ante*.

(a) 1 W. P. C. 237.

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

an alternative for other substances, of *fossil salt*, but it appeared at the trial that *fossil salt* was a generic term, including several species, and that *sal gem* was the only species of it which would answer the purpose. The patent was declared void, the specification not being intelligible, in so far as it did not state the degree of heat necessary, and the particular species of fossil salt which would answer the purpose.

Two inventions in one patent, must be both properly specified.

In *Morgan v. Scaward*,^(c) Alderson, B., told the jury that the patentee had in his specification described two inventions, and that the patent would fail if either of them were insufficiently specified; for if a person run the hazard of putting two inventions into one patent, he cannot hold his patent, unless each can be supported separately.

He told the jury this after having previously directed them that, in law, the patentee is required to state fairly to the public what the invention really is, in order that other persons may know what is the prohibited ground, and that the public may be made acquainted with the means by which the invention is to be carried into effect.

The learned baron also pointed out to the jury that it is of great importance to the public, and by law absolutely necessary, that the patentee should state in his specification not only the nature of his invention, but how that invention may be carried into effect. Unless he be required to do this, monopolies would be given for a term of years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect.

If the specification be not intelligible to the public to whom it is addressed, the patentee will not have fulfilled the obligation which the law imposes upon him of telling the public for what it is that he claims the invention.^(d) And in the words of Lord Eldon, L.C., "in order to support a patent, the specification

^(c) 2 M. & W. 544; 1 W. P. C. 170; 6 L. J. Ex. 153; see also *Reg v. Wheeler*, 2 B. & Ald. 345; *Macnamara v. Hulse*, Car. & M. 471; *Stevens v.*

Keating, 2 W. P. C. 175; 19 L. J. Ex. 57.

^(d) *Neilson v. Thompson*, 1 W. P. C. 283.

should be so clear as to enable all the world to use the invention as soon as the time for which it was granted is at an end.”(e)

If the specification is not sufficiently explicit to enable others to practise the invention, then it defeats one of the objects for which it was required—viz., “that useful novelties may be given to the public, of which, at the end of the term granted to the patentee, they shall have the full benefit.”(f)

In *R. v. Arkwright*,(g) Buller, J., directed the jury that 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 which the patent is granted, what the art is; and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it.

If the patentee use a word inaccurately, but from the context it is perfectly clear in what sense he intends it to be understood, such an inaccuracy will not be an objection which could be successfully urged against the validity of the specification.(h)

A specification which discloses in one set of words both the nature of the invention and the mode of performing it is sufficient.(i)

All that is necessary is that the specification shall be intelligible to the persons to whom it is addressed, and enable them to perform the invention; and a specification so intelligible will not be vitiated by the fact that it contains slight mistakes and errors which any workman of ordinary skill and experience would perceive and correct.(k)

But this last statement must be understood as referring only to errors which appear on the face of the specification, or the drawings therein referred to, or which would be at once dis-

(e) *Newbury v. James*, 2 Mer. 446, 451; 1 Carp. P. C. 367.

(f) *Holmes v. London and North Western Ry. Co.*, Macr. P. C. 13, 16; *Hills v. London Gas Light Co.*, 5 H. & N. 312, 340.

(g) *Dav. P. C. 61*; 1 W. P. C. 64.

(h) *Derosne v. Fairie*, 1 W. P. C. 154, 157; *Minter v. Mower*, 1 W. P. C. 141;

see also *R. v. Metcalf*, 1 W. P. C. 141 n.; 3 Car. & P. 611.

(i) *Edison v. Holland*, 6 P. O. R. 280.

(k) *Simpson v. Holliday*, 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Otto v. Linford*, 46 L. T. N. S. 35; *Morgan v. Seaward*, 1 W. P. C. 176.

covered and corrected in following out the instructions given, for such errors cannot possibly mislead ;(l) and it must not be understood as a correct statement of the law where errors are discoverable only by experiment and further inquiry. The proposition, moreover, is not true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describe several processes or several combinations of machinery, and affirm that they will all produce a certain result which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be observed by an ordinary workman.(m)

A workman is not to be called upon to correct any error unless there is something to correct it by.(n) Thus, in the case of Hinks' patent for the paraffin lamp the drawing did not show, and the letterpress did not describe, a certain small opening in the second burner which was necessary to the effective working of the lamp. Jessel, M.R., held this to be a fatal defect which a workman could not be called on to remedy. In the case of an invention the whole merit of which is very small indeed, if people are told how to do things better, they must be told properly, without the exercise of invention or much trouble.(o)

Objections to the working of a patent are not usually allowed when a patent has stood for a long time the test of inquiry.(p)

Foreign words. The objection to the sufficiency of a specification, on the ground that it made use of *French* expressions, such as *vis de pression*, *vis de repulsion*, and *vis de reaction*, for different screws, and *centimetres* for inches, was taken in *Bloxam v. Elsee*,(q) but was not sustained, as it appeared that, although these terms would

(l) p. 159 *ante*.

(m) See remarks by Lord Westbury, L.C., in *Simpson v. Holliday*, 13 W. R. 577; 5 N. R. 340; 35 L. J. Ch. 811; L. R. 1 H. L. 315; p. 89 *ante*.

(n) *British Dynamite Co. v. Krebs*; 41 P. C. 190; *Hinks v. Safety Lighting*

Co., 4 Ch. D. 615; *United Telephone Co. v. Harrison*, 607 L. R. 21 Ch. D. 720.

(o) *Hinks v. Safety Lighting Co.*, L. R. 4 Ch. D. 615; 46 L. J. Ch. 185.

(p) *Betts v. Neilson*, L. R. 5 H. L. 121; per Lord Westbury, L.C.

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

not be understood by *English* mechanics, yet a skilful workman could construct the machine by the aid of the drawings annexed to the specification, Abbott, C.J., saying: "An inventor of a machine is not tied down to make such a specification, as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and if by a comparison of the words and drawing the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

The use of the word "discolour," as meaning "discharge the colour," being a bad translation of the French word "discolour" has been held not to be of sufficient importance to upset a specification.^(r)

A specification will be sufficient which contains directions enabling a person having a reasonably competent knowledge and skill of the subject to make the article described without further invention, though it may be necessary for him to make some trial and experiment before succeeding,^(s) but a specification which does not contain sufficient information to enable this to be done is absolutely fatal to the validity of the patent.^(t)

Specification valid, though trials are necessary to success.

VI. *The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.* VI. Must not be ambiguous.

In the language of Ashurst, J., "It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable, and if it appears that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. . . . It is certainly of consequence that the terms of a specification

Per Ashurst, J.

(r) *Tetley v. Easton*, Newton's L. J. vol. xlii. p. 58; 18 C. B. 643; 25 L. J. C. P. 293.

(s) *Edison v. Holland*, 6 P. O. R. 243.

(t) *Liardet v. Johnson*, 1 W. P. C. 53; *R. v. Arkwright*, 1 W. P. C. 70; *Neilson v. Harford*, 1 W. P. C. 317; *Hinks v.*

Safety Lighting Co. L. R. 4 Ch. D. 607; *Bailey v. Robertson*, L. R. 3 App. Cas. 1055; *Pooley v. Pointon*, 2 P. O. R. 167; *Hutchison v. Patullo*, 5 P. O. R. 351; *Ellington v. Clark*, 5 P. O. R. 327; *Goulard v. Gibbs*, 5 P. O. R. 525, 535.

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,^(u) and, as was pointed out by Dallas, L.C.J.,^(x) if the instrument contains an ambiguity in a material point, that is a ground on which it may be avoided altogether.

Want of clear-
ness or studied
ambiguity.

If there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention, and if there is any studied ambiguity in it, so as to conceal from the public that of which the patentee is, for a term, enjoying the exclusive benefit, the patent itself will be completely void.^(y)

Including
what will, and
what will not
answer.

Again, if the specification in describing any materials or ingredients which are necessary for the purpose of carrying out the invention, uses language wide enough to include what is unsuitable as well as what is suitable for the purpose, the ambiguity will be fatal.^(z)

Meaning of
terms liable to
change.

It must not, however, be forgotten that the meaning of words is liable to change with the progress of science and discovery, and a term, which, for the purpose of the specification, is sufficiently accurate, may, in future years, include that which will not answer the purpose the patentee has in view. In such a case the specification will be read with reference to the state of knowledge at the time it was prepared, and if the term used include nothing *then* known that would not answer, it will not be held to be ambiguous, though the use of the same term subsequently might be.^(a) This is only equitable, for a patentee is not entitled to a monopoly of ingredients and materials unknown at the date of the specification, even though the language used be sufficiently wide to include them.^(b) It would be manifestly unfair to hold that language which, by the advance

Interpreted
with reference
to their mean-
ing at date of
specification.

^(u) *Turner v. Winter*, 1 T. R. 602 ;
1 W. P. C. 77.

^(x) *Campion v. Benyon*, 6 B. Moo. 71 ;
3 Brod. & B. 5

^(y) Per Tindal, C.J., *Galloway v.*
Bleaden, 1 W. P. C. 521.

^(z) *Ralston v. Smith*, 9 C. B. N. S.
117 ; 11 C. B. N. S. 471 ; 11 H. L. Cas.
223 ; *Booth v. Kennard*, 2 H. & N. 84 ;
Haworth v. Hardcastle, 1 W. P. C. 484 ;
Saunders v. Aston, 3 B. & Ad. 881, 886 ;
1 W. P. C. 75 n. ; *Kurtz v. Spence*, 5
P. O. R. 161 ; *Stevens v. Keating*, 2

W. P. C. 194 ; *Muntz v. Foster*, 2 W.
P. C. 109 ; *Hills v. London Gas Light Co.*,
5 H. & N. 312 ; 27 L. J. Ex. 60 ; 29 L.
J. Ex. 409 ; *Bailey v. Robertson*, L. R.
3 App. Cas. 1070.

^(a) *Badische Anilin und Soda Fabrik*
v. Levinstein, L. R. 24 Ch. D. 156 ; 12
App. Cas. 410 ; 4 P. O. R. 449 ; *Cross-*
ley v. Beverley, 3 Car. & P. 513 ; 1 W.
P. C. 112.

^(b) *Tetley v. Easton*, Macr. P. C. 77 ;
18 C. B. 643 ; 25 L. J. C. & P. 293.

of knowledge, has come to include more than the patentee contemplated, should vitiate the patent.

In *Wegmann v. Corcoran* (c) the Court of Appeal upheld a decision of the Court below declaring a patent for an improved machine or apparatus for treating or preparing meal, void on the ground of the ambiguity of the language used by the specification. The patentee stated that the squeezing rollers of the improved machine were to have "a surface consisting of a material containing so much silica as not to colour the meal or flour" and went on to say that he preferred to make them of "iron coated with china, and finely turned with diamond tools." It was proved in evidence that there are two kinds of china—Oriental or Chinese china, containing 73 per cent. of silica, and very hard, and the china usually made in this country, containing only about 40 per cent. of silica, and much softer. The evidence also established that the first kind of china would answer the purpose, but the second would not, and that the invention was useful in milling operations. The Courts held that the specification was bad, as being ambiguous and inadequate in so far as it did not state what kind of china was to be employed.

Example:
Wegmann v
Corcoran.

It is always a question for the jury, or the Court acting as a jury, to say whether or not the specification describes with sufficient accuracy the ingredients or materials which the patentee directs to be used, (d) but a patentee is not obliged in referring to materials and ingredients to enter into minute details as to them, if they are known in commerce and can be readily procured under the names which he gives them. (e) The names of articles mentioned must be taken to be used in their ordinary commercial sense. (f)

Accuracy
question of
evidence.

The specification of Medlock's patent for improvements in the preparation of red and purple dyes directed the use of *dry*

Examples.

(c) L. R. 13 Ch. D. 66.

(d) *Bickford v. Skewes*, 1 W. P. C. 214; *Derosne v. Fairie*, 1 W. P. C. 154; *Elliott v. Turner*, 2 C. B. 446; *Wallington v. Dale*, 7 Exch. 888.

(e) *MacIntosh v. Everington*, 2 Carp. R. 180, 191.

(f) *Simpson v. Holliday*, 2 Newton,

L. J. 118; 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Stevens v. Keating*, 2 W. P. C. 183, 187; 19 L. J. Ex. 57; *Muntz v. Foster*, 2 W. P. C. 104; *Sturz v. De la Rue*, 1 W. P. C. 83; 5 Russ. 327; *Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 24 Ch. D. 156; 12 App. Cas. 710; 4 P. O. R. 449.

arsenic acid in a part of the process, and this was held by Lord Westbury, L.C., to refer to the ordinary arsenic acid of commerce (which is dry to the touch, although it contains water of hydration), which would answer, and not to the anhydrous form, which would not answer;(g) but in a case where the specification directed the use of "the finest and purest chemical white lead," and it appeared in evidence that there was no substance known in the trade by that name, but that white lead only was known, the specification was held to be defective on the ground of ambiguity."(h)

Where proportions are essential, the most suitable must be stated.

In the case of an invention of a new use of known substances in new proportions,(i) the patentee in his complete specification is bound to state the most suitable proportions within his knowledge,(k) but he is not obliged to limit his claim to the precise proportions mentioned.(l)

Example of an ambiguous specification.

In *Hastings v. Brown*,(m) a patent granted for "certain improved arrangements for raising ships' anchors and other purposes" was upset, on the ground that the language used in the specification was ambiguous. The patent related to a windlass, the drum of which was grooved in a V form, the sides of the V groove being scalloped or recessed into a series of shell-like indentations, which formed a hold for the links of a chain cable, and the words used in the specification to describe the object of the invention were, "the scallop shell is upon a new plan, intended to hold, without slipping, a chain cable of any size, as shown by the opening form of the scallop at the top and bottom of Figure 2." The drawing referred to (n) merely showed an indented V groove. It was established in evidence that before the date of the patent no cable-holder was known which would hold chains of different sizes, and the invention claimed by the pleadings as a novelty was the application of a single windlass to different sizes of chain cable. It was also established that a windlass, capable of holding a chain cable of a given size, was no novelty. The defendant's case was that

(g) *Simpson v. Holliday*, 5 N. R. 340; L. R. 1 H. L. 315.

(h) *Sturz v. De la Rue*, 1 W. P. C. 83; 5 RUSSELL 327.

(i) Chap. II. p. 65.

(k) See *post*.

(l) *The Patent Type Foundry Co. v. Richards*, 6 Jur. N. S. 39.

(m) 1 E. & B. 450; 22 L. J. Q. B. 161.

(n) Fig. 2.

the patent was void because the language used in the specification left it doubtful whether the claim was for holding a chain of a given size, or for holding chains of different sizes. The jury gave a verdict in favour of the patent. The Court of Queen's Bench subsequently, however, directed a nonsuit to be entered, on the ground that the specification was bad, Lord Campbell, C.J., saying: "It is clear that the patentee ought to state distinctly what it is for which he claims the patent, and describe the limits of the monopoly. This is not done by this specification. The claim is for an invention by which a single windlass may raise cables of different diameter, which is allowed to be a great improvement. But is that pointed out by the specification? The words are at best equivocal. If he claims for a windlass that is fitted for one cable only, of whatever size, there is no novelty; and the vice of the specification is that it does not assert that more can be done by the invention. The title tells us nothing. The words of the specification are, 'a chain cable of any size.' 'A' applies to one only. At all events, the phrase is capable of that meaning; and the specification, if it be equivocal, is bad. I see nothing in the words, or in the drawing, that necessarily indicates the contrivance to be for fitting more than one cable. You might make a windlass according to the drawing which would do no more than that."

It is settled law that a person, to be entitled to the benefit Directions. of a patent, must disclose his secret and specify his invention in such a way that others of the same trade may be taught to do that for which the patent is granted, by following the directions in the specification, without any new invention or addition of their own.^(o) And the specification ought to be framed so as not to call on 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.

In judging of the sufficiency of the specification, the proper Criterion of sufficiency. criterion is whether a person, by using only the existing knowledge common to the trade at the date of the patent,

(o) Per Buller, J., *R. v. Arkwright*, Dav. P. C. 106; 1 W. P. C. 66, and note.

would be able to exercise the invention without using information derived from any other source.^(p) Tindal, C.J., directing the jury in *Muntz v. Foster* (*q*) as to the sufficiency of the specification, used the following words: "People are not to go on and make experiments, at a great expense to themselves, which shall turn out to be bootless and fruitless; but they rely on an honest and open and candid exposition by the patentee of everything that is necessary for the easy and certain procurement of the commodity for which the patent was granted; that is a question upon the evidence." And, in the language of Jessel, M.R., "you are not to tell a man to make an experiment, but to tell him how to do the thing."^(r)

*Stevens v.
Keating.*

In *Stevens v. Keating* (*s*) the Court of Exchequer upheld the verdict, given in the court below for the defendant, on the question of the sufficiency of the plaintiff's specification. One of the patents in question in the action related to a method of making cement, by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlash in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated: "Other alkalis and acids, besides those hereinbefore mentioned, will answer the purpose of my invention, though some that I have tried answer as well as the alkali and acid hereinbefore set forth;" and concluded with a claim for the process of mixing the powdered materials, alkalis, and acids, as described, and subsequently burning, heating, or calcining the same, for the purposes set forth.

Pollock, C.B., in the Court of Exchequer, upholding the verdict below, pointed out in his judgment that only one alkali (potash) and one acid (sulphuric) were mentioned in the specification, but manifestly the inventor did not confine himself to them; if he did, the defendant would be entitled to a verdict,

(*p*) Per Alderson, B., *Morgan v. Seaward*, 1 W. P. C. 173, 174; *Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 12 App. Cas. 710; 4 P. O. R. 463; *British Dynamite Co. v. Krebs*, G. P. C. 88; *Neilson v. Harford*, 1 W.

P. C. 371; *Rex v. Arkwright*, 1 W. P. C. 66.

(*q*) 2 W. P. C. 92, 109.

(*r*) *British Dynamite Co. v. Krebs*, G. P. C. 90.

(*s*) 2 W. P. C. 175; 19 L. J. Ex. 57.

on the plea of no infringement, for he used neither. "To what extent, then, does the claim go beyond the alkali and acid named? If it be a claim of all acids and alkalis, it is clearly bad, as there are some that will not answer the purpose. If it be a claim of those only which will answer the purpose, it is clearly bad, in consequence of not stating those which will answer the purpose and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not; and this was expressly so determined by the Court of Queen's Bench in *R. v. Wheeler*,^(t) where they say that a specification which casts on the public the expense and labour of experiment and trial is bad. In my view, therefore, this specification is defective."

If the specification be such that the persons to whom it is addressed are not able, by following its directions, to produce any beneficial result without the further necessity of performing experiments and trials involving invention, it is bad. It will not, however, be bad if a beneficial result can be obtained by strictly carrying out the directions given, though further experiments may be necessary to obtain the result in a higher degree,^(u) provided that the patentee has given the best means known to him of carrying out the invention.^(x)

If the specification contain language which is calculated to mislead the public into performing experiments which the patentee knows must fail, such language will be a fatal defect in the specification. Thus, in *Crompton v. Ibbotson*,^(y) a patent for "improvements in dyeing and finishing paper" was held bad on this ground. The specification stated: "My invention consists in conducting paper by means of a cloth against a heated cylinder, which cloth may be of *any suitable* material, but I *prefer* it to be made of linen warp and woollen weft." One of the witnesses for the plaintiff admitted that as to the conducting medium he had tried several things, but he was not aware that

Specification necessitating experiments involving invention.

Misleading language.

Crompton v. Ibbotson.

^(t) 2 B. & Ald. 345.

^(u) *Neilson v. Harford*, 1 W. P. C. 295, 318; *Macnamara v. Hulse*, Car. & M. 471; 2 W. P. C. 128 n.; *Otto v.*

Linford, 46 L. T. N. S. 39; *Edison v. Holland*, 6 P. O. R. 243.

^(x) p. 183 *post*.

^(y) Dan. & L. 33; 6 L. J. O. S. K. B. 214.

anything would answer the purpose except the material which the patentee said he preferred, and the plaintiff was nonsuited. The Court of King's Bench refused to set the nonsuit aside, Lord Tenterden, C.J., pointing out that the patent was obtained for the discovery of a proper conducting medium, and that the plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in the specification, whilst he said that the cloth might be of any suitable material, and merely that he preferred the particular kind in the specification mentioned. Other persons, misled by this statement, might be induced to make experiments, which the patentee knew would fail. The public, therefore, had not the full and entire benefit of the invention. In *Winter v. Turner* (z) a patent was held void on the ground of a similar ambiguity in the specification.

Absolute
precision.

Absolute or perfect precision in the specification is impossible, and cannot therefore be required. It will be quite sufficient if the document is comprehensible to the ordinary workman in the trade to which the invention relates.

The following remarks of Grove, J., are instructive upon this point: "Every word I give will be open to exception, and no human being probably could criticise my language more than I could myself, if I were to sit upon it, because I am one of those who believe that there is no form of words which can be used with such accuracy as to exclude every other conclusion but the one which the speaker or the writer intends to express. I have never yet seen any form of words, even of moderate length, upon which a person reading it in an adverse spirit might not put a different conclusion from that which the author intends, and those who have written books, or have had to deal with drawing legal documents, or other matters of that sort, know how impossible it is to give any definition, or use any form of words, which may not be excepted to."(a)

(z) 1 T. R. 602; 1 W. P. C. 77. 216; *Arkwright v. Nightingale*, Dav. P. C. 37.
(a) *Philpot v. Hanbury*, 2 P. O. R. 38; see also *Boulton v. Bull*, Dav. P. C.

VII. *The complete specification need not describe any step or process which is necessarily implied.*

VII. Need not describe any step or process implied.

For instance, in the case of a specification of a newly invented chemical process, which directed that some particular chemical substance should be poured upon gold in a state of fusion, it would not be necessary that the specification should describe the obvious fact that, in order to carry out this direction, the gold would have to be put into a crucible and melted; nor would it be necessary to specify the manner in, nor the utensils with, which the operation of putting gold into a state of fusion was to be performed, these being mere incidents with which every man acquainted with the subject must be familiar.(b)

Examples.

In *Crossley v. Beverley* (c) it was sought to upset a patent for an "improved gas apparatus," on the ground that the specification did not specify the use of a condenser, without which the apparatus would not work satisfactorily. Lord Tenterden, C.J., however, overruled this objection, holding that any workman capable of making a gas apparatus would know that he must put in a condenser, and the specification did not direct that the condenser should be left out.

In *Russell v. Cowley* (d) the specification of an invention for the manufacture of iron tubes without the use of a mandril was held sufficient, though it did not specifically state that the mandril was to be left out. The ground of the decision was that an ordinarily intelligent workman would, from the general purport of the specification, sufficiently understand that the mandril was to be omitted.(e)

VIII. *The complete specification need not necessarily describe minutely any known thing to which it refers.*

VIII. Need not describe minutely any known thing.

For example, in the case of an invention which consists of an improvement on an existing machine, it would not be necessary for the patentee in the specification to enter into a minute description of the old machine, but it must not be forgotten that

E.g., An old invention.

(b) *Boulton v. Bull*, Dav. P. C. 162; 2 H. Bl. 498.

(c) 3 Car. & P. 513; 1 W. P. C. 106.

(d) 1 W. P. C. 459.

(e) See also *Beard v. Egerton*, 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

the language used must be such as will distinguish the invention from that which is old. (*f*)

In *Harmar v. Playne* (*g*) the patent related to improvements in machinery secured by previous letters patent. It was admitted by the defendant that the improvements for which the second patent was granted were included in the second specification, which gave a full and proper description of the whole machine in its improved state. It was objected, on the other hand, that the second specification did not, in any manner, point out or explain the improvements upon the former patented machine, for which the second patent was granted, and, therefore, that it was insufficient. The Court of King's Bench, however, held the specification sufficient, Lord Ellenborough, C.J., remarking that the difficulty which pressed most was, whether this mode of making the specification was not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent was granted might extend to preclude the imitation of other parts of the machine than those for which the new patent was granted, when he could only tell, by comparing it with some other patent, what were the new and what were the old parts; and if that might be done with reference to one, why not with reference to many other patents. so as to render the investigation very complicated?

It may not be necessary, in drafting a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and to apply to those the improvements, but it may be sufficient to refer generally to them; *e.g.*, in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them.

IX. Need not describe the particular shape of any part, if the form is not essential.

IX. *The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.*

Thus, in Neilson's specification of his invention of an improved application of air in furnaces, the patentee stated that the form

(*f*) See *post*.

(*g*) 14 Ves. 130; 11 East, 101; Dav. P.C. 311.

of the vessel in which the air was heated was quite immaterial, and the Court of Exchequer ruled that, on the evidence, the specification was sufficient in that particular.^(h)

X. *The complete specification must describe the best method known to the patentee of performing the invention, and all his knowledge relating thereto.* X. Must describe the best method known to the patentee;

It is expressly enacted that the patentee must, in the complete specification, describe the manner in which the invention is to be performed,⁽ⁱ⁾ and the description will not be sufficient unless it include the best means known to him at the time of filing the document. In fact, a man has no right to patent an invention and give the public only the humblest means that can be devised for carrying it into effect, and reserve to himself all the better part of it, and to box up his improvements, and to say to the world, "You are at liberty to perform my invention in this way, but it will be of very little use."^(k) He must, on the other hand, put the public in possession of the discovery in as ample and beneficial a way as he himself uses it,^(l) and place them in a position to derive the same benefit from it which he himself does.^(m)

To use the words of Gibbs, L.C.J.: "There is another con-
sideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent to the extent most beneficial within the knowledge of the patentee at the time; for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefits than another, and states in his specification only that mode which would be least beneficial,

Per Gibbs,
L.C.J.

(h) 1 W. P. C. 295, 328.

(i) 46 & 47 Vict. c. 57, s. 5, ss. 4.

(k) Tetley v. Easton, Mac. P. C. 48.

(l) R. v. Arkwright, Dav. P. C. 61;
1 W. P. C. 64.

(m) Turner v. Winter, 1 T. R. 602; 1
W. P. C. 77; Bovill v. Moore, 2 Coop.
Ch. Cas. 56; Dav. P. C. 361; 2 Marsh, R.

211; Wood v. Zimmer, Holt, N. P.
57; Tetley v. Easton, Mac. P. C. 48;
Savory v. Price, 1 Ry. & Mo. 1; 1 W.
P. C. 83; Walton v. Bateman, 1 W. P.
C. 613; Heath v. Unwin, 2 W. P. C.
243; Plimpton v. Malcolmson, L. R. 3
Ch. D. 531, 582.

LETTERS PATENT FOR INVENTIONS.

reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends, yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him."⁽ⁿ⁾

If a patentee is acquainted with any particular mode by which his invention may most conveniently be carried into effect, he ought to state it in his specification.^(o)

not necessarily the best possible method.

It is evident that the patentee may not be in possession of the very best possible way of carrying out the invention. In that case, the specification will not be bad if it turn out afterwards that it does not describe the best possible way of performing the invention; all that is necessary is, that it should give the best method known to the patentee.^(p)

Imported inventions.

In the case of an invention made abroad it is the usual practice for the foreign inventor, who is desirous of protection in this country, to employ an agent to take out the patent for him, and the grant is made to the agent, who is therefore in law the patentee.^(q) Under such circumstances the fact that the foreign inventor was possessed of knowledge not in the specification will not render that instrument bad, if it appear that the agent did not possess such knowledge, for the agent is the patentee, and it is only necessary that the specification should contain a description of the best means known to him of carrying out the invention.^(r) On the other hand, if the agent, the actual patentee, be possessed of knowledge not in the specification, it is no answer, to an objection on the ground of insufficiency, to say that the specification contains all the information which the agent received from the foreign inventor.^(s)

⁽ⁿ⁾ *Bovill v. Moore*, 2 Coop. Ch. Cas. 56; *Day*, P. C. 361; 2 Marsh, R. 211.

^(o) Per Alderson, B., *Morgan v. Seaward*, 1 W. P. C. 174.

^(p) *Neilson v. Harford*, 1 W. P. C. 317, 356; *The Househill Co. v. Neilson*, 1 W. P. C. 693; *Wood v. Zimmer*, Holt, N. P. 57; 1 W. P. C. 82 n.; *Savory v. Price*, 1 Ry. & Mo. 1; 1 W. P. C. 83; *Turner v. Winter*, 1 W. P. C. 81; *Morgan v. Seaward*, 1 W. P. C.

170; *Sturtz v. De la Rue*, 1 Carp. Rep. 463; 5 Russ. 322; 1 W. P. C. 83; *Tetley v. Easton*, Mac. P. C. 76; *Derosne v. Fairie*, 1 W. P. C. 158; *Walton v. Bateman*, 1 W. P. C. 622; *Heath v. Unwin*, 2 W. P. C. 243.

^(q) Chap. VII. *post*.

^(r) *Plimpton v. Malcolmson*, 3 Ch. D. 531, 582.

^(s) *Wegmann v. Corcoran*, 13 Ch. D. 66; 41 L. T. N. S. 358.

The question may arise as to whether, if an inventor after having lodged a provisional, but before filing a complete specification, discover an improvement on the invention covered by such provisional specification, he must include a description of the improvement in his final specification (on the ground that the document would be insufficient without it, the improvement being the best means known to the patentee of performing the invention), or whether the improvement may form the subject-matter of a separate and further patent. In such a case it would appear that the real point to decide would be the nature of the improvement in question. It is submitted that, if the evidence establish this to be only a method of carrying out the invention covered by the provisional specification, the omission of a description of it would render the final specification bad on the ground that the document did not contain the best method known to the patentee of performing the invention. It is further submitted that if the patentee were to obtain a second patent in respect of the improvement, he would thereby obtain an extension of the monopoly and impose on the public the necessity of taking out two licences if they desired to use the improvement, whereas they ought to have the benefit of it under a licence to use the first patent. If, however, the improvement consist in an invention which is really distinct from that comprised by the provisional specification, it may be capable of forming the subject of a separate patent,^(t) and the insertion of it in the final specification would be a fatal defect; for the claim to the improvement in that case would be a claim to an invention in respect of which the provisional specification gave no protection, and the patent therefore could not include it.^(u)

If the specification do not describe everything which is necessary to the working of the invention to the best of the patentee's ability, it will not "particularly describe and ascertain the manner in which the invention is to be performed," as required by the Act of 1883. Hence the patentee must give

^(t) Edison v. Woodhouse, L. R. 32 Ch. D. 520. P. C. 240; Bailey v. Robertson, L. R. 3 & 5 App. Cas. 1055; Penn v. Bibby, L. R. 2 Ch. 27; Siddell v. Vickers, L. R. 39 Ch. D. 105.

^(u) Edison v. Woodhouse, L. R. 32 Ch. D. 520; Crossley v. Potter, Mac.

Improvements
between
provisional
and complete
specifications.

General refer-
ence to what
is old; omis-
sion of any-
thing useful.

the public every information which is necessary to enable them completely to perform every part of the invention, although it may be sufficient to refer in general terms to such things and processes as are old. And it also follows that if a material part, or anything which the patentee knows to be useful, is omitted, the specification will be insufficient.

Examples.

In a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, which was rubbing it with tallow, and for want of that Lord Mansfield held it void.^(x)

In the case of Galloway's patent for improvements in steam engines and machinery for propelling vessels it appeared that a slight difference in the length of certain rods was a necessary feature in the successful working of the invention, and the specification did not state this fact. At the trial of an action ^(y) relating to this patent, Alderson, B., told the jury that the small necessary difference in the lengths of the rods ought to have been specified; and if it could not have been ascertained fully it should have been so stated. The small adjustment of the different lengths might have been made for the purpose of making the machine work more smoothly, and, if so, it was just as necessary that it should be so stated in the specification as it was that the tallow should be mentioned in *Liardet v. Johnson*. The true criterion is this: "Has the specification substantially complied with that which the public has a right to require? Has the patentee communicated to the public the manner of carrying his invention into effect? If he has, and if he has given to the public all the knowledge he had himself, he has done that which he ought to have done, and which the public has a right to require from him."

Full disclosure
of best mode
of carrying out
invention.

It has been previously shown that a patentee suppressing anything, or misleading, thereby renders his specification bad,^(z) for it is the duty of a patentee, possessed of a mode of carrying on his invention in a beneficial manner, to dis-

^(x) *Liardet v. Johnson*, 1 W. P. C. 53.
^(y) *Morgan v. Seaward*, 1 W. P. C.
182.

^(z) *Lewis v. Marling*, 10 B. & C.
22; 4 Car. & P. 56; 1 W. P. C. 496;
p. 173 *ante*.

close the means of producing it in equal perfection, and with as little expense and labour as he himself incurred. To enable the public, at the expiration of the monopoly, to perform the invention in the same way, and with the same advantages as himself, is the price which the grantee pays for the patent, and the specification is void if anything which gives an advantageous operation to the invention be concealed. Thus, in the case of *Wood v. Zimmer*,^(a) a patent for a method of manufacturing verdigris was held void on the ground of the insufficiency of the specification, which did not disclose the fact that the patentee was accustomed to use *aqua fortis* in a boiler to facilitate the solution of copper, the evidence having established that the use of *aqua fortis* enabled the operation to be carried on in a much more satisfactory manner than the method described by the patentee.

In the case of the Hinks patent for the duplex lamp, the drawing attached to the specification did not show, and the letterpress did not describe, a certain aperture through which air was admitted to the second burner, and without which the lamp would not work. Jessel, M.R., on this ground, held that the specification was bad.^(b) Examples.

In the case of Mackelcan's patent for improvements in floating docks, the patentee was unable to support his contention that his invention consisted in the use of *iron* for the construction of the floating dock described by the complete specification, because that document omitted all mention of the material of which the dock was to be constructed, and the patent was accordingly declared void, as it appeared that floating docks constructed of *wood* and of design similar to that described by the patentee was old.^(c)

In the case of *Derosne v. Fairie* ^(d) it appeared that it was desirable and necessary for the most beneficial working of the plaintiff's patented process for extracting sugar or syrup from cane juice and other substances containing sugar, and for refining sugar and other syrups, to remove all iron from the bituminous

^(a) Holt, N. P. 58; 1 W. P. C. 82 n.

^(b) *Hinks v. Safety Lighting Co.*,
L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

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

^(d) 5 Tyr. 393; 1 W. P. C. 154.

schistus used in the operation, and the complete specification did not state how this was to be done. The Court of Exchequer set aside the verdict given for the plaintiff, and directed a new trial, Lord Abinger, C.B., saying that nothing he had heard had removed his original impression that there was no evidence to show that the process carried on with bituminous schistus in combination with any iron whatsoever would answer at all. The plaintiff had himself declared that in the bituminous schistus which he himself furnished, the whole iron was extracted, and it appeared that it was admitted by counsel that the presence of iron would not only be disadvantageous, but injurious. In the opinion of the learned lord, without considering whether or not the patent would be avoided by the patentee keeping secret the means requisite to extract the iron from the bituminous schistus, the patentee had not shown that what he had described in the patent could be used as so described without injury to the material going through the process. Under all the circumstances, the Court thought the plaintiff ought to have given some evidence to show that bituminous schistus, in the state in which it is found and known in *England*, could be used in the process with advantage; and, as he had not done that, the defendant was entitled to a nonsuit; but, at the same time, as it was alleged that the plaintiff might, on a new trial, supply the defect of proof as to the schistus by other evidence, the Court was desirous that the patent, if a good one, should not be affected by their judgment, and therefore they granted the new trial.

It was laid down by Parke, B., to the jury in *Neilson v. Harford*,^(e) that if the patentee knew that internal partitions in a certain cylinder, interposed between a blowing apparatus and a furnace, were useful, the omission to state that fact in the specification would be a fatal defect.^(f) And in the case of *Rex v. Arkwright* ^(g) it was proved that for the successful working of the defendant's spinning machinery it was necessary that the difference in the velocity of certain rollers should be adjusted, and the specification was silent on this point. Buller, J., com-

(e) 1 W. P. C. 317, 321.

(f) See also *Macnamara v. Hulse*, Car. & M. 471; 2 W. P. C. 128 n.

(g) 1 W. P. C. 70.

menting on the evidence which the defendant adduced to show what his invention really was, used the following words: "The man that comes to give an account of the invention says, 'I had calculated it, and the difference of the velocity was to be as five to one; this is the way I made my rollers.' Now the defendant has not said a word of that in his specification. In that he has kept back the knowledge he had as to the size of the rollers and velocity, and it is left to people to find it out as chance may direct." The jury gave a verdict against the patentee, the sufficiency of the specification being one of the issues.

It is not necessary that all the processes described in a specification should prove equally successful, or of equal commercial value, and the fact that persons to whom the specification is addressed have to try them to determine which is the best commercially, or that even the patentee himself does not know which is the best at the time, will not invalidate the patent.^(h)

Processes described not equally successful or of equal commercial value.

Lord Herschell, in his judgment in the House of Lords in *The Badische Anilin und Soda Fabrik v. Levinstein*,⁽ⁱ⁾ after having pointed out the causes which may give a different commercial value to a given product at different times, continued: "It was urged by the learned counsel for the respondents that a patentee is bound to disclose the means by which his invention may be carried into effect, and that, if he leaves this to be ascertained by experiments, his patent cannot be supported. This is, no doubt, correct. But I think the patent under consideration does show how the colouring matters are to be produced, and that what it leaves a skilled person of the class to whom the specification is addressed to discover, is only which of these colouring matters will best answer his purpose at any particular time. There is, in my opinion, no warrant for asserting that this invalidates the patent."

Variation of commercial value.

^(h) *Otto v. Linford*, 46 L. T. N. S. 35; *Badische Anilin und Soda Fabrik v. Levinstein*, 4 P. O. R. 449; L. R. 12 App. Cas. 710; *Thomson v. Batty*, 6 P. O. R. 84, 97.
⁽ⁱ⁾ 4 P. O. R. 466.

XI. Must give any information relating to the best means of performing the invention prior to the date of filing the complete specification ;

XI. *The complete specification must give any information relating to the best means of performing the invention, which the patentee may have acquired, during the period of provisional protection, prior to the date of filing the complete specification.*

Provisional protection is granted to the patentee for the express purpose of enabling him to bring the invention to a state of perfection, and it is only equitable that he should be compelled to disclose the latest and best information he possesses, so that the public may profit by it when the patent expires.

but not improvements which do not fall within the limits of the provisional.

If the improvements made during the period of provisional protection be of such a nature as not to fall within the limits of the provisional, they must not be inserted in the final, specification, as a claim to them would probably render the patent void ; (k) moreover, the patentee, by a general claim, cannot include in his patent improvements of which he was ignorant at the date of the patent.(l)

Observations of Bailey, J.

Bailey, J., speaking at a time when the patent was granted before, and subject to, the filing of a final specification, said : " It is the duty of the inventor, if between the period of taking out the patent and enrolling the specification he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification."(m)

Observations of Tindal, C.J.

And Tindal, C.J., speaking at a like period, declared that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification.(n)

A patentee filing a provisional specification which shows the

(k) p. 154 ante.

(l) Tetley v. Easton, Macr. P. C. 77.

(m) Crossley v. Beverley, 1 W. P. C. 117 ; 3 C. & P. 513.

(n) Jones v. Heaton, 1 W. P. C. 404 n. ; see also Crossley v. Beverley, 1 W. P. C. 117 ; Woodward v. Sansum, 4 P. O. R. 166 ; Crompton v. Patents Investments Co., 5 P. O. R. 397.

nature of his invention is not bound to describe therein any mode of carrying it into effect, but if he does so, and before filing his complete specification discovers an improvement in such mode, he is bound to give to the public in his complete specification the benefit of what he has discovered as to the mode of carrying the invention into effect; and a statement in the complete specification of improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with a view of producing the same results, the substitution of mechanical equivalents, modifications and developments within the scope of the invention set out in the provisional specification will not invalidate a patent on the ground of disconformity between the provisional and complete specification.(o)

When a patentee explained the objection to his specification, that it did not contain all the knowledge he possessed relative to carrying out the invention, by saying that, at the date of the patent, he did not think a certain substitute for a method given equally good to that described, and that, though since the date of the patent he had actually patented the new method, he had in fact returned to the original, the Court held that the patent was not invalidated.(p)

And when, during the interval between the filing of the provisional and complete specifications of an invention of an electric lamp with a carbon filament made in a particular manner, the patentee lodged a provisional specification of an invention for another method of making the carbon filament, the Court held that it was no objection to the validity of the patent for the first invention that the patentee did not in the complete specification, filed in respect of it, disclose the method of making the filament, which formed the subject of the invention disclosed by the second provisional specification.(q)

(o) *Woodward v. Sansum*, 4 P. O. R. 166; *Siddell v. Vickers*, L. R. 39 Ch. D. 92, 103; *Plimpton v. Malcolmson*, L. R. 3 Ch. D. 531, 580; *Moseley v. Victoria Rubber Co.*, 4 P. O. R. 241; *Crampton*

v. Patents Investments Co., 5 P. O. R. 382, 397.

(p) *Thomson v. Batty*, 6 P. O. R. 84, 100.

(q) *Edison v. Woodhouse*, L. R. 32 Ch. D. 520.

XII. Need not mention everything which will produce the result.

XII. *The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.*

It is not necessary that the specification should state precisely every means that will produce a given effect. Thus the specification of Bickford's miners' safety fuse, which was formed of several strands of flax, hemp, &c., enclosing within the interior a small core of fine powder, stated: "I manufacture flax, hemp, cotton, or other suitable materials, spun, twisted, and countered, and otherwise treated in the manner of twine spinning and cord making, by means whereof I embrace in the centre of my fuse a small portion or compressed cylinder or rod of gunpowder or *other proper combustible matter*, prepared in the usual pyrotechnical manner of firework for the discharging of ordnance." It appeared in evidence, at a trial in which the sufficiency of the specification was in issue, that gunpowder was, in fact, the material used by the patentee, but, in the opinion of one witness, detonating powder would answer the purpose, but less effectively. The jury gave a verdict for the patentee on the issue of sufficiency, and a rule *nisi* for a new trial was discharged by the Court of Queen's Bench, who were of opinion that it was immaterial if other materials, not specified, but within the description given, would answer the purpose, and that it was certainly not necessary to specify all.^(r)

If the specification state the best method known to the patentee of carrying the invention into effect,^(s) it is not necessary to give every means of so doing, though a general claim will not entitle the patentee to improvements of which he was ignorant at the date of the patent.^(t)

^(r) Bickford *v.* Skewes, 1 W. P. C. 211, 218.
^(s) p. 183 *ante*.

^(t) Neilson *v.* Harford, 1 W. P. C. 356; Badische Anilin und Soda Fabrik *v.* Levinstein, L. R. 24 Ch. D. 156; 4 P. O. R. 449; 12 App. Cas. 710.

XIII. *If the complete specification describes anything which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.*

XIII. Must distinguish that which is old from that which is new, and claim only the latter.

The Act of 1883 requires that the complete specification shall particularly describe and ascertain the invention; it is impossible to contend that a specification does this, if it describes things which are old as well as the novelty without distinguishing the one from the other. The point to be carefully borne in mind in considering this question, is whether or not the claim amounts to a claim to anything which is old, in which case the specification will be bad, and the patent void, on the ground that the patentee has claimed something which lacks the essential feature of novelty.(u)

In the case of a patent, for a combination, which consists of new and old parts, if the combination as a whole is claimed, it is not necessary to specify which of the parts are new and which old.(v)

If a combination as a whole is new, it is not necessary to specify which of the parts are old and which new.

An improvement on an existing machine may be the subject-matter of a new patent;(y) but if the specification does not distinguish clearly the improvement from the old parts, and claim only the new improvement, the patent will be void, for it cannot include both the addition and the whole machine.(z)

If the subject-matter is an improvement, the specification must distinguish and claim only the improvement.

And, if, in the case of a combination patent, the combination as a whole is not new, but there is some particular improvement in some particular part, the specification will be insufficient if it claims the whole combination as new. It must condescend upon that which is improved, and specifically lay claim to that and that only.(a)

Combination as a whole not new.

Thus, if a compensation pendulum were now for the first time invented, it would not do to patent improvements in clocks

(u) See Chap. III.

(v) *Moore v. Bennett*, 1 P. O. R. 129, 142; *Foxwell v. Bostock*, 4 De G. J. & S. 298; *Harrison v. Anderston Foundry Co.*, L. R. 1 App. Cas. 574; *Watling v. Stevens*, 3 P. O. R. 37; *Proctor v. Bennis*, 4 P. O. R. 333, 358; *Kaye v. Chubb*, 5 P. O. R. 641; *Clark v. Adie*, L. R. 2 App. Cas. 315, 328.

(y) p. 57 ante.

(z) *Rex v. Else*, 1 W. P. C. 76; *Bovill v. Moore*, 2 Coop. Ch. Cas. 56; *Dav. P. C.* 361; *Potter v. Parr*, 2 B. & S. 216n.; *Moore v. Bennett*, 1 P. O. R. 129, 143; *Harrison v. Anderston Foundry Co.*, L. R. 1 App. Cas. 574; *Parkes v. Stevens*, L. R. 8 Eq. 358, 366.

(a) *Moore v. Bennett*, 1 P. O. R. 129, 143; *Philpot v. Hanbury*, 2 P. O. R. 33, 39.

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in general terms, introducing somewhere in the course of the description the mode of making a compensation pendulum, and then end by claiming the arrangement and combination. The patentee ought to say expressly: "I claim the invention of a compensation pendulum, and make it thus."*(b)*

A new combination of old parts, or partly old and partly new parts, may form the subject-matter of a valid patent.*(c)* If a combination of a certain number of these parts existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specification will be bad if it state the whole machine as the invention.*(d)* If, on the other hand, all the parts are old, the specification will be bad unless it claim only the new combination.*(e)* A patentee is required to set forth in the complete specification a true account and description of his invention, and it is necessary that he should state what his invention is—what he claims to be new, and what he admits to be old; for, if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole, as new, then his patent must be taken to be a patent for the whole and for each particular part, and his patent will be void if any particular part turn out to be old, or the combination itself not new.*(f)*

If specification does not distinguish new from old, the patent is considered as for both.

And the patentee is taken to lay claim to both.

Again, if the specification describe both old and new parts without clearly making it appear that that which is old is not claimed, the patentee must be taken to lay claim to all, and the specification will be consequently bad.*(g)* But this rule may, perhaps, admit of some modification in favour of the patentee, in respect of things incidentally mentioned, which are old and universally known to be so; for, if he had occasion to introduce

(b) Per James, V.C., *Parke v. Stevens*, L. R. 8 Eq. 358, 365.

(c) p. 50 *ante*.

(d) *Bovill v. Moore*, per Gibbs, L.C.J., Dav. P. C. 404.

(e) *Lister v. Leather*, 3 Jur. N. S. 811; 8 E. & B. 1004; *Seed v. Higgins*, 8 H. L. Cas. 550; *Potter v. Parr*, 2 B.

& S. 216 n.; *Kay v. Marshall*, 2 W. P. C. 71; *Moore v. Bennett*, 1 P. O. R. 129; *Proctor v. Binnis*, 4 P. O. R. 333, 358; *Clark v. Adie*, L. R. 2 App. Cas. 315, 328.

(f) *Carpenter v. Smith*, 1 W. P. C. 530.

(g) *Tetley v. Easton*, Macr. P. C. 48.

a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new.^(h)

In the case of an invention which is alleged to be an improvement on something which has been done before, it is necessary that the complete specification should state in what the improvement consists. If the invention be claimed as an improvement, and nothing is said of any previous use of which the thing proposed is an improvement, the patent may incur the risk of being construed as a claim of entire and original discovery.⁽ⁱ⁾

If the subject-matter is an improvement, the specification should state the improvement.

In the case of *Holmes v. The London and North-Western Railway Co.*^(k) it appeared that the plaintiff had obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument, and gave a verdict for the plaintiff, which was, however, ordered by the Court of Common Pleas to be entered for the defendant, on the ground that the specification was bad, as not distinguishing between the new and the old.

Examples.

So in *Macfarlane v. Price* ^(l) the omission of a distinction between the new and old matters mentioned in the specification proved a fatal defect to the plaintiff's patent for "improvements in umbrellas," and in *Saunders v. Aston* ^(m) a patent for "improvements in making buttons" was declared void on account of a like omission in the specification.⁽ⁿ⁾

Lord Westbury, L.C., in *Foxwell v. Bostock*,^(o) laid down the rule, as following from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise, and in a more specific form, than by the

Rule in *Foxwell v. Bostock*.

^(h) Per Coleridge, J., *Macr. P. C.* 87.

⁽ⁱ⁾ *Hill v. Thompson*, 1 *W. P. C.*

247.

^(k) *Macr. P. C.* 4; 12 *C. B.* 831; 22 *L. J. C. P.* 57.

^(l) 1 *Stark. R.* 199.

^(m) 1 *W. P. C.* 75.

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

^(o) 4 *De G. J. & S.* 298, 313.

general description of the entire machine; it must assign the *differentia* of the new combination.

Claim may be for a combination as a whole or for parts separately.

In an improved machine, which is the result of several combinations, the claim may be so framed that the several combinations leading up to the one combination may be themselves divided into several parts in which each specific combination, A, B, and C, may be considered as a separate integer, and each such integer may in itself be a subject of letters patent, and also in their combination the several inventions, A, B, and C, may produce a total result which may also be a subject of letters patent.^(p)

Lister v. Leather.

In *Lister v. Leather* (q) it was stated by Lord Campbell, C.J., and approved by the Court of Exchequer, that if the combination, the subject of the patent, was new and useful, though each of the parts which entered into it were old, still the combination might be the subject of a valid patent, and a patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has often been decided. Further, a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, without any express claim of particular parts, and notwithstanding that parts of the combination are old.

True meaning of the decision in *Foxwell v. Bostock.*

The decisions in *Foxwell v. Bostock*, and *Lister v. Leather*, deserve careful consideration, and have formed the subject of judicial explanation and comment. First, *Foxwell v. Bostock* must not be taken as deciding that where there is a patent for a combination there must be a discovery or explanation of the novelty of each respective part, and that the specification must also show what is the novelty and what the merit of the invention. On the contrary, in the case of a patent for a combination the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which must be proved by evidence. And the claim to it is a sufficient description.^(r) The rule in *Foxwell v. Bostock*,

(p) *Clark v. Adie*, L. R. 2 App. Cas. 315, 327.
(q) 8 E. & B. 1031; 27 L. J. Q. B. 295; 4 Jur. N. S. 947.

(r) *Harrison v. Anderston Foundry Co.*, L. R. 1 App. Cas. 576, 580; *Proctor v. Bennis*, L. R. 36 Ch. D. 740; 4 P. O. R. 333.

when properly explained, really only means that when a claim is made to a general combination and arrangement of the different parts of a machine, if the combination is not new, but there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but the patentee must condescend upon that which is improved. For example, if a machine exactly similar to another had been in long use in a particular trade, and some particular improvement, say, in the arrangement of a cog, or in the arrangement of some other portion of an old combination, which was new and useful, had been made, the general combination remaining the same, then it would be a misdescription to describe it as a new combination, because the thing discovered would be a particular improvement upon a particular part or element of that combination.^(s)

If it is clear that the claim is for a combination, and nothing but a combination, there can be no infringement of the patent unless the whole combination, or such combination of some or all other parts as amounts only to a colourable imitation, be used; ^(t) and it is in that way immaterial whether any or which of the parts are new. It might, however, be left open on the specification for the patentee to claim not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, as it was held a patentee might do in *Lister v. Leather*; in such a case, in accordance with the true meaning of the rule in *Foxwell v. Bostock*, it would appear that the specification would be defective if, by merely giving a general description of the whole combination, it left in doubt what claim to parts in addition to the claim to the combination the patentee meant to assert. The specification must not mix up the real novelty with the old parts mentioned, and so render it necessary for a person reading it to get rid of a large portion by eliminating all that is old and commonplace, all that has formed the subjects of other patents and other improvements,

^(s) *Moore v. Bennett*, 1 P. O. R. 129, 143; see pp. 74, 75, *ante*.

^(t) *Clark v. Adie*, 2 App. Cas. 315, 320; p. 90 *post*.

before he is able to discover in what the new invention made by the patentee really consists.^(u)

Bowen, L.J., commenting on the decision in *Foxwell v. Bostock*, in a subsequent case, said: "When a combination and nothing more is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to me to be the true law as laid down in *Harrison v. The Anderston Foundry Co.*, without a reference to which case *Foxwell v. Bostock* ought not to be read, because it is possible to misread *Foxwell v. Bostock*, unless you correct your impression of it afterwards by the judgment of the House of Lords, *Harrison v. The Anderston Foundry Co.*"^(x)

Harmar v. Playne.

The case of *Harmar v. Playne* ^(y) at first sight appears an exception to the rule in *Foxwell v. Bostock*, but it is not so. It there appeared that a patent was taken out for a machine, and that the inventor afterwards discovered an improvement and obtained a second patent for the improved machine, describing in the specification the whole machine without distinguishing the improvement. The Court overruled the objection that the specification was bad, saying that the patentee had, in the second specification, recited the first, and that recital being in immediate comparison with the new specification, furnished *in gremis* of the new patent, the means of distinguishing the new from the old.

True meaning of the decision in *Lister v. Leather.*

The marginal note in *Lister v. Leather*, if hastily read, is calculated to give colour to the erroneous conclusion that it decided that a patent for a combination or arrangement is a distinct patent for everything that is new and material, and goes to make up the combination. A careful consideration of the judgment, however, shows that there is really no warrant for this notion. What the decision really amounts to is a de-

^(u) *Harrison v. The Anderston Foundry Co.*, L. R. 1 App. Cas. 574, 579; *Parkes v. Stevens*, L. R. 8 Eq. 358, 365; *Clark v. Adie*, L. R. 2 App. Cas. 315, 328; *Proctor v. Bennis*, 4 P. O. R.

333, 350; *Moore v. Bennett*, 1 P. O. R. 129.

^(x) *Proctor v. Bennis*, 4 P. O. R. 333, 358.

^(y) 11 East, 101; 14 Ves. 130; Dav. P. C. 311.

claration that a valid patent, for an entire combination for a process, gives protection to each part thereof that is new and material for that process; which is really nothing more than saying, in other words, that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question is in every case a question of fact—is it really and substantially a part of the invention? (z) If a man is desirous of securing to himself protection by letters patent, in respect of not only the whole, but something less than the whole, of a new arrangement, construction, or combination of parts, he must clearly show that he claims that something less more specifically than by merely describing and claiming the whole.(a) If, on the other hand, the invention is for the combination only, and not any of the specific parts, the specification must make it clear that it is the combination, and not any of the specific parts, which is claimed.(b)

The Claim.

Previous to the passing of the Patents Designs and Trade Marks Act, 1883, a distinct claim was not a necessary part of the complete specification, but it had long been the practice to insert one, in spite of the fact that it had been held that neither a claim nor a disclaimer was essential; and further, that that which appeared to be the invention, or part of it, would be protected though there were no distinct claim, and those matters which manifestly formed no part of the invention need not be disclaimed.(c)

The Act of 1883, however, expressly provides (d) that the complete specification must, in every case, end with a distinct statement of the invention claimed, but this provision is only in the nature of a direction, and a failure to comply with it will

(z) Per James, V.C., *Parkes v. Stevens*, L. R. 8 Eq. 365; *Clark v. Adie*, L. R. 10 Ch. 674; L. R. 2 App. Cas. 315.

(a) *Clark v. Adie*, L. R. 10 Ch. 667; L. R. 2 App. Cas. 315.

(b) *Rowcliffe v. Morris*, 3 P. O. R. 17; *Murray v. Clayton*, L. R. 7 Ch. 570, 578; *Westinghouse v. Lancashire and*

Yorkshire Ry. Co., 1 P. O. R. 229, 241; *Watling v. Stevens*, 3 P. O. R. 37.

(c) *Lister v. Leather*, 8 E. & B. 1004; *Dudgeon v. Thomson*, L. R. 3 App. Cas. 34, 54; *Plimpton v. Spiller*, L. R. 6 Ch. D. 426.

(d) S. 4, ss. 5.

Previous to Act of 1883 a distinct claim was not necessary.

Act of 1883.

not invalidate the patent.^(e) Consequently, it is no more necessary since the Act of 1883, than before it, that the complete specification should end with a distinct claim, if what the patentee claims can be gathered from the specification; though it must not be forgotten that, independently of the provisions of s. 5, ss. 5, of the Act of 1883, the specification may be so indefinite as to be bad, on the ground that the patentee has not fulfilled the obligation of properly describing the invention for which he claims the protection of the law.^(f)

“Distinct statement.”

A “distinct statement” means something more than a separate paragraph. It should be a concise statement of the main features of the invention, something to which the reader may readily refer, and learn therefrom, without referring to the body of the specification, what are the characteristic features of the invention claimed.^(g)

Object of claim.

The claim is not to be considered as a description of the means of performing the invention, but it is introduced as a security for the patentee. It is evident that the patentee may in the specification have alluded to things which are not new, in his endeavour to describe the invention and the manner of performing it; in such a case, the claim is introduced, not with the object of aiding the description, but so that the patentee may limit his claim to protection only to such matters as he can prove are his invention and new.^(h) The real object is not to claim anything which is not mentioned by the specification, but to limit the claim, and, in the language of James, L.J., “A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use. He describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says, ‘But take notice, I do not claim the whole of that machine: I do not claim the whole of that

(e) *Siddell v. Vickers*, 5 P. O. R. 431-3; L. R. 39 Ch. D. 92.

(f) *Ibid.*

(g) *Siddell v. Vickers*, L. R. 39 Ch.

D. 109; but see *Smith's Patent*, Griff. P. C. 268.

(h) *Kay v. Marshall*, 2 W. P. C. 39.

modus operandi, but that which I claim is, that which I am now about to state.' That surely is the legitimate object of a claim, and you must always construe a claim with reference to the whole of a specification." (i)

It is a frequent practice for a patentee in his specification to state that he does not claim such and such a thing described; but this is not necessary, for when a distinct claim is made the patentee is not bound further to distinguish between what is claimed and what is disclaimed, for everything which is not included in the claim is thereby disclaimed. (k) And consequently, if a patentee has described in his specification a number of distinct inventions which are all new and useful, but so related as probably to come within one patent, (l) and he has chosen to claim only one, he has thereby made a present of the rest to the public, and he can only be protected in respect of the one he has claimed. (m) Thus, where a patentee claimed a general combination, and also certain subsidiary parts, the House of Lords held that the claim to those specified subsidiary parts excluded the possibility of a claim for any other parts. (n)

The following are the chief features to be observed in drafting claiming claims:—

- I. The claim must not be too extensive, so as to embrace more than the patentee has invented.
- II. The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.
- III. If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.
- IV. A claim to something old, when that claim is not made

(i) *Plimpton v. Spiller*, L. R. 6 Ch. D. 426; see *Edison v. Woodhouse*, 32 Ch. D. 520; *Daw v. Eley*, 14 W. R. 126; L. R. 3 Eq. 496; *Russell v. Cowley*, 1 W. P. C. 465; *Thomas v. Welch*, L. R. 1 C. P. 192.

(k) *Harrison v. The Anderston Foundry Co.*, 1 App. Cas. 574, 579; *Easterbrook v. Great Western Ry. Co.*, 2 P. O. R. 201, 208; *Lucas v. Miller*, 2 P. O. R. 159; *Hinks v. Safety Lighting*

Co., L. R. 4 Ch. D. 607, 612; *United Telephone Co. v. Harrison*, L. R. 21 Ch. D. 721, 741.

(l) *Chap. VII. post.*

(m) *Hinks v. Safety Lighting Co.*, L. R. 4 Ch. D. 607, 612; *Jackson v. Wolstenhulmes*, 1 P. O. R. 105; *Fairburn v. Household*, 3 P. O. R. 263.

(n) *Harrison v. Anderston Foundry Co.*, L. R. 1 App. Cas. 574, 578.

Disclaimer
not necessary.

Features of
claims.

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in gross, but only as *appendant* to something new, will not vitiate the patent.

V. A patent for the production of a new and useful material will not be vitiated by a claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.

I. Must not be too extensive.

I. *The claim must not be too extensive, so as to embrace more than the patentee has invented.*

If the patentee lay claim to anything he has in fact not invented, he will thereby render his patent bad,^(o) notwithstanding that the specification may describe and claim things which are new and of which he was the undoubted discoverer—*e.g.*, if the specification describe both a machine and a method of using it, and the evidence establish that the machine was old, but that the method was new, then the patent cannot be supported, unless the claim is strictly limited to the method of using the machine.^(p)

The patentee must not lay claim to every mode of carrying a principle into effect, for such a claim amounts to a claim to the principle itself,^(q) and a principle alone cannot form the subject-matter of a valid patent;^(r) moreover, if a claim be so wide in its terms as to amount to the enumeration of a known truth, it cannot be supported.^(s)

Hill's patent, for an invention of improvements in the smelting of iron, was rendered void because in the specification he claimed both the usefulness of lime in the process, and the use of a certain specified quantity, whereas it appeared in evidence that the use of lime for the purpose was not new. The patent was therefore declared void, although it might

(o) *R. v. Else*, 1 W. P. C. 76; *Thomas v. Foxwell*, 5 Jur. N. S. 37; 6 Jur. N. S. 271; *Crossley v. Potter*, Macr. P. C. 240; *Ralston v. Smith*, 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, 2 H. & N. 84; *Saunders v. Aston*, 3 B. & Ad. 881; 1 W. P. C. 75; *Haworth v. Hardcastle*, 1 W. P. C. 484; *Jordan v. Moore*, L. R. 1 C. P. 624; *Patterson v. Gaslight and Coke Co.*, L. R. 2 Ch. D. 812; 3 App. Cas. 239; *Bailey v. Robertson*, L. R.

3 App. Cas. 1055; *Cropper v. Smith*, 1 P. O. R. 81; *Gaudy v. Reddaway*, 2 P. O. R. 49; *Leadbeater v. Kitchin*, 7 P. O. R. 235.

(p) *Hill v. Thompson*, 1 W. P. C. 232; *Tetley v. Easton*, 2 E. & B. 956; but see pp. 62-84 *ante*.

(q) *Neilson v. Harford*, 1 W. P. C. 355.

(r) p. 35 *ante*.

(s) *Patterson v. Gas Light and Coke Co.*, L. R. 2 Ch. D. 812; 3 App. Cas. 239.

possibly have been good if the claim had been limited to the use of the specified quantity.(*t*)

Minter's patent for an improvement in the construction of chains suffered from a like defect in the specification, and was consequently declared void by the Court when its validity was questioned. It appeared that a chair on the same principle as Minter's, had been invented before the patent, but encumbered with additional parts, and, unfortunately for Minter, the claim in his specification included not only the chair as made by him, but also the former one, and covered, therefore, more than he had invented. In fact, it would, if upheld, have prevented the former inventor from continuing to make the same chair that he had made before Minter's discovery.

A claim may be so extensive, as of itself, quite independently of evidence, to vitiate a patent;(u) but a claim must be very extensive indeed to justify the Court in saying, without evidence, that it is impossible to sustain a patent based upon it.(*v*)

The claims are not to be read as isolated sentences, but they must be interpreted by a reference to the body of the specification of which they form a part.(*y*) Consequently, a claim which, isolated, would be bad as being too extensive, may, when explained and narrowed down by a reference to the specification, be perfectly valid.(*z*)

Also a claim which at first sight appears to be too general, may by evidence be shown to be perfectly definite—*e.g.*, if the claim is for the use of a whole class of articles, and only one kind will do, but the evidence shows that although the words of the claim do on the face of them claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, then the claim might be construed as being for that part which an ordinary workman would take, and not for that part which an ordinary workman would not take.(*a*)

(*t*) Hill v. Thompson, 1 W. P. C. 232.

(*u*) Neilson v. Harford, 1 W. P. C. 355; Arnold v. Bradbury, L. R. 6 Ch. 706.

(*v*) Arnold v. Bradbury, L. R. 6 Ch. 706; Wyeth v. Stone, 1 Story, 273.

(*y*) Edison v. Woodhouse, 4 P. O. R. 107; p. 224 *post*.

(*z*) Arnold v. Bradbury, L. R. 6 Ch. 706; Edison v. Woodhouse, 4 P. O. R. 107; Kay v. Marshall, 2 W. P. C. 36; Beard v. Egerton, 8 C. B. 165, 215.

(*a*) Gandy v. Reddaway, 2 P. O. R. 52; Edison v. Woodhouse, 4 P. O. R. 107.

If the patentee includes more in his claim than he has invented, he by so doing makes his patent null and void. But if he thinks he has invented more than he has in fact invented, and describes the advantages which arise from that which is not as well as that which is his own invention, it does not follow that the patent may not be a good one, for it can be sustained if the invention, as claimed, is so limited as to fail to cover the actual thing in use, while it does cover some of the advantages mentioned.(b)

If the complete specification describe any method of carrying out the invention which will not answer, and so leads the public to perform operations which must necessarily fail, the patent will be bad;(c) much more, then, if a distinct claim is made to any such useless method must the patent be void. If the specification claims a number of methods, and one only of them turns out to be bad, the whole patent will be void.(d)

II. Must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.

II. *The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.*

The law will allow a patentee to claim that which he has invented by means of successful experiments or otherwise, and which he has given to the public, but it will not allow him to claim that which is the mere subject of his speculation and imagination, or of his endeavouring to possess more than he is entitled to; and while the Court is bound to give as far as possible the fullest effect to an invention, it is also equally bound to oppose endeavours to make a patent embrace matters that were never in the head of the inventor.(e) Moreover, a claim which is general will not entitle a man to improvements of which he was ignorant at the date of the patent.(f)

In the language of Pollock, C.B., the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves especially to one good thing, and a jury will always take care that if that be the real invention, no man under colour of improvement shall

(b) *Frearson v. Loe*, L. R. 9 Ch. D. 48, 58.

(c) p. 169 *ante*.

(d) *Patterson v. Gas Light and Coke*

Co., L. R. 2 Ch. D. 812, 833; L. R. 3 App. Cas. 239.

(e) *Totley v. Easton*, Macr. P. C. 48, 76.

(f) *Ibid.*

be allowed to interfere with that which is the offspring of their genius.(g)

If the patentee claims to perform the operation by the use of one or more of several substances, and it turns out that some of them will not answer, the patent will be void.(h)

Stevens v. Keating (i) was an action brought to restrain the infringement of two patents belonging to the plaintiff, one of which related to a method of making cement by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlsh in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated that "other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my invention, though none that I have tried answer so well as the alkali and acid hereinbefore set forth;" and then claimed "the process of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning or calcining the same for the purposes hereinbefore set forth." It was proved at the trial that though there were certain acids other than sulphuric that would answer, there were other acids that would not answer the purpose of the patentee at all; and Pollock, C.B., directed the jury that if the construction was that every acid was claimed, then all acids would not do, and the specification was bad; and if the construction was that some acids were claimed beyond sulphuric acid, the patentee did not say whether that was claimed which would do or that which would not do, and to take it, as he in his second specification explained, he said, "I claim all that will succeed." No person can be allowed to take that course, and to say, "Whereas other substances will succeed, I claim all those substances that may succeed."(j) And his lordship directed a verdict for the de-

(g) *Crossley v. Potter*, Macr. P. C. 256.

(h) *Stevens v. Keating*, 2 W. P. C. 181; *Felley v. Easton*, Macr. P. C. 48; *Hills v. London Gas Light Co.*, 5 H. & N. 312; *Ralston v. Smith*, 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L.

Cas. 223; *Booth v. Kennard*, 2 H. & N. 84; *Haworth v. Hardcastle*, 1 W. P. C. 480; *Saunders v. Aston*, 13 B. & Ad. 881; 1 W. P. C. 75 n.; *Kurtz v. Spence*, 5 P. O. R. 161.

(i) 2 W. P. C. 181.

(j) *Ibid.*

fendant on the issue of the sufficiency of the specification, which was upheld by the Court of Exchequer.

Pollock, C.B., also, in a case where a patentee in his specification had described the use of atmospheric air to charge a certain portion of his machinery, and stated: "If any gases or elastic media, other than atmospheric air, are used, with which to charge the case, I claim the sole right to do so," directed a jury that the patentee had, in point of law, no right to make such a claim, and that the law would not permit a patentee to claim more than he had invented. The learned baron also, in the same case, told the jury that a statement made by the patentee in the specification, to the effect that he proposed to construct a certain wheel of every variety of configuration, so long as it was constructed with a channel in the interior, would not do. It appeared that the defendant had used a wheel with *curved* hollow arms, and the patentee desired to treat this as an infringement of his wheel, in which the arms were not curved, but, as the judge directed, the patentee's claim to every shape of arm would not stand. To hold that it was good would be to reward a man who had rashly and ignorantly taken out a patent on a subject he had not appreciated.(k)

In the case of *Hills v. London Gas Light Co.*,(l) the plaintiff in his specification claimed the use of "hydrated or precipitated oxide of iron" for the purification of gas. It was proved that some of the hydrated oxides of iron would not effect the purpose the patentee had in view. It was objected on behalf of the defendant that the claim included all hydrated oxides of iron, and was therefore bad. The Court of Exchequer, however, admitted that the language was not accurate, but, in its desire to uphold the patent, decided that the patentee meant to refer to such hydrated oxides as were precipitated. A claim to the use of "the alkaline and earthy sulphites" in a specification under a patent for improvements in preserving animal substances was held by the House of Lords, in *Bailey v. Robertson*,(m) to be bad, on the ground of ambiguity. It appeared that some of

(k) *Tetley v. Easton*, Macr. P. C. 48.

(l) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409.

(m) L. R. 3 App. Cas. 1055, 1078.

the earthy sulphites are poisonous, and that some of the alkaline sulphites possess properties which render them unsuitable for the purpose the patentee had in view. It was held that the claim was too wide and vague, and that the specification ought to have defined more precisely the materials to be used. Booth's patent for "improvements in the manufacture of gas" was declared to be invalid, on the ground that the claim was a claim, not to any particular mode of manufacturing gas from seeds, but to the manufacture of gas from seeds however carried out.⁽ⁿ⁾

III. *If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.*

III. Must claim subordinate parts, if protection is desired.

It is evident that an invention may consist of any number of different parts—A, B, C, and D—of which A may be a totally new thing, and B may be a combination of things which in themselves are perfectly old, but which have never been combined in that particular way before, and C and D may be old parts. Now, in such a case, the inventor would in law be entitled to protection, both in respect of the whole invention, consisting of the combination A, B, C, and D, and also in respect of the subordinate inventions A and B; but he would not obtain such protection in respect of the subordinate parts alone by laying claim to the combination of the four elements. He must, if he desire it, specifically claim protection in respect of the new subordinate integers of the larger invention.^(o)

In considering the above paragraph, the reader must be careful to notice that the integers of the supposed invention are perfectly distinct and separate from the combination A, B, C, D, as a whole. A claim to a combination will no doubt protect the patentee against the use of any of the elements of that combination, if the use of such elements, either alone or together with others, would amount to only a colourable departure from the patentee's specified combination; ^(p) and very

⁽ⁿ⁾ Booth v. Kennard, 2 H. & N. 84; 26 L. J. N. S. Ex. 23, 305.

^(o) Clark v. Adie, L. R. 2 App. Cas. 320, 321; Cropper v. Smith, 1 P. O. R. 87.

^(p) Clark v. Adie, L. R. 2 App. Cas. 320; p. 197 ante.

little merit will do to support a claim to a subsidiary part of a great invention.^(q)

In *Clark v. Adie* ^(r) it was alleged that the defendant had infringed a patent for "improvements in apparatus for clipping or shearing horses," granted to one *Grayson*, but at the date of the action the property of the plaintiff, Clark, by purchase. The specification described the instrument or clipper by reference to drawings, and showed a fluted guide or comb-plate, with a straight edge, like a musical box comb, the points of the teeth being tapered so as to be raised a little above the surface. A thin plate of steel, with V-shaped cutters, traversed to-and-fro over the comb, being guided by steerers working in rectangular slots, cut parallel to its edge. The drawings showed the cutter-bar in plan and section, the latter view representing it as somewhat arched or convex in the middle, so as to take its bearing only at the edges. The specification, however, did not allude by any words of description to this peculiarity of form. The two handles were pivoted on a strong stem, set in a square hole in the comb-plate, and secured by a nut on the screwed end of the stud. One of these handles worked the cutter, and the other took its bearing at the rear of the comb-plate, and was capable of being set and clamped in different positions, to suit the convenience of the operator. At the end of the working handle a sliding block was pivoted, having slots corresponding with those on the cutter, and the comb could be regulated by means of nuts and washers. By the removal of the nuts on the stems and stud, the instrument could be readily taken to pieces.

The claim was in the following terms:—"The general arrangement, construction, and combination of parts, whereby I am enabled to construct an apparatus for clipping and shearing horses and other animals, in such a manner that the apparatus may be adjusted to numerous angles or positions to suit the varying surface of the animals; and whereby the shearing or clipping may be regulated to the exact extent required, without shaving the hair too closely, and, without injuring the animal,

^(q) *United Telephone Co. v. Harrison*,
L. R. 21 Ch. D. 720.

^(r) L. R. 10 Ch. 667; 2 App. Cas.
315.

leaving a smooth surface without marks, the apparatus being capable of being taken to pieces and adjusted for sharpening or renewing the cutter-bar, or for other purposes, all substantially as herein specified and shown."

It appeared that the plaintiff had bought *Grayson's* patent in order to free himself from any interference in respect of a horse-clipper, made by himself but not patented, which incorporated the arched cutter-bar, the movement thereof parallel to the line of the comb, and the substitution of strong stems secured by nuts and washers instead of being screwed into the comb-plate, but which did not resemble *Grayson's* instrument in other respects.

The alleged infringement consisted in the making of horse-clippers in exact imitation of those brought out by *Clark*, as above stated, and it was contended that there had been infringement of *Grayson's* patent in four particulars—viz., (1) In the use of fixed stems which could not be shaken loose; (2) In applying nuts and washers to the top of the fixed stems above the cutting plate so as to adjust the friction; (3) In forming the cutter-plate in an arch and thereby rendering it elastic; (4) In the mode of communicating motion to the upper or cutting plate, so as to bring it to the true line of cutting. It was argued, that although the defendant had not copied the whole of the apparatus patented, yet he had taken so much of that which was the pith and marrow of it, as to make up a subordinate integral part of the invention, and that by taking such subordinate integer, which was in itself matter of protection, he had infringed the patent.

Bacon, V.C., decided the case in favour of the plaintiff, but the Court of Appeal and the House of Lords both decided that the defendant had committed no infringement, not having taken anything claimed by the patent.

Lord Cairns, L.C., pointed out that the subordinate integer which was said to be protected, and which the respondent was alleged to have taken, was described as consisting of four different matters—viz., in the first place, what was called the fixed stems, springing from the under or comb-plate, which could not be shaken loose; in the second place, the nuts and

washers applied to the top of those fixed stems, above the cutting plate, so as to adjust the friction; in the third place, the shape of the cutter-plate made in an arch, by which the bearing of the cutter-plate upon the comb-plate was better adjusted; and fourthly, the mode of communicating the motion to the upper or cutting plate, so as to bring it to the true line of cutting. In reference to the third of these items, his lordship said that he had read with great care the specification of *Grayson*, and there was not a word in the letterpress of that specification, from beginning to end, which referred in any shape or form to the arching of the cutter-plate or to the advantage to be derived from that arching; and in answer to a suggestion of the appellant's counsel that the arch form of the cutter-plate was designed in order to bring into play elasticity as produced by the arching, his lordship pointed out that the cutter-plate was adjusted and fitted to a solid rigid bolt at the back thereof, which restrained any elastic yielding, and stated that he was compelled in the first place to put aside altogether the idea of the advantage of the elasticity of the cutter-plate as an after-thought, which was in no way present to the mind of the patentee. It might be an advantage, but if it was an advantage, it was an advantage which subsequent practice and experiment had brought to light, and it was not an advantage which appeared to suggest itself to the mind of the patentee when he made the specification.

In reference to the remaining three items which were said to produce the combination, his lordship remarked that each of them was not, in itself, a new invention, but an old step well known in the making of a clipper, and said: "I have read and re-read, with the greatest anxiety, the specification in the present case. I cannot find from beginning to end of it any sentence or any number of sentences, as to which, by any reasonable interpretation, you can say that they make a claim to a subordinate combination of these particular items as constituting in itself a novelty, a new manufacture; a thing to be protected by the patent." The House agreed with the conclusions arrived at by the Lord Chancellor, and decided in favour of the respondent.

IV. *A claim to something old, when that claim is not made in gross, but only as appendant to something new, will not vitiate the patent.*

IV. A claim to something old, not made in gross, will not vitiate the patent.

A claim which is only subsidiary, even though the thing claimed is old, will not vitiate a patent when that subsidiary claim is not for a distinct and substantive invention, but only for one of the merits and advantages of the entire construction which the patentee has described and claimed, and does not in any way enlarge the monopoly.^(s)

Thus, in *The United Telephone Co. v. Harrison* ^(t) one of the Examples. questions in issue was whether the claim in the plaintiff's patent, which was in the words, "In an instrument for transmitting electric impulses by sound, a diaphragm or tympan of mica, substantially as set forth," amounted to a claim for the mica diaphragm or tympan in all instruments for transmitting electrical impulses by sound, in which case it would be bad, as being merely a claim to the application of an old thing to a particular purpose, without the use of any ingenuity in that application; or whether it was a claim only to the mica diaphragm or tympan in the particular instrument for transmitting electrical impulses by sound described in the specification. Fry, J., was of opinion that the claim related only to the mica diaphragm in combination with the rest of the instrument, and that the specification was good in regard to that objection. This ruling was upheld by the Court of Appeal, consisting of Jessel, M.R., Lindley and Bowen, L.JJ.

In *The British Dynamite Co. v. Krebs* ^(u) it was sought to upset a patent for "improvements in explosive compounds, and in the means of igniting the same." The specification stated: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive

^(s) Neilson v. Betts, L. R. 5 H. L. 21; 40 L. J. Ch. 317; Plimpton v. Spiller, L. R. 4 Ch. D. 286; 6 Ch. D. 412; British Dynamite Co. v. Krebs,

G. P. C. 94; Ehrlich v. Ihlee, 5 P. O. R. 437.

^(t) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705.

^(u) G. P. C. 88.

substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into a powder which I call *dynamite* or *Nobel's* safety powder. By this absorption of the nitro-glycerine in some porous substances it acquires the property of being in a higher degree insensible to shocks, and it can also be burned over fire without exploding. The aforesaid safety powder or dynamite is exploded :—

“ *First*, when under close or resisting confinement, by means of a spark or any mode of ignition used for firing ordinary gunpowder. *Secondly*, without or during confinement by means of a special fulminating cap, containing a strong charge of fulminate which is adapted to the end of a fuse and is strongly squeezed to the latter for the purpose of more effectually confining the charge so as thereby to heighten the effect of the detonation. *Thirdly*, by means of an additional charge of ordinary gunpowder, the explosion of the latter will cause the dynamite to go off even when it is only partially confined.

“ *Claim* : I claim, as the invention secured to me by letters patent as aforesaid, the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth.”

Fry, J., on trying the case, gave judgment for the plaintiff, with costs, but the Court of Appeal (Jessel, M.R., James and Thesiger, L.JJ.) reversed the order and dismissed the action, with costs, on the ground of the insufficiency of the specification and that the claim, in so far as it claimed the modes of firing the dynamite by special ignition set forth, claimed that which was not new. On appeal, however, to the House of Lords, the order of the Court of Appeal was reversed, and the order of Fry, J., was restored, with costs to the appellants, on the ground that the specification was sufficient, and that the patentee did not claim the means of explosion *in gross*, but only as *appendant* to dynamite.

Earl Cairns, L.C., speaking on the question of the extent of the claim, made the following instructive observations : “ I will assume that the modes of firing by special ignition, or some of them, were known before the date of the patent, and therefore

that if the patentee claimed them as independent inventions (inventions, if I may use the expression, *in gross*), his claim would be too large and his patent void. But is that what he here does or means to do? It is to be observed that the mere manufacture of an explosive substance, such as dynamite, would not, *per se*, have constituted an invention, or, at all events, a useful and practical invention, which could be protected by a patent. An explosive substance like dynamite would be of little or no utility unless there were the means of bringing to bear upon it a method of detonating explosion which would be at once economical and easily applied. . . . I look upon the means of explosion, even assuming them to be known as applicable to the other substances, to be part and parcel of the invention, which the patentee was bound to give to the public as a complete invention, and I understand him to claim these means of explosion only as part and parcel of this invention. He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he would not be allowed, under this patent, to claim them for any other purpose. In other words, he claims, in the first claim, the dynamite, the substance itself; and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could be exploded, he might have omitted his second claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the use of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

In the case of Plimpton's patent for the roller skate (*x*) the specification stated that the invention related to an improvement in attaching the rollers or runners to the stock or footstand of a skate, whereby the rollers or runners were made to turn or cant by the rocking of the stock or footstand so as to assume radii of a circle, and facilitate the performing with ease gyrations or evolutions without taxing unduly the muscles of the foot or ankles. The specification then went on to describe the construction of the skate as a whole, including a description of a

(*x*) *Plimpton v. Spiller*, 4 Ch. D. 286; 6 Ch. D. 412.

mode of attaching the runners and making them reversible, and the two claims were—1. Applying rollers or runners to the stock or footstand of a skate, as described, so that the said rollers or runners may be cramped or turned, so as to cause the skate to run in a curved line, either to the right or left, by the turning, canting, or tilting of the stock or footstand. 2. The mode of securing the runners and making them reversible as above described. It was held by the Court of Appeal that the want of novelty in the method included in the second claim would not vitiate the patent, as this only amounted to a claim to one of the merits and advantages of the entire construction which the patentee had described, and not in any way to a claim which would enlarge the monopoly secured under the first claim.

It is important to bear in mind that the above cases are merely authorities for the construction to be placed on the specifications in particular cases, and, when a claim contains particular subdivisions, it is not right to say that when the first is for a general combination, the second and third are only to be considered as pointing out what the patentee considers material. On the contrary, when there are more than one separate claim, the first of which is for a general combination, the others may be separate and independent claims for subordinate combinations which will render the patent void, if those subordinate parts or combinations are old.(y)

V. Patent not vitiated by a claim to a particular use of a material.

V. *A patent for the production of a new and useful material will not be vitiated by a further claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.*

Thus, in the case of *Betts v. Neilson*,(z) it was objected (*inter alia*) to Betts' patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes," that the manufacture of capsules from the patented material was not the subject-matter of a patent.(a)

The specification claimed, *First*: "The manufacture of the new material, lead combined with tin on one or both of its

(y) *Cropper v. Smith*, 1 P. O. R. 88, 90, 91.

(z) L. R. 3 Ch. 429; 5 H. L. 1.
(a) See p. 62 *ante*.

surfaces, by rolling or mechanical pressure, as herein described. *Secondly*: The manufacture of capsules of the new material of lead and tin combined by mechanical pressure as herein described."

Wood, V.C., the Lords Justices, Lord Chancellor Chelmsford, and the House of Lords, all separately held that the objection to the validity of the patent on the ground of the second claim was invalid, and awarded the plaintiff damages in respect of infringements committed by the defendant.

Lord Westbury, addressing the House of Lords, said: "The last objection to the patent is one of a very material character; it is this: that after having described the process and the material, and claiming the material as the result of the process, so that the material is not claimed independently of the process, nor the process independently of the product, the specification concludes with a claim of the manufacture of capsules out of the material. But the manufacture of capsules out of the material would be one purpose only to which the material could be applied; and if a claim to the material can be substantiated by the patent, the specification of a particular use of it, comprehended in the general uses claimed, cannot for a moment be accepted as a ground for vitiating the patent."

Construction of the Specifications.

During the course of proceedings in which the validity of a patent is contested, it usually becomes necessary to decide, first, whether, or not, the specification is sufficiently explicit in its directions to enable a person to whom it is addressed to perceive what is the exact invention covered by the patent, and how to carry that invention into practical operation. And, secondly, what is the true construction to be put on the language of the specification when its meaning is dubious, and more than one interpretation is possible. The determination of the first question, which is one of fact, is to be determined by the jury, if there be one, otherwise by the judge. (b) The determination of

Construction of the specifications necessary in legal proceedings.

Sufficiency is a question for a jury: Construction is for the Court.

(b) *Walton v. Bateman*, 1 W. P. C. 621; *Beard v. Egerton*, 8 C. B. 165; 19 L. J. N. S. C. P. 36; *Hill v. Thompson*, 1 Web. P. C. 237; *Bickford v. Skewes*, 1 Q. B. 938; *Neilson v. Harford*, 1 W. P. C. 370; *Wallington v. Dale*, 7 Exch. 888; *Parke v. Stevens*, L. R. 5 Eq. 358; L. R. 5 Ch. App. Cas. 36.

the second question is one of law, and is to be interpreted by the Court alone; (c) the judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result. (d)

Interpretation
of language of
specifications.

The Court in construing specifications gives to their language the ordinary meaning, unless there are circumstances to show that any word or expression is a term of art, and would be understood by the person, to whom the specification may be supposed to be addressed, in a particular sense. It is a well-established rule that the Court will receive and consider evidence as to the exact sense in which the patentee intended a word or expression to be understood, and will give full effect to such meaning in the construction of the specification. (e)

The Court will not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate. (f)

Technical
terms.

It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes requiring the aid of the light derived from surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words in technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described, are all matters of fact, upon which evidence may be given, and contradictory testimony may be adduced, between which it is for a jury to decide. (g)

The Court ought to construe the specification, like all written instruments, taking the words, and seeing what is the meaning

(c) *Hill v. Evans*, 31 L. J. Ch. 460; *Neilson v. Harford*, 1 W. P. C. 370; *British Dynamite Co. v. Krebs*, G. P. C. 91; *R. v. Wheeler*, 2 B. & Ald. 345; *Seed v. Higgins*, 8 H. L. Cas. 561; *Bovill v. Pimm*, 11 Ex. 740.

(d) Per Cresswell, J., *Beard v. Eger-ton*, 19 L. J. N. S. C. P. 38; see also *Neilson v. Harford*, 1 W. P. C. 370.

(e) *British Dynamite Co. v. Krebs*,

G. P. C. 91; *Clark v. Adie*, L. R. 2 App. Cas. 436; *Neilson v. Harford*, 1 W. P. C. 313; *Elliot v. Turner*, 2 C. B. 446; *Walton v. Potter*, 1 W. P. C. 595; *Harrison v. The Anderston Foundry Co.*, L. R. 1 App. Cas. 581.

(f) Per Pollock, B., *Kaye v. Chubb*, 4 P. O. R. 299.

(g) *Hill v. Evans*, 31 L. J. Ch. 460.

of those words, when applied to the subject-matter, and in the case of a specification which is addressed, not to the world at large, but to a particular class—for instance, skilled mechanics, possessing a certain amount of knowledge—it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanics, and to see what the words of the specification mean when applied to such a subject as skilled mechanics would know, and then to say what the words of the specification mean when applied to such a subject-matter.^(h)

Even in cases where it is sought to establish that an invention described in a specification is not new by reason of the existence of a prior specification, which, it is alleged, describes the same invention, the Court will not, without evidence, assume that words or terms of art, which are common to the two specifications, bear in each the same meaning, but will receive and consider evidence on the point.⁽ⁱ⁾

It is impossible to predict, of two documents framed at different periods, that the terms of art common to the two had the same signification, and directed the same identical thing at the date of each respectively, for terms of art are liable to constant change of meaning with the progress of science and invention; and the cases establish that the identity of signification between two written documents containing the same description must belong to the province of evidence, and not to the province of construction.^(k)

The former practice of construing specifications very strictly against the patentee, and in favour of the Crown, in which judges indulged who had not freed themselves from the general prejudice against monopolies of all kinds, and did not accept the view that patents for useful inventions are to be encouraged

^(h) Per Lord Blackburn, *Clark v. Adie*, L. R. 2 App. Cas. 436; see also *Betts v. Menzies*, 10 H. L. Cas. 117; *Simpson v. Holliday*, 13 W. R. 577; L. R. 1 H. L. 315; *Edison v. Holland*, 5 P. O. R. 474.

⁽ⁱ⁾ *Thomas v. Foxwell*, 5 Jur. N. S. 37; *Roberton v. Trench*, 4 East, 135, 136; *Betts v. Menzies*, 10 H. L. Cas. 117, 152;

10 H. L. Cas. 152; *Hill v. Evans*, 6 L. T. N. S. 70; *Neilson v. Harford*, 8 M. & W. 806; 1 W. P. C. 331; *Hills v. The London Gas Light Co.*, 5 H. & N. 312; *Jupe v. Pratt*, 1 W. P. C. 144; *Walton v. Potter*, 1 W. P. C. 585; *Steiner v. Heald*, 6 Exch. 607.

^(k) *Betts v. Menzies*, 10 H. L. Cas. 152.

on the ground of public policy, drew from Lord Tenterden, C.J.,^(l) the remark: "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat, and not to sustain them."

Nothing is to be intended either in favour of a specification or against it.

It is now a rule of construction accepted by the Courts, that nothing is to be intended either in favour of a specification or against it, but that it is to be dealt with just as it appears, and a true and right and fair construction is to be put upon every allegation and every fact connected with it, such construction being neither a benign nor a strict one.^(m)

It may at one time be the interest of the patentee to endeavour to induce the Court to put a wide construction on the specification, so that it may be held to include and claim a particular thing, which an alleged infringer uses, and another time it may be to the advantage of the patentee to obtain a narrower construction, so that the specification may be held not to include something which is old.⁽ⁿ⁾ Whether it is for the interest of one side or the other, it is the duty of the Court to fairly construe the specification, neither favouring the one side nor the other: neither putting an unfair gloss or construction upon the specification for the purpose of saving a patent, if it is said that the patent is void; nor putting an unfair gloss or construction upon it in order to extend the patent, and make it take in something which might be thought to be an unhandsome taking of the fruits of his invention from the patentee, if it is not really an infringement of the patent.^(o) The Courts endeavour to hold a fair hand between the patentee and the public, being willing to grant to the patentee on his part the reward of a valuable patent, but taking care to secure to the public, on the other hand, the benefit of the provision that the

^(l) *Huddart v. Grimshaw*, 2 B. & Ald. 377.

^(m) *Stevens v. Keating*, 2 W. P. C. 177; *Russell v. Cowley*, 1 W. P. C. 465; 1 Cr. M. & R. 864; *Harrison v. The Anderston Foundry Co.*, L. R. 1 App. Cas. 574; *Young v. Rosenthal*, 1 P. O. R. 33; *Westinghouse v. The Lancashire and Yorkshire Ry. Co.*, 1 P. O. R. 229.

⁽ⁿ⁾ *Stevens v. Keating*, 2 W. P. C.

194; *Dowers v. Falcon Works*, 3 P. O. R. 70; *Kaye v. Chubb*, 4 P. O. R. 289; *Hutchinson v. Patullo*, 4 P. O. R. 329; *Gosnell v. Bishop*, 5 P. O. R. 151, 158; *Ellington v. Clark*, 5 P. O. R. 319, 327.

^(o) Per Lord Blackburn, *Dudgeon v. Thompson*, L. R. 3 App. Cas. 53; see remarks of Tindal, C.J., *Haworth v. Harcastle*, 1 W. P. C. 480; 1 Bing. N. C. 182, 190.

patentee must clearly define both the invention and the method of performing it.^(p)

The construction of the specification must be logical, fair, and impartial. It is proper for the Courts, seeing that patents for a limited period operate as an encouragement to the production of useful inventions, of which the public get the benefit after the monopoly is expired, to endeavour, if it can fairly and honestly be done, to support the patent, and to adopt a construction of the specification, which will give it validity when it can fairly be interpreted so as to achieve this result.^(q)

Construction must be logical, fair, and impartial.

It is a proper assumption to make that a patentee would not be so absurd as to claim anything which would render his grant void, for instance, anything which he knew, or which he was aware everybody else knew, to be old; and the Court will avoid such an absurdity if by any legitimate construction of the words used it can do so.^(r)

Assumption that patentee would not claim anything which would render his patent void.

The argument of absurdity cannot be used in favour of the patentee, if the wording of the specification is perfectly clear.^(s)

In *Neilson v. Harford*,^(t) on a motion being made to the Court of Exchequer to enter a verdict for the plaintiff on the issue of sufficiency of the specification, the question arose as to the proper construction to put on the statement that "the shape of the receptacle is immaterial to the effect, and may be adapted to the local circumstances." The invention consisted in the application of hot air to the blast furnace, and the receptacle above referred to was the chamber in which the air was to be heated before being passed into the furnace. The jury in the court below had found that the shape and form was material to the effect—*i.e.*, to the extent of beneficial effect—produced, not to producing some effect, for some beneficial result would be produced from any shape, but as to producing the extent of beneficial effect, the form and shape were material. If the proper con-

Examples.

^(p) *Neilson v. Harford*, 1 W. P. C. 310.

^(q) *Hinks v. Safety Lighting Co.*, L. R. 4 Ch. D. 612; 46 L. J. Ch. 185; *Plimpton v. Spiller*, L. R. 6 Ch. D. 422; *Russell v. Cowley*, 1 Cr. M. & R. 864; 1 W. P. C. 460; *Automatic Weighing*

Machine Co. v. Knight, 6 P. O. R. 297, 307.

^(r) *Clark v. Adie*, L. R. 3 Ch. D. 142.

^(s) *Cropper v. Smith*, 1 P. O. R. 90; *Clark v. Adie*, L. R. 2 App. Cas. 423, 437.

^(t) 1 W. P. C. 331.

struction of the patentee's statement was that the shape of the receptacle was immaterial to the degree of effect in heating the blast, in the face of the finding of the jury, the specification would be bad as containing a false statement in a material circumstance, of such a nature that, if literally acted upon by a competent workman, it would mislead him, and cause the experiments to fail. Parke, B., who tried the case in the court below, was at first of opinion that this was the proper construction, but in the Court of Exchequer he concurred in the opinion of the other judges, that from the context of the specification, taken as a whole, the word "effect" might reasonably be construed to mean "beneficial effect," and that such meaning ought to be adopted as it would support the patent. This latter being the proper construction, and the jury having found as a matter of fact that any shape in which the air vessel could reasonably be expected to be made by a competent workman would produce a beneficial effect, and be a valuable discovery, the Court was of opinion that the verdict ought to be entered for the plaintiff, on the issue of sufficiency, and consequently the patent was upheld on this point.

Again, in *Oxley v. Holden* (*v*) the question was as to the true meaning in the specification of the words, "I claim the metal fittings and the mode of applying the same described herein as the second part of my invention." If these words meant that the patentee claimed separately the metal fittings themselves, and the mode of applying them, the evidence showed that the metal fittings had been anticipated and published; but if the true construction was that the claim was for the metal fittings and the mode of applying them, as one part of the invention, then the patent would be good as regarded novelty. The Court of Common Pleas thought that from the context of the specification the patentee intended the latter construction, and he must have intended the patent to be valid. This construction was the more probable, and to support the first construction it would have been necessary to assume on the part of the patentee extreme ignorance in respect of the metal fittings, or extreme confusion in describing particular metal fittings.

(*v*) 8 C. B. N. S. 666 ; 30 L. J. C. P. 68.

The doctrine that the patentee intends his patent to be a good one must not be pushed too far in construing the specification. Assumption must not be pushed too far. In the above case what the patentee was held to have intended, turned out to be favourable to the validity of the patent, and the Court took into consideration the fact that he must have intended it to be valid, though that did not alone decide the judges in adopting the construction they did. Independently of this fact it was the more probable.

It will not do to argue that a great part of that which is covered by the patent is old and therefore bad, but some little part is new and therefore good, and that the Court ought consequently to confine the patent to that which is good.^(x) The utmost extent to which the doctrine can be pushed in favour of the patentee, is the conclusion that when two or more constructions are equally tenable the Court will adopt the one which will give validity to the patent, in preference to all others.^(y)

The Court will construe the specification so as to support the patent, if it can be fairly done,^(z) and will not be astute to find flaws in small matters in a specification with a view to overthrow it.^(a) Where any expression is ambiguous, the Court will endeavour to give effect to the intentions of the patentee.^(b) Court construes the specifications so as to support the patent if it can be fairly done;

In *Palmer v. Wagstaffe*^(c) the plaintiff obtained an injunction against the defendant, restraining the infringement of a patent for "improvements in the manufacture of candles." The second claim was, "the mode of manufacturing candles by the application of two or more plaited wicks as herein described." The evidence of infringement was the production of a candle purchased by the plaintiff at the defendant's manufactory, which was identical with those made by the plaintiff according to his process. It was not proved, however, that the defendant's candle had been made according to the patented process, and therefore, in order to support the verdict in the court below, it became necessary for him to contend that his and endeavours to give effect to the intention of the patentee.

^(x) *Clark v. Adie*, L. R. 3 Ch. D. 142.

^(y) *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 307; *Needham v. Johnson*, 1 P. O. R. 58; *Vorwerk v. Evans*, 7 P. O. R. 167, 265.

^(z) p. 219 *ante*; *Russell v. Cowley*, 1 W. P. C. 457; 1 Cr. M. & R. 864.

^(a) *Otto v. Linford*, 46 L. T. N. S. 35, 39; *Plimpton v. Spiller*, L. R. 6 Ch. D. 422.

^(b) *Russell v. Cowley*, 1 W. P. C. 476; *Palmer v. Wagstaffe*, 9 Exch. 494, 501.

^(c) 8 Exch. 840; 22 L. J. Ex. 295; 9 Exch. 494; 23 L. J. Ex. 217.

patent was for the candle, and not merely the process of producing it. The Court of Exchequer, however, made absolute a rule *nisi* to enter a verdict for the defendant, on the ground that the patent was for the method and not the candle, and consequently infringement had not been proved. Pollock, C.B., and Parke, B., both agreed that a specification should be construed as the patentee intended, and that, if any expressions were ambiguous, the Court should give effect to the intention; but the Court must not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate.

In *Boulton v. Bull* (d) it was attempted, in the Court of Common Pleas, to upset a patent, on the ground that a certain Act of Parliament, by which the original period of the duration of the monopoly was extended, purported to deal with a different kind of invention to that comprised by the patent. The Court was equally divided, so no judgment was given. But Eyre, C.J., was of opinion that the patent could be supported, on the ground that—(1) it was not for an abstract principle, but for a practical embodiment of a principle; (2) the Act and specification were referable to the same thing; and, when taken with their correlation, they were perfectly intelligible; and in his desire to reward the patentee, he declared that he would, if necessary, resort to the exposition of the word “engine,” in the body of the Act, to mean a “method,” in order to support the patent, “*ut res magis valeat quam pereat.*” Pollock, C.B., in another case, (e) said: “I agree that we are to construe the specification, ‘*ut res magis valeat quam pereat,*’ but still we are bound to ascertain what is the true and sound construction of the instrument, construing the language used with reference to the subject-matter, which may very much control the judgment to be given.”

“ Ut res magis
valeat quam
pereat.”

In construing a claim, if there is nothing else in the matter, it is the duty of the judge to adopt that construction which makes sense of the patent instead of that which makes it

(d) D. P. C. 162; 2 H. Bl. 463; 3 Ves. 143.

(e) Thomas v. Foxwell, 6 Jur. N. S. 272.

useless. (f) And there is, as there ought to be, a bias between different constructions in favour of the real improvement and genuine invention, to adopt that construction which supports an invention. (g)

It is sometimes contended that judges should put a benevolent construction on the specification, so as to support the patent for the encouragement of inventors; but the true rule of construction is that the language of the specification should not be subjected either to a benign interpretation or to a strict one. (h)

In *Hinks v. Safety Lighting Co.* (i) Jessel, M.R., said: "I am anxious, as I believe every judge is, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections or on mere cavillings with the language of their specification, so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use; but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. Beyond that the 'benevolent' construction does not go. It was never intended to make use of ambiguous expressions with a view of protecting that which was not intended to be protected by the patentee, and which has not been claimed to be so protected by him, whether or not it was an invention unknown to himself." (j)

If a claim can be read in two ways—one claiming something that has the merit of novelty, and the other claiming something which would show the patentee to be ignorant of all the ordinary appliances used to effect a particular purpose, it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible, rather than that construction

Benevolent construction.

If a claim can be read in two ways, the Court adopts the construction which makes the specification reasonable and proper.

(f) Per Jessel, M.R., *Plimpton v. Spiller*, L. R. 6 Ch. D. 422.

(g) Per Jessel, M.R., *Otto v. Linford*, 46 L. T. N. S. 39.

(h) *Harrison v. The Anderston Foundry Co.*, L. R. 1 App. Cas. 574; *Needham v. Johnson*, 1 P. O. R. 58; see p.

104; *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 307.

(i) L. R. 4 Ch. D. 607, 612.

(j) See also *Plimpton v. Spiller*, L. R. 6 Ch. D. 422; *Otto v. Linford*, 46 L. T. N. S. 39; *Cropper v. Smith*, 1 P. O. R. 89.

which makes the patent utterly absurd ; (*k*) but if it is established by the evidence before the Court that certain matters, which the specification upon a fair construction claims, were not new at the date of the patent, and were generally thought to be old, the Court is not therefore to narrow down the claim so as to exclude the old matters. Such a proceeding would be contrary to the decisions, and would afford a very simple precedent for saying that no patent is to be upset on the grounds of novelty. (*l*) In the words of Lord Hatherley, "the Courts will not alter the construction in order to save a patent where the patentee has himself explained his meaning in the claiming clauses." (*m*)

A word used in a popular sense does not bear its strict meaning.

Where a word is used in a specification in a popular sense, it is not to bear its strict mathematical meaning—*e.g.*, a patentee in his specification referred to a certain comb-plate "being cut with teeth pointed like a comb, and in parallel portions." It was objected that the teeth, if pointed, could not be parallel, but the House of Lords adopted the view of Lord Cairns, that the patentee explained in the clearest way that he used the word in a popular and not in a mathematical sense, and that the word must be construed in that sense. (*n*)

Claims are construed with reference to the title and contents of the specifications.

The claiming clauses of the specification are construed with reference to the title, (*o*) and with reference to the whole of the specification. (*p*)

Thus, in the case of *Newton v. Vaucher* (*q*) it was material to decide whether the patentee claimed the application of soft metal for the purpose of preventing friction where there is pressure and motion, or whether he did not also claim the application of soft metal in the case of stuffing-rods for the purpose of excluding air, water, or other fluid. On reading the title and specification with reference to each other, the Court

(*k*) *Plimpton v. Spiller*, L. R. 6 Ch. D. 422; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, 1 P. O. R. 98; *Cropper v. Smith*, 1 P. O. R. 81; *Haworth v. Harcastle*, 1 W. P. C. 484; *Needham v. Johnson*, 1 P. O. R. 58.

(*l*) *Clark v. Adie*, L. R. 2 App. Cas. 433, 437.

(*m*) *Clark v. Adie*, 2 App. Cas. 431.

(*n*) *Clark v. Adie*, L. R. 2 App. Cas. 426.

(*o*) *Oxley v. Holden*, 8 C. B. N. S. 666; 30 L. J. C. P. 68; *Newton v. Vaucher*, 6 Exch. 859; 21 L. J. Ex. 305.

(*p*) *Plimpton v. Spiller*, L. R. 6 Ch. D. 426; *Wegmann v. Concoran*, L. R. 13 Ch. D. 65, 77; *Edison v. Woodhouse*, 4 P. O. R. 107; *Kaye v. Chubb*, 5 P. O. R. 641.

(*q*) 6 Exch. 859; 21 L. J. Ex. 305.

was convinced that the claim was confined to bearings in cases where there is pressure with motion, and adopted that construction accordingly.

And the complete specification must be construed without calling in the aid of the provisional specification to explain or enlarge its meaning.^(r)

Complete specification construed without the aid of the provisional.

The specification is always construed by the Courts, with regard both to accuracy of definition and sufficiency of description, by reference to the knowledge of the world existing at the date of the patent; and the Court, for purposes of construction, will not take notice of any subsequently acquired information, but will endeavour to divest itself of such knowledge, and place itself in the position of the person to whom the specification may have been supposed to be addressed at the date of the patent.^(s)

Specifications construed with reference to the knowledge of the world at the time of the patent.

Moreover, in determining the sufficiency of the specification, the Court will not take cognisance of what the patentee says he intended, but only of what the ordinary intelligent workman, to whom the specification may be supposed to be addressed, says it would lead him to do.^(t)

Sufficiency.

In *Badische Anilin und Soda Fabrik v. Levinstein*,^(u) a question arose as to the meaning of the term "Naphthylamine," in the specification of the plaintiff's patent for "improvements in the production of colouring matters suitable for dyeing and printing," taken out in 1878. All the amines are capable of existing in three different isomeric modifications. At the date of the action, which was 1883, two of the isomeric naphthylamines known as alpha- and beta-naphthylamine respectively, were generally known. It was also established in evidence that these two isomers were known at the date of the patent, but that the beta-naphthylamine was only known to the highly trained organic chemists acquainted with the latest discoveries of the day, and it had not found its way into use in the arts. The question really was, would the direction to use "Naphthylamine," taking into account only the state of public knowledge at the

Examples.

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

^(s) *Badische Anilin und Soda Fabrik v. Levinstein*, L. R. 12 App. Cas. 710.

^(t) *Kaye v. Chubb*, 4 P. O. R. 289. See p. 164 *ante*.

^(u) L. R. 24 Ch. D. 156; L. R. 29 Ch. D. 366; L. R. 12 App. Cas. 710; 2 P. O. R. 73; 4 P. O. R. 449.

date of the patent, lead the public to use the alpha isomer which would answer, and not the beta isomer which would not answer.

Pearson, J., in the Chancery Division,^(x) upheld the patent, but in the Court of Appeal it was declared void on the ground of insufficiency of the specification. Bowen and Fry, L.JJ., thought that the specification being addressed to highly skilled experts—"advanced students of organic chemistry"—the term "naphthylamine" would include both isomers, and therefore be bad for ambiguity. Whilst Baggallay, L.J., drew a distinction between different classes of literature, and concluded that in the knowledge of practical men at the date of the patent, the term "naphthylamine" would mean only the alpha-naphthylamine, and this view was finally adopted by the House of Lords,^(y) who supported the patent, thus upholding the decision of Pearson, J., and reversing that of the Court of Appeal.^(z)

Construction
by antecedent
specifications.

In *Clark v. Adie*,^(a) the question arose as to how far the Court is justified in looking at antecedent specifications for the purpose of construing a specification in dispute, but the House of Lords refused to lay down any general rule. Lord Cairns, L.C., however, said that it might be open to the patentee or licensee to refer, in launching his case, to the state of manufacture up to, and at the time, when the patent was granted.

Westinghouse v. Lancashire and Yorkshire Railway Co.,^(b) Denman, J., held that it was necessary to look at the state of knowledge at the time of the publication of the specification in order to decide whether a particular claim was a claim to a combination, or a claim to several distinct inventions.^(c) And in *Couchman v. Greener*,^(d) Lord Esher, M.R., said that if there be any doubt on the construction of the plaintiff's patent, you may look at former patents for the purpose of seeing what is the proper construction of the plaintiff's patent.

On the other hand, Manisty, J., in a case between licensor and licensee, refused to admit evidence of the state of public knowledge at the date of the plaintiff's patent.^(e)

^(x) L. R. 24 Ch. D. 156; 29 Ch. D. 384, 406, 411.

^(y) L. R. 12 App. Cas. 710.

^(z) See opinion of Lord Halsbury, L. C., L. R. 12 App. Cas. 714.

^(a) L. R. 2 App. Cas. 423, 431.

^(b) 1 P. O. R. 98, 101.

^(c) See also *Ellington v. Clark*, 5 P. O. R. 325.

^(d) 1 P. O. R. 197, 199.

^(e) *Crosthwaite v. Steel*, 6 P. O. R. 190.

The law provides that both the provisional and complete ^{Drawings.} specifications are to be accompanied by explanatory drawings, if required.^(f) Such drawings are part of, and are to be read with, the specification to which they are attached, and of which they form a part as much as the letter-press. In the words of Abbott, C.J. : ^(g) “ An inventor of a machine is not tied down to make such a specification, as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification ; and if by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient.”

Drawings are subsidiary to the verbal part of the specification, and not the verbal part to them, and a patentee is not allowed to rely on a drawing as being a description of a material part of his invention when there is no reference whatever to such material part in the body of the specification.^(h) Moreover, the Act of 1883 only says the specification must be accompanied by drawings, if required, not that it must have them in every case ; and it is no objection to a specification that it has no drawings annexed to it, if it sufficiently describes the invention.⁽ⁱ⁾ Nor is it an objection that the drawings are roughly executed, if they are sufficient with the verbal part of the specification to enable a competent person to use the invention.^(k)

On the point as to how far the drawings may aid the description in the specification, the following observations of Lord Blackburn are instructive :^(l) “ The next thing as to which there is said to be an infringement is the plate being made with a curve, so that it is elastic. . . . Now we have to look at *Grayson's* patent in order to see whether that merit is claimed in any part. It is admitted that throughout the whole of the letter-press there is never an allusion to any curved or elastic plate

^(f) 46 & 47 Vict. c. 51, s. 5, ss. 3 and 4.
^(g) *Bloxam v. Elsee*, 1 Car. & P. 558 ; 9 Dowl. & Ry. 215 ; 6 B. & C. 169 ; 3 L. T. O. S. Q. B. 93.
^(h) *Clark v. Adie*, L. R. 2 App. Cas. 315 ; P. O. R.

⁽ⁱ⁾ Per Rook, J., in *Boulton v. Bull*, D. P. C. 188, 189.
^(k) Per Gibbs, C.J., in *Bovill v. Moore*, D. P. C. 369 ; see also *Hinks v. Safety Lighting Co.*, L. R. 4 Ch. D. 607 ; 46 L. J. Ch. 185.
^(l) *Clark v. Adie*, L. R. 2 App. Cas. 338.

at all; but in one of the figures, No. 2, in profile, there does appear a curved plate, and it is said that the fact that there appears a curved plate upon that figure is enough to indicate that in the description of his invention *Grayson* described that curved plate, and claimed it as part of his invention. Now, I will not stop to inquire how far a mere picture may be a description of an invention and help the letter-press. It may be so to some extent—how far, I do not stop to inquire. But upon that drawing there is represented a curved plate with a curved bolt attached to it in a way which, if it were carried out according to the drawing, would prevent the elasticity. . . . Whatever you may say about the picture being part of the description, and so bringing the curved plate within your invention, when the only drawing which shows a curved plate shows that curved plate in a position in which it would not give elasticity, it seems to me to be quite plain that you cannot say that the advantage resulting from a curved plate was contemplated as being included in the invention at all.”(m)

Correction of errors.

The specification is to be read as a whole, and if one part corrects what is evidently a slight error contained in another part, it is proper to make the correction, and the presence of such an error will not vitiate the specification; (n) but the provisional and complete specifications cannot be read together in order that the provisional shall supply an omission from the complete specification of a statement which is material to the validity of that document; (o) in other words, the complete specification must itself completely describe the nature of the invention, and in what manner it is to be performed, and if it omits to do either the one or the other, or does the one or the other erroneously, it will be no answer to say that the omission may be supplied by a reference to the provisional.

An error in the drawings or on the face of the specification which a competent workman would at once perceive and correct will form no substantial objection; (p) but the public, to whom

(m) See also *Otto v. Linford*, 46 L. T. N. S. 40.

(n) *Tetley v. Easton*, Macr. P. C. 47; *Wegmann v. Corcoran*, L. R. 13 Ch. D. 65.

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

(p) *Otto v. Linford*, 46 L. T. N. S. 40; *Morgan v. Seaward*, 1 W. P. C. 174.

the specification is addressed, are not to be called upon to exercise any invention in supplying its defects, and unless there is something in the document itself by which the error can be corrected, it will be fatal.^(q)

It cannot be contended that errors on the face of the specification or in the drawings which would at once be made apparent and corrected in following out the directions given, tend in any way to mislead; on the other hand, errors which are discoverable only by experiment and further inquiry, are absolutely fatal to the specification, on the ground that the public are not to be misled into performing experiments which must fail. It is, moreover, a fatal defect if the specification contain any erroneous statements, amounting to a false suggestion, even though such error would be at once observed by a workman possessed of ordinary knowledge of the subject.^(r)

^(q) *British Dynamite Co. v. Krebs*, G. P. C. 90; *Hinks v. Safety Lighting Co.*, L. R. 4 Ch. D. 616; *United Telephone Co. v. Harrison*, L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; *Muntz v. Foster*, 2 W. P. C. 108.

^(r) *Simpson v. Holliday*, 5 N. R. 340; see also p. 169 *ante*.

CHAPTER VI.

AMENDMENT OF THE SPECIFICATIONS.

AMENDMENT BY DISCLAIMER, CORRECTION OR EXPLANATION—AMENDMENT PENDING ACTION FOR INFRINGEMENT OR PROCEEDING FOR REVOCATION—RETROSPECTIVE EFFECT OF AMENDMENT—PERSONS ENTITLED TO OPPOSE—CLERICAL ERRORS—AMENDMENTS ALLOWED ON TERMS—COSTS.

Certain amendments are permissible.

NOTWITHSTANDING that a defective specification is absolutely fatal to the validity of the patent, the law in the interests, and for the protection, of patentees allows certain amendments to be made in the specifications, so that a patent, that would otherwise be void owing to the carelessness or ignorance of the patentee in fulfilling his obligation of specifying the invention, and the mode of carrying it into practical operation, may by amendment of the specification, or specifications, as the case may require, be made perfectly valid.

Interest of patentees to draft their specifications so as not to require subsequent amendment.

It will appear that it is greatly to the interest of the patentee to draft the specifications in the first instance with such care as will render subsequent amendments unnecessary. The consequences of an amendment may be not only the incurring of expense, but the possible inability to recover damages in respect of infringements of the patent committed before the amendment.^(a)

Procedure.

The procedure relative to the amendment of specifications which have become public property is regulated by s. 18 (as amended by s. 5 of the Act of 1885) and s. 19 of the Act of 1883, and where this procedure applies it is immaterial whether

(a) 46 & 47 Vict. c. 57, s. 20. The present chapter deals only with the amendment of specifications which have been accepted and become open to public inspection (46 & 47 Vict. c. 57,

s. 10); questions relating to the amendment of the specifications before they have become public property are treated of in Chap. VII.

the Patent Office has, or has not, advertised its acceptance of the complete specification.(d) Consequently, when a complete specification has been accepted, though the Patent Office has not by advertisement (e) signified its acceptance, it is a valid objection to a proposed amendment being allowed that the request and the nature of such proposed amendment have not been advertised in the prescribed manner.(f)

The hearing of an opposition to the grant of a patent will be postponed to the hearing of an opposition to an application for leave to apply at the Patent Office for leave to amend the specification.(g)

If the specification describe and claim anything which is ^{Defects.} useless(h) or which is not new(i) at the date of the patent, the patent is void. Again, if the title of the invention is inaccurate and misdescribes the invention in any respect, the patent is void on the ground of misrepresentation, though there may have been no intention to deceive either the Crown or the public; (k) and if the specification be insufficient as to any part of the invention described, or if it contain any misstatement respecting any material particular relating to the invention whether inadvertently inserted or not, the patent is wholly void.(l)

Before 1834, when the Statute 5 & 6 Will. IV. c. 83 was ^{Previous to 1834 it was not possible to amend a defective specification.} passed it was impossible to cure any defects such as the above, and persons not unfrequently lost the benefit of useful and meritorious inventions in consequence. The passing of the above statute, however, to a great extent removed this reproach to our Patent Laws, and though this statute was repealed by the Act of 1883,(m) its provisions, and the benefits which it extended to patentees, were with further additions re-enacted.

Previous to the Act of 1883 patentees could only amend ^{Previous to 1883 specifications could} their specifications by way of disclaimer,(n) that is to say, they

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| (d) Jones' Patent, Griff. P. C. 313. | (i) Chap. III. |
| (e) 46 & 47 Vict. c. 57, s. 10. | (k) Chap. V. |
| (f) <i>Ibid.</i> ; 46 & 47 Vict. c. 57, s. 18; | (l) Chap. V. |
| Chap. VII. | (m) 46 & 47 Vict. c. 57. |
| (g) Cochrane's Patent, Griff. P. C. | (n) Foxwell v. Bostock, 4 De G. J. & |
| 304. | S. 298, 306. |
| (h) Chap. IV. | |

only be amended by disclaimer.

could only cut matter out which they considered to be superfluous as lacking utility, novelty, or not being subject-matter.

If what was left of the specification would satisfy the requirements of the law, then the patent would be saved; but there was no provision for making a bad or incomplete description into a good or complete one, neither was it allowable to explain any ambiguity. It consequently very frequently happened that patentees found their specifications construed by judges in a manner which they never intended, and were sometimes to their mortification told that though their inventions were good and valuable yet their specifications were so defective, and so hopelessly beyond the power of amendment by any means known to the law, as to make it impossible to maintain protection in respect of such inventions.

Slight additions were, however, allowed.

Very slight additions, however, were formerly allowed when they were necessary to render what remained after disclaimer intelligible,^(o) as, for example, the addition or transfer of the words "herein described."^(p)

Amendment under Act of 1883.

The Act of 1883 not only provides that patentees may disclaim any portion of their specifications, but extends to them the right, with the sanction of the Comptroller-General, and the law officer on appeal, to correct or explain any defective passage on condition that such disclaimer, correction, or explanation does not make the specification as amended claim an invention substantially larger, or substantially different from the invention claimed by the specification as it stood originally.^(q)

If there be no action for infringement, or proceeding for the revocation of the patent pending at the time the patentee wishes to make an amendment in the specification, or if there be an action for infringement, or petition for revocation pending, and the patentee has obtained the necessary permission of the Court or a judge,^(r) all that it is necessary for him to do, is to obtain the sanction of the Comptroller-General, or law officer, in the prescribed manner, when he will be allowed to make the amendment as a matter of course.^(s)

(o) *Ralston v. Smith*, 11 H. L. C. 223, 245.

(p) *Thomas v. Welch*, L. R. 1 C. P. 192, 195.

(q) 46 & 47 Vict. c. 57, s. 18, ss. 8.

(r) 46 & 47 Vict. c. 57, s. 19; In the *Matter of Hall*, 5 P. O. R. 306.

(s) 46 & 47 Vict. c. 57, s. 18, ss. 9.

An amendment when there is no pending action or petition for revocation may consist of a disclaimer, correction, or explanation, but it would appear that when a patentee desires to amend his specification pending an action for infringement, or petition for the revocation of the patent, he will only be allowed to do so by way of disclaimer, and not by correction, or explanation, and he must first obtain the sanction of the Court or a judge,^(t) after which the procedure is the same as if no such action or proceeding for revocation were pending.^(u)

No pending action for infringement, or petition for revocation.

Action for infringement or petition for revocation pending.

By s. 18 of the Act of 1883,^(x) as amended by the Act of 1888,^(y) it is enacted as follows:—

“ 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. S. 18 of Act of 1883.

“ 2. The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

“ 3. When 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.

“ 4. 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.

“ 5. When 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.

“ 6. When leave to amend is refused by the Comptroller, the

(t) 46 & 47 Vict. c. 57, s. 19; 51 & 52 Vict. c. 50, s. 5.

(u) In the Matter of Hall, 5 P. O. R. 306.

(x) 46 & 47 Vict. c. 57, s. 18.

(y) 51 & 52 Vict. c. 50, s. 5.

person making the request may appeal from his decision to the law officer.

“7. 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.

“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.

“9. 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.

“10. The foregoing provisions of this section do not apply when, and so long as, any action for the infringement or proceeding for the revocation of a patent is pending.”

S. 19 of Act
of 1883.

S. 19 of the Act of 1883 (z) deals with the amendment of the specification during an action for infringement or proceeding for the revocation of a patent, and enacts as follows:—“In an action for the infringement of a patent, and in a proceeding for the 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.”

Vice-Chancellor of the County Palatine of Lancaster.

The above section confers power on the Vice-Chancellor of the County Palatine of Lancaster to grant leave to apply to amend a specification by way of disclaimer pending an action in his honour's court.(a)

House of Lords.

But it would appear that, since “the Court” means “the High Court of Justice,”(b) the House of Lords has therefore no original jurisdiction under the section.(c)

Exercise of discretionary

The Comptroller cannot exercise any discretionary power

(z) 46 & 47 Vict. c. 57, s. 19.

(a) Winter v. Baybut, 1 P. O. R. 76.

(b) S. 117.

(c) Cropper v. Smith, L. R. 28 Ch. D. 148, 152; 1 P. O. R. 90.

adversely to an applicant for leave to amend a specification without (if so required within the prescribed time) giving the applicant an opportunity of being heard personally or by his agent.^(d) powers by the Comptroller.

Under the old law it was competent for the grantee of a patent to enter a disclaimer, even though he had partially^(e) or wholly^(f) parted with his interest; but this is not so now, as, according to the provisions of the Act of 1883,^(g) only an applicant or a patentee is entitled to apply for leave to amend, and the term "patentee" is expressly defined as meaning the person for the time being entitled to the benefit of the patent.^(h) Old law amended by Act of 1883.
An assignee of a patent is consequently entitled to apply for leave to amend the specification, as he was before the Act of 1883.

It is submitted that a mortgagee need not be made a party to an application by the beneficial owner of a patent for leave to apply to amend the specification.⁽ⁱ⁾ Mortgagee need not be a party to an application.

It is only in cases where the Comptroller-General or the law officer is perfectly sure, on the evidence, that the consequences of the proposed amendment would be to infect the specification with the vice described in s. 18, ss. 8, of the Act of 1883, that they will absolutely refuse to give leave to apply at the Patent Office. Cases in which leave to apply is refused.

Leave to apply is no guarantee that the specification, when amended, will not render the patent invalid. The patentee, it must be remembered, makes the amendment at his own peril; and, in cases of doubt as to its effect, permission to make the application is given.^(k) Leave to apply is no guarantee of validity.

The decision of the law officer is final, and if it should afterwards turn out that the specification, as amended, is good, it would be evident that, had leave to apply been refused, the patentee would have suffered a hardship; whereas, if the specification should turn out to be bad, the public would be amply protected, for the patent would be void.^(l) Law officer's decision is final.

^(d) 46 & 47 Vict. c. 57, s. 94; P. R. 1890, n. 11-14.

^(e) *Spilsbury v. Clough*, 1 W. P. C. 255.

^(f) *Wallington v. Dale*, 7 Exch. 888.

^(g) S. 18, ss. 1.

^(h) S. 46.

⁽ⁱ⁾ *Van Gelder Co. v. Sowerby Co.*, 7 P. O. R. 208.

^(k) *Lake*, Griff. L. O. C. 16.

^(l) In the Matter of *Bateman and Moore's Disclaimer*, Macr. P. C. 116; *Lake*, 1886, No. 4357, Griff. L. O. C. 16.

Discretion of law officer.

The law officer grants or refuses an application for leave to amend at his discretion, and, not being a "Court," prohibition does not lie to him.^(m)

Amendment which makes the amended specification claim an invention larger than, or different from, the invention claimed by the specification before amendment.

The Act of 1883, which provides that an amendment shall, in all courts and for all purposes, be deemed to form part of the specification,⁽ⁿ⁾ expressly states^(o) that no amendment shall be allowed that would make the specification, as amended, claim an invention larger than, or different from, the invention claimed by the specification as it stood before amendment. It follows that if the Comptroller, or the law officer on appeal, do in fact allow an amendment which increases or alters the scope of the patent, the amended specification is not conclusive in a subsequent action, but may be questioned.^(p)

It is submitted that a disclaimer which increases or alters the scope of the patent is not wholly void, but is inoperative only as regards the excess.^(q)

Disconformity.

A disconformity between an amended complete specification and a provisional specification is just as fatal to the validity of the patent as a disconformity between the original specifications before amendment.^(r)

Amendment which imputes disadvantages in prior invention.

A patentee is not allowed to amend his specification in such a way as to make the amendment amount to an imputation that certain disadvantages exist in the method of carrying out an invention described and claimed by the specification of a prior patent, when, as matter of fact, there is no evidence before the Comptroller or law officer of the actual existence of such alleged disadvantages, though such allegation would not be an objection to filing the specification in the first instance.^(s)

Amendment has retrospective effect.

The Act of 1883 provides ^(t) that, after an amendment has been allowed, "the amendment shall, in all courts and for all purposes, be deemed to form part of the specification." The authorities warrant the statement that these words mean that the

^(m) Van Gelder's Patent, 6 P. O. R. 22; *Ex parte* Simon, Times, Aug. 6, 1888.

⁽ⁿ⁾ S. 18, ss. 9.

^(o) S. 8, ss. 8.

^(p) In the Matter of Van Gelder's Patent, 6 P. O. R. 22; *Ex parte* Simon, Times, Aug. 6, 1888; In the Matter

of Gaulard and Gibbs' Patent, 6 P. O. R. 225.

^(q) See *Foxwell v. Bostock*, 4 De G. J. S. 298.

^(r) *Gaulard and Gibbs*, 6 P. O. R. 215.

^(s) *Hampton and Facer*, Griff. L. O. C. 13.

^(t) 46 & 47 Vict. c. 57, s. 18, ss. 9.

amended specification shall, in all courts and for all purposes, have the same effect as if it had been filed, in the amended form, on the date of the original, so that a patentee may sue for, and recover, on his amended specification, damages in respect of infringements committed before the amendment; but this statement is subject to the qualification that the patentee must establish, to the satisfaction of the Court, that his original specification was framed in good faith and with reasonable skill and knowledge.^(u)

Moreover, the Comptroller and law officer have the power to impose conditions when granting leave to apply at the Patent Office to amend; ^{Power to impose conditions.} (x) as also has the Court or a judge, in cases where a patentee desires to amend during an action for infringement or a petition for revocation.^(y)

It is not an uncommon condition that no action shall be brought on the amended specification in respect of infringements committed before amendment,^(z) or in respect of certain continued infringements after amendment,^(a) though it is not the usual practice to impose the former condition when leave is granted to amend the specifications of patents of later date than January 1, 1884. Such cases are regulated by s. 20 of the Act of 1883, and the Court has, on the trial, to decide whether the matters referred to in that section have been established to its satisfaction—that is to say, whether or not the original claim was framed in good faith and with reasonable skill and knowledge; for damages cannot be awarded in respect of prior infringements unless the Court finds that good faith and reasonable skill and knowledge have been exercised in framing the original specification.^(b)

Actions for infringements committed before amendment are in certain cases justifiable, on the ground that it is not right that a person should gain his information from a patentee, and, acting on that information, copy and use his invention. He ^{Actions for infringements before amendment sometimes justifiable.}

(u) 46 & 47 Vict. c. 57, s. 20.

(x) p. 251 *post*; *In re Hearson's Patent*, 1 P. O. R. 214.

(y) 46 & 47 Vict. c. 57, s. 19; p. 251 *post*.

(z) p. 252 *post*.

(a) p. 252 *post*; *Holmes v. L. & N. W. Ry. Co.*, Macr. P. C. 31; *Smith's Patent*, Macr. P. C. 232; *Re Medlock's Patent*, Newton, L. J. vol. xxii. p. 69.

(b) 46 & 47 Vict. c. 57, s. 20; *Wenham v. Carpenter*, 5 P. O. R. 68.

must not presume upon some defect in the specification, and infringe upon the valuable part of the patent.(c)

Under old law amendments were retrospective except entered pending an action for infringement.

Under the law prior to the Act of 1883, amendments by disclaimer were retrospective, except when entered pending an action for infringement, in which case it was specially provided that the amended specification should not be given in evidence at the trial.(d)

No action, however, could be brought at all in respect of infringements committed before amendment without the leave of the law officer, certified by his *fiat*.(e) Cases in which amendments were made retrospective, and power was given to the patentee to proceed against those who had infringed before the disclaimer was filed, were the exception, and not the rule, and it lay on the party applying for a certificate giving a disclaimer a retrospective power to make out a case entitling him to that certificate.(f)

The terms usually imposed by the Court, in granting leave to apply to amend under s. 19 of the Act of 1883, and the concluding words of the section, "and may direct that, in the meantime, the trial or hearing of the action shall be postponed," are a clear indication that the amendment speaks from the date of the patent, and that there are cases where the Court, in its discretion, ought to, and would, under the present law, allow an amended specification to be given in evidence in a pending action.(g)

Injunction obtained before amendment.

If a patentee obtains an injunction against an infringer, before he amends the specification, he cannot enforce his injunction after the amendment, but must proceed *de novo*.(h)

Persons entitled to oppose.

S. 18, ss. 3, of the Act of 1883, which regulates the practice before the Comptroller on an application for leave to apply to amend, does not appear to give the applicant any right to object to the opposer as being a person not entitled to be heard in opposition, whereas ss. 4, which relates to an appeal to the law officer, provides that he (the law officer) shall hear the applicant and the opposer who is, "in the opinion of the law officer, entitled

(c) See Lucas' Patent, Macr. P. C. 234.

(d) 5 & 6 Will. IV. c. 83, s. 1; Perry v. Skinner, 2 M. & W. 471; R. v. Mill, 10 C. B. 379.

(e) 15 & 16 Vict. c. 83, s. 39.

(f) Lucas' Patent, Macr. P. C. 234, 239.

(g) Bray v. Gardner, 4 P. O. R. 41, 42.

(h) Dudgeon v. Thompson, L. R. 3 App. Cas. 34.

to be heard in opposition," thus giving the applicant the right to object to the opposer as a person not entitled to be heard.

In *Bell's Case*,⁽ⁱ⁾ however, the Comptroller refused to listen to the objection that a proposed amendment would make Bell's specification claim the same invention as that described in two prior specifications, on the ground that the opponents were not the owners of the prior patents, and therefore, being mere members of the public, the objection was not one which it was competent for them to set up. On appeal, the Solicitor-General supported the decision of the Comptroller, and held that the opponents were not in the position of persons entitled to be heard with regard to the prior patents.^(k)

A prior patentee is a person entitled to oppose an application for leave to apply to amend the specification of a subsequent patent on the ground that the amendment, if allowed, would prejudice the patentee's rights under the prior patent.^(l)

Walker's Application^(m) furnishes a good illustration of an amendment being refused on the ground that no amendment can be allowed which would make the amended specification claim an invention substantially larger than, or substantially different from, the invention as claimed by the specification, as it stood before amendment.⁽ⁿ⁾ Walker's patent was for "improvements in machinery employed for preparing and spinning cotton and other fibrous materials." The complete specification stated that the object of the invention was to support the top clearing rollers, so as to prevent them from rolling off the front rollers, and to keep them always in equal contact with both rollers. The invention consisted principally in an inclined bearer or bearers (slotted or otherwise) on or against which the pivots projecting from the centre of the clearers rested. In one part of the specification it was stated that "the said bearers may either be fixed to any hook, or they may be attached to any other fixing or part of the frame, in which case they form adjustable inclined planes." The claim was for the construction and application to the class of machinery referred to

(i) Griff. L. O. C. 10.

(k) See also Glossop, Griff. P. C. 285; Heath and Frost, Griff. P. C. 288.

(l) *Hampton v. Facer*, 1885, No. 8981, Griff. L. O. C. 15.

(m) Griff. L. O. C. 22.

(n) 46 & 47 Vict. c. 57, s. 18, ss. 8.

of an inclined bearer or bearers to support the top clearing rollers substantially as set forth. The patentee sought by his amendment (*inter alia*) to insert the word "*adjustable*" before the term "bearer or bearers" wherever the same occurred in the description and in the claim. The Comptroller, however, refused to allow this, holding that the insertion of the word "*adjustable*," as desired, would make the specification claim an invention substantially larger than, or substantially different from, the original specification.(o)

Amendment of a claim to a combination as a whole.

It is competent for a patentee to claim a combination as a whole, and also a subordinate part or parts separately.(p) When, however, there is a distinct claim to the whole, it is not allowable for the patentee to amend his specification by striking out that claim and inserting one for a subordinate part alone, since such an alteration would make the amended specification claim an invention substantially different to that claimed by the original.(q)

Intention to claim several parts conjointly.

In a case where certain patentees in their specification described and claimed several parts of an apparatus, and it appeared on the face of it that the intention was to claim the several parts conjointly, an alteration was allowed whereby the words "firstly," "secondly," and "thirdly" were struck out, and the word "or" was substituted for "secondly" and "and" for "thirdly," but the insertion of the words "in combination with" between the second and third claiming clauses was not allowed.(r)

Reasons for amendment

When an amendment is required it is because there is some defect in the specification, but that defect must be one which is consistent with the patentee intending to fulfil the condition of the grant by properly describing his invention, and the mode of carrying it into effect; and, if that condition has been fulfilled, no amendment is required, or will be allowed.(s)

must be stated in writing,

A patentee desirous of amending his specification is required to state in writing his reasons for the same,(t) but such reasons

(o) See also *Ralston v. Smith*, 11 H. L. C. 223, 254; *Lucas' Patent*, Macr. P. C. 235; *Gaulard and Gibbs' Patent*, 6 P. O. R. 215; *Heath and Frost's Patent*, Griff. P. C. 311.

(p) See Chap. V. p. 207.

(q) *Serrell's Patent*, 6 P. O. R. 101.

(r) *Bateman and Moore's Disclaimer*, Macr. P. C. 116.

(s) See *Nordenfelt*, 1885, No. 8269, Griff. L. O. C. 18, 21.

(t) 46 & 47 Vict. c. 57, s. 18, ss. 1.

form no part of the specification when amended ;(u) nor will leave to amend be refused merely on the ground that the reasons given by the applicant in his application are insufficient.(v) It is to be noticed that s. 18, ss. 2, of the Act of 1883 does not in terms say that the reasons on the strength of which the applicant or patentee desires to be allowed to amend the specification are to be advertised, but probably the reasons are part of the request,(x) and therefore should be advertised.

but amendment will not be refused merely because the reasons are insufficient.

The following remarks of Lord Westbury with reference to a disclaimer under the Act of 1835 are applicable to a disclaimer under the Act of 1883:—"The object of the Act authorising disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description in its integrity good and sufficient . . . then you might, by the operation of a disclaimer, lop off the vicious matter, and leave the original invention as described in the specification, untainted and uninjured by that vicious excess.(y) But it never was intended that you should convert a bad specification, in the sense of its not containing the description of any useful invention at all, into a good specification by adding words which would convert what has been properly called in the court below 'a barren and unprofitable generality,' into a specific and definite and practical description. . . . The statute never contemplated that a patentee should have the power, under the form of a disclaimer, of making material additions to the original specification, so as, by the aid of the corrected form of words and the additions so made, to introduce into the specification an accurate and perfect description of an invention which you seek for in vain in the original specification."(z)

Remarks of Lord Westbury with reference to disclaimers under the Act of 1835.

A disclaimer which extends the scope of the patent will render

(u) *Cannington v. Nuthall*, L. R. 5 E. & I. App. 205, 208.
 (v) *Ashworth*, 1878, No. 3513, Griff. L. O. C. 6, 7.
 (x) *Ibid.*
 (y) *E.g.*, *Cochrane's Patent*, Griff. P. C. 304; *Rylands' Patent*, 5 P. O. R. 665; *Nordensfelt's Patent*, Griff. L. O. C. 18; *Allen's Patent*, Griff. L. O. C. 3.
 (z) *Ralston v. Smith*, 11 H. L. C. 223, 243.

Example of a disclaimer extending the scope of the patent.

it void.(a) Thus a patentee of "improvements in embossing fabrics" claimed the use of grooved, fluted, or indented rollers of metal, wood, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing action on the fabric, and thereby produce an indefinite variety of patterns. Subsequently he disclaimed the use of any pattern rollers with the exception of metal rollers with circular grooves. It appeared in evidence that only circular grooves would produce the effect required, and further that the making the roller and bowl revolve at different speeds was not new at the date of the patent. Under these circumstances it was held that the disclaimer extended the exclusive right granted by the patent, which was consequently bad.(b)

As Lord Chelmsford observed, the rollers were not specifically described in the original specification, but were merely involved in the general terms which were used, and the plaintiff had consequently not complied with the condition of the letters patent in particularly describing and ascertaining the nature of the invention. When, therefore, by his disclaimer, he confined his claim to circular grooved rollers as his sole invention, though in one sense he might be said to narrow a right, yet he really extended it, because he thereby enlarged his alleged invention sufficiently to enable him to assert a right under the patent which he never could have successfully maintained upon the original specification.(c)

Example of a legitimate disclaimer.

In a case (d) where a patentee obtained a patent for an improvement in machinery used for sewing-cotton, and his specification appearing to claim the discovery of the application of the principle of centrifugal force for such purpose, he filed a disclaimer, declaring that he intended to claim only the application of centrifugal force in the particular manner described in the specification, the House of Lords held that the disclaimer was legitimate and saved the patent.

The principle involved in the above case is that approved of by the Attorney-General in giving his judgment in an

(a) 46 & 47 Vict. c. 57, s. 18, ss. 8.
 (b) *Ralston v. Smith*, 11 H. L. C. 223.
 See also *Gaulard and Gibbs*, 6 P. O. R. 215; *Lucas' Patent*, Macr. P. C. 235.

(c) *Ralston v. Smith*, 11 H. L. C. 255.
 (d) *Seed v. Higgins*, 8 H. L. C. 550.

appeal from the decision of the Comptroller(*e*)—viz., if on its face the specification is clearly capable of two or more constructions, it is open to a person, applying to amend, to satisfy the law officer or the Comptroller that he desires to limit the claim to one, or more, of two or more constructions to which the specification is open.

If a specification is on the face of it open to two or more constructions, the patentee may limit his claim to one only of such constructions.

The essence of Rylands' invention was two modifications in which forms of boxes were constructed, wherein, instead of there being the ordinary hoop-iron, nailed on the flat or side, and so forming an angle with the corner, a groove was cut in the surface of the two sides of the right angle, and in this groove wire or hoop-iron of some kind was placed, and fastened in, the object being to prevent the edges of the wire catching any obstruction, or being caught by any obstruction in the course of transit, and thereby being torn off or injuring other property. It was agreed on both sides that the patentee contemplated fastening the iron by either *nails* or *loops*, but the opposer alleged that to limit the claim, as the applicant desired to do, to fastening the hoop-irons in the grooves by means of *loops* would be to make the amended specification claim an invention larger than, and different to, that described and claimed by the specification before amendment. The Attorney-General, however, did not take this view of the case, and, applying the above-stated principle, granted leave to apply at the Patent Office to make the amendment proposed.

Rylands' Patent.

So in *Ashworth's Application*(*f*) it was objected that the proposed amendment would make the specification claim an invention different to that claimed by the original specification, but the Comptroller allowed the amendment. The Solicitor-General, in dismissing an appeal from the Comptroller's decision, expressed himself to be of opinion that the amendment only amounted to an explanation as to which of two possible constructions the patentee wished put on his claim, and that the specification, as a whole, before the amendment, indicated that the patentee really intended the construction to which by the alteration he desired to limit his claim.

Ashworth's Patent.

During proceedings for the repeal of a patent for "improve- R. v. Mill.

(*e*) In the Matter of Rylands' Patent, 5 P. O. R. 665.

(*f*) Griff. L. O. C. 6.

ments in instruments used for writing and marking, and in the construction of inkstands," the patentee filed a disclaimer of three of the claims of his specification. These claims related to pens, and to instruments used for marking with a stamp. Those which remained untouched by the disclaimer were for improvements in pen-holders and pencil-cases. It was held by the Court of Common Pleas that the title of the letters patent was satisfied by the specification as amended by the disclaimer.^(g)

Example of an amendment by explanation and correction.

Morgan's Patent^(h) furnishes an instance of an amendment by way of explanation and correction. It appeared that one of the figures in the drawings had been misdescribed, and the figure was clearly included in the provisional specification and covered by the claim of the complete specification. The patentee was allowed to amend by inserting a proper description of the figure, but he was not allowed to add anything to his claim.

Function of an explanation.

The function of an explanation within s. 18 of the Act of 1883 is to explain more clearly what was the meaning of the patentee at the time he patented the invention; it is not intended that he should put in subsequently ascertained knowledge, and such an insertion will not be allowed by the law officer.⁽ⁱ⁾

Clerical errors. Power of Master of the Rolls.

The Master of the Rolls, as keeper of the records, had, prior to the Act of 1883, an original jurisdiction, in cases where he was satisfied that a specification as filed contained clerical errors, to order that such errors should be rectified.^(k)

Corrections were made, on the authority of the Master of the Rolls, where "October" was written by mistake for "November;"^(l) where "Charles" was written for "George;"^(m) where reference numbers were transposed;⁽ⁿ⁾ where "recovery" had been written for "covering;"^(o) where "wire" was inserted for "fire" and the mistake was not discovered for five years; and where there was an apparent error in the drawings attached to the specification.^(p)

The Master of the Rolls had never authority to permit or

(g) *R. v. Mill*, 10 C. B. 379.
 (h) *Griff.* L. O. C. 17.
 (i) *Beck and Justice*, 1877, No. 4114, *Griff.* L. O. C. 10.
 (k) *Sharp's Patent*, 1 W. P. C. 641, 646; 3 *Beav.* 245; *Johnson's Patent*, L. R. 5 Ch. D. 503.

(l) *Rubery's Patent*, 1 W. P. C. 649 n.
 (m) *Dismore's Patent*, 18 *Beav.* 538.
 (n) *Redmond's Patent*, 1 W. P. C. 649 n; 5 *Russ.* 44.
 (o) *Nickell's Patent*, 1 W. P. C. 650; 4 *Beav.* 563.
 (p) *Abel's*, 1874, No. 2081.

order an erroneous claim or statement to be expunged or amended merely in his capacity of keeper of the records, his authority in such capacity to allow corrections being strictly limited to verbal or clerical errors.

But in *Re Berdan's Patent*,^(q) where a disclaimer had been filed without the consent of the patentee, it was held that the Master of the Rolls had jurisdiction, without bill filed, to order it to be taken off the file. The case was distinguished from *In re Sharp's Patent*,^(r) on the ground that in the latter the application was not to take an improperly filed document off the file, but to alter an enrolment.

The Act of 1883 does not appear to have taken away this jurisdiction of the Master of the Rolls to allow an amendment of merely verbal or clerical errors in a specification, both before and after it has been placed on the file.^(s)

In *Re Gare's Patent*^(t) the Master of the Rolls allowed the correction of a clerical error in a specification which had been filed under the Patent Law Amendment Act of 1852, and gave it as his opinion that the Act of 1883 does not affect the power of the Master of the Rolls, as keeper of the records, to allow the amendment of a clerical error in a specification, which is to be considered as under his authority. The Master of the Rolls expressed the further opinion that so long as the specification is in the Patent Office, and before the patent is sealed, the proceedings of s. 18 of the Act of 1883 should be the only proceedings taken by any one asking for amendment.

The amendment of a clerical error is included in the term "correction" in s. 18, ss. 1, of the Act of 1883, and consequently it is not necessary to invoke the authority of the Master of the Rolls to rectify a clerical mistake. S. 91 expressly gives the Comptroller power to correct clerical errors in, or in connection with, any application for a patent, or in the name, style, or address of a registered proprietor.^(u)

The amendment of a clerical error in a specification may be

(q) L. R. 20 Eq. 346.

(r) 1 W. P. C. 641.

(s) *Re Gare's Patent*, L. R. 26 Ch. D. 105; *Re Morgan's Patent*, 24 W. R. 245; Judicature Act, 1873, s. 17, ss. 6.

(t) L. R. 26 Ch. D. 105.

(u) See Patent Rules, 1890, r. 16; Form P., Appendix.

Amendment of clerical error may be refused on the ground of delay.

refused on the ground of delay. Thus in *Re Blamond's Patent*(*x*) the Lord Chancellor, though doubting whether he had power under 15 & 16 Vict. c. 83, to order the amendment of a clerical error in the spelling of the patentee's name, refused to do so, on the ground that the applicant had shown gross negligence in not applying to rectify the mistake earlier, as the patent was five years old, and it was impossible to say what interests might be affected by doing what was desired.

Under s. 18 of the Act of 1883 a patentee may obtain leave to correct an erroneous description, or to explain an imperfect one.

Insertion of drawings.

So far there has been no application for leave to amend a specification by the insertion of a drawing not described in the specification. It is submitted that, if the insertion of a drawing be desirable in order to make clear what the patentee intended when he filed his specification, it would be allowed, on the ground that a drawing is part of the specification, and its insertion merely amounts to a legitimate explanation.(*y*)

Ambiguous claim.

When a claim is ambiguous it may be amended by way of explanation, so as to make perfectly clear what was the real meaning of the patentee, taking into account the fact that the claim must be construed with reference to the context and drawings of the specification.(*z*)

Claiming clauses may be struck out.

Prior to the Act of 1883 all the claiming clauses of a specification might be struck out by disclaimer, if there remained in the body of the specification words sufficiently distinguishing what the invention was which the patentee claimed. The explanation given by the Court of Appeal (*a*) of the concluding words of s. 5, ss. 5, of the Act of 1883 supports the statement that the law in this particular remains unaltered. It must, however, be remembered that the effect of a disclaimer is merely to strike out from the specification those parts which are disclaimed, and it cannot operate by way of a claim to the residue, nor can what remains of the specification be construed by the disclaimer; (*b*) nor does the reason

Effect of a disclaimer, or other amendment.

(*x*) 3 L. T. N. S. 800.

(*y*) But see *Re Pullan's Patent*, Johns. Pat. Man. 5th ed. p. 118.

(*z*) Ashworth, 1878, No. 3513, Griff. L. O. C. 6.

(*a*) *Siddell v. Vickers*, L. R. 39 Ch. D.

92; 5 P. O. R. 416.

(*b*) Per Cresswell, J., *Tetley v. Easton*,

2 C. B. N. S. 706, 730.

for a disclaimer form any part of the specification, by virtue of the disclaimer, so as to influence the construction to be put upon it.(c)

It is not to be inferred from the circumstance that a patentee has entered a disclaimer, or made any other amendment of the specification, that the patent was necessarily bad before the amendment, for it may well be that the alteration was in fact not requisite, and only made to obviate any doubt that might arise on the specification as originally filed.(d)

The patentee must show that there is a real reason for requiring a correction or explanation before he will be permitted to make one. Thus, where an applicant asked for leave to amend his specification by inserting an explanatory statement of the principle on which the invention was based, the law officer, on appeal, refused to allow the amendment, because he thought the principle of the invention was amply described in the original specification, and he was of opinion that no ground had been shown on which the amendment ought to be allowed.(e)

Patentee must show a reason for requiring a correction or explanation.

If a patentee is desirous of amending his specification during an action for infringement or proceeding for revocation of a patent,(f) he cannot apply at the Patent Office for the necessary leave without first obtaining the permission of the Court or a judge, to do so, and the authority of the Court or judge in such cases is limited to granting permission

Amendment pending an action for infringement or proceeding for revocation.

(c) *Cannington v. Nuttall*, L. R. 5 E. & I. App. 205, 228.

(d) See *Stocker v. Warner*, 1 C. B. 148, 165; 9 Jur. 136, 138.

(e) *Nordenfelt*, Griff. L. O. C. 18.

(f) The terms "action for infringement" and "proceeding for revocation" here mean an action for infringement and proceeding for revocation before judgment: *Cropper v. Smith*, 1 P. O. R. 254; L. R. 28 Ch. D. 148; *Lawrence v. Perry*, 2 P. O. R. 179, 188; *Haslam and Hall*, 5 P. O. R. 1, 24.

In *Cropper v. Smith* (1 P. O. R. 254) the plaintiffs obtained at the trial judgment against the defendants, which, however, the Court of Appeal reversed as against one of the defendants, Hancock. The plaintiffs thereupon applied to the Comptroller, under s. 18 of the Act of 1883, for leave to apply at the Patent Office to amend the specification by disclaimer, and the defendants opposed the application. The defendant Hancock subsequently appealed to the House of Lords, and the Comptroller, being doubtful whether the appeal was a pending action within s. 18, ss. 10, of the Act of 1883, refused to proceed with the application until the consent of the Court had been obtained. Accordingly the plaintiffs took out a summons under s. 19 of the Act of 1883 that they might be at liberty to apply at the Patent Office to disclaim. Chitty, J., held that an action for infringement pending means an action before judgment, and further that, final judgment having been given, there was in the present case no action for infringement pending; and the summons was consequently dismissed, but, under the circumstances, without costs.

to apply at the Patent Office for leave to amend by disclaimer only. *(g)*

How the authority of the Court or a judge may be obtained.

Use of the amended specification in evidence in the pending action for infringement or proceeding for revocation.

The authority of the Court or a judge may be obtained by summons in chambers, *(h)* or on motion in court.

As a rule, patentees who obtain the consent of the Court or a judge, pending an action for infringement or proceeding for the revocation of a patent, are not allowed to use the amended specification in evidence in the action or petition as the case may be. *(i)* Nevertheless, the patentee may in such a case derive a great benefit from being allowed to make an amendment, for there may be other persons, not parties to the action or proceeding for revocation, who, relying on some defect in the specification, are continuing an infringement on the advice that the patent is bad; and it may be of great importance to the patentee to remedy the defect, and place himself in a position to sue other parties, besides defendants in the action or the petitioners in the proceeding for revocation.

To allow a plaintiff in an action for infringement or a respondent in a proceeding for the revocation of a patent to use in evidence a specification amended pending such action or proceeding would be to give him, when he had originally come to the Court with a patent which could not be relied on, power to put himself in a different position, as against the defendant or petitioner; and though the consequences of amendment may be that the plaintiff or respondent is entitled to maintain an action in respect of previous acts, which are infringements of the patent as amended, yet an absolute discretion is vested in the Court to impose, as a condition of leave being granted, that the amended specification shall not be given in evidence so as to enable a patentee to sue on a patent which, at the time when he commenced his action, he could not sue on at all. *(k)*

Court or a judge has power to impose terms.

The Court has a discretion, unfettered by authority, to grant or refuse leave to apply to amend by disclaimer pending an action for infringement or petition for the revocation of a patent,

(g) 51 & 52 Vict. c. 50, s. 5; 46 & 47 Vict. c. 57, s. 19.

(h) *Singer v. Stassen*, 50 L. T. N. S. 326; 1 P. O. R. 121.

(i) But see *ante*.

(k) See remarks of Cotton, L.J., *Bray v. Gardner*, 4 P. O. R. 43.

and to impose such terms and conditions as it may think the justice of each particular case requires.^(l)

The result of recent decisions appears to be that leave will only be given, under s. 19 of the Act of 1883, where the Court sees its way to make full compensation to those against whom the leave is asked, and that where such compensation can be given then the leave will be given.^(m)

Leave only given when compensation can be made to those against whom it is asked.

It is submitted that if there be more than one action for infringement or more than one petition for revocation of a patent, or an action for infringement and a petition for revocation pending, leave may be given, under s. 19 of the Act of 1883, in one such proceeding without application being made in any other proceedings; ⁽ⁿ⁾ though no doubt the parties to the other proceedings would be protected by the terms imposed by the Court, or by the Comptroller, when granting the leave to amend.

When there is more than one action for infringement or petition for revocation pending, leave may be given in one without an application being made in all.

The former practice of the Patent Office in cases where there was more than one action for infringement or petition for revocation, or an action for infringement and petition for revocation, pending, was to refuse to allow an application for leave to amend, unless the leave of the Court or a judge was obtained in all the different pending proceedings; ^(o) but, it is submitted, the Comptroller would not now refuse to entertain an application made in respect of the leave of the Court, or a judge, obtained in one only of such proceedings.^(p)

Former practice of Patent Office.

Present practice.

The Court or a judge exercising the power of imposing terms ^(q) when granting leave to apply at the Patent Office for leave to amend pending an action for infringement or petition for the revocation of a patent usually imposes the terms laid down in the case of *Bray v. Gardner*.^(r) These terms are that the amended specification shall not be given in evidence at the hearing of the action or petition,^(s) and that the costs of, and

Terms usually imposed.

^(l) *Allen v. Doulton*, 4 P. O. R. 377; *Lang v. Whitecross Co.*, 6 P. O. R. 570.

^(m) Per Kekewich, J., in the Matter of *Gaulard and Gibbs' Patent*, 5 P. O. R. 191; *Bray v. Gardner*, 4 P. O. R. 40; *Gaulard v. Lindsay*, 5 P. O. R. 192.

⁽ⁿ⁾ See in the Matter of *Hall and others*, 5 P. O. R. 306, 310; L. R. 21

Q. B. D. 137; but see *Gaulard v. Lindsay*, 5 P. O. R. 192, 196.

^(o) *Codd's Patent*, Griff. P. C. 385; *Gaulard and Gibbs*, 5 P. O. R. 192, 196.

^(p) In the Matter of *Hall and others*, 5 P. O. R. 307; L. R. 21 Q. B. D. 137.

^(q) 46 & 47 Vict. c. 57, s. 19.

^(r) 4 P. O. R. 40; *Lang v. Whitecross Co.*, 6 P. O. R. 570.

^(s) But see pp. 236, 237, 248 *ante*.

occasioned by, the plaintiff's or respondent's application, as the case may be, shall be the defendant's or petitioner's in any event; though the terms to be imposed are entirely in the discretion of the Court, and no rule can be given applicable to every case.(t)

When, in an action for infringement or petition for revocation

(t) In *Winter v. Baybut* (1 P. O. R. 76), a case tried in the Court of the County Palatine of Lancaster, the Vice-Chancellor only imposed the terms that the plaintiffs should pay the defendant's taxed costs of the motion and of the action up to, and inclusive of, the hearing of the motion; and that proceedings in the action should be stayed pending the application to the Patent Office.

In *Singer v. Stassen* (1 P. O. R. 121) the Court of Appeal held that s. 19 of the Act of 1883 applied in the case of an action commenced before the Act came into operation, and gave liberty to apply to amend the plaintiff's specification upon the terms that the costs of, and occasioned by, the amendment should be the defendant's in any event; and that the specification, as amended, should not be receivable in evidence in the action; and that the costs of the appeal should be costs in the action, as there had been a substantial failure and a substantial success by both parties.

In *Codd v. Bratby* (1 P. O. R. 209) Chitty, J., granted leave to apply under s. 19 of the Act of 1883, on the terms that the specification; when amended, should not be given in evidence at the trial of the action, and that no evidence should be given of any infringement prior to the date of the filing of the amended specification; and that the costs of the motion, and of the previous application to the Comptroller thrown away by reason of the amendment, be paid by the plaintiff.

In *Fusee Vesta Co. v. Bryant & May* (4 P. O. R. 71) Kay, J., granted the plaintiffs leave to apply to amend before they had delivered their statement of claim, upon the terms that they paid all costs, in any event, of the defendants of the action up to and including the application consequent on the amendment of the specification; that no further proceedings should be taken till the disclaimer had been properly made; that the plaintiffs should undertake, forthwith, to take proceedings for disclaimer, and then to amend the action by stating the disclaimer pending the action on the specification as amended; failing this, the action to be dismissed.

In *Allen v. Doulton* (4 P. O. R. 377) Huddleston, B., held, on the authority of *Bray v. Gardner*, that leave to apply to amend should be given to the plaintiffs only on condition that the specification, as amended, should not be receivable in evidence in the action. Upon appeal to the Divisional Court the learned judges were divided in opinion, and upon appeal to the Court of Appeal it was held that ss. 18 and 19 of the Patents, &c., Act of 1883 give a discretion to the Court or a judge, to be exercised on the circumstances of each particular case, and which is not fettered by authority; and that although there had been no exercise of discretion by the judges below, yet, having regard to the nature of the proposed amendment, the Court, in the exercise of their discretion, would not interfere with the order.

In the Matter of *Gaulard and Gibbs' Patent* (5 P. O. R. 189) was a petition for the revocation of *Gaulard and Gibbs' patent* for a system of distribution of electricity. Kekewich, J., granted the respondents leave to apply at the Patent Office to amend, on condition that they paid the petitioner's costs up to date; that they applied at the Patent Office forthwith, and prosecuted their application with due diligence. His lordship also gave the petitioner leave, within fourteen days after the amendment, or after it should be ascertained that no amendment would be made, to discontinue by notice, or, if he did not do that, to have fourteen days to amend the petition and the particulars of objection.

In *Haslam Foundry and Engineering Co. v. Goodfellow* (5 P. O. R. 28) Kay, J., granted leave under s. 19 of the Patents, &c., Act of 1883, on the following terms. The plaintiffs to pay the costs of the application and the costs of, and occasioned by, the disclaimer; the plaintiffs and defendants to be allowed to make all necessary amendments in their pleadings after disclaimer; the plaintiffs to undertake,

of a patent; permission to apply at the Patent Office for leave to amend a specification has been given by the Court or a judge, the procedure to be observed in order to obtain the leave desired is that under s. 18 of the Act of 1883, (f) and it does not follow, as matter of course, that, because the Court or a judge has given permission to apply, therefore the Comptroller will grant the application.

When the leave of the Court or a judge has been obtained the procedure is that under s. 18 of the Act of 1883.

Where, however, the Court or a judge, in an action for infringement or petition for revocation of a patent, has granted leave to apply to the Comptroller for leave to apply at the Patent Office without imposing any terms, no terms will be imposed by the Comptroller or law officer relative to the action or petition, as the case may be. (g)

If the Court or a judge granting leave has not imposed conditions, the Comptroller or law officer will not do so.

When an application for leave to apply at the Patent Office is made to the Comptroller, and there is no action for infringement or proceeding for the revocation of the patent pending, the Comptroller (as well as the law officer on appeal) has the power to, and frequently does, impose conditions if the application is granted. (h)

Comptroller and law officer have power to impose conditions.

forthwith, to amend the pleadings, confining their action to the specification as amended by the disclaimer, or to consent to the action being dismissed with costs.

In *Gaulard v. Lindsay* (5 P. O. R. 192), which was an action for infringement of five patents, a petition for the revocation of one of such patents having been previously presented, and leave to apply for liberty to disclaim having been granted in the petition, Kekewich, J., refused to grant similar leave in the action, but subsequently it was granted by consent by the Court of Appeal. The patentees were allowed to give the amended specification in evidence, but the terms imposed were that the plaintiffs should consent to pay all costs of the action up to the application, and waive all claim to relief in respect of any infringement before the date of the disclaimer; and that they should pay the costs of the application, but not on the higher scale.

In *Lang v. Whitecross Co.* (6 P. O. R. 570) Wills, J., gave the plaintiffs leave to apply at the Patent Office for liberty to amend their specification by way of disclaimer. The judge also gave the plaintiffs leave to use the amended specification as evidence, on condition that no damages should be recovered, or claim for an injunction founded, on anything done before disclaimer, and that the costs of the action up to the time (if disclaimer used) be the defendants' costs in the cause. The judge further ordered that the costs of the application and the costs caused in the action by the disclaimer should be the defendants' in any event, and that proceedings should be stayed pending the disclaimer. The plaintiffs appealed from this order, and contended that the conditions imposed would prevent them from deriving any advantage from continuing the present action, and that the condition as to damages was not within the jurisdiction of the judge at chambers, but the Divisional Court and the Court of Appeal held that the judge had absolute discretion, under s. 19 of the Act of 1883, to impose terms, and that the order ought not to be interfered with.

(f) In the Matter of Hall, 5 P. O. R. 306.

(g) *Hearson's Patent*, 1 P. O. R. 213.

(h) 46 & 47 Vict. c. 57, s. 18, ss. 4; *In re Hearson's Patent*, 1 P. O. R. 213; *Pietschmann's Patent*, Griff. P. C. 314; p. 237 ante.

Protection of manufacturers who have embarked capital on the strength of the invalidity of a patent.

Under the old practice, in order to protect the interests of manufacturers who had embarked large capital in a trade on the strength of a patent having been allowed to remain in its imperfect state for a long time, the law officers frequently imposed conditions for their protection.⁽ⁱ⁾ Such conditions were that the patentee should not sue in respect of infringements committed before amendment,^(k) or in respect of certain continued infringements by the use of certain specified machines actually in use before the amendment,^(l) or in respect of fresh infringements by certain persons in virtue of the continued use of a process employed by them prior to the amendment,^(m) or in respect of infringements by machines made under specified contracts.⁽ⁿ⁾

Effect of a condition that no action be brought in respect of any infringement prior to a certain date.

A condition that no action be brought in respect of infringements prior to a certain date protects the continued user of infringing articles made before that date, and also the sale of such articles unsold at the fixed date.^(o)

But a condition that no action be brought in respect of the infringement of a patent, of which the amendment of the specification is sought, does not prevent the patentee from bringing an action on another patent belonging to him, if those articles infringe such other patent.^(p)

When the condition is imposed that no action be brought in respect of certain specified machines, it is usual for the Court to order that such machines be marked with distinguishing marks.^(q)

In the case of patents dated after Jan. 1, 1884, it is not usual to impose condition that no action be brought for

In the case of patents bearing dates subsequent to the Jan. 1, 1884, it is not usual for the Comptroller or law officer to impose the condition that no action shall be brought in respect of any infringements committed after that date, as such cases are provided for by s. 20 of the Act of 1883.

(i) Tranter's Patent, Jones' Patent, Johns. Pat. Man. 5th ed. pp. 191, 192.

(k) Lucas' Patent, Macr. P. C. 234, 239; Smith's Patent, Macr. P. C. 232.

(l) Harrison's Patent, Macr. P. C. 31; Westinghouse's Patent, Griff. P. C. 315; Crabtree's Patent, Eng. Rep. Jan. to Mar. 1881; Fox's Patent, 1878, No. 3988.

(m) *Re Medlock's Patent*, Newton, Lond. Journ. N. S. vol. xxii. p. 69.

(n) Fox's Patent, 1878, No. 3988.

(o) Cheesebrough's Patent, Griff. P. C. 303.

(p) *United Telephone Co. v. London and Globe Telephone Co.*, L. R. 26 Ch. D. 766.

(q) Edison's Patent, 1877, No. 2909; Westinghouse's Patent, Griff. P. C. 315; Haddan's Patent, Griff. L. O. C. 12, 13; Crabtree's Patent, Eng. Rep. Jan. to Mar. 1881.

In *Re Hearson's Patent* (r) the Comptroller, on granting leave to apply at the Patent Office to amend the specification, imposed the condition that the applicants should not bring an action, or take any proceeding in respect of an infringement of the patent prior to January 1, 1884. infringements committed after that date,

An examination of the cases in which January 1, 1884, has been fixed shows that the reason for fixing that date was the doubt as to whether s. 20 of the Patents, &c., Act, 1883, would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act.(s)

Any party is, however, at liberty to bring forward any special circumstances to cause the law officer to insert a later date than January 1, 1884,(t) though the practice is not to extend protection to infringers beyond that date.(u) but under special circumstances such a condition may be imposed.

During the argument in *Ashworth's Application*,(w) the Solicitor-General said that if he saw, or if there was any evidence before him, that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claimed, he should consider that a special circumstance, and impose the condition that no action should be brought for anything done at any time before the amendment; for instance, if the patentees had been threatening persons, and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different to that described and claimed by the amended specification.

If the Comptroller decides against an applicant or patentee applying for leave to amend his specification, the applicant or patentee must not delay exercising his right of appeal and filing the fourteen days' notice required by the Law Officer's Rules,(y) or the appeal may not be heard, on the ground that it is too late. Applicant should not delay exercising his right of appeal from the Comptroller's decision.

Thus in *Arnold's Application*,(z) the Comptroller decided against the applicant, who two years afterwards applied again, and then appealed to the law officer. The Attorney-General said that he thought he should have allowed the proposed

(r) 1 P. O. R. 213.

(s) See cases in Griff. P. C. ; Allen, Griff. L. O. C. 3.

(t) Haddan, Griff. L. O. C. 12.

(u) *Ashworth*, Griff. L. O. C. 6.

(w) Griff. L. O. C. 6.

(y) L. O. Rules, r. i.

(z) Griff. L. O. C. 5.

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amendment, but the affidavit of the applicant, to the effect that he was ignorant of the patent law, and that he could have appealed against the former decision of the Comptroller, did not satisfy him that any sufficient reason existed why proceedings were not taken to question the previous decision of the Comptroller, and he refused to allow the appeal.

Leave to amend is conclusive, except in the case of fraud.

Leave to amend is conclusive of the applicant's or patentee's right to make the amendment, except in the case of fraud,^(a) *e.g.*, where a disclaimer was filed without the consent of the patentee.^(b)

Comptroller has no power over costs. Law officer has.

The Comptroller has no power over the costs of an application either directly or, indirectly, by making the payment of costs a condition of the amendment; ^(c) but, on appeal, the law officer may order costs to be paid by either party, and any such order may be made a rule of court.^(d) Where the law officer orders that costs shall be paid by any party, he has power to fix the amount of such costs, and, if he does not fix the amount thereof, he must direct by whom and in what manner the amount of such costs shall be ascertained.^(e)

Second amendments.

As a general rule, costs of an appeal to the law officer are given against the unsuccessful party, but, in the case of a second amendment, costs will most probably not be given against the opponents, on the ground that second amendments are not to be encouraged if they can possibly be avoided.^(f)

Comptroller does not as a rule give or receive costs.

Where an applicant appeals from the decision of the Comptroller, on an unopposed application, and the Comptroller is represented at the hearing, the Comptroller does not, except in very special circumstances, either give or receive costs.^(g)

Defendant's costs in cases of applications pending action for infringement or petition for revocation.

In cases where leave is given to apply to amend a specification pending an action for infringement, or proceeding for the revocation of a patent, the Court or a judge does not as a rule order the applicant to pay to the defendant, or petitioner, his costs of

^(a) 46 & 47 Vict. c. 57, s. 18, ss. 9.

^(b) *Re Berdan's Patent*, L. R. 20 Eq. 346.

^(c) *Pietschmann's Patent*, Griff. P. C. 314; *Codd's Patent*, Griff. P. C. 305.

^(d) 46 & 47 Vict. c. 57, s. 38.

^(e) L. O. Rules, r. xi.; *Ashworth's*, 1878, No. 3513, Griff. L. O. C. 9; *Bell's*, 1885, No. 1965, Griff. L. O. C. 11.

^(f) See *Haddan*, Griff. L. O. C. 12.

^(g) *Lake*, Griff. L. O. C. 16.

appearing to oppose the application on the hearing before the Comptroller.(h)

When, however, a plaintiff's application was refused by the Comptroller on the ground that an action was pending and the leave of the Court or judge had not been obtained, on an application to the Court for leave to apply again to the Comptroller, the judge made it a condition that the plaintiffs should pay the costs of the first application.(i)

Where, in an action for infringement, the plaintiff obtained the leave of the judge to apply at the Patent Office for leave to amend, and did so, but subsequently abandoned the action, and then applied, under s. 18 of the Act of 1883, to make a different amendment, the Comptroller and the law officer both refused to make it a condition of allowing the amendment that the applicant should pay the costs of the opponents (who were the defendants in the action) incurred in respect of the opposition to the abandoned application.(k)

In *Morgan's Application* (l) the Comptroller refused to allow an amendment, on the ground that he thought it would enlarge the scope of the invention; but the law officer, on appeal, allowed the amendment, being of opinion that the provisional specification was comprehensive enough to cover the claim to the thing shown in a certain drawing and indicated by the corrected description.

In this case an application was made for a return of the stamp on the notice of appeal, but the law officer refused the application, on the ground that there was sufficient difficulty to justify the Comptroller in declining to allow the amendment, and leaving it to the law officer.

(h) See *Fusee Vesta Co. v. Rylands*, 4 P. O. R. 71.

(i) *Codd v. Bratby*, 1 P. O. R. 209, 211.

(k) *Bell*, Griff. L. O. C. 10.

(l) *Griff. L. O. C.* 17.

CHAPTER VII.

OBTAINING LETTERS PATENT FOR INVENTIONS.

DISCRETION OF THE CROWN—PATENT AGENTS—APPLICATION—ACCEPTANCE OF COMPLETE SPECIFICATION—OPPOSITION—CONDITIONS—SEALING THE PATENT—FOREIGN APPLICATION—EXTENT AND DURATION OF LETTERS PATENT—ILLUSTRATED JOURNAL AND REPORTS OF CASES—PATENT OFFICE MUSEUM—REGISTER OF PATENTS.

Discretion of the Crown.

Discretion of the Crown in granting letters patent, exercised

No person can demand protection for an invention by letters patent as of right. The power of the Crown to grant letters patent is purely discretionary. It was exercised during, and most probably previous to, the reign of Edward III.,^(a) and preserved by the Statute of Monopolies,^(b) and is not suspended during the minority, or other incapacity of the reigning Sovereign.^(c)

through the medium of certain officers.

The Crown exercises its discretion in the matter of granting patents for inventions through the medium of certain officers appointed under the Patents Designs and Trade Marks Act, 1883—viz., the Comptroller-General of the Patent Office, and the Attorney-General, or the Solicitor-General.

Grant may be made to true and first inventor alone or jointly with other persons.

The Crown can grant letters patent for an invention only to the true and first inventor or inventors, but the grant may be made to such true and first inventor or inventors alone, or jointly with any other person or persons.^(d)

Every grant of letters patent is made at the grantee's peril, and on condition that it is valid only if one or more of the grantees is, or are, in fact the true and first inventor or inventors,

(a) Year Book, part iv. 40 Edw. III. fol. 17, 18; Darcy v. Allen, Moore's Reps. 675.

(b) 21 Jac. I. c. 3.

(c) Co. Lit. 43 b; 5 Co. 27 a; 7 Co. 12 a.

(d) 21 Jac. I. c. 3, s. 6; 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, s. 5.

the invention is new and useful, and the specifications are sufficient to fulfil the requirements of the law; moreover, the Crown in no way whatever guarantees the validity of any letters patent, if the representations and conditions on the strength of which it is made are not rigidly correct and fulfilled.

The practice which it is necessary for any person desirous of obtaining a grant of letters patent to observe is laid down, and regulated, by the Act of 1883, and the rules and regulations from time to time made by the Board of Trade in pursuance of the powers conferred by that statute.^(e)

Practice is regulated by Act of 1883 and rules made thereunder.

Except as regards patents binding the Crown and compulsory licences, the Act of 1883 in all respects (including the amount and time of payment of fees) extends to all patents granted before the commencement of the Act, or on applications then pending, in substitution for such enactments as would have applied thereto if the Act had not been passed; and all instruments relating to patents granted before the commencement of the Act required to be left or filed in the Great Seal Patent Office are deemed to be so left or filed, if left or filed before or after the commencement of the Act in the Patent Office.^(f)

Patent Agents.

It is the usual practice for a would-be patentee to engage the services of a patent agent of experience and skill to aid him in filling up the many necessary forms, drafting the specifications, and attending the hearing of oppositions to the grant of the patent.

The form of application must be signed by the applicant himself, but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require, resident in the United Kingdom.^(g)

If any person describe himself as a patent agent, either by advertisement, by description on his place of business, by any

^(e) 46 & 47 Vict. c. 57, s. 101.
^(g) P. R. 1890, r. 8.

^(f) 46 & 47 Vict. c. 57, s. 45.

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document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of the Patents Designs and Trade Marks Act, 1888, (h) he is liable on summary conviction to a fine not exceeding twenty pounds. But any person who proves to the satisfaction of the Board of Trade that he had been practising *bonâ fide* as a patent agent prior to December 24, 1888, is entitled as of right to be registered. (i)

Application.

Any person may make an application.

Any person, whether a British subject or not, is entitled to make an application for a patent, and two or more persons may make a joint application, and a patent may be granted to them jointly. (j)

The application must be made on one of the forms set forth in the first schedule to the Act of 1883, or in such other form as may be from time to time prescribed. (k)

Invention partly original and partly communicated from abroad.

If an invention is partly original and partly communicated from abroad, it is doubtful whether it is incumbent on the applicant to distinguish which is which; (l) and it is an undecided point whether, or not, the omission to do so would render the patent void. (m)

Applicant must leave the application at the Patent Office.

The applicant having filled up the form of application, which must be signed by himself, must leave it at, or send it by post to the Patent Office. If sent by post as a prepaid letter, it will be deemed to have been left at the Patent Office at the time when the letter containing the same would be delivered in the ordinary course of post, and, in case it becomes necessary to prove such sending, it will be sufficient to prove that the application was properly addressed and posted. (n)

Application must contain a declaration,

The application must contain a declaration, which may be either a statutory declaration under the Statutory Declarations

(h) 51 & 52 Vict. c. 50, s. 1.

(i) *Ibid.* ss. 3. The rules made by the Board of Trade in pursuance of the Act of 1888 for the regulation of the registration of patent agents will be found in the Appendix.

(j) 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, s. 5.

(k) 46 & 47 Vict. c. 57, s. 5, ss. 1. The

forms at present in use for this purpose will be found in the second schedule to the Patent Rules, 1890: see Appendix.

(l) *Renard v. Levinstein*, 10 L. T. N. S. 177.

(m) *Re Avery's Patent*, L. R. 36 Ch. D. 307.

(n) 46 & 47 Vict. c. 57, s. 5, ss. 1; s. 97; F. R. 1890, r. 16 a.

Act, 1835, or not, as may be from time to time prescribed,^(o) to the effect that the applicant is in possession of an invention whereof he claims, or, in the case of a joint application, one or more of the applicants claims or claim, to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or a complete specification.^(p)

and must be accompanied by either a provisional or a complete specification.

Where the provisional specification is accepted it cannot be impeached as being too general.^(q)

The form of declaration at present in use ^(r) is not a declaration, under the Statutory Declarations Act, 1835.

Statutory declarations required for use in the Patent Office are to be made and subscribed as follows ^(s) :—

Statutory declarations required for use in Patent Office.

(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 her 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 her 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 a notary public, or before a judge, or magistrate.

If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration, or doing anything required or permitted by the Act of 1883, or by any rules made thereunder, then the guardian or committee (if any) of such incapable person, or, if there be none, any person appointed by the Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration, or doing such thing,

Persons incapable of making a declaration.

^(o) 48 & 49 Vict. c. 63, s. 2.

^(p) 46 & 47 Vict. c. 57, s. 5, ss. 2. As to size of paper drawings, &c., see P. R. 1890, rr. 10, 30-33: see Appendix.

^(q) Penn v. Bibby, L. R. 2 Ch. App.

127.

^(r) See Appendix.

^(s) P. R. 1890, r. 17: see Appendix.

may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing, in the name and on behalf of such incapable person, and all acts done by such substitute are, for the purposes of the Act, as effectual as if done by the person for whom he is substituted.^(t)

Statutory declaration forming part of an application for a patent is exempt from stamp duty.

A statutory declaration, made under the provisions of the Statutory Declarations Act, 1835, and forming part of an application for a patent, in conformity with the Patents, Designs, and Trade Marks Act, 1883, is exempt from the stamp duty charged on a statutory declaration, under the provisions of the Stamp Act, 1870.^(u)

Application should comprise only one invention.

An application for a patent should comprise only one invention. It is provided by the Act of 1883,^(v) that every patent shall be granted for one invention, though, if a patent should, by inadvertence, be made to include several inventions, it is not competent for any person, in an action, or other proceeding, to take any objection on the ground that it comprises more than one invention.^(w)

If the Comptroller refuse to accept an application on the ground that it includes more than one invention, the person making it may amend it so as to apply to one invention only, and may make application for separate patents for each of such inventions accordingly, and every such application must bear the date of the first application and must be proceeded with as if it had been originally made on that date for one invention only.^(y)

Test.

Lord Herschell, when Solicitor-General,^(z) gave it as his opinion that the general object of the invention is the test by which the question of one invention must be decided, and in reference to a particular case said: "If you have a particular general object of an invention to make rails rest more securely, and you describe one, or two, or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both

^(t) 46 & 47 Vict. c. 57, s. 99.

^(u) 47 & 48 Vict. c. 62, s. 9.

^(v) S. 33.

^(x) 46 & 47 Vict. c. 57, s. 33.

^(y) P. R. 1890, r. 19.

^(z) Jones' Patent, Griff. P. C. 265.

servicing the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention. But if you say, 'I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct,' then those are six inventions."

Where (a) an applicant applied for a patent, under the title *Examples.* "Improvements in apparatus for rapidly heating flowing water, a part of which improvements is applicable to other purposes," and after describing in his provisional specification an apparatus consisting of several parts, including improved mechanism, by which the turning of the taps of a geyser, otherwise than in the required order, was prevented, stated: "The arrangements hereinbefore described for locking the water and gas-cocks is applicable to oxyhydrogen light apparatus, and to other apparatus in which two cocks, or a number of cocks, are required to be turned in a certain order," he was ordered to amend his application by striking out from the title the words in italics. Both the Comptroller and the law officer were of opinion that the application, as it stood before amendment, included more than one invention, and the latter pointed out that the applicant was entitled, if he so desired, to make a separate contemporary application for his new and improved cock, or arrangement of cocks by itself, and that he might of course, describe the cock, or arrangement of cocks, as part of his combination or apparatus which he claimed to have invented, but that he should, in doing so, refer to his contemporary application if he desired to make one.

Again, when a person applied for a patent for an invention of "improvements in the art of producing and utilising induced electrical currents for telegraphy and other purposes," (b) and it appeared that the invention consisted in the employment in telegraphic transmitting and receiving instruments of a certain

(a) Hearson's Patent, 1885, No. 11,437, Griff. P. C. 266.

(b) Robinson's Patent, Griff. P. C. 267.

appliance, the Comptroller objected to the title, stating that the appliance could be applied to purposes other than telegraphic, and required an amendment so as to limit the invention to such purposes, and held that, if the applicant desired to claim the general use of the appliance for the production of induced currents, it must form the subject of a separate patent.

On appeal, the law officer informed the applicant that if he intended to claim, as a combination, the whole of the apparatus as one telegraphic apparatus, then it might all be included in one specification; but if he was including, for all purposes, the invention of "the appliance," then it was something different, which could not be protected by the same patent. The law officer further stated that he would allow that, if the whole were limited to telegraphy, because that would make an improved telegraphic arrangement, and, although consisting of several parts, he would allow it to be included in one patent; but if there were to be two separate things, which could only be allowed together because they went to make up one better kind of instrument or machine, then he would never allow the use of a part of that for a purpose independent of the main object of the machine.

It was therefore a question for the applicant whether it answered his purpose better to protect "the appliance" for all purposes, or to protect improved telegraphic apparatus, consisting of the employment of "the appliance" therein. The applicant elected to take a patent for the general use of "the appliance," and the law officer allowed the title to be amended to "improvements in the art of producing and utilising induced electrical currents," the description of the telegraphic apparatus being struck out of the provisional specification.

Separate patents granted to joint applicants who are inventors of distinct parts.

If an application be made by two or more joint applicants, and it appears that the invention consists of distinct parts, invented separately by the applicants respectively, it seems that separate patents will be granted to the actual inventors in respect of the separate and distinct parts.(c)

If an applicant does not leave a complete specification with

(c) See Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.

his application, he may leave it at any subsequent time within nine months, or, on obtaining the leave of the Comptroller on payment of the prescribed fee, within a further extended period of one month,^(d) from the date of application, but, unless a complete specification is left within that time, the application will be deemed to be abandoned.^(e)

Time within which complete specification may be left at the Patent Office.

The nine months will be reckoned exclusively of the day of the date of the application.^(f)

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 are not at any time open to public inspection, or published by the Comptroller.^(g)

If an application is abandoned, the specifications are not published.

If a provisional specification is left with the application a fee of £1 is payable, and a further fee of £3 becomes due on the filing of the complete specification, whereas, if a complete specification is left with the application, a fee of £4 must be paid at the same time.^(h)

Fees.

Acceptance of the Complete Specification.

Every application for a patent is referred by the Comptroller-General to an examiner appointed under the Act of 1883,⁽ⁱ⁾ whose duty it is to ascertain whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any), have been prepared in the prescribed manner, and whether the title sufficiently indicates the nature of the invention.^(k) It is also the examiner's duty to report whether the invention is contrary to law and morality,^(l) and whether the application comprises more than one invention.^(m) 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

Application is referred to an examiner.

Duties of examiner.

^(d) 48 & 49 Vict. c. 63, s. 3; see P. R. 1890, rr. 50, 51.

^(e) 46 & 47 Vict. c. 57, s. 8; see also 46 & 47 Vict. c. 57, s. 98.

^(f) *Russell v. Ledsam*, 14 M. & W. 572, 582; *Williams v. Nash*, 28 Beav. 93.

^(g) 48 & 49 Vict. c. 63, s. 4.

^(h) P. R. 1890, 1st schedule.

⁽ⁱ⁾ 46 & 47 Vict. c. 57, s. 83.

^(k) 46 & 47 Vict. c. 57, s. 6. See Chap. V.

^(l) 46 & 47 Vict. c. 57, s. 86.

^(m) 46 & 47 Vict. c. 57, s. 33.

the invention, the Comptroller may, subject to appeal to the law officer, refuse to accept the application, or require that the specification, or drawings be amended before he proceeds further; and in the latter case the application must, if the Comptroller so directs, bear date as from the time when the requirement is complied with.⁽ⁿ⁾

It is also the examiner's duty to report whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification, and if the examiner reports that such conditions have not been complied with, the Comptroller is empowered to refuse to accept the complete specification unless and until it shall have been amended to his satisfaction; any such refusal, however, is subject to appeal to the law officer, who must, 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.^(o)

In *Everitt*, 1886, No. 8403,^(p) the Comptroller refused to accept the complete specification on the ground that the invention described by the provisional was a general principle, whilst that referred to by the complete specification was a special means for carrying the principle into effect. On appeal to the law officer it was held that the provisional sufficiently described the nature of the invention, and the complete specification was ordered to be accepted.

The complete specification must be signed by the applicant or his authorised agent, but in the case of a joint application, the Comptroller will not refuse to accept the complete specification on the ground that it is only signed by, or on behalf of, only one applicant.^(q)

The fact that the complete specification narrows the scope of the provisional, is not a ground on which the Comptroller or law officer is justified in refusing it.^(r)

And, if the specification ends with a real statement of the

⁽ⁿ⁾ 51 & 52 Vict. c. 50, s. 2, (1), (2), (3).
^(o) 46 & 47 Vict. c. 57, s. 9, (1), (2), (3); see *In the Matter of Anderson's Patent*, 7 P. O. R. 323.

^(p) *Griff. L. O. C.* 27.
^(q) *In the Matter of Grenfell and McEvoy's Patent*, 7 P. O. R. 151.
^(r) *Everitt*, 1886, No. 8403, *Griff. L. O. C.* 27; p. 154 *ante*.

invention claimed, distinct from the description in the body of the document, it is not competent to the Comptroller or law officer to inquire whether the claim is in conformity with the description or not. A claim to an improved machine, "substantially as described," is not a distinct statement within the meaning of ss. 5, s. 5, of the Act of 1883, and is not sufficient.^(k)

Reports of examiners are not in any case published, or open to public inspection, and are not liable to production or inspection in any legal proceedings under the Act of 1883, unless the Court or officer having power to order discovery in such legal proceedings shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.^(l) It consequently follows that where there are two applicants for a patent for the same or analogous inventions, each cannot know the nature of the other's specification until the rival specifications themselves are accepted and open to public inspection.^(m)

Sub-sections 5 and 6 of s. 7 of the Act of 1883, were found in practice to be useless, and to give rise to much hardship and blackmailing, perpetrated by prior against later applicants, and they were abolished by the Act of 1888, which provides that ^{S. 2. ss. 5, of Act of 1888.} (n) if, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification, having 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.

In cases where the Comptroller refuses to accept an application or requires an amendment, the applicant has the right of appeal to the law officer, who must, 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.^(o)

(k) Smith's Patent, Griff. P. C. 268.

(l) 46 & 47 Vict. c. 57, s. 9, ss. 5; 51 & 52 Vict. c. 50, s. 3.

(m) 46 & 47 Vict. c. 57, s. 10.

(n) S. 5, ss. 5.

(o) 51 & 52 Vict. c. 50, s. 2. The practice on appeal to the law officer is regulated by the Law Officer's Rules: see Appendix.

The Comptroller is not entitled to exercise any discretionary power adversely to an applicant without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.(p)

Practico.

In any case where a person, having the right, intends to appeal to the law officer from a decision of the Comptroller, he must, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such intention, stating the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of the decision, and he must otherwise conform to the Law Officer's Rules.(q) In all cases of appeal to the law officer it is desirable that a statement of fees paid be handed in to the law officer so that he may have it before him when considering the question of costs.(r) Where the right of appeal to the law officer lies against a decision of the Comptroller, the effect of Nos. 1 and 2 of the Law Officer's Rules is to limit the hearing before the law officer to points specifically raised by the notice of appeal, and where a notice of appeal is given as to parts only of the Comptroller's decision, the person receiving such notice, if he desires to question other parts of the Comptroller's decision, must give a counter notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter notice may be extended under rule 5.(s)

Costs.

The Act of 1883 gives the law officer control over the costs of the proceedings before him, but there is no such provision in the case of proceedings before the Comptroller.(t)

As a general rule the costs of an appeal to the law officer follow the event,(u) unless there has been unfair conduct;(x) and where an appeal is withdrawn the opponent pays the costs.(y)

(p) 46 & 47 Vict. c. 57, s. 94; see P. R. 1890, rr. 11-14.

(q) See Appendix.

(r) See remarks of Webster, A.G., in the Matter of Sielaff's Application, 5 P. O. R. 487.

(s) In the Matter of Bairstow's Patent, 5 P. O. R. 289.

(t) 46 & 47 Vict. c. 57, s. 38.

(u) Anderton, 1885, No. 1840, Griff. L. O. C. 25; *Ex parte* Fox, 1 W. P. C. 431 n.

(x) *Re* Lowe's Patent, 25 L. J. Ch. 456.

(y) Knight, 1886, No. 15,580, Griff. L. O. C. 35; *Re* Cobloy's Patent, 8 Jur. N. S. 106; *Re* Ashenurst's Patent, 2 W. R. 3.

Where an applicant, on appeal, consented to make a slight modification in his specification to satisfy the ground of opposition, but asked for costs of appeal, as he had not been previously asked to make the modification, costs were disallowed, as it was not the fault of the other side that the matter had arisen.^(z)

In cases of unsuccessful opposition the insertion of a few explanatory words in the specification may be allowed at the hearing before the law officer, and if the amendment is not a substantial alteration the costs of the appeal may be given as if no such modification had been accepted.^(u)

Slight amendments allowed at hearing before the law officer.

In *Brown's Application*^(b) for a patent under the title "improvements in casks and tubs," accompanied by a complete specification in the first instance, which stated that the invention was applicable to barrels or other casks and also to tubs *and analogous vessels*, in which the staves are formed with a croze or groove for receiving the head or bottom, and the object of the invention was to secure the bottom or head against outward displacement, and also to support the staves beyond the croze against any force or blow delivered upon the exterior of the staves such as would tend to break off their ends projecting beyond the croze, the Comptroller refused to accept the specification unless the words "and analogous vessels" were added to the title, or omitted from the specification, on the ground that the title did not, in view of the words "and analogous vessels" in the body of the specification, sufficiently indicate the subject-matter of the invention. The law officer on appeal, however, reversed the Comptroller's decision, being of opinion that the title taken together with the claims, which were specific, was sufficient, and he also pointed out that the patentee is entitled to frame his title in his own way, provided he does not infringe the rules of the statute.

In *Everitt's Application*^(c) the Comptroller refused to accept the complete specification on the ground that it claimed only a special means of carrying a principle into effect, whilst the provisional was apparently for the principle, but this decision

^(z) Woodhead, 1886, No. 2727, Griff. L. O. C. 44.

^(u) Fletcher, 1886 No. 13,598, Griff. L. O. C. 30.

^(b) Griff. L. O. C. 1.

^(c) Griff. L. O. C. 27.

was reversed on appeal, on the ground that in law the Comptroller was not entitled to refuse to accept the complete specification, which only narrowed down the ambit of the provisional and did not go outside it.

Effect of
notice of
acceptance.

If the application is accepted the applicant will receive due notice to this effect, (e) and the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice to the patent to be granted for the same; (f) though the applicant is not entitled to sell any article made in accordance with his invention, and represent it as "patented," until the seal of the Patent Office has actually been obtained; (g) nor is he entitled to sue in respect of infringements of the invention committed before the acceptance and publication of the complete specification. (h)

It is not an offence under the Act of 1883 to represent an article as patented when the patent has expired. (i)

A person is deemed to represent that an article is patented if he sells the article with the word "patent," "patented," or any other word expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article. (k)

Unauthorised
use of the
royal arms.

Any person who, without the authority of her Majesty, or any of the royal family, or of any Government department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession, by, or under, such authority as aforesaid, is liable, on summary conviction, to a fine not exceeding twenty pounds. (l)

Scotland.

In Scotland, any offence under the Act of 1883 declared to be

(e) 51 & 52 Vict. c. 50, s. 2 (4).

(f) 46 & 47 Vict. c. 57, s. 14; p. 138 ante.

(g) 46 & 47 Vict. c. 57, s. 105; *The Queen v. Wallis*, 3 P. O. R. 1; *The Queen v. Crampton*, 3 P. O. R. 367.

(h) 46 & 47 Vict. c. 57, s. 13; p. 139 ante; Chap. XIII. post.

(i) *Cheavin v. Walker*, L. R. 5 Ch. D. 850.

(k) 46 & 47 Vict. c. 57, s. 105, ss. 2; but see *Cheavin v. Walker*, L. R. 5 Ch. D. 863; *Linoleum Co. v. Nairn*, L. R. 7 Ch. D. 834.

(l) 46 & 47 Vict. c. 57, s. 106.

punishable on summary conviction, may be prosecuted in the Sheriff Court.^(m)

The punishment for a misdemeanour, under the Act of 1883, Isle of Man. in the Isle of Man, is imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court.⁽ⁿ⁾ And any offence committed in the Isle of Man, which would in England be punishable on summary conviction, may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.^(o)

The acceptance of a specification by the Comptroller is no guarantee that it is good in law. The Comptroller is only required to be satisfied that the specification is prepared in the prescribed manner, and that the invention particularly described in the complete is substantially the same as that described in the provisional specification. Acceptance of a specification is no guarantee of its validity.

If a complete specification is not accepted within twelve months from the date of application, or within a further extended period of three months, on obtaining the leave of the Comptroller and payment of the prescribed fee,^(p) then (save in the case of an appeal having been lodged against the refusal to accept) the application at the expiration of such period becomes void.^(q)

When the complete specification is accepted, the Comptroller is required by the Act of 1883 to advertise the acceptance in the Official Journal of the Patent Office, and the application and specification or specifications with the drawings (if any), are thereupon open to public inspection and may be inspected at the Patent Office upon payment of the prescribed fee.^(r) Advertisement of complete specification. Public inspection.

Opposition.

By s. 11 of the Patents, Designs and Trade Marks Act, 1883, Who may oppose an application. as amended by the Act of 1888,^(s) it is enacted as follows:—

^(m) 46 & 47 Vict. c. 57, s. 108.

⁽ⁿ⁾ 46 & 47 Vict. c. 57, s. 112, ss. 2.

^(o) 46 & 47 Vict. c. 57, s. 112, ss. 3.

^(p) 48 & 49 Vict. c. 63, s. 3.

^(q) 46 & 47 Vict. c. 57, s. 9 (4).

^(r) 46 & 47 Vict. c. 57, s. 10; P. R. 1890, rr. 21, 22.

^(s) S. 4.

“(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification, give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention 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 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, but on no other ground.

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

“(3) The law officer shall, if required, hear the applicant and any person so giving notice, and being, in the opinion of the law officer, entitled to be 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 expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.”

Hence the only grounds on which a person entitled so to do may oppose the grant of letters patent are—

- (1) That the applicant has obtained the invention from him, or from a person of whom he is the legal representative.
- (2) That the invention has been patented in this country, on an application of prior date.
- (3) That 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 hearing of the provisional specification and the hearing of the complete specification.

Formerly, want of novelty, non-utility, and lack of subject-

matter, were all grounds of opposition, but the effect of the Act of 1883, is to abolish the right of the opposer to raise any of these grounds on an application for a patent; though, if the patent is granted, the Crown in no way guarantees that it may not be upset on one or other of these points in subsequent proceedings.^(k)

It is not the duty of the Comptroller on an application which is opposed, or of the law officer on appeal, to decide whether or not the applicant is the true and first inventor, and he cannot inquire into the circumstances under which the applicant became possessed of the invention, other than those which go to show that it was derived from the opponent, or the person of whom he is the legal representative, if his ground of opposition is properly raised.^(l) If this objection be clearly proved no patent will be granted.^(m)

Opposition on the ground that the applicant obtained the invention from the opponent or the person of whom he is the personal representative.

If at the hearing before the Comptroller the evidence as to the applicant having obtained the invention from the opponent, or a person of whom he is the personal representative, is conflicting, the patent will be ordered to be sealed without prejudice to an appeal to the law officer,⁽ⁿ⁾ and in order that the witnesses may be cross-examined.^(o)

The fact that other persons have made experiments identical with the applicant's, will not stop the patent being granted, unless the opposer shows that the applicant derived the invention from the person making such experiments, and then only, if such person or his legal representative is the opponent.^(p)

In *David and Woodley's Application*, 1884, No. 13,873,^(q) the facts were that *Jones* having invented some improvements in sewing machines, was introduced by *David* to *Woodley*, and *Woodley* was employed by *Jones* and *David* conjointly (*David* claiming some interest in *Jones's* invention) to make a model. *Woodley* made some suggestions, which were embodied in the

(k) p. 256 ante.

(l) See In the Matter of Adolph Spiel's Application, 5 P. O. R. 281; In the Matter of Lake's Patent, 5 P. O. R. 415.

(m) In the Matter of Marshall's Application, 5 P. O. R. 661; In the Matter of Griffin's Application, 6 P. O. R. 296.

(n) Luke's Patent, Griff. P. C. 294.

(o) Hatfield's Patent, Griff. P. C. 288.

(p) See *Ex parte* Henry, L. R. 8 Ch. 167; In the Matter of Homan's Patent, 6 P. O. R. 104; *Saxby v. Gloucester Waggon Co.*, Griff. L. O. C. 57.

(q) Griff. L. O. C. 26.

model. *Jones* took out a patent for the machine, whereupon *David* and *Woodley* applied for a patent for the suggestions made by *Woodley*. *David* and *Woodley* had also applied for a patent for alleged improvements on this invention. The Comptroller refused the grant, and the law officer upheld his decision, on the ground that when a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them. Further, if *Woodley* was in the employment of *Jones* and *David*, and not of *Jones* alone, the invention was *Jones'*, and he had never parted with his property in it, and *Woodley* stood to *Jones* in the relation of paid servant to employer. *David* was entitled to enforce in a court of law any claims he might have against *Jones*, founded on the alleged partnership or of a pecuniary character.

Where (r) on an application for a patent on a communication from abroad, the opposer objected that the applicant had obtained the invention from him, through a third party abroad, the patent was granted on the ground that a person availing himself of information from abroad is an inventor within the Statute of Monopolies.(s) It is to be observed that the Comptroller has no authority to inquire into the source of a patentee's information.(t)

Where an opponent in carrying on business had got into difficulties and had made an agreement to sell the business to the applicant, part of the consideration being an understanding that the opponent should give the applicant the benefit of a certain invention for sewing button-holes, and the opponent opposed on the ground that the invention had been obtained from him, the patent was refused in the absence of a written assignment.(u)

Foreign applicant.

Though a foreign applicant has important rights under s. 103

(r) In the Matter of Lake's Patent, 5 P. O. R. 415.

(s) 21 Jac. I. c. 3, s. 6; *Nickels v. Ross*, 8 C. B. 679.

(t) See *Edmunds' Patent*, Griff. P.

C. 281; In the Matter of Adolph Spiel's Patent, 5 P. O. R. 281; In the Matter of Bairstow's Patent, 5 P. O. R. 286.

(u) In the Matter of Marshall's Application, 5 P. O. R. 661.

of the Act of 1883, and the convention of 1884, he is not entitled to oppose on the ground that the applicant obtained part(*v*) or the whole(*x*) of the invention from him, an application in this country of later date than his own.(*y*)

It is a good ground of opposition to the grant of a patent for a communication from abroad that the applicant had no authority from the foreign inventor to make the application, but that the opposer was the person to whom the foreigner entrusted his invention with the view of gaining protection in this country.(*z*)

A person who has obtained an assignment of a patent, with the full benefit of all improvements and modifications thereof, from the assignee of the patentee, does not thereby become the legal representative of the patentee, so as to entitle him to oppose the grant of a patent to another inventor, on the ground that the applicant obtained the invention from the prior patentee;(a) nor is a person holding a power of attorney from a patentee his legal representative within the meaning of the Act.(b) The term legal representative must be construed in its ordinary meaning of executor or administrator.(c)

The words of the above-quoted section of the Act of 1883, at first sight would appear to give the right of opposition, on the second specified ground, to any person, whether he have a direct interest in opposing the patent or not; but the decisions lead to the conclusion that only persons having a direct interest are allowed to oppose, as they were formerly by the special enactment of the Act of 1852.(d) It must also be noticed that ss. 3 directs the law officer, on an appeal, to hear the applicant and any person giving notice, and being, "*in the opinion of the law officer*, entitled to be heard," and thus it is evident that the section contemplates the existence of persons who have no right of opposition.

In Glossop's case(e) the law was laid down to the effect that a person having no interest in a prior patent could not be

(*v*) Edmunds' Patent, Griff. P. C. 281.

(*x*) In the Matter of Lake's Patent, 5 P. O. R. 415.

(*y*) Everitt, 1886, No. 10,680, Griff. L. O. C. 28.

(*z*) Fiechter, 1882, No. 2485, Griff. P. C. 284.

(*a*) In the Matter of Adolf Spiel's Patent, 5 P. O. R. 281.

(*b*) Edmunds' Patent, Griff. P. C. 281.

(*c*) *Ibid.*

(*d*) S. 12.

(*e*) Griff. P. C. 285.

heard in opposition to an application for a new patent, when the ground of opposition was that the prior patent included the invention for which the applicant sought protection.⁽ⁱ⁾

Mere agent of a prior patentee.

A person who is merely an agent of a prior patentee has not such an interest in the prior patent as will entitle him to oppose a subsequent application on his own behalf.^(k)

Person about to work an invention included in a prior patent.

It has been held that where a person was about to commence to work an invention, which he alleged was included under certain expired patents, he had not such an interest in the expired patents as to entitle him to be heard in opposition to the granting of a fresh patent; ^(l) though where the opponent was the patentee by direct grant,^(m) or by assignment⁽ⁿ⁾ under the expired patent, he is entitled to oppose; ^(o) but a person who has no further interest in an expired patent than the fact that he manufactured under it, is not entitled to be heard in opposition to the grant of a fresh patent.^(p)

Patentee by grant or assignment under an expired patent. Person who merely works under an expired patent.

Statement by Webster, A.G.

Webster, A.G., has stated that, in his opinion, the only persons entitled to oppose under the words "patented, &c.," are persons who have made an application in the United Kingdom, of prior date to the date of the applicant's patent,^(q) and that the effect of s. 15 of the Act of 1883, is to place a person who has had a complete specification accepted in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose.^(r)

Objection that opposer is not entitled to be heard.

It is not competent to an applicant at the hearing before the Comptroller to raise the objection that the opposer is not a person entitled to be heard; he can only take this objection when the matter reaches the stage of an appeal to the law officer.^(s) If, however, the law officer on appeal allows the objection, he will not interfere with the Comptroller's decision, unless he is

⁽ⁱ⁾ See also Heath and Frost's Patent, Griff. P. C. 288; Hookham, 1886, No. 3778, Griff. L. O. C. 32; In the Matter of Macevoy's Patent, 5 P. O. R. 285.

^(k) Heath and Frost's Patent, Griff. P. C. 288; Lake, 1886, No. 8642; Griff. L. O. C. 35; Hookham, 1886, No. 3778, Griff. L. O. C. 32.

^(l) In the Matter of Bairstow's Patent, 5 P. O. R. 286.

^(m) Lancaster's Patent, Griff. P. C. 293.

⁽ⁿ⁾ Glossop's Patent, Griff. P. C. 285.

^(o) Lancaster's Patent, Griff. P. C. 293.

^(p) Macevoy's Patent, 5 P. O. R. 285.

^(q) Everitt, 1886, No. 10,680, Griff. L. O. C. 28.

^(r) L'Oiseau and Pierrard, 1886, No. 12,833, Griff. L. O. C. 36; but see *Ex parte* Henry, L. R. 8 Ch. 167.

^(s) Heath and Frost's Patent, Griff. P. C. 290.

satisfied that, looking at the substance of it, that decision ought to be interfered with. (*f*)

When an application is resisted on the second ground of opposition, (*g*) all the Comptroller or law officer can, on the hearing, be called on to decide is, whether or not the invention sought to be patented is the same as that patented on an application of prior date, and in cases of doubt the grant is allowed. (*h*) It is no part of the duty of the Comptroller or law officer to inquire whether the applicant's patent, if granted, would infringe a prior patent, (*i*) or whether the alleged invention is proper subject-matter, (*k*) or whether the patent, if granted, would be invalid from any other cause; (*l*) and the applicant in all cases frames his specification at his peril. (*m*)

If the ground of opposition to the grant of a patent be that the invention has been patented in this country on an application of prior date, the notice of opposition must distinctly allege this; it will be wrong in form if it allege that the prior invention was the same, "*or substantially the same,*" as the appli-

Duties of
Comptroller
and law
officer on
hearing of
oppositions.

Opposition on
the ground
that the in-
vention has
been patented
on an applica-
tion of prior
date.

(*f*) Heath and Frost's Patent, Griff. P. C. 290. (*g*) p. 270 *ante*.

(*h*) p. 281 *post*; Jones, 1885, No. 5237, Griff. L. O. C. 33. In the following cases, decided since the Act of 1883 came into operation, patents were refused on the ground that the respective inventions had been patented on applications of prior date:—

Heath and Frost's Patent, Griff. P. C. 310.

In the Matter of Daniel's Application, 5 P. O. R. 413.

In the Matter of Aire and Calder Glass Bottle Works and Walker's Application, 5 P. O. R. 345.

In the Matter of Wallis and Ratcliff's Application, 5 P. O. R. 347.

In the Matter of Webster's Patent, 6 P. O. R. 163.

Green's Patent, 1885, No. 8178, Griff. P. C. 286.

Lancaster's Patent, 1884, No. 4571, Griff. P. C. 293.

Re Bailey, Goodeve, P. P. 57.

In the following cases, decided since the Act of 1883 came into operation, the objection was taken that the respective inventions had been patented on applications of given date, but unsuccessfully:—

In the Matter of Lorrain's Patents, 5 P. O. R. 142.

In the Matter of Newman's Patent, 5 P. O. R. 271.

In the Matter of Pitt's Patent, 5 P. O. R. 343.

In the Matter of Airey's Application, 5 P. O. R. 348.

In the Matter of Sielaff's Application, 5 P. O. R. 484.

In the Matter of Brownhill's Patent, 6 P. O. R. 135.

Anderton, 1885, No. 1840, Griff. L. O. C. 25.

Fletcher, 1886, No. 13,598, Griff. L. O. C. 30.

Von Buch, 1886, No. 1235, Griff. L. O. C. 40.

Huth's Patent, Griff. P. C. 292.

Cumming's Patent, Griff. P. C. 277.

Stubbs' Patent, Griff. P. C. 298.

(*i*) Jones, 1885, No. 5237, Griff. L. O. C. 35; In the Matter of Sielaff's Application, 5 P. O. R. 484.

(*k*) Jones, 1885, No. 5237, Griff. L. O. C. 33.

(*l*) p. 256 *ante*.

(*m*) In the Matter of Lorrain's Patents, 5 P. O. R. 142.

cant's,(n) or that the applicant's invention is "a direct infringement of the opponent's patent."(o)

Disconformity. If an application be opposed on the ground that the invention was patented on an application of prior date, it is not competent to the applicant to object that the prior patent was void on the ground of disconformity between the specifications or between the title and the specifications.(p)

In *Green's Patent*, 1885, No. 8178,(q) the grant was opposed by Lowcock and Sykes, on the ground that the invention for which the applicant sought to obtain protection had been, as to certain parts, patented by them. The applicant objected that the opponent's patent was bad, because the complete specification went beyond the provisional, which did not include the parts which the applicant wished to cover. The law officer held, that though the opponent's patent might in fact be void, yet he could not entertain the objection; and since the opponent's patent included the parts in dispute, he could not allow a patent to be sealed to the applicant. The applicant consequently suffered in that he was prevented from obtaining a patent for the parts which he had invented between the dates of filing the opponent's specifications. The opponent's specifications having been referred to an examiner, and reported favourably upon by him, it was the duty of the Comptroller and law officer, for the purpose of the application, to treat them as good specifications, and consequently the question of disconformity could not be raised.(r)

The third ground of opposition,(s) which was introduced by the Act of 1888,(t) provides for such a case as the above. It would have been competent to Green to have opposed the grant of Lowcock and Sykes' patent, and to have himself applied for a patent in respect of his own invention.

If the application is opposed on the ground that the invention has been patented on an application of prior date, it does

(n) *Jones*, 1885, No. 5237, Griff. L. O. C. 33.

(o) In the Matter of Daniel's Application, 5 P. O. R. 413.

(p) *Green*, 1885, No. 8178, Griff. P. C. 286; *Newman*, 1886, No. 3480, Griff. P. C. 40; In the Matter of Haythornthwaites' Application, 7 P. O. R. 70.

(q) Griff. P. C. 286.

(r) *Ibid.* In the Matter of Haythornthwaite's Application, 7 P. O. R. 70.

(s) p. 270 *ante*; In the Matter of Anderson and Anderson's Patent, 7 P. O. R. 323.

(t) S. 4.

not signify that the prior patent has expired ;(u) but if an invention has only received provisional protection it cannot be made an objection to a later application.(x)

If an invention is only described and not claimed in a prior specification, it may be patented on an application of later date, Prior description without claim. it being a long-established and obvious rule, that only that is patented which the inventor claims.(y) There would be great doubt as to the validity of a patent granted under such circumstances.(z)

When an application is opposed on the ground that an alleged invention is the same as that comprised in the opponent's patent, and it appears that there is a difference, but that such difference is quite immaterial, the patent is refused.(a)

It is competent to the Comptroller or law officer, when an Equivalents. application is opposed on the ground that the invention has been patented on an application of prior date, to consider the question of mechanical equivalents ; (b) though the application will not be refused unless it is clear that the invention in respect of which it is made is practically identical with that forming the subject-matter of the prior patent.(c)

When a would-be patentee has good subject-matter, which is not identically the same as that comprised in a prior patent, he is entitled to have his patent sealed, though an action for infringement may lie against him if he puts his alleged invention into practice.(d)

A person entitled so to do, and desirous of opposing a grant Notice of opposition. of letters patent, must, within the two months allowed from the date of the advertisement of the acceptance of the complete specification, give a notice of his opposition at the Patent Office, on Form D., stating the ground or grounds on which he intends to oppose, and he must himself sign the notice, stating his

(u) Lancaster's Patent, 1884, No. 4571, Griff. P. C. 293.

(x) Bailey's Patent, Griff. P. C. 269; Patterson's Patent, Griff. P. C. 295.

(y) Von Buch, 1886, No. 1235, Griff. L. O. C. 40.

(z) See Chap. III.

(a) In the Matter of Airo and Calder Glass Bottle Works and Walker's Application, 5 P. O. R. 345; In the Matter of Wallis and Ratcliffe, 5 P. O. R. 347;

In the Matter of Daniel's Application, 5 P. O. R. 413; In the Matter of Haythornthwaite's Application, 7 P. O. R. 70; Heath and Frost's Patent, Griff. P. C. 310.

(b) In the Matter of Haythornthwaite's Application, 7 P. O. R. 70.

(c) p. 275 *ante*.

(d) In the Matter of Newman's Patent, 5 P. O. R. 271.

address, for service in the United Kingdom ; (*d*) and, if he opposes on the ground that the invention has been patented in this country on an application of prior date, the notice must specify the title, number, and date, of the patent granted in such prior application. (*e*)

The Comptroller has power to allow an amendment of an improperly drawn notice of opposition to be made at the hearing but he cannot impose terms. (*f*)

On giving the notice of opposition the opponent is required to pay a fee of ten shillings, and on the hearing of the opposition both the applicant and the opponents are required to pay a fee of one pound. (*g*)

Evidence of
opponent.

The Comptroller will, on receipt of the notice of opposition, furnish the applicant with a copy of it. (*h*)

Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification—*i.e.*, within fourteen days after the expiration of the time fixed by the Act as the limit within which notice of opposition can be taken—the opponent is required to leave at the Patent Office statutory declarations (*i*) in support of his opposition, lists of which he must also deliver to the applicant. (*k*)

Evidence of
applicant.

The applicant on his part must, within fourteen days from the delivery of such list, leave at the Patent Office statutory declarations in answer, delivering a list of them to the opponent, who then is allowed seven days from such delivery to leave at the Patent Office statutory declarations in reply, which must be confined strictly to matters in reply, and a list of which he must give to the applicant. (*l*)

Copies.

Either party desiring copies of any of these statutory declarations, may obtain them from the Patent Office or the opposite party. (*m*)

Further evi-
dence.

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

(*e*) P. R. 1890, r. 36. The practice on oppositions to grants of patents is regulated by the Patent Rules, 1890, rr. 34-44, and the Law Officer's Rules.

(*f*) In the Matter of Airey's Application, 5 P. O. R. 348; Lake, 1886, No.

8642, Griff. L. O. C. 35; P. R. 1890, r. 16.

(*g*) See Appendix.

(*h*) P. R. 1890, r. 35.

(*i*) See p. 259 *ante*.

(*k*) P. R. 1890, r. 37.

(*l*) P. R. 1890, r. 38.

(*m*) *Ibid.*

with the leave of the Comptroller, and upon the written consent of the opposite party, or by special leave of the Comptroller on application made to him for that purpose,⁽ⁿ⁾ of which application the party making it must give notice to the other party who is entitled to oppose it.^(o)

When the evidence is finally completed, the Comptroller appoints a time for the hearing of the case, of which he must give at least ten days' notice to the parties.^(p) Notice of hearing.

If the applicant or opponent desires to be heard, he must forthwith send the Comptroller an application on Form E.^(q) The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the Comptroller decides the case, and notifies his decision to the parties.^(r) Application to be heard.

On the hearing, no opposition can be allowed in respect of any ground not stated in the notice of opposition, and where the ground, or one of the grounds, is that the invention has been patented in this country on an application of prior date, the opposition is not allowed upon such ground unless the title, number, and date of the patent granted on such prior application is duly specified on the notice of opposition.^(r)

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 is left at the Patent Office within the time prescribed by the Patent Rules, 1890, the opposition is deemed to be abandoned, and the patent is sealed forthwith.^(s)

As a rule, at the hearing of an opposition, the applicant begins, but when the opponent alleges *fraud* as a ground of opposition, the *onus* being on him, his evidence may be ordered to be taken first.^(t) Hearing.

If the opponent does not appear at the hearing, the Comptroller will decide the case in his absence, and will not recall his decision, even though it is subsequently shown that the opponent

(n) P. R. 1890, r. 39.

(o) P. R. 1890, r. 40.

(p) P. R. 1890, r. 41.

(q) *Ibid.*

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

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

(t) Luke's Patent, Griff. P. C. 294.

LETTERS PATENT FOR INVENTIONS.

did not, in fact, receive the notice of hearing, which was duly posted. In such a case, on appeal to the law officer, the matter would most probably be sent back to the Comptroller for re-hearing.^(u)

Appeal to
law officer.

The Comptroller will notify his decision to the parties,^(x) either of whom has the right of appeal to the law officer.^(y)

Evidence.

The evidence used on such an appeal will be the same as that used at the hearing before the Comptroller, and no further evidence can 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.^(z)

An appeal to the law officer is a re-hearing.^(a) The law officer is entitled, if he desires it, to the assistance of an expert; ^(b) and he is also empowered, at the request of either party, to order the attendance at the hearing, for the purpose of cross-examination, of any person who has made a declaration; ^(c) and he is entitled to examine witnesses on oath, and to administer oaths for that purpose; and to order costs to be paid by either party.^(d)

The law officer does not allow the cross-examination of witnesses or the admission of further evidence, when it appears to him that there has been ample opportunity for the filing of declarations when the case was before the Comptroller, and that he could not deal better with evidence given on cross-examination, than with the declarations.^(e) The law officer does not take on himself to decide adversely to the applicant fine points of anticipation.^(f)

The law officer (and [*sic*] the Comptroller) is entitled to look at models in order to better understand the drawings and specifications, though the models are not exhibits, and consequently not evidence.^(g)

Where an opposer appeals to the law officer from a decision of

^(u) Warmann, 1885, No. 8650, Griff. L. O. C. 43.

^(x) P. R. 1883, r. 41.

^(y) 46 & 47 Vict. c. 57, s. 11 (2).

^(z) L. O. Rules, r. viii.; Hampton v. Facer, 1885, No. 8981, Griff. L. O. C. 13; Cheesebrough's Patent, Griff. P. C. 303.

^(a) Stubbs' Patent, Griff. P. C. 298.

^(b) 46 & 47 Vict. c. 57, s. 11 (4).

^(c) L. O. Rules, r. ix.

^(d) 46 & 47 Vict. c. 57, s. 38.

^(e) In the Matter of Pitt's Patent, P. O. R. 343, 345.

^(f) *Ibid.*

^(g) Lancaster's Patent, Griff. P. C. 294.

the Comptroller, it is not necessary that he should send a copy of his notice of appeal to the applicant.(t)

A patent is only refused in cases where the opposer proves his ground or grounds of opposition beyond all possibility of doubt, as there is no appeal from the decision of the law officer. It is evident that should he wrongfully refuse a patent the applicant would suffer an irremediable injury, whereas, if a grant be made in the face of what is really a valid ground of opposition, the public injury thereby occasioned may be remedied in a subsequent action for infringement, or petition for the revocation of the patent.(u)

Patent refused only when the ground of opposition is proved conclusively.

Conditions.

The Comptroller and the law officer have power to impose conditions on the granting of a patent, which power arises from the statutory right to refuse the grant altogether.(x)

Comptroller and law officer have power to impose conditions.

Sometimes the patent is granted to the applicant and opponent conjointly, if it appears that the invention is the joint production of both.(y)

When there were concurrent applications for a patent in respect of the same invention, it was formerly a recognised principle that the patent would be awarded to the inventor, who ran quickest through the process and was ready first to obtain the Great Seal.(z) Now, however, since the patent is in all cases dated as on the day of application,(a) in the case of concurrent applications on the same day, one patent would most probably be granted to the two applicants jointly, and if the concurrent applications were not made on the same day, the prior applicant would be entitled to the prior patent.

(t) Anderson and McKinnell, Griff. L. O. C. 23.

(u) *Re Russell's Patent*, 2 De G. & J. 130, 132; *Re Simpson and Isaacs' Patent*, 21 L. T. N. S. 81; *Re Spence's Patent*, 3 De G. & J. 523; *Re Lowe's Patent*, 25 L. J. Ch. 454; *Re Tolson's Patent*, 6 De G. M. & G. 422; *Chandler's Patent*, Griff. P. C. 270; *Stubbs' Patent*, Griff. P. C. 298; *Welch's Patent*, Griff. P. C. 300; *Edmunds' Patent*, Griff. P. C. 281; *Newman*, 1886, No. 3481, Griff. L. O. C. 40; *Jones*, 1885, No. 5237, Griff. L. O. C. 33; In the *Matter of Aire and Calder Glass Bottle*

Works and Walker's Application, 5 P. O. R. 345; In the *Matter of Daniel's Application*, 5 P. O. R. 413; In the *Matter of Wallis and Ratchiff's Application*, 5 P. O. R. 347; In the *Matter of Luke's Patent*, 6 P. O. R. 548.

(x) *L'Oiseau and Pierrard*, 1886, No. 12,833; Griff. L. O. C. 36.

(y) *Eadie's Patent*, 1885, Griff. P. C. 279; *Re Russell's Patent*, 2 De G. & J. 130; *Luke's Patent*, Griff. P. C. 294.

(z) *Ex parte Dyer*, Hindmarch on Patents, p. 535; *Re Simpson and Isaacs' Patent*, 21 L. T. N. S. 81.

(a) 46 & 47 Vict. c. 57, s. 13.

It may be made a condition of the granting of a patent that the grantee shall assign a certain share to another person, if the justice of the case appears to require it; (b) and each co-owner may be bound to pay a proportionate part of the fees necessary to keep the patent on foot. (c)

The condition has been imposed, under circumstances that called for it, that the grantee and opponent should enter into an agreement by which the former should undertake to do all such acts as might be necessary to secure to the latter the full rights of a joint patentee in the invention, and the latter should undertake not to commence proceedings for revocation of the patent when granted. (d)

In the case of rival applicants, if it appear that distinct parts are the separate inventions of the rival applicants, separate patents will be ordered to be sealed to each applicant in respect of his own invention alone. (e)

Disclaimers
and references
to prior pa-
tents.

The authority of the Comptroller and law officer to impose conditions on the grant of a patent is often exercised for the protection of previous inventors, (f) and the public generally, (g) by means of the imposition of a condition that the applicant shall insert in his specification certain disclaiming clauses or references to other patents.

If a subsequent patent be granted, and a specification accepted which actually or apparently claims something which is included in a prior patent, or something which is not patentable, the prior patentee in the one case, or the public in the other, suffers what may be a disadvantage to them, in so far as the subsequent patentee may endeavour under his grant to lay claim to the exclusive monopoly in the particular thing in question, yet they do not sustain any permanent injury, for the subsequent patent granted under such circumstances would be void. (h)

(b) Evans and Otway's Patent, 1884, No. 12,415, Griff. P. C. 279; Garthwaite's Patent, 1886, No. 3124, Griff. P. C. 284.

(c) Evans and Otway's Patent, Griff. P. C. 279.

(d) Luke's Patent, 1885, No. 5156, Griff. P. C. 294.

(e) Craig and Macfarlane's Applications, P. M. J. vol. iv. 3rd series, p. 366.

(f) In the Matter of Newman's Patent, 5 P. O. R. 271; Griff. L. O. C. 40.

(g) In the Matter of Lorrain's Patent, 5 P. O. R. 142; In the Matter of Guest and Banon's Patent, 5 P. O. R. 312; Tcague's Patent, Griff. P. C. 298.

(h) p. 257 *ante*; In the Matter of Hill's Application, 5 P. O. R. 599.

It is not to the interests of subsequent patentees that their patents should be apparently for an original invention, when, as a matter of fact, they can only claim a particular combination which they have described; and it is not to the interest of the public that they should be led into supposing that a description in a specification is entirely general, whereas it can only be supported as a specification of valid letters patent, if the description be understood to be a description of an improvement.⁽ⁱ⁾

If an invention is merely an improvement on a prior patented machine or process, the Comptroller and law officer will require a disclaimer by reference to the name and number of the prior patent.^(j)

It is a principle recognised by the law officers that where there is an existing patent, and there is fair ground for supposing that the construction of the specification of a subsequent applicant would interfere with the rights of the existing patentee, he is entitled to be protected. Such protection is usually given by the insertion in the specification of the subsequent applicant of a general disclaiming clause or special reference.^(k)

It would appear that, if there be a distinct reference in a provisional specification to an invention or device, which was within the specification of the opponent properly construed, the opponent is entitled to have a disclaimer on the face of the complete specification.^(l)

It is to the interests of the public that, where patents overlap, the distinctions between the inventions described in the specifications filed under the earlier and later applications should be made clear; ^{Object of dis-}^{claiming}^{clause.} ^(m) but it must be remembered that the object

⁽ⁱ⁾ Hoskins' Patent, Griff. P. C. 291; In the Matter of Newman's Patent (2), 5 P. O. R. 279.

^(j) Hoskins' Patent, Griff. P. C. 291; Welch's Patent, Griff. P. C. 300; In the Matter of Newman's Application, 5 P. O. R. 279; In the Matter of Lynde's Patent, 5 P. O. R. 663.

^(k) In the Matter of Newman's Patent, 5 P. O. R. 271; In the Matter of Hall and Hall's Patent, 5 P. O. R. 283; In the Matter of Lynde's Patent, 5 P. O. R. 663; In the Matter of

Gozney's Patent, 5 P. O. R. 597; In the Matter of Guest and Barrow's Patent, 5 P. O. R. 312; In the Matter of Wallace's Patent, 6 P. O. R. 134; Anderson and McKinnell, 1886, No. 3801, Griff. L. O. C. 23; In the Matter of Hoffman's Patent, 7 P. O. R. 92.

^(l) Hookam, 1886, No. 3778, Griff. L. O. C. 32; see also In the Matter of Hoffman's Patent, 7 P. O. R. 92.

^(m) In the Matter of Hill's Application, 5 P. O. R. 599.

of a disclaiming clause is to guard against the inclusion in a new patent of something embraced by the old patent, not of something merely mentioned in the old patent, but of something which has been claimed as part of the previous invention.⁽ⁿ⁾

In *In the Matter of Guest's and Barrow's Patent* (o) Webster, A.G., said: "I have on many occasions pointed out that the insertion of these disclaimers does not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interests, in order that his specification may not be considered as being too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge. It is not because a particular patentee, or a prior inventor, has made a broad claim that he is entitled to have limiting words inserted, unless he can show, upon a fair view of the evidence before the law officer, or before the Comptroller, that such words are really necessary to protect him."^(p)

Where a specification only contains a statement of general knowledge, there is nothing in the Patent Law to prevent a patentee on the face of his specification referring to the general defects, which he alleges rightly or wrongly, exist; but it would appear that, if a prior patentee is referred to specifically in a subsequent specification, no reference to any defect in the prior invention ought to be allowed in the latter specification.^(q)

An opponent, who is prior patentee, has no right to be specially named in a disclaiming clause in the specification of a subsequent patent unless the applicant is willing to name him, or unless it is clear that there is no other prior publication than the specification of the opponent.^(r)

⁽ⁿ⁾ In the Matter of Gozney's Patent, 5 P. O. R. 597; In the Matter of Holliman's Patent, 7 P. O. R. 92.

^(o) 5 P. O. R. 312.

^(p) See also Newman's Patent, 5 P. O. R. 279, 281; In the Matter of Holliman's Patent, 7 P. O. R. 92.

^(q) In the Matter of Guest and Barrow's Patent, 5 P. O. R. 316.

^(r) Teague's Patent, Griff. P. C. 298; Guest and Barrow's Patent, 5 P. O. R. 312; Brownhill's Patent, 6 P. O. R. 135.

An opponent, though not appealing against the grant of a patent, is entitled to appeal against the Comptroller's decision that no reference to his patent be inserted in the specification.^(s)

The law officers are always very unwilling to order the insertion of a special reference to the patent of a prior inventor and opponent. They usually prefer to insert a general disclaimer of the principle included in the invention of the prior patentee,^(t) bearing in mind that every prior patentee does not possess a right to have a disclaiming clause inserted in a subsequent specification, because, as was pointed out by Lord Cairns, every specification must be read as though the patentee had a knowledge of every previous complete and published specification of earlier letters patent.^(u)

Law officers unwilling to order special references.

In cases, however, where the rights of prior patentees cannot be effectually protected without special mention of the prior patents, the insertion of a special disclaimer is usually made a condition of the granting of a patent to a subsequent applicant, and the form of reference generally ordered, is to the effect that the patentee is aware of the existence of the prior patent, and that he does not claim anything claimed and described therein.^(v) So also in the case of concurrent applications and cross oppositions, if it appear that the specification of one of the applicants includes something which is the sole invention of the other applicant the Comptroller will insist on the first applicant amending his specification so as to confine it to what has actually been invented by him.^(y)

It is submitted that, in order to obtain a special reference to his patent in the applicant's specification, the opponent must show that the applicant's specification includes, and purports to

^(s) In the Matter of Brownhill's Patent, 6 P. O. R. 135.

^(t) Anderson and McKinnell, Griff. L. O. C. 23; In the Matter of Sielaff's Application, 5 P. O. R. 484; In the Matter of Wallace's Patent, 6 P. O. R. 134.

^(u) See In the Matter of Newman's Patent, 5 P. O. R. 279.

^(v) In the Matter of Lorrain's Patent, 5 P. O. R. 142; In the Matter of Airey's

Patent, 5 P. O. R. 348; In the Matter of Lynde's Patent, 5 P. O. R. 663; In the Matter of Newman's Patent, 5 P. O. R. 271; In the Matter of Wallace's Patent, 6 P. O. R. 134; Hoskins' Patent, Griff. P. C. 291; Welch's Patent, Griff. P. C. 300.

^(y) Paterson's Patent, Griff. P. C. 295; Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.

claim a part of the invention described, and claimed in the opponent's specification. (z)

A special reference will sometimes tend to stop further litigation where a general disclaimer would not, and will be ordered to be inserted on that account. (a)

Meaning
ambiguous.

If the meaning of a specification be ambiguous the Comptroller or law officer may, on the hearing of the application, order it to be placed on record to what the specification is understood to be confined by the statement and agreements of both the opposer and applicant; (b) and, if the provisional specification contain a reasonably clear indication of the improvement it is ultimately desired to protect by the patent, the Comptroller has power to order any amendment which will put the particular description of the invention claimed absolutely beyond doubt. (c)

Claim may be
ordered to be
struck out.

Sometimes a claim in an applicant's specification is ordered to be struck out altogether, when it includes something claimed by the complete specification under a prior patent; (d) but it must be remembered that the applicant is entitled to frame his specification as he pleases, so long as he does not interfere with existing rights. (e) The Comptroller or law officer has no authority to order a claim to be struck out merely because it may invite the public to infringe a prior patent, if the applicant, in the body of the specification, shows some invention with regard to the thing claimed. (f) Nor can the Comptroller or law officer require the amendment of a claim in order to make it conform to the description in the specification, if the claim is otherwise a real statement of the invention claimed. (g)

Sealing the Patent.

Sealing the
patent.

If there be no opposition, or if there be opposition, and the determination is in favour of the applicant, the Comptroller is

(z) In the Matter of Hill's Application, 5 P. O. R. 599.

(a) In the Matter of Lynde's Patent, 5 P. O. R. 663.

(b) Anderton, 1885, No. 1840, Griff. L. O. C. 25.

(c) Chandler's Patent, Griff. P. C. 270, 274.

(d) In the Matter of Hall and Hall's Patent, 5 P. O. R. 283; In the Matter of Webster's Patent, 6 P. O. R. 163.

(e) See p. 269 *ante*.

(f) In the Matter of Webster's Patent, 6 P. O. R. 165.

(g) Smith's Patent, Griff. P. C. 268.

required, by the Act of 1883,^(e) as soon as may be, to cause a patent to be sealed with the seal of the Patent Office, which is equivalent for this purpose to the Great Seal of the United Kingdom.^(f)

A patent cannot be sealed after the expiration of fifteen months from the date of application,^(g) except in the following cases:—

- (1) When the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, in which case the patent may be sealed at such time as the law officer may direct.^(h)
- (2) If the person making the application dies before the expiration of fifteen months from the date of application, in which case the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant.⁽ⁱ⁾
- (3) Where the Comptroller has granted an extension of time for the leaving and accepting of a complete specification, in which case a patent may be sealed within nineteen months from the date of the application.^(k)

In the case of delay caused by opposition, a patent may be sealed at such time as the law officer appoints, even though the opposition is not adjudicated upon, till after the expiration of fifteen months from the date of the application.^(l)

It is expressly enacted that every patent shall be dated and sealed as of the day of the application: Provided that in the case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.^(m)

Before the Act of 1883, where there was more than one applicant for a patent for the same invention, the applicant who first obtained the Great Seal was held to be entitled to the benefit of it, and the patent of any other applicant, if granted at all, was dated subsequently.⁽ⁿ⁾ Such is not the case now, for

(e) S. 12.

(f) 46 & 47 Vict. c. 57, s. 12, ss. 2.

(g) 46 & 47 Vict. c. 57, s. 12, ss. 3.

(h) *Ibid.*

(i) *Ibid.*

(k) 48 & 49 Vict. c. 63, s. 3.

(l) *Re Somerset and Walker's Patent*, L. R. 13 Ch. D. 397; *Re Johnson's Patent*, L. R. 13 Ch. D. 398 n.

(m) 46 & 47 Vict. c. 57, s. 13.

(n) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577, 580; see p. 281.

Date of letters patent.

the patent of each applicant (if granted) must bear the date of the application, and consequently the first applicant is the one who gets the real benefit of the invention; for where there is more than one patent for the same invention, anything done under those subsequently dated is an infringement of that which bears the earliest date. (o) Formerly, however, in cases where there was evidence of *mala fides* the patent of a second applicant was ordered to be dated before that of the prior applicant. (p) The reason was that the Crown will not grant a second patent in derogation of its own grant, and the system of ante-dating enabled the question of validity to be decided in subsequent proceedings. (q)

Foreign Application.

Foreign applicants.

In order to enable the British Government to join the "Union for the Protection of Industrial Property," which consists at present of the following States—Great Britain, Belgium, Brazil, Spain, France, Guatemala, Italy, Holland and its East Indian Colonies, Portugal, Servia, Switzerland, Norway, Sweden, Tunis, the United States, and Mexico—it is provided by s. 103 of the Act of 1883, as amended by s. 6 of the Act of 1885, as follows:—

If her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, then any person who has applied for protection for any invention in any such State shall be entitled to a patent for his invention under the Act of 1883, in priority to other applicants; and such patent, shall have the same date as the date of application in such foreign State: Provided that his application is made within seven months from his applying for protection in the foreign State with which the arrangement is in force: And provided further that the patentee shall not be entitled to recover damages for infringements hap-

(o) *Saxby v. Hennett*, L. R. 8 Ex. 210.

(p) *Ex parte Scott and Young*, L. R. 6 Ch. 274; *Saxby v. Hennett*, L.R. 8 Ex. 210; *Re Vincent's Patent*, L.R. 2 Ch. D. 341.

(q) *Ex parte Bailey*, L. R. 8 Ch. 61; *Ex parte Henry*, L. R. 8 Ch. 167, 169; *Ex parte Bates and Redgate*, L. R. 4 Ch. 577.

pening prior to the date of the actual acceptance of his complete specification.

It is also enacted that the publication in the United Kingdom, or the Isle of Man, during the above period of seven months, of any description of the invention, or the use therein during such period of the invention, shall not invalidate the patent which may be granted for the same.

The application for the grant of a patent under the above provisions must be made in the same manner as an ordinary application; and those provisions apply only in the case of those foreign States with respect to which her Majesty shall, from time to time, by order in Council, declare them to be applicable, and so long only in the case of each State, as the Order in Council shall continue in force with respect to that State.^(r)

An Order in Council, made under the above provisions, has a retrospective effect. Thus, where a person has applied for a patent in a foreign State or British possession to which the provisions of s. 103 of the Act of 1883 have not been extended at the date of the application, he is entitled, during the period of seven months from the date of such application (if it is the first foreign application he has made), to a British patent, bearing the date of such application, if the provisions of s. 103 of the Act of 1883 have been extended to such foreign State or British possession before the expiration of such period of seven months.^(s)

Retrospective effect of Order in Council.

The Act of 1883 further empowers her Majesty, where it is made to appear to her that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, by Order in Council (to take effect as if its provisions had been contained in the Act, and from the date fixed by the Order), to apply the above provisions with such variations or additions, if any, as to her Majesty in Council may seem fit; and it is lawful for her Majesty in Council to revoke any such order.^(t)

A patent in this country can only be granted under the provisions of s. 103 of the Act of 1883, to the person who has

Patentee under s. 103 of Act of 1883.

^(r) 46 & 47 Vict. c. 57, s. 103, (3) and (4).

^(s) In the Matter of Main's Patent, 7 P. O. R. 13.

^(t) 46 & 47 Vict. c. 57, s. 104; see International Convention (see Appendix).

actually made application for protection in the foreign State, and not to another person on his behalf.(u)

Moreover, s. 103 of the Act of 1883 does not confer any rights on a person making an application for a British patent, in respect of an invention communicated to him from abroad. The rights conferred by the section are personal, and intended to encourage people who have invented abroad, to come to this country and to make known their inventions.(x)

In *L'Oiseau and Pierrard's Application*, 1886, No. 12, 833,(y) the applicants applied for a patent for "automatic apparatus for subjecting the person to the action of electric currents," which was opposed by one *Everitt*, on the ground that his prior application, in which his complete specification had been accepted, for a patent for "improvement in completing electric currents," contained the subject-matter of the applicant's alleged invention. It appeared, however, that L'Oiseau and Pierrard had obtained a patent for their invention in France within seven months of their application in England, and on an application in France of earlier date than Everitt's application in England. L'Oiseau and Pierrard were therefore held entitled to an English patent, under the Act of 1883, and the Convention of 1884, to the disadvantage of Everitt.

When a person on 8th February 1887 made an application in America for a patent, which became abortive, and on the 7th September 1887 renewed his application, and then on 8th April 1888 made an application for a British patent, under s. 103 of the Act of 1883 to bear date the 7th September 1887, the Comptroller refused the application. The law officer reversed the Comptroller's decision, and ordered a patent to be granted, and dated the 7th September 1887, on the ground that the patentee had no subsisting rights under his abortive application in America, of 8th February 1887.(z)

A foreigner applying for a British patent under the provisions of s. 103 of the Act of 1883, must include in his applica-

Practice.

(u) In the Matter of Shallenberger's Application, 6 P. O. R. 550; In the Matter of Carey's Application, 6 P. O. R. 552.

(x) In the Matter of Shallenberger's Application, 6 P. O. R. 550.

(y) Griff. L. O. C. 36.

(z) In the Matter of Van de Poele's Patent, 7 P. O. R. 69.

tion a declaration that the foreign application has been made, (a) and must specify the foreign States or British possessions in which foreign applications have been made, and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any. (b)

The application in the United Kingdom must be made in the Form A2, (c) and must be accompanied by a specification, provisional or complete, together with

- (1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British possession, in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign State or British possessions, or otherwise verified to the satisfaction of the Comptroller.
- (2) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification or document corresponding thereto be in a foreign language, a translation thereof must be annexed to, and verified by such statutory declaration. (d)

Minor differences of departure in an applicant's English specification may be allowed, if the Comptroller and law officer are enabled, by the agreed translation of the foreign specification, to conclude that the inventions referred to in the two documents are substantially the same. (e)

(a) "Foreign application" means an application by any person for protection of his invention in a foreign State, or British possession, to which by an order of her Majesty in Council for the time being in force, the provisions of s. 103 of the Act of 1883 have been declared applicable, see Patent Rules, 1890, r. 24.

(b) See P. R. 1890, r. 25.

(c) See Appendix.

(d) See P. R. 1890, r. 26; for further details as to practice on applications under s. 183 of Act 1883, see rr. 27, 29.

(e) L'Oiseau and Pierrard, 1886, No. 12,833, Griff. L. O. C. 37; In the Matter of Main's Patent, 7 P. O. R. 13.

LETTERS PATENT FOR INVENTIONS.

When a foreigner applies for an English patent under the provisions of s. 103 of the Act of 1883, his specification must not claim any invention which is not included in his foreign patent. The British specification may contain a description of an invention not included in the foreign patent, but the claim must be limited to the invention protected in the foreign State.(f)

Extent and Duration of Letters Patent.

Extent and
duration of
letters patent.

Every patent when sealed has effect throughout the United Kingdom and the Isle of Man,(g) and the term for which every patent is granted originally, is fourteen years,(h) which may however, in certain cases, be prolonged on petition to her Majesty in Council.(i) The time from which a patent runs dates from, and includes, the day of the date of the patent.(k)

A patent is conditional on the patentee making the prescribed payments within the prescribed times,(l) and ceases if he fail to do so.(m)

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, and the Comptroller is required, if he is satisfied that the failure has arisen from any of the above causes, on receipt of the prescribed fee for enlargement,(n) not exceeding ten pounds, to enlarge the time accordingly, subject to the following conditions:

- (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

(f) L'Oiseau and Pierrard's Application, 1886, No. 12,833, Griff. L. O. C. 36.

(g) 46 & 47 Vict. c. 57, s. 16.

(h) 46 & 47 Vict. c. 57, s. 17.

(i) 46 & 47 Vict. c. 57, s. 25; Chap. XI.

(j) Russell v. Leddam, 14 M. & W. 574.

(k) 46 & 47 Vict. c. 57, s. 24; P. R. 1890, rr. 45, 46.

(m) 46 & 47 Vict. c. 57, s. 17 (2).

(n) See Appendix.

think fit, refuse to award or give any damages in respect of such infringement.(o)

An application for enlargement of the time for making a prescribed payment must 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.(p)

Whenever the last day for leaving any document, or paying a fee, at the Patent Office falls on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the documents may be left, or the fee may be paid, on the day next following any of these days.(q)

If a patentee fails to make a prescribed payment, whether he has obtained an enlargement of time or not, his patent is void and can only be revived by a special Act of Parliament.(r) A special act will most probably not be obtained unless it is made clear that the renewal fees were not paid in consequence of the serious illness of the patentee,(s) and if a special Act is passed, it will most probably provide protection for persons who may have used the subject-matter of the invention after the notice of the lapsing of the patent.(t)

Revival of
lapsed letters
patent.

Under the Act of 1852(u) letters patent, obtained in the United Kingdom for inventions already patented abroad, did not continue in force after the expiration of the foreign patent. This provision was repealed by the Act of 1883, but the effect of s. 113, which provides that the past operation of any Act repealed shall not be affected, is to render it still a fatal objection to the validity of any patent in the United Kingdom, dated earlier than January 1, 1884, that there was a prior foreign

(o) 46 & 47 Vict. c. 57, s. 17 (3) (4).

(p) P. R. 1890, r. 49.

(q) 46 & 47 Vict. c. 57, s. 98.

(r) *E.g.*, Wright's Patent Act, 1884, Boulton's Patent Act, 1885; Bradbury and Leman's Patent Act, 1884; Auld's Patent Act, 1885; Potter's Patent Act, 1887. See also Appendix A. to Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill

[H. L.] and Gilbert and Sinclair's Patent Bill, [H. L.].

(s) See Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill [H. L.], and Gilbert and Sinclair's Patent Bill.

(t) *Ibid.*; Appendix A., Potter's Patent Act, 1887.

(u) S. 25.

patent for the same invention which expired before that date.(v)

Confirmation
of letters pa-
tent granted
prior to Jan. 1,
1884.

The Act of 1834 was repealed by the Act of 1883, but all rights and privileges of patentees in respect of patents granted prior to the Act of 1883, were preserved by that Act, and are still subsisting.(w) One of the rights and privileges of a patentee under letters patent granted prior to Jan. 1, 1884, the date on which the Act of 1883 came into operation, is that provided by the repealed Act of 1834—viz., “If in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or, if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his Majesty in Council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such Committee, upon examining the said matter and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any

(v) See as to effect of cases decided under Act of 1852, s. 25, Lawson, Patent Designs and Trade Marks Acts, 2nd ed. pp. 275, 276.

(w) In the Matter of Brandon's Patent, 1 P. O. R. 154.

former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same."^(y)

Since the Act of 1883 came into operation no petition for confirmation has been presented under the above power.

S. 35 of the Act of 1883 enacts that a patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Application in fraud of true and first inventor.

In the event of a patent being lost or destroyed, or its non-production being accounted for to the satisfaction of the Comptroller, the Comptroller has authority at any time to cause a duplicate to be sealed.^(z)

Duplicates of letters patent.

Illustrated Journal and Reports of Cases.

The Comptroller is required to cause to be issued periodically an illustrated journal of patented inventions, as well as reports of cases decided by Courts of Law, and any other information that he may deem generally useful or important.^(a) The Comptroller is also required to keep on sale copies of the illustrated journal, and all complete specifications of patents for the time being in force; and to prepare and publish indexes, abridgments of specifications, catalogues and other works relating to inventions, as he may see fit.^(b)

Illustrated journal and reports of cases.

Patent Office Museum.

The control and management of the Patent Museum is vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.^(c)

Patent Office Museum.

^(y) 5 & 6 Will. IV. c. 83, s. 2; The following reported cases relate to petitions presented under this section, Heurteloup's Patent, 1 W. P. C. 553; Westrupp and Gibbins' Patent, 1 W. P. C. 554; In the Matter of Card's Patent, 2 W. P. C. 161; In the Matter of Lamenaude's Patent, 2 W. P. C. 164; Honiball's Patent, 2 W. P. C. 201.

^(z) 46 & 47 Vict. c. 57, s. 37; P. R. 1890, Form N.

^(a) 46 & 47 Vict. c. 57, s. 40.

^(b) *Ibid.* The Illustrated Official Journal, comprising reports of the cases decided by the courts of law, the Comptroller, and the law officers, is at present published weekly. Cases decided before the Comptroller or the law officer ought not to be cited before the High Court of Justice or the Court of Appeal (*Siddell v. Vickers*, 5 P. O. R. 416, 436).

^(c) 46 & 47 Vict. c. 57, s. 41.