

Prior User.

Re Adamson's
patent.

In *Re Adamson's Patent*, (1856) 6 De G. M. & G. 420; 25 L. J. Ch. 456, on the other hand, where a person invented certain machinery during the fulfilment of a contract for the building of a pier, and used that machinery for four months in a place to which the public had access, before applying for the patent, and, after the utility of the machinery in question had been determined and profit had been derived from the public user, made an application, he was held not to be entitled to a patent.

Experimental
user, though
pecuniarily
profitable, is
not necessarily
publication.

An inventor may, in certain cases, derive pecuniary profit from an experimental user of his invention before applying for protection, without rendering his patent subsequently obtained deficient on the ground of want of novelty. Thus, in the case of *Newall's* patent for "improvements in apparatus employed in laying down submarine electric telegraph wires," experiments on dry land were necessarily not sufficient to prove the utility of the apparatus for the purpose for which it was designed, and *Newall* accordingly tested the practicability of the invention during the laying of a submarine cable under a Government contract. The Court held that this user, notwithstanding the fact that *Newall* had derived profit from it, was only experimental, and did not prevent him obtaining a valid patent for the invention.^(u)

Prior user of
the invention
by the patentee
himself.

Apart from experimental user it is to be observed that it is competent for a person himself before the date of a patent to use the invention, the subject of the grant, in either or both of two ways. First, he may use it openly in such a manner that the user will convey to the mind of any one seeing it a knowledge of what the invention consists, *e.g.*, if the alleged invention relate to the particular construction of a lock, any person who has before the date of the patent constructed a lock on the principles claimed by the patentee, and publicly used it in this country, will thereby have published the invention, and any subsequent patent for it could not be sustained.^(x) Secondly, the inventor may so use his invention that the user will not enable any one seeing it to discover in what the invention really consists, *e.g.*, in the case of a chemical invention, a dye for instance, the dye might be produced and known, but the

^(u) *Newall v. Elliott*, (1858) 4 C. B. N. S. 269; see also *Morgan v. Seaward*, (1837) 1 W. P. C. 194.

^(x) *Carpenter v. Smith*, (1841) 1 W. P. C. 530, 534; see also *Stead v. Williams*, 2 W. P. C. 136; *Heath v. Smith*,

(1854) 2 W. P. C. 278; *Honiball v. Bloomer*, (1854) 10 Exch. 588; *Honiball's Patent*, (1855) 2 W. P. C. 209; *Young v. Fernie*, (1863) 4 Griff. 577; *Bereton v. Richardson*, (1884) 1 R. P. C. 177.

existence of it would not demonstrate the method according to Prior User which it was prepared, and no person other than the manufacturer in possession of the secret would be able to produce it—in such a case it is submitted, for reasons which will appear hereafter, (y) that such a user would not prevent the manufacturer, though it might prevent another person who should discover the secret, from obtaining a patent valid on the ground of novelty for the invention. (z) Again, a prior user of an invention may be made in public or in secret. It is well settled law that, if the invention has been used publicly, a subsequent patent would, under section 6 of the Statute of Monopolies, be void, (a) whereas if the user has only been secret, the grant *may* be sustained, (b) and this whether the user has been by the inventor himself, (c) or by a manufacturer for the inventor under terms of secrecy to him, (d) or his workmen. (e) It may be open to question, however, as to whether if a patentee has made profit by a prior secret user of the invention, he has not thereby rendered his subsequent patent null and void. (f)

The public use of only one specimen of a patented article, (g) even if by only one person, (h) is quite sufficient to invalidate a subsequent patent.

Lord *Abinger*, explaining to a jury what in the patent law sense is meant by the “public use and exercise” of an invention which will render a subsequent patent void on the ground of want of novelty, used the following words:—

“I think that what is meant by ‘public use and exercise’ is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not

(y) pp. 120–123 *post*.

(z) See *Hancock v. Somervell*, (1851) 39 *Newton, L. J.*, 158.

(a) *Cornish v. Keen*, (1835) 1 *W. P. C.* 568.

(b) *Dollond's Case*, (1776) 1 *W. P. C.* 43; but see p. 121 *post*.

(c) *Smith v. Davidson*, (1857) 19 *C. B.* 690; *Bentley v. Flemming*, (1844) 1 *Car. & K.* 587.

(d) *Morgan v. Seaward*, (1837) 1 *W. P. C.* 187; *Useful Patents Co. v. Rylands*, (1885) 2 *R. P. C.* 235; *Humpherson v. Syer*, (1887) 4 *R. P. C.* 407; *Kurtz v. Spence*, (1888) 5 *R. P. C.* 161.

(e) *Betts v. Menzies*, (1857) 1 *E. & E.* 1008.

(f) See pp. 120–122 *post*.

(g) *Honiball v. Bloomer*, (1854) 10 *Exch.* 538; *Honiball's Patent*, (1855) 2 *W. P. C.* 201, 209; *Carpenter v. Smith*, (1841) 1 *W. P. C.* 530, 534; *Young v. Fernie*, (1863) *Griff. P. C.* 577; *Bereton v. Richardson*, (1884) 1 *R. P. C.* 177.

(h) *Stead v. Williams*, (1843) 2 *W. P. C.* 136; *Heath v. Smith*, (1854) 2 *W. P. C.* 278.

Prior public use of one specimen sufficient to invalidate the patent.
Meaning of “public use and exercise,” per Lord Abinger.

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Meaning of
"public use
and exercise,"
per Lord
Abinger.

brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them. A great many patents have been taken out, for example, upon suggestions made in a celebrated work by the Marquis of *Worcester*, and many patents have been derived from hints and speculations by that ingenious author. But yet, as he never acted upon them, as he never brought out any machines whatsoever, those patents are good. So that the meaning of these words, 'public use' is this: that a man shall not by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right which another man has to a patent for the same invention. Now, 'public use' means this: that the use of it shall not be secret, but public. . . . If a man invents a thing for his own use, whether he sells it or not—if he invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequences would be. If Mr. *Davies* has a lock which he directed to be made and put on his gate sixteen years ago at least; if that was not a public use which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it. How can he be the inventor of it? Because, to obtain a patent, a man must be the inventor; and if it has been once in public use (that is, used in a public manner, not used by the public), yet if it has been used by half a dozen individuals or one in a public manner, any man having access to it, how can he be said to be the inventor if by merely gaining access to that he takes out a patent? . . . A man cannot be said to be the inventor of that which has been exposed to public view, and to which he might have had access if he had thought fit. . . . If you are of opinion (not that they were generally adopted by the public and used by the public, for that in my opinion is a perfect fallacy) that the use of them is public, and the exercise of the invention was public, and not kept secret so that the public might have no benefit from it, then I think that part of the issue you ought to find for the defendant." (*l*) The jury found for the defendant, and on a motion for a new trial, on the ground of misdirection, the Court of Exchequer approved of the statement of the law made by Lord *Abinger*, *Alderson*, B., adding these words: (*l*) "Public use means a use in public, so as to come to the knowledge of others than the inventor as contradistinguished from the use of it by himself in his chamber." (*m*)

Per *Alderson*,
B.

(*l*) *Carpenter v. Smith*, (1841) 1 W. P. C. 530, 534, 535, 540.
(*l*) 1 W. P. C. 542.

(*m*) See *Crossdale v. Fisher*, (1884) 1 R. P. C. 21.

To rebut the claim of novelty, it is not necessary to show Prior User. that the invention has been used by the public; it is quite sufficient to establish that it has been used in public as distinguished from being used in secret,⁽ⁿ⁾—*e.g.*, to show that an article has been openly manufactured^(o) or exhibited in a workshop,^(p) where all the workmen knew the process of its manufacture, or that a model has been exhibited to persons interested in the subject-matter of the invention without any concealment, secrecy, or confidence,^(q) or that the article has been used in a private house under such circumstances that visitors thereto could comprehend the invention.^(r)

Use in public as distinguished from use by the public avoids a patent.

The following are illustrative cases:—

Illustrative cases.

In *Tennant's Case*, (1798) 1 W. P. C. 125, the patent was for a method of using certain calcareous earths instead of alkaline substances, by neutralising the oxygenated muriatic acid used in bleaching, &c. The great utility of the invention, and the general ignorance of bleachers with respect to such bleaching liquor before the date of the patent, were established in evidence. It was, however, proved that a bleacher had used the same means of preparing his bleaching liquor for five or six years prior to the date of the plaintiff's patent, and that he had kept his method a secret from all but his two partners and two servants concerned in preparing it; and a chemist deposed that having, in 1796, had frequent conversations with the plaintiff on the means of improving bleaching liquor, he had in one of them suggested that he would probably attain his end by keeping the lime water constantly agitated; that the plaintiff afterwards had found the method successful and embodied it in his claim. Lord *Ellenborough*, C.J., who tried the case, nonsuited the plaintiff, holding that the above evidence established a prior publication of the invention.

Tennant's case.

Losh v. Hague, (1838) 1 W. P. C. 202, was a case in which damages were sought for the infringement of *Losh's* patent for "certain improvements in the construction of wheels for carriages to be used on railways," and it was established, to the satisfaction of the jury, that wheels made on the same principle as those claimed by *Losh*, had been constructed before the date

Losh v. Hague.

(n) *Carpenter v. Smith*, (1841) 1 W. P. C. 530; *Stead v. Williams*, (1843) 2 W. P. C. 136; *Stead v. Anderson*, (1846) 2 W. P. C. 149; *Hancock v. Somervell*, 39 Newton, L. J. 158; *Honiball v. Bloomer*, (1854) 2 W. P. C. 199; *Young v. Rosenthal*, (1884) 1 R. P. C. 32.

(o) *Croysdale v. Fisher*, (1884) 1 R. P. C. 17; *Lister v. Norton*, (1886) 3 R. P. C. 199; *Heath v. Smith*, (1854)

3 E. & B. 256; *Betts v. Neilson*, (1868) L. R. 3 Ch. 436.

(p) *Humpherson v. Syer*, (1887) 4 R. P. C. 407.

(q) *Winby v. The Manchester, &c., Steam Tramways Co.*, (1891) 8 R. P. C. 61.

(r) *Taylor's Patent*, (1896) 13 R. P. C. 482; *Stead v. Williams*, (1843) 2 W. P. C. 136.

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Illustrative
cases.

Muntz v.
Foster.

of his patent, though they had not been previously used on railways. The invention was, under these circumstances, held not to be novel, Lord *Abinger*, C.B., pointing out to the jury that if the wheels had been made and sold to any one individual, it made no difference though the public did not want them, because there were no railways, and they were not adapted to any particular use to which at that time the public could apply them (1 W. P. C. 205).

In *Muntz v. Foster*, (1844) 2 W. P. C. 96, it was proved that *Muntz* discovered, in a particular combination of metals made before, a hidden virtue or quality which had never before been noticed, and in consequence of this discovery he was enabled to apply the metal to a new and useful purpose, and thereby became entitled to a patent for the application, under the name of "an improved manufacture of metal plates for strengthening the bottoms of ships or other such vessels." *Tindal*, C.J., in summing up to the jury, used these words: "I look upon the invention to consist in this, that *Muntz* has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing by reason and by means of its oxidating just in sufficient quantities—that is, not too much, so as wear away and impair the sheathing and render the vessel unsafe, but enough at the same time to keep by its wearing the bottom of the vessel clean from those impurities which before attached to it. And if it was shown, as it possibly might be, that sheets had been made of metal before, in the same proportion which he had pointed out, and if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, that such application has been considered as the ground, and proper ground, of a patent; and therefore when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose. . . . I do not think that the circumstance of showing that the combination of these two materials in a metal plate will of itself destroy this patent, when no attention at the time was paid to the purpose

for which this patent was taken out, and it was made merely in the ordinary course of melters of metal for the various and ordinary purposes of life. I do not think that the circumstances of showing that in the long time that has passed before us in the different, and, I may say, infinitely varying, combinations that must have been made for the various purposes for which brass and other metal was manufactured for ordinary and common purposes of life—to call a workman to show that on some occasion or occasions he had combined them in those proportions for another and different purpose; it does not appear to me that such destroys the patent.”

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Use in public as distinguished from use by the public avoids a patent.

Illustrative cases.

Muntz v. Foster, (1844) 2 W. P. C. 96, is to be distinguished from *Losh v. Hague*, (1838) 1 W. P. C. 203, in that in the former case the patent was for a result which had been arrived at casually before, but there was merit in discovering a hidden virtue in the result which made it applicable to a particular purpose and capable of sustaining a patent, whereas, in the latter case, the result was known before, but the application to the particular purpose (which was self-evident) was not made because the occasion had never arisen, and the patent was therefore held void.

Muntz v. Foster and *Losh v. Hague* distinguished.

In *Lewis v. Marling*, (1829) 10 B. & C. 22; 4 Cas. & P. 57; 1 W. P. C. 493, the patent related to a shearing machine in which the novelty consisted in shearing from list to list. It was proved at the trial that a similar machine had been made previously to the patent, which was tried by a person called on behalf of the defendant, but he did not think it answered, and soon discontinued the use of it. It was also proved that a model had been sent over from America and shown to a few persons, but no machine was made from it, and also that a specification had been brought over from America and two persons employed to make a machine from this, which, however, was never completed, so that, before the patentee's, no machine was publicly known or used in this country for shearing from list to list. Lord *Tenterden*, C.J., directed the jury that if it could be shown that the patentees had seen the model or specification, that might answer the claim of invention, but there was no evidence of that kind, and he left it to the jury to say whether the machine had been in public use and operation before the patent was granted, and they found that it had not.

Lewis v. Marling.

On a motion for a rule nisi for a new trial this direction of Lord *Tenterden*, C.J., was approved of, *Bayley*, J., saying: “If I make a discovery and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else had made a similar discovery by his

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mind, unless it has become public. So if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have received previously a communication from abroad which would have enabled him to have made the machine."

Heath v. Smith.

In *Heath v. Smith*, (1854) 2 W. P. C. 268, it was proved that the process included in the plaintiff's claim had been practised by five manufacturers in the course of their trade before the date of the patent, and that whilst two of these manufacturers had kept the process a secret and the other three had practised it openly, it was not generally known till the plaintiff stated it in his specification. The Court of Queen's Bench held that there had been a public use of the process and that the patent was consequently invalid.

Abandoned
prior user
avoids a
patent.

It is not necessary to show that the prior use relied on was continued up to the date of the patent, for if there be a complete anticipation, by prior use, the abandonment of it is nothing, yet when it is a question whether there really was a machine perfected in accordance with the alleged invention, the fact that it had never been used for a number of years before the patentee took out his patent is most material, as leading to the conclusion that that which was made many years ago was not a machine in accordance with the invention.^(s)

Applicant for
a patent pro-
visionally pro-
tected against
public use of
the invention.

An inventor who, before applying for a patent, uses his invention in such a manner as to convey to the public a knowledge of it, or allows it to be used by the public, will thereby render his patent just as invalid on the ground of want of novelty as if a prior public use and exercise by persons other than himself were shown to have existed.^(t) But after the inventor has sent in his application for a patent, and the same has been accepted, and before the patent is sealed, he is justified in using the invention in public, and will not by such use render the grant void, but he is not entitled to use, in connection with the apparatus manufactured according to the invention, the word "patent" until he has obtained the seal of the Patent Office.^(u)

Fiduciary
communica-
tions of inven-
tion prior to
application.

An inventor may, before making application for a patent, entrust his invention to another person, bound to him by terms of confidence and secrecy, for the purpose of making experi-

^(s) Per Lord Brougham, *The House-hill Co. v. Neilson*, (1843) 1 W. P. C. 673; *Tangue v. Stott*, (1865) W. N. 1866, p. 68; *Morgan v. Windover*, (1888) 5 R. P. C. 303; *King, Brown & Co. v. Anglo-American Brush Co.*,

(1889) 6 R. P. C. 414; pp. 105-110 *ante*. ^(t) p. 110 *ante*.

^(u) 46 & 47 Vict. c. 57, ss. 14, 15; Row on the prosecution of *Crow v. Wallis*, (1886) 3 R. P. C. 1; *R. v. Crampton*, (1886) 3 R. P. C. 367.

ments, with a view to rendering the invention more perfect and efficient, and such an experimental user, though to a certain extent a user in public, will not necessarily invalidate a subsequent patent. (x) Prior User.

The combined effect of Art. 4 of the International Convention of 1883 (y) and s. 103 of the Act of 1883, is to protect any person who has duly registered an application for a patent in any of the States of the Union, during a period of seven months from the date of such application, against the ordinary consequences of publication of the invention in this country. Such a person has a right of priority to a British patent at any time before the expiration of such period of seven months from the date of his application in the foreign State, notwithstanding that in the meanwhile the invention may have been published in this country. Foreign applicant protected against publication.

It is submitted that the period of seven months, during which protection from publication is afforded to the inventor, dates from the first application in one of the States of the Union, and not from the last of several applications in different States.

If an inventor desires to exhibit at an industrial or international exhibition an invention for which he has not applied, but intends to apply, for protection by letters patent, he can do so without thereby rendering his subsequent patent, if obtained, null and void, by proceeding under s. 39 of the Patents, &c., Act 1883, and Rule 15 of the Patent Rules 1890. The section of the Act referred to enacts that the exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or publication of any description of the invention during the period of the holding of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor, or his legal personal representative, to apply for, and obtain, provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely :

Exhibition of invention at industrial or international exhibitions prior to application for a patent.

(a) The exhibitor must, before exhibiting the invention, give

(x) Bentley v. Flemming, (1844) 1 Car. & K. 578 ; Morgan v. Seaward, (1837) 1 W. P. C. 193, 195 ; Humpherson v. Syer, (1887) 4 R. P. C. 414 ; Useful Patents Co. v. Rylands, (1885) 2 R. P. C. 262. (y) See Appendix.

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the Comptroller the prescribed notice of his intention to do so;

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

Rule 15 of the Patent Rules 1890,(*z*) provides that the inventor shall give to the Comptroller notice in writing of his intention to exhibit, publish, or use the invention, as the case may be, and for the purpose of identifying the invention in the event of an application for a patent being subsequently made, the applicant shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

Delay in applying for a patent is undesirable.

The fact of an inventor having kept his invention secret, after it has been brought to completion, does not, at any rate if there has been no profitable use of it,(*a*) deprive the Crown of its right to grant a patent on the application of such inventor,(*b*) but delay on the part of the applicant is extremely undesirable, because it is always possible that some one else may make an application first, and so get a prior right to a patent.(*c*)

Offering for sale is publication;

If an inventor manufacture and offer for sale an article made in accordance with his invention before the date of his patent, even though no sale actually take place, he will thereby, if the nature of the invention can be understood from an inspection of the article, publish his invention and deprive himself of any right to become a patentee in respect of it.(*d*)

The public sale of a single specimen of a patented article before the date of the patent is sufficient to render the grant null and void,(*e*) though the sale was for export,(*f*) or as an experiment to ascertain whether there would be a demand for the article.(*g*)

but not if the

But if the article does not on the face of it show the manner

(*z*) See Appendix.

(*a*) See p. 120 *post*.

(*b*) *Bentley v. Fleming*, (1844) 1 C. & R. 587; *Bowman v. Taylor*, (1834) 1 W. P. C. 293.

(*c*) *Hancock v. Somervell*, (1851) 39 Newton, L. J. 158.

(*d*) *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; *Wood v. Zimmer*, (1815) 1 Holt, N. P. C. 57; 1 W. P. C. 44; *Morgan v. Seaward*, (1837) 1 W. P. C. 194; *Mullins v. Hart*, (1852) 3 Car. &

K. 297; *Lister v. Norton*, (1886) 3 R. P. C. 192, 207; *Lifeboat Co. v. Chambers*, (1891) 8 R. P. C. 418.

(*e*) *Horniball v. Bloomer*, (1885) 2 R. P. C. 199; *Germ Milling Co. v. Robinson*, No. 2, (1886) 3 R. P. C. 399; *Hollins v. Capper*, (1888) 5 R. P. C. 289.

(*f*) *Carpenter v. Smith*, (1842) 1 W. P. C. 541.

(*g*) *Lister v. Norton*, (1886) 3 R. P. C. 207.

in which it was made, it may be doubted whether such a manufacture and offering for sale by the inventor himself would deprive him of his right to a subsequent patent for the process of manufacture, (*h*) and the bare fact of the article having been made before the patent was obtained would not alone render it bad. (*i*)

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 article sold or offered for sale does not show the manner of its manufacture.

Publication is always a question of fact. In one case the manufacturer of two pairs of paddle-wheels, under an injunction of secrecy, which were sold and shipped, boarded up, abroad, was held to be no publication. (*k*)

It has been held that when delay has arisen in the granting of a patent from causes over which the patentee had no control, the manufacture by him of articles made according to, and before the date of the patent, for sale after the seal of the Patent Office has been obtained, will not vitiate the patent. (*l*)

The loan of an article for the purpose of experiment, before the application for a patent in respect of it, may not amount to publication sufficient to avoid the patent when obtained.

Loan of an article for the purpose of experiment may be publication.

Thus, in *Bentley v. Fleming*, (*m*) it appeared that a machine manufactured according to the invention had, before the date of the patent, been lent by the patentee to a friend for the purpose of trial, and that the machine was fixed in a room in a mill to which workpeople had access. *Cresswell, J.*, who tried the case, held that the machine having been merely lent for the purpose of testing it, the use of it did not under the circumstances amount to a publication of the invention.

In *Morgan v. Seaward*, (*n*) the Court of Exchequer thought that the manufacture of two pieces of machinery for a person connected in business with the patentee, under an injunction of secrecy and their user abroad, might not be such a publication as would vitiate a subsequent grant.

Manufacture by one person confidentially related to another.

When an article has been manufactured and openly sold in England, even though it be manufactured and sold expressly for exportation abroad, the article has been published, and a subsequent patent for it will consequently be bad for want of novelty; but this must not be taken to mean that if a man abroad employ an agent in England to see if he can get an article manufac-

(*h*) See p. 120 *post*; *Hancock v. Somervell*, (1851) 39 Newton, L. J. 158.

(*i*) *Bramah v. Hardecastle*, (1789) Holroyd, 81; *Lewis v. Marling*, (1829) 4 C. & P. 57; *Moss v. Malings*, (1886) 3 R. P. C. 378.

(*k*) *Morgan v. Seaward*, (1837) 1 W. P. C. 187.

(*l*) *Betts v. Menzies*, (1862) 4 Jur. N. S. 477.

(*m*) (1844) 1 C. & R. 587.

(*n*) (1837) 1 W. P. C. 195.

Prior User. tured according to a particular model, not with a view of making it public at all, but with the object of taking out a patent for it himself, he is thereby disentitled to the invention afterwards, because he employs a workman to assist him in it; or that if he had failed entirely some other man might not make the invention in England.(o)

Prior user in colony no legal bar.

It has been held that the prior user of an invention in a colony forms no legal bar to the granting of a patent for the same invention in this country.(p)

Prior secret profitable user by the inventor.

We have now to consider the question whether the fact of an inventor having made pecuniary profit by a secret user of his invention before the date of a subsequent grant of letters patent will render the grant invalid.

The question has never been judicially decided, though Lord *Campbell*, C.J., is reported, in *Heath v. Smith*,(q) to have given expression to the following *obiter dictum*: "If one party only had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." And in *The Germ Milling Company, Limited, v. Robinson*,(r) the plaintiff elected to be nonsuited, on his own evidence of prior user of the invention, the validity of which was in contest, and did not take up the position of such prior user being secret.

The above remarks of Lord *Campbell*, C.J., must, from the context, be assumed to refer to a user by a person other than the patentee, and so do not directly bear on the question now under consideration. It is submitted, from the first principles of the patent law, that there does not appear any reason why an inventor should not be capable of receiving a grant of letters patent from the Crown at any time before he has disclosed his invention to the public and enabled them to practise it for themselves. The bargain between the patentee and the Crown(s) is, that the former discloses his invention and the manner in which it is to be performed, in exchange for a patent for a limited period from the latter, and it is evident that the patentee is capable of carrying out his part of the bargain, whether or not he has derived profit from what has hitherto been a secret use of the invention.

The argument(t) that the patentee, by keeping the invention secret and making profit by its use before applying for a patent,

(o) Per Lord Abinger, C.B., in *Carpenter v. Smith*, (1841) 1 W. P. C. 536.

(p) *Rolls v. Isaacs*, (1878) L. R. 19 Ch. D. 268.

(q) (1854) 2 W. P. C. 278.

(r) (1886) 3 R. P. C. 254.

(s) p. 93 *ante*.

(t) *Morgan v. Seaward*, (1837) 194.

would thereby obtain a monopoly longer than fourteen years, **Prior User.** or the usual duration of the grant, is not at all conclusive; for it must be remembered that the Crown offers patent grants as rewards for the disclosure of useful inventions and the means of performing them, for the public good, and it does not go into the past history of the inventor and insist on his having made the discovery within any fixed time prior to his application, but merely requires that it shall be a new manufacture which others shall not use.^(u)

Moreover, the bare fact of an article having been made before a patent for its manufacture is obtained does not alone render the grant void,^(x) and it would be absurd to hold that profit would render public that which otherwise would have been a secret use, though of course the fact of profit having been derived would no doubt influence the Court against the contention of secrecy.

There is a considerable difference between a prior secret user of the invention, which is subsequently patented, by a person other than the patentee and by the patentee himself. If it be established that a person or persons other than the patentee were in the habit of using the invention, though secretly, for the purposes of trade before the date of the grant, such prior secret user renders the patent void on the ground that the invention does not fulfil the requirements of the sixth section of the Statute of Monopolies,^(y) as being one "which others at the time of making such letters-patent and grants shall not use." Thus in *Tennant's Case*^(z) a secret user by persons other than the patentee was held to vitiate the grant. And in the more recent case of *Cheetham v. Oldham*^(a) the prior sale of hats in appearance the same as those treated by the patentee's process, but from which it could not be conclusively inferred that the patentee's process had been used, together with the statements of the defendant's witnesses to the effect that such process had been used in their manufacture, was held to invalidate the patent.^(b) For some time after the date of the Statute of Monopolies—*i.e.*, until the reign of Queen Anne—*publication* of the invention was not made a condition of the grant of the patent.^(c) And patents were

^(u) 21 Jac. I. c. 3, s. 6.

^(x) *Bramah v. Hardcastle*, (1789) Holroyd, 81; 1 Carp. P. C. 168; 1 W. P. C. 44 n.

^(z) (1798) 1 W. P. C. 125.

^(a) (1890) 7 R. P. C. 124.

^(b) See also *Hill v. Thompson*, (1818) 1 W. P. C. 240; *Cornish v. Keene*, (1835) 1 W. P. C. 511.

^(c) *The Small Patents*, (1606) 1 W. P. C. 9; *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1074.

Distinction between prior secret user by the inventor and by others.

Prior User. sometimes granted for the introduction of a *secret* trade or mystery,^(d) but it may be doubted whether such patents were really valid, for, if there was no publication, the public obtained no benefit in return for the grant.^(e)

Importation of
an article made
abroad.

A question closely connected with the above is, will the publication in this country of an article made *abroad* be a publication of the *invention* by the exercise of which the article was made? If the article made abroad shows on the face of it how it was made, its sale in this country is a publication of the invention; ^(f) but there is authority for saying that such will not be the case if the article does not show on the face of it how it was made. In *Hancock v. Somervell*^(g) it was sought to upset *Hancock's* patent for improvements in the preparation of caoutchouc consisting in combining sulphur with it, and thus rendering it elastic at all temperatures. The evidence established the fact that shoes had been imported from America made of caoutchouc which on analysis was found to contain sulphur as well as oxide of lead and other ingredients. Prior to the plaintiff's patent samples of caoutchouc prepared by sulphur were sent to England by one *Goodyear* of New York, and were shown to *Hancock*, but the secret of their manufacture was not communicated to him. It was attempted to negotiate a sale of the invention to *Hancock*, but this was never completed. *Goodyear's* agent left the samples with *Hancock* under the impression that it would not be possible for him to discover the secret of their manufacture. As the result of experiments, *Hancock*, however, discovered that sulphur made caoutchouc elastic at all temperatures, and he then obtained his patent for his method of manufacturing it. *Williams, J.*, directed the jury to say whether, supposing the shoes to have been manufactured in England, they could have been made without injuring the plaintiff's patent, and made use of the following words: "The defendants do not deny that *Hancock* is to be considered the inventor, notwithstanding *Goodyear* had previously made the discovery, provided the invention had not been published or in use in this country before the date of the patent. The defence consists of this: not only had *Goodyear* discovered the invention first, but also that the invention had been substantially published and was in use—not in secret use, but in public use—before the date of

^(d) Mansell's Patent, (1624) 1 W. P. C. 19.

^(e) See p. 93 *ante*.

^(f) *Jensen v. Smith*, (1885) 2 R. P. C. 249.

^(g) (1851) 39 Newton, L. J. 158.

the patent; that the material being in public use, the ready means of performing the invention were also necessarily before the public; because it is said the article presented in itself such means of knowledge to the public as to enable any one of ordinary competence to reproduce the article. If you should be of opinion that the material was in use before the date of the patent, then the question resolves itself into this: What is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that notwithstanding the invention remained still a matter to be discovered, in my opinion the plaintiff's case would not be affected by the circumstance of the material being in public use. If, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it is necessary that the use should be actual sale—if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handing about the country for the purpose of attracting customers): if you should think, also, that the material being so in use it was so palpable how you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it; if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have been describing." The jury found a verdict for the plaintiff, and his patent was accordingly upheld.

In the recent case of *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*,^(h) *Wills, J.*, held that *Rawson's* patent for stiffening incandescent gas mantles was not anticipated by the prior importation into this country of *Clamond's* magnesium baskets, stiffened by substantially the same process, because an inspection of the baskets did not disclose the process according to which they were stiffened.

PUBLICATION BY PERSONAL COMMUNICATIONS.

When a patentee has communicated his invention to others before applying for a patent, it is always a question of evidence whether the communications were of a fiduciary nature, and whether the persons to whom they were made have kept faith

Prior com-
munications
made by the
patentee
personally.

(h) (1897) 14 R. P. C. 757.

Prior Documents.

Prior communications made by the patentee personally.

with the patentee, or whether the communications were made to individuals as members of the public, or such individuals have broken faith with the patentee by publishing the invention to the world at large. In one case⁽ⁱ⁾ it was proved that the patentee had, before application for a patent, confidentially communicated the invention to nine separate people, but the Court of First Instance and the Court of Appeal held on the facts there was no publication which vitiated the patent. In another case it appeared that the patentee entrusted his invention—a pince-nez—to an optician in Paris, whose employee showed it to a third party, who wrote a description of it in a French scientific publication, three or four copies of which came over to this country and were in public libraries before the date of the patent. The House of Lords held that under these circumstances the patent was bad for want of novelty.^(k)

PUBLICATION BY DOCUMENTS.

Books and documents as means of publication.

Besides the different ways heretofore indicated, a knowledge of an invention may be made the property of the public, so as to render a subsequent patent for it void on the ground of want of novelty, by a description of it being contained in a printed or written book or document or specification published in this country in such a manner that the public have access to such document or specification, and may, therefore, be presumed or assumed to have a knowledge of its contents.^(l)

Foreign books.

It has been held that an invention is published if a description of it is contained in a foreign book which has been circulated in England,^(m) in such a manner that some English people may be fairly supposed to know of it,⁽ⁿ⁾ whether the foreign book be in a foreign language or English;^(o) but it

(i) *Gadd v. Mayor, &c., of Manchester*, (1892) 9 R. P. C. 249, 516.

(k) *Pickard v. Prescott*, (1892) 9 R. P. C. 195; A. C., (1892) 263; see also *Blank v. Tortman*, (1888) 5 R. P. C. 653, 656.

(l) *Rex v. Arkwright*, (1785) 1 W. P. C. 72; *Huddart v. Grimshaw*, (1803) 1 W. P. C. 86; *Jones v. Berger*, (1843) 1 W. P. C. 550; *Cornish v. Keene*, (1835) 1 W. P. C. 507; *Heurteloup's Patent*, (1836) 1 W. P. C. 553; *Dobbs v. Penn*, (1849) 3 Exch. Rep. 427; *The Househill Co. v. Neilson*, (1843) 1 W. P. C. 673; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531; *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 412; *Lawrence v. Perry*, (1885) 2 R. P. C.

180; *United Horseshoe and Nail Co. v. Stewart*, (1885) 2 R. P. C. 122, 133; *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 429.

(m) *Reg. v. Seine*, 40 Newton, L. J. 71; *The United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

(n) *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 429; remarks of Cotton and Lindley, L.J.J.

(o) *Lang v. Gisborne*, (1862) 31 Beav. 133; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720; *Otto v. Steele*, (1884) L. R. 31 Ch. D. 241; *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 416.

would appear that if the foreign book is in a remote language with which very few English people would be acquainted, it might not amount to such a publication as would vitiate a subsequent patent.^(p)

Prior Documents.
—

Publication in a foreign book, only four copies of which were sent over to this country and exposed for sale (only one copy of which was actually sold), has been held sufficient to vitiate a patent.^(q)

In order to invalidate a patent on the ground of prior publication in a book or document, it is not necessary to show that the patentee actually derived his knowledge of the invention from such prior book or document; it is quite sufficient to show that the prior book or document was open to public inspection before the date of the patent.^(r)

Unnecessary to prove that the patentee ever saw the prior book or document relied on.

Thus, where an American book was kept in a private room at the Patent Office, and not entered in the donation book or in the catalogue,^(s) it was held that there was not sufficient publication to upset an English patent.^(t) Again, the fact that a French book containing a description of an invention was mentioned in catalogues distributed in this country, was held, in the absence of any proof that a single copy of the French book had ever been brought to this country, to be no publication of the invention.^(u) If, however, the foreign book or document is catalogued and in a library to which the public have access, it will amount to a publication of the invention, though only one person has seen it,^(x) or it is the only copy accessible to the public.^(y)

The question whether a particular document has really become part of the stock of public knowledge, or at any rate part of the knowledge of that portion of the public interested in the invention, is in every case a matter of evidence.^(z) In the words of *Tindal*, C.J. :—

Publication by prior document is always a question of fact.

“The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a

Per *Tindal*, C.J.

^(p) *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 426.

^(q) *Lang v. Gisborne*, (1862) 31 Beav. 133.

^(r) *Stead v. Williams*, (1844) 2 W. P. C. 142.

^(s) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531.

^(t) See *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 412.

^(u) *Otto v. Steel*, (1887) L. R. 31 Ch. D. 241.

^(x) *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 426; 3 R. P. C. 383; 4 R. P. C. 225.

^(y) *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 721, 731.

^(z) *The Houshill Co. v. Neilson*, (1843) 1 W. P. C. 673; *Stead v. Williams*, (1844) 2 W. P. C. 137; *Stead v. Anderson*, (1846) 2 W. P. C. 147; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531.

Prior Documents.

Publication by prior document is always a question of fact.

state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be whether, on the whole evidence, there has been such a publication as to make the description a part of the public stock of information.”(a)

It is idle to lay down any general canon of what will be the result of a given case. The effect, extent, and operation of the document by which the invention is supposed to be communicated to the public in this country, so as to anticipate the invention of the person who first takes out letters patent for the invention, vary infinitely, as the facts must vary. In a great variety of instances it may very well be that the mere fact of an invention being completely disclosed in a written paper and that written paper brought into this country would, notwithstanding those circumstances, not in the smallest degree amount to publication, and would not interfere with a patent afterwards taken out. In other cases the inference, which is simply a question of fact, may be irresistible that the invention was communicated in the strictest sense to the public in such a way as to prevent the operation of letters patent taken out after the date of that publication.(b)

In *Plimpton v. Malcolmson*,(c) the facts proved were that a copy of a book published in America containing a short description of the invention forming the subject of the patent in dispute was sent over to this country before the date of the patent, and placed in the library of the Patent Office, but it was not entered in the catalogue of the library, and was not placed on the shelves of the room to which the public had access, but in a private room; and it was also proved that the book did not come to light till ten years or more after the date of the patent. Under these circumstances, *Jessel*, M.R., held that there had not been such a publication of the invention as would deprive the man who first made it known in this country of that merit—the only merit so far as an importer is concerned—which consists in making known a useful invention to the public. This decision was in a subsequent case(d) upheld by the Court of Appeal.

(a) *Stead v. Williams*, (1844) 2 W. P. C. 143; see also *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531; Judgment of *Jessel*, M.R., at p. 561, and his explanation of the dictum of *Romilly*, M.R., in *Lang v. Gisborne*, (1862) 31 Beav. 133; see also *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 412; *Von Heyden v. Neustadt*, (1880) 50 L. J.

N. S. Ch. 126; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

(b) See observations of *Halsbury*, L.C., in *Pickard v. Prescott*, (1892) 9 R. P. C. 195.

(c) L. R., (1876) 3 Ch. D. 531.

(d) *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 412.

A document containing a description of an invention may under some circumstances, however, be public property from the moment it is written. For example, where a referee appointed by Act of Parliament to inspect the works of the London Gas Companies, whilst engaged in the prosecution of his duties discovered a process for purifying gas and obtained a patent for the invention, after the report of himself and his co-referees embodying the principle of the process had been drawn up, it was held by the House of Lords that the patent was void for lack of novelty, because the report conveying a knowledge of the invention had become public property from the time it was written.^(e)

Prior Documents.

Document is sometimes public property the moment it is written.

It is not always possible to predict of two documents which make use of terms of art *ipsissimis verbis* the same, that they describe the same invention, if they were composed at different periods. For it must not be forgotten that terms of art are liable to constant changes of meaning during the progress and development of any particular department of science, and therefore, in considering whether a description in an earlier published book or document is really the same as that in a later specification, it must be carefully ascertained that the terms of art used in the two denote the same thing. In the words of Lord *Westbury*: "Even if there is identity of language in two specifications, and (remembering that those specifications describe external things) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predict of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification, and denote the same external objects at the date of the one specification as they do at the date of the other."^(f)

Terms of art used in different documents may not have the same meaning.

A document which upon its true construction points away from the use of a certain thing, or the use of a certain thing in a particular manner, cannot be successfully pleaded as a publication of an invention which consists in the use of the thing, or in its use in a particular manner.^(g)

Document which points away from the patentee's claim is no publication.

Provisional specifications which are filed in the Patent

Provisional specifications.

^(e) *Patterson v. Gas Light and Coke Co.*, (1856) L. R. 3 App. Cas. 239.

^(f) *Betts v. Menzies*, (1862) 10 H. L. Cas. 152.

^(g) See *Nobel's Explosives Co. v. Anderson*, (1895) 12 R. C. P. 164;

Morris v. Young, (1895) 12 R. P. C. 461; *Monnet v. Beck*, (1897) 14 R. P. C. 777; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 875.

Prior Documents.

Provisional specifications.

Power of Court to order production of abandoned provisional specifications.

Effect of publication of a prior abandoned provisional specification and a subsequent application within the period of provisional protection.

Office and subsequently abandoned by the applicant, are under the present practice never published. Consequently, an abandonment of a provisional specification will not amount to a publication of the invention, which may form the subject-matter of a subsequent patent.^(h)

The Courts have power to order the production of an abandoned provisional specification if it is required in the interests of justice—*e.g.*, when in an action on a subsequent patent the defendant pleads invalidity by reason of his own prior user, and states that he has filed but abandoned a provisional specification for the thing which he alleges he used about the date of the abandoned provisional specification, and which he contends was an anticipation of the plaintiff's claim.⁽ⁱ⁾

If, however, an abandoned provisional specification has been published, as was the former practice, a description of an invention contained in it will invalidate a subsequent patent, though it turns out that the prior patent, in respect of which the provisional specification was filed, is void.^(j)

In *Lister v. Norton*,^(l) the facts were these: the plaintiff, on 24th July 1880, filed a provisional specification of an invention for "improvements in the manufacture of pile fabrics in imitation of sealskin and other similar fabrics." This specification was abandoned by the plaintiff, and on the 21st January 1881 he filed a second provisional specification of an invention for "improvements in the manufacture of velvets and of pile fabrics in imitation of sealskin and other similar materials." On the 21st July 1881 he obtained a grant of letters patent on his provisional specification of 21st January 1881. The invention claimed consisted in a new combination of materials for use in the manufacture of the fabrics referred to—the employment of a mixture of mohair and silk in the raw state, combined and blended before spinning. It was held that, assuming the invention in the two provisional specifications to be identical, the abandonment of this first provisional specification did not avoid the patent which was granted, *i.e.*, dated, within the period of provisional protection secured by the first provisional specification, even if actual user during such period could be shown.^(m)

^(h) 48 & 49 Vict. c. 63, s. 4; *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; *Lister v. Norton*, (1886) 3 R. P. C. 199.

⁽ⁱ⁾ *Pneumatic Tyre Co. v. English Cycle and Tyre Co.*, (1897) 14 R. P. C. 851.

^(j) See *Kaye v. Chubb*, (1888) 5 R. P. C. 641, 648.

^(l) (1886) 3 R. P. C. 199.

^(m) See also *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68; *Stoner v. Todd*, (1876) L. R. 4 Ch. D. 58.

A prior description, which has become the property of the public, of a machine or combination, though that machine or combination has never been actually made and publicly used, will render a subsequent patent for that machine or combination bad both on the ground that the patentee is not the true and first inventor, and because the invention is not new.⁽ⁿ⁾

Prior Documents.

Not necessary to prove that a prior published invention has been actually used.

As has been shown, the subject of a patent is really the art of producing the new and useful result,^(o) and it is not necessary to avoid a patent that the art should have actually been put in practice—*i.e.*, the machine, for instance, made by the exercise of it, need not have been constructed, provided that the public are, at the date of the patent, in possession of full and sufficient information to enable them to produce, without the exercise of further invention, the result claimed by the patentee.^(p) The question whether a description has really become the property of the public so as to vitiate a subsequent patent is therefore always one of evidence, when that description has not been acted upon and no machine made has been in accordance with it.^(q)

Lord *Blackburn*, in the House of Lords,^(r) pointed out that in order to vitiate a patent on the ground of want of novelty it is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used have been made known to the public by a description in a work which has been publicly circulated^(s) or a specification duly enrolled,^(t) it avoids the patent, though there is no proof that the invention was ever actually put in use.

If the document relied on as a publication contain *merely a suggestion* of the invention, it will be immaterial to the novelty of a subsequent patent, which will only be upset on the ground of prior publication, if the document contain a description which is such that the invention could be easily carried out from it.^(u)

Mere suggestion is not publication.

⁽ⁿ⁾ *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 62.

^(o) p. 21 *ante*. ^(p) p. 95 *ante*.

^(q) *Humpherson v. Syer*, (1887) 4 R. P. C. 407; *Tickelpenny v. Army and Navy Co-operative Society, Ltd.*, (1888) 5 R. P. C. 405.

^(r) *Patterson v. Gas Light and Coke Co.*, (1875) L. R. 3 App. Cas. 239.

^(s) *Stead v. Williams*, (1844) 7 M. & G. 818, 842; 2 W. P. C. 141.

^(t) *Bush v. Fox*, (1856) 5 H. L. C. 707; *Betts v. Menzies*, (1862) 10 H. L. C. 117.

^(u) *Woodcroft's Patent*, (1846) 2 W. P. C. 23; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117; *Betts v. De Vitre*, (1862) 11 L. T. N. S. 445; *Von Heyden v. Neustadt*, (1880) L. R. 14 Ch. D. 230; 50 L. J. N. S. Ch. 126; *Stoner v. Todd*, (1876) L. R. 4 Ch. D. 58; *Moseley v. Victoria Rubber Co.*,

Prior
Docu-
ments.

The law requires the inventor in the specification which he is compelled to lodge at the Patent Office (*x*) to describe his invention and the mode of performing it in language so accurate and explicit as will enable an ordinary and intelligent workman in the trade, to which the invention relates, to put it in practice. The question arises as to whether it is necessary that a document containing an alleged anticipation of a subsequently patented invention should be framed in language equally accurate and explicit as that which is required in the specification itself. In other words, will an alleged anticipating document, which is sufficiently accurate and explicit to enable a highly skilled person to perceive without effort and perform the invention, though it is not intelligible to a less skilled ordinary workman, amount to a prior disclosure of the discovery which will render a subsequent patent void on the ground of want of novelty?

In *Betts v. Menzies* (*y*) it was held that an antecedent description must disclose a practicable mode of producing the result of the subsequent discovery if the description is to be held sufficient to invalidate the subsequent patent. In this case *Dobbs'* specification was relied on as an anticipation of *Betts'*, but it was not contended that the former would enable any skilled person to perform the invention. It appeared that proportions and subsidiary processes not disclosed by *Dobbs* were necessary. *Dobbs'* was held not to be an anticipation of *Betts'*. The information given would clearly not enable *any one* without experiments to perform the invention, and the point of it being intelligible to a skilled person was not raised at the Bar.

As was remarked by Lord *Abinger*, (*z*) many patents have been taken out upon suggestions contained in a celebrated work by the Marquis of *Worcester*, and from hints and speculations from the same author, and his Lordship seemed of opinion that these patents would have been good as regards anticipation by the Marquis of *Worcester*. All the Marquis did in his writings was to make suggestions and speculations, not to describe perfected inventions in language which would disclose them, as such,

(1887) 4 R. P. C. 252; *Bray v. Gardner*, 4 P. O. R. 405; *Haslam v. Hall*, (1888) 5 R. P. C. 19; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 450; *Thompson v. American Braided Wire Co.*, (1887) 4 R. P. C. 316; 5 R. P. C. 113; 6 R. P. C. 518; *Winby v. Manchester, &c., Steam Tramways Co.*, (1889) 6 R. P.

C. 359; *Shaw v. Jones*, (1889) 6 R. P. C. 336.

(*x*) 46 & 47 Vict. c. 57, s. 3; see chap. v.

(*y*) 10 H. L. Cas. 152.

(*z*) *Carpenter v. Smith*, (1841) 1 W. P. C. 530.

to any one, however skilled he might be. This is a very different thing to a description of an invention in terms that would enable skilled persons, though not the ordinary workman, to perceive and carry it out.

Prior
Docu-
ments.

The real point to be considered in determining whether a prior description is sufficiently explicit to vitiate a subsequent patent is: will the prior description enable any person, *without the exercise of invention*, to carry out the alleged new discovery? It may be that a given prior description will enable a highly skilled person to perform an invention for which a patent is subsequently taken out, whereas a less skilled ordinary workman in the trade would not be able to carry the invention into effect from the hints and suggestions contained in that prior description. If the highly skilled person has to exercise any ingenuity or invention to enable him to arrive at the result achieved by the patentee it is submitted that the prior description is not one which will vitiate a subsequent patent; otherwise it is.

Sufficiency of
description
necessary in
an anticipating
document.

Lord *Westbury*, L.C., in *Hills v. Evans*(a) first laid down authoritatively the rule on the subject of what must be the nature of an antecedent paper publication in order that it may be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty. The rule in *Hills v. Evans* has been slightly modified and brought up to date by subsequent cases. The following extract from the judgment of *Lindley*, L.J., in *Savage v. Harris*,(b) contains a clear statement of what the law upon the subject now is:

Rule in *Hill v. Evans*.

Statement of
the present law
by *Lindley*,
L.J.

“I cannot do better than refer to the well-known judgment of Lord *Westbury* in the case of *Hills v. Evans*, which is to be found in 4 De Gex, Fisher, and Jones, at page 289. He says: ‘I have therefore to consider and to give my opinion upon the question that has been argued, namely, whether there be or be not anything in these specifications which has rendered the plaintiff’s invention matter of public knowledge, and therefore matter of public property, anterior to the granting of the patent. I was extremely desirous to ascertain, in the course of the argument, whether any clear rule has been laid down on the subject of what shall be the nature of the antecedent publication which shall be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty.’ After saying that a specification is not to be distinguished in principle from any other publication, he says: ‘The question, then, is—

(a) 4 De Gex, Fisher and Jones, 289.

(b) (1896) 13 R. P. C. 368.

Prior
Docu-
ments.

What must be the nature of the antecedent statement? I apprehend that the principle is correctly thus expressed.' I will show that that has been corrected more recently. 'The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent.' And after commenting on the statute of James, he goes on: 'The information as to the alleged invention given by the prior publication must for the purposes of practical utility be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication.' With the exception to which I have called attention—I mean about the ordinary workman—that is the law. Mr. Justice *Grove* was the first to call attention to the fact that there might be prior anticipation by publication, although the specification was defective in the directions given to the workman. His judgment upon that point will be found in *Philpott v. Hanbury*, 2 R. P. C. 43, and it has been adopted. I do not know whether expressly or not, but the same criticism and the same observations will be found in the House of Lords cases for 1892, at page 378, in the case of the *Anglo-American Brush Electric Light Corporation v. King, Brown & Co.*, 9 R. P. C. 313. The question there was whether a specification of one *Varley* was an anticipation of the plaintiff's patent, and Lord *Watson* says this: 'I do not think it necessary to deal with the conflict of testimony as to the sufficiency of *Varley's* specification for the guidance of a skilled workman. The Lord Ordinary was of opinion that the appellants had failed to prove that part of their case. But I agree with his Lordship and with the learned Judges of the First Division in holding that the sufficiency or insufficiency of the specification for that purpose does not afford a crucial test of prior publication. Every patentee, as a condition of his exclusive privilege, is bound to describe his invention in such detail as to enable a workman of ordinary skill to practise it, and the penalty of non-compliance with that condition is forfeiture of his privilege. His patent right may be invalid by reason of non-compliance, but it certainly does not follow that his invention has not been published. His specification may,

notwithstanding that defect, be sufficient to convey to a man of science and employers of labour information which will enable them, without any exercise of inventive ingenuity, to understand his invention and to give a workman the specific directions which he failed to communicate. In that case I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill.' With that correction of Lord *Westbury's* judgment, the judgment stands, and, applying it to this case, I confess I cannot see what on earth there is in the plaintiff's specification which is not to be found in *O'Connor's*; I do not say in actual words, but to anybody who reflects upon it and thinks about it and grasps it." (c)

Prior
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ments.

When, however, a skilled person with the knowledge of the patentee's specification produces a successful result and says he obtained it by following only the directions of an old and unused paper anticipation, the Courts look very carefully at such evidence before accepting it. (d)

Evidence of a skilled person, with knowledge of the patent, as to anticipations.

In *Otto v. Linford* (e) a prior specification was relied on as a publication of the invention claimed by *Otto*. *Brett*, L.J., said that the question to be considered was whether the prior specification, fairly read by a person conversant with such matters, would give a reasonably clear description of the latter invention. In other words, supposing it to relate to a machine, would it give such a reasonably clear description of a machine that would accomplish what the machine of the later inventor effected.

Unless all essential features of the invention are disclosed by an anticipating document it will not be a publication.

In *Stoner v. Todd*, (f) it appeared that a certain provisional specification contained a partial description of a piece of mechanism which was not mentioned in the corresponding complete specification. A subsequent patent was taken out for the piece of mechanism, and this was held not to be invalidated by the incomplete description in the prior provisional specification.

In the words of Lord *Westbury*: "An antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery; (g) and in the language

(c) See also *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 256; *Gadd v. Mayor of Manchester*, (1892) 9 R. P. C. 532; *Shrewsbury and Talbot Cab Co. v. Sterckx*, (1896) 13 R. P. C. 53; *Edison v. Holland*, (1887) 5 R. P. C. 459; 6 R. P. C. 243.

(d) *Defries v. Sherwood*, (1897) 14 R. P. C. 313.

(e) 46 L. T. N. S. 35.

(f) L. R. 4 Ch. D. 58.

(g) *Betts v. Menzies*, (1881) 10 H. L. Cas. 154; see also *Woodcraft's Patent*, (1846) 2 W. P. C. 23.

Prior
Docu-
ments.

of Lord *Wensleydale*, 'the mere production of a notion that a particular article might be made, without any information or means of knowledge communicated to the public, does not prevent a subsequent first inventor of those means from taking out a patent.'"^(h)

In order that a description in a prior document may invalidate, on the ground of want of novelty, a subsequent patent, it is necessary that *all* the essential features of the alleged invention should be disclosed by the prior document. Thus, a patented process for "improvements in the manufacture of grooved tyres for wheels" consisted in rolling a flat bar of iron so as to get it into a curved form with flanges set up upon each side, and then to roll so as to get the curved form into a flat base, but not so as to get merely rectangular flanges, but to roll (which necessitated rollers of a novel and peculiar kind) so as to get flanges at an acute angle to the flat base; or, if not at an acute angle, by rolling, to get flanges with bead-shaped heads whereby to produce an iron tyre with an undercut dovetailed section which would grip the india-rubber tyre and would have a flat base in order that it might accurately fit on to the felloe of the wooden wheel and that the india-rubber might lie perfectly flat upon it when extended round it. This was held not to be anticipated by a specification which did not disclose the attainment of the undercut dovetailed section, though it did disclose the attainment of the other essential features.⁽ⁱ⁾

Highly scientific inventions.

With reference to the publication of a highly scientific—*e.g.*, a chemical—invention it is to be remembered that there are two distinct forms of literature on the subject: the systematic scientific literature, and the technical literature; and the distinction is one very important to be borne in mind in dealing with such patents, since publications having reference to chemical science will be studied by scientific chemists, but speaking generally such publications are not sought after and studied by the practical working chemists.^(k)

The existence of a chemical patent wherein the combined effect of two or more chemicals is claimed in order to bring about a desired result does not by any means necessarily constitute an anticipation of a subsequent discovery that by use of any one of the named chemicals the desired result can be

^(h) *Betts v. Menzies*, (1862) 10 H. L. Cas. 157; see also *Muntz v. Foster*, (1844) 2 W. P. C. 105; *Galloway v. Bladen*, (1839) 1 W. P. C. 521; *Thomson v. Batty*, (1889) 6 R. P. C. 84.

⁽ⁱ⁾ *Shrewsbury and Talbot Cab Co. v. Sterckx*, (1895) 12 R. P. C. 336; 13 R. P. C. 44.

^(k) *Anilin und Soda Fabrik v. Levinstein*, (1885) L. R. 29 Ch. D. 384.

attained, and *a fortiori* when the compound of the two has failed to do so, for there are any number of cases known in chemistry where two things when put together act very differently from what they do apart.^(l)

Prior Documents.
—
Though an anticipation might be an infringement, it is not necessarily a publication.

It does not at all follow that an unused paper anticipation which, if constructed, might be held to be an infringement of a subsequent patent, is an anticipation of the subsequent patent. A clumsy imitation of a patented machine or a patented article may be an infringement, although it is not such as would have been, if prior in date, an anticipation defeating an inventor's right to a patent.^(m) Thus, in the recent case of *Welch's* patent for holding on bicycle tyres by inextensible wire rings, it was objected that this was anticipated by a prior specification of *Lata*. Two figures in *Welch's* specification, showing extreme cases of the application of his invention, approximated in appearance to a figure in *Lata's* specification. From *Lata's* specification, however, it was clear that he proposed to use the wires—of which he had three—for a different object to *Welch*—viz., to hold on the tyre by means of the pressure of the wires and rubber on the rim; and *Lata* further stated that if any one of his wires were cut the tyre would still be held on. This clearly showed that his object was different to *Welch's*, and as there was no evidence of user of *Lata's* invention the Court held that it did not anticipate *Welch*—though, no doubt, if after *Welch's* patent some one adopted *Lata's* figure and was really intending to use *Welch's* invention, and merely putting in the third wire as a colourable distinction, such conduct would be an infringement of *Welch's* patent.⁽ⁿ⁾

Though a documentary publication may not be an anticipation of a subsequent patent, notwithstanding that it describes the main features of the invention, still such a publication may very much narrow the ambit of the patentee's claim; and an alleged infringer may consequently be held not to have infringed, whereas had it not been for the prior publication he might have been an infringer.^(o)

A document which is not a publication may narrow the ambit of the claim.

^(l) In judgment of C. A., Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 256.

^(m) Caldwell v. Van Vlissingen, (1851) 9 Hare, 421; Murray v. Clayton, (1872) L. R. 7 Ch. 585; Daw v. Eley, (1865) L. R. 3 Eq. 492, 501 n.; Newton v. Grand Junction Ry. Co., (1846) 5 Ex. 334; Pneumatic Tyre Co. v.

East London Rubber Co., (1896) 14 R. P. C. 103; 14 R. P. C. 573.

⁽ⁿ⁾ Pneumatic Tyre Co. v. East London Rubber Co., (1896) 14 R. P. C. 77, 102; 14 R. P. C. 573.

^(o) Automatic Weighing Machine Co. v. Knight, (1889) 6 R. P. C. 113; Automatic Machine Co. v. Combined Weighing Machine Co., (1889) 6 R. P. C. 120; Automatic Weighing Machine

Prior Documents.

General statement as to a class no publication of selection of a particular member.

A general statement that a class of bodies will effect a certain purpose is no anticipation of an invention which consists in the application of one member of the class which possesses particular advantages not shared by the other members of the class. (*p*) So also the use in a particular way of a limited number of a larger class of bodies mentioned in a prior document may form the subject-matter of a valid patent when the inventor has, by the particular use of the limited suitable members of the class, been enabled to produce a new result. (*q*)

Drawings.

A drawing alone which has been published so as to become the property of the public is quite sufficient to invalidate a subsequent patent, if the drawing is intelligible to machinists and enables them by its aid alone to make the machine indicated; (*r*) and a description that will enable competent workmen to carry out an invention will vitiate a subsequent patent for that invention, even though at the time of the prior description no one did use the machine made according to the description, provided that its use is indicated in such description. (*s*)

Description of a useless machine is no publication of a useful one.

If a prior description when completely carried out results in the production of an impracticable and useless machine, it will be no anticipation and publication of the result arrived at by a subsequent inventor when that result is both practicable and useful. (*t*)

So also if the alleged anticipation describes a machine which has a practical defect, and a subsequent invention removes that defect, the prior description is no publication of the later invention. Thus, in the case of a sewing machine to be used for stitching boots, a prior description of a machine in which a forked looper and an auxiliary looper were used and the thread was presented to the point of the needle, was relied on to defeat the patent of the plaintiff. The auxiliary looper and the presentation of the thread to the point of the needle were shown to be defects, and the plaintiff's invention, according to which he removed the auxiliary looper and presented the thread to the notch of the needle instead of to the point, and

Co. v. National Exhibitions Association, (1892) 8 R. P. C. 345; 9 R. P. C. 41; Automatic Weighing Machine Co. v. International Hygienic Society, (1889) 6 R. P. C. 475; Voeruk v. Evans, (1890) 7 R. P. C. 265.

(*p*) Hills v. The London Gas Light Co., (1857) 27 L. J. Ex. 60; 5 H. & N. 312; 29 L. J. Ex. 409; Wylie and Norton's Application, (1896) 13 R. P. C. 97; see p. 35 *ante*.

(*q*) Lancashire Explosives Co. v. Roburite Explosives Co., (1895) 12 R. P. C. 470, 478; 13 R. P. C. 429; 14 R. P. C. 303.

(*r*) Herrburger v. Squire, (1889) 6 R. P. C. 194.

(*s*) United Telephone Co. v. Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705, judgment of Fry, J.; see p. 129 *ante*.

(*t*) See p. 133 *ante*.

so removed the defect, was held to be good subject-matter of a valid patent.^(u)

An invention may be anticipated partly by one prior publication and partly by another, so that in the result the whole invention may have been previously published. It is not, however, allowable to take a mosaic construction of previous publications, and thereby deny the want of novelty in an invention, which consists in the construction of a whole, the component parts of which have never before been put together in the manner shown by the subsequent inventor.^(v)

Two or more documents which are public knowledge, and which indicate discussion, invention, or discovery in the same line may be honestly taken together and form a publication of a subsequent alleged invention; but it is not allowable, for the purpose of showing the publication of a combination which has never in fact existed or been described prior to the time the patentee discloses his invention, to piece together parts of prior documents which describe things now found to be useful, but which were never before intended to be put in combination.^(y)

James, L.J., delivering the judgment of the Court of Appeal in *Von Heyden v. Neustadt*,^(z) and commenting on a number of extracts and papers relied on as evidence of the prior publication of the invention which was the subject of the action, said:

“We are of opinion that if it requires this mosaic of extracts from annals and treatises spread over a series of years to prove the defendant's contention, that contention stands thereby self-condemned. . . . And even if it could be shown that a patentee had made his discovery of a constructive process by studying, collating, and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of Nature would do.”

It is to be remembered that there is no case where a new commercial article consisting of a combination of parts being produced for the first time, a separate description of any one or more of those parts alone, or of some combinations of them,

^(u) *English and American Machinery Co. v. Union Boot and Shoe Machinery Co.*, (1894) 11 R. P. C. 137, 367.

^(v) *Neilson v. Betts*, (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317; *Von Hey-*

den v. Neustadt, (1880) 50 L. J. N. S. Ch. 126; *Young v. Fernie*, (1866) 4 Giff. 577; L. R. 1 H. L. 36.

^(y) See *Otto v. Linford*, (1881) 46 L. T. N. S. 35.

^(z) (1880) 50 L. J. N. S. Ch. 128.

Prior Documents.

Invention may be partly published by one document and partly by another.

Mosaic of extracts from prior documents not a publication.

Prior Documents.

when the whole combination has never before been used, (a) has been held to amount to a publication of that article. (b) It is no detraction from the merit of an inventor to point out that one detail is to be found in one obscure specification, and another detail in another, and so on, and to say that all he had to do was to put these things together. The getting of the idea, and the putting together of that idea, with the mechanical means of attaining it, may constitute invention. (c)

Difference between a prior machine and a prior document as publications.

There is a considerable difference as to the effect on the question of publication of an invention between the production of a machine made prior to the date of the patent and a document published before that date. In the former case the production of a machine made for a particular purpose, which would accomplish, when used, results which were not thought of when it was made, might possibly, without any user, be an anticipation of a patent for the application of the machine to produce such results. It would be a question of evidence as to whether it required invention to make the application. If the machine were used in such a way as to make clear to the public what it would effect, it would be a sufficient publication to defeat any subsequent patent for any such result. (d)

In the case of a written document it is not apparent, except from the language thereof, what results the contemplated machine would accomplish. It is not sufficient to defeat a patent to say that, if a machine were made by following the description in a document, something in that machine would anticipate the invention of the patentee, unless that something is apparent from the description itself. When the publication is in writing, and in writing only, it is necessary to show that a person conversant with such matters, on reading it, would find a reasonably clear description of the invention in the writing alone. If it be necessary that the machine should be made in order that the publication may be seen, the subsequent inventor is not obliged, when his attention is called to a mere writing, to make a machine from it in order to see what will be the effect. If the document is to invalidate the subsequent patent, it must contain on the face of it a description of the invention. (e)

(a) *Pneumatic Tyre Co. v. Casswell*, (1896) 13 R. P. C. 375.

(b) *Otto v. Linford*, 46 L. T. N. S. 35; *Pneumatic Tyre Co. v. Casswell*, (1896) 13 R. P. C. 375.

(c) *Fawcett v. Homan*, (1896) 13 R. P. C. 410.

(d) *Ibid.*

(e) *Hills v. Evans*, (1862) 31 L. J. Ch. 457; 4 De G. F. & J. 288; *Betts v. Menzies*, (1862) 10 H. L. Cas. 152-154; *Otto v. Linford*, (1881) 46 L. T. N. S. 44; *Gouland v. Gibbs*, (1888) 5 R. P. C. 535.

CHAPTER IV.

UTILITY.

UTILITY AT COMMON LAW.

THERE do not appear to be any words in the sixth section of the Statute of Monopolies directly implying that the subject of a patent must be an invention which is useful, but "utility" is a condition imposed by the Common Law quite independently of enactment. Utility is a requisite at Common Law.

The Crown in exercising any of its prerogatives must do so for the good of the public, otherwise it would be acting contrary to the law. (a) The Sovereign has no power to charge its subjects, or abridge any of their liberties, excepting it be for their benefit, or in exchange for a sufficient consideration. (b) It is evident that during the continuance of a patent, which grants to the patentee and his nominees the sole use and enjoyment of the invention forming the subject of the grant, the public are not able to exercise the invention without the licence of the owner for the time being of the patent, even though they should, independently of the information contained in the specification, (c) make the discovery for themselves, and if they desire to procure articles made according to the invention they are obliged to pay whatever price the owner of the patent right chooses to demand. (d) The Sovereign in making the grant really acts on behalf of the public, (e) and it is therefore only equitable that they should obtain some consideration in respect of the benefit they confer on the grantee.

The subject-matter of every patent must be an art, (f) and if such art is incapable of producing useful results in its application to any of the purposes in respect of which the grantee claims protection, it is clear that the public can get no benefit from its application, and the grant will be therefore void on

(a) Bac. Abr. tit. "Prerog."

(b) 2 Rol. Abr. 172, s. 20.

(c) See chap. v. *post*.

(d) As to compulsory licences, see chap. ix.

(e) Per Lord Eldon, L.C., in *Harmer v. Plane*, (1809) 14 Ves. 130, 136.

(f) Chap. ii. p. 24.

Utility at the ground that the necessary consideration for its support is
Common wanting.
Law.

Utility is requi-
site at Com-
mon Law;

Moreover, every patent contains a recital to the effect that the Sovereign, being willing to give encouragement to all arts and inventions which may be for the public good, is pleased to condescend to the applicant's request. It is the evident intention, therefore, that the patentee should give as a consideration to the public an art or invention which is for their good, whereas one devoid of utility would not be. In this latter case the Crown would have been deceived in its grant, which would be void on the ground of the failure of part of the consideration in respect of which the grant was made,^(g) that is to say, because there was no utility in the invention.^(h)

It is, of course, the subject of the patent—*i.e.*, the art by the exercise of which the manufactured articles are produced, which must possess the quality of utility.⁽ⁱ⁾ The utility of the articles produced by the exercise of the protected art is necessarily the measure of the utility of the art itself, for an art incapable of yielding useful results cannot possess this quality, which is essential for its protection by letters patent.

It is required by the Common Law, in existence before the Statute of Monopolies, that an invention to be capable of substantiating a patent shall possess the element of utility.^(k)

^(g) Vin. Abr. Prerog. M.C.

^(h) p. 146 *post*.

⁽ⁱ⁾ See Palmer *v.* Wagstaff, Newton, L.J., vol. xliii. p. 151.

^(k) It was laid down in Darcy *v.* Allin, (1602) Noy, R. 182, that when a man brings into the realm any new trade, and that for the good of the realm, the King may grant him a monopoly for a reasonable time "in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not."

And again, in Sheppard's Abridgment (Part iii. p. 61), it was stated that the King may for a reasonable time grant a monopoly patent for a new trade or device, or any new engine tending to the furtherance of it, for the good of the realm.

In a *scire facias* to repeal a patent, Buller, J., held that it was a question for the jury to decide whether the only new part of the machinery described in the specification was material or useful, and that if they came to the conclusion that such was not the fact the patent was void. The jury gave their verdict against the patent, and on the motion for a new trial no objection was taken to this direction of the Judge (*R. v. Arkwright*, Dav. P. C. 138).

In *Boulton v. Bull*, (1795) 2 H. Bl. 463; Dav. P. C. 162, Rooke, J., said the public had a right to receive a meritorious consideration in return for the protection which the patent claimed.

In *Turner v. Winter*, (1785) 1 T. R. 602; Dav. P. C. 151, Ashurst, J., stated that a patent would be contrary to law were it not for the advantages which the public derive from the communication of the invention.

In *Manton v. Parker*, (1815) Dav. P. C. 327, Thomson, L.C.B., holding the plaintiff's patent void on the ground of the utility of the invention having failed, nonsuited him.

In *Manton v. Manton*, (1815) Dav. P. C. 333, Gibbs, L.C.J., held that in order to support a right to the exclusive enjoyment of a patent, it is necessary that the party who takes out a patent should show that the invention is useful to the public.

In *Bovill v. Moore*, (1815) Dav. P. C. 399, the same learned Judge held that

As we have seen, (l) the Statute of Monopolies did not confer any new right on the Crown, but only reserved to it the privilege which it had long enjoyed before the statute, of granting monopolies in respect of new inventions, and the concluding words of the reserving clause (m) expressly declared that such privileges are not to be "contrary to the law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient." And the section concludes with a declaration that grants made in virtue of the power thereby reserved to the Crown shall be "of such force as they should be if this Act had never been made, and of none other," clearly indicating that all the provisions imposed by the Common Law were to be preserved, whether expressly mentioned in the Act or not. Thus the element of utility is as much a requisite, since the passing of the statute, as it was before it, for the enactment made no difference in this respect, and every case relative to utility decided since the statute is a fresh declaration of the Common Law on the subject.

Utility at
Common
Law.
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and is pre-
served by the
Statute of
Monopolies.

Sir *Edward Coke*, commenting on the words "mischievous to the State by raising the prices of commodities at home," in 21 Jac. I. c. 3, s. 6, says: "In every such new manufacture as deserves a privilege there must be *urgens necessitas* and *evidens utilitas*," and that the reason why such a privilege is good in law is "because the inventor bringeth to and for the commonwealth a new manufacture by his invention, costs, and charges, and therefore it is reason that he should have a privilege for his reward (and the encouragement of the like) for a convenient time."

it was necessary that the plaintiff should prove that his invention was useful.

In *Huddart v. Grimshaw*, (1803) Dav. P. C. 265, *Ellenborough, C.J.*, held that in order to support the patent the invention ought to be beneficial to the public.

In *Brunton v. Hawkes*, (1820) 4 B. & Ald. 541, *Abbott, C.J.*, put it to the jury to say whether the invention was useful. And in *Russell v. Cowley*, 1 W. P. C. 459, *Lyndhurst, C.B.*, said that the first question respecting the invention was whether it was new and useful; and the rest of the Court concurred in this statement.

In *Hill v. Thompson*, (1817) 1 W. P. C. 235, *Eldon, L.C.*, concurred in the direction of *Dallas, J.*, to the jury who tried the case in the Court of Common Pleas, that the invention to support a patent must be useful. And in *Minter v. Wells*, 1 W. P. C. 129, *Alderson, B.*, stated the same fact. And again, in *Morgan v. Seaward*, 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 170, the same learned Judge said, that if the invention was useful it was a subject to be protected by patent; but if it was of no use then it was not a subject to be protected by patent.

In *Neilson v. Harford*, (1841) 8 M. & W. 806; 1 W. P. C. 331, the Court of Exchequer held that a machine produced according to the invention must be beneficial to the public in order that the patent may be valid.

(l) p. 1 ante.

(m) s. 6.

Utility at
Common
Law.

Parke, B.,⁽ⁿ⁾ assigned as the reason why the law requires an invention to be useful in order to merit protection by patent, "that a grant of a monopoly for an invention which is altogether useless may well be considered as 'mischievous to the State, to the hurt of trade, or generally inconvenient,' within the meaning of the Statute of Jac. I., which requires, as a condition of the patent, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly without obliging the person making use of it to purchase the useless invention."

Patents only
used for pur-
pose of ob-
structing
improvements
are void.

On a review of the cases it may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question whether the patent be void under the Statute of Monopolies. So where the evidence showed^(o) that the patent, the subject of the action, had never been worked, and no attempt had been made to bring the articles, manufactured according to the method stated in the specification, before the public, and that the patent was only being used for the purpose of stopping the defendant from making improvements in the manufacture of candles, *Pollock, C.B.*, said that in legal language it is a fraud on the law of patents for any person to take out a patent with a view to the obstruction of improvements. And again, the same learned Judge in another case^(p) held that a patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind and the introduction of other inventions adapted to the particular subject to which the invention may be applicable, could not in his judgment be supported.

It is to be remembered that not every useful novelty is patentable. To be patentable the novelty, besides being useful, must be the outcome of inventive ingenuity.^(q)

It is not necessary that the invention should be actually put in practice, and the articles produced by its exercise sold, in order that the requisite utility in the invention to merit protection by letters patent may be established; it is quite sufficient if there is evidence to the effect that the invention, if put in practice, would produce useful results.^(r)

⁽ⁿ⁾ *Morgan v. Seaward*, (1836) 1 W. P. C. 197.

^(o) *Palmer v. Wagstaff*, (1853) Newton, L.J., vol. xliii. p. 131.

^(p) *Crossley v. Potter*, (1853) Macr. P. C. 240.

^(q) *Brook v. Aston*, (1857) 8 Ell. & B. 478; *Ralston v. Smith*, (1865) 11 H. L. C. 223; *Rickmann v. Thierry*, (1896) 14 R. P. C. 185; p. 95 *ante*.

^(r) *Otto v. Linford*, (1881) 46 L. T. N. S. 39; *United Telephone Co. v.*

MEANING OF UTILITY IN LAW.

Meaning
of Utility
in Law.

The kind of utility which the law requires that an invention must possess to make it fit subject-matter for a patent is not abstract utility.

Utility does not mean abstract utility;

In a case in which the validity of a patent for improvements in the manufacture of stays and corsets was questioned, on the ground that the invention was not useful, *Grove, J.*, directed the jury that, though they might be of opinion that stays are very bad things in themselves, they ought not to say that the invention was useless for that reason, for utility in law means "an invention better than the preceding knowledge of the trade as to a particular fabric."^(s)

This definition given by *Grove, J.*, requires some modification, for it may well be that a person might produce a new article not so good as the best of its kind, but still *good* and readily sold because it is cheaper. It is submitted that an article which is *good* and cheaper, by reason of its manufacture, than an intrinsically *better* prior article may be sufficiently useful to support a patent on the ground of utility. Further, it is no objection to a patent on the ground of want of utility, provided the thing is useful for the purpose for which the patentee intends it, to point out that it has not come into general use because something else more recent has been preferred. Comparative utility in this sense has nothing to do with it so long as the thing is useful for the purpose intended.^(t) It would appear that an "invention" is useful in the eye of the law when the public are thereby enabled to do something which they could not do before, or to do something which they could do before, but in a more advantageous manner; provided always that the thing in question is not contrary to the law, nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient.

or necessarily an improvement from all points of view.

When the validity of a patent is put in issue, in an action at law, on the ground of inutility, it is not necessary, for the purpose of supporting the patent, to establish that the invention is *commercially* useful. The reason why it has not been adopted in commerce may be that it has been immediately superseded

Commercial utility.

Bassano, (1886) 3 R. P. C. 313; Ehrlich v. Ihlee, (1888) 5 R. P. C. 450; Edison v. Holland, (1889) 6 R. P. C. 277.

^(s) Young v. Rosenthal, (1884) 1 R. P. C. 34, 41; see also Manton v. Par-

ker, (1815) Dav. P. C. 327; 1 W. P. C. 192 n.; Manton v. Manton, (1815) Dav. P. C. 348; 1 W. P. C. 192 n.; 1 Carp. P. C. 278.

^(t) Fawcett v. Horman, (1896) 13 R. P. C. 405.

Invention
must be
Useful as
Specified.

by simpler and better or cheaper constructions, involving the same principle.^(u) There is in fact no necessary relationship between the commercial pecuniary success of an invention and its utility in patent law.^(x) The circumstance that an invention has not come into general use merely raises a strong presumption against its utility,^(y) and commercial success is not necessarily evidence that the subject-matter of the patent, though useful, is the outcome of *invention* sufficient to support the patent.^(z)

An alleged invention which differs from a prior invention only in that it contains an ingredient which does neither good nor harm does not possess sufficient utility to merit a patent.^(a)

INVENTION MUST BE USEFUL AS SPECIFIED.

Invention is
useless unless
it does what
the patentee
states it will
do.

The patent will be void unless the invention be useful exactly as it is specified by the patentee, notwithstanding that it may be useful in a modified form.^(b) In other words, the question always is, Does the invention really do, when put in practice by a competent man, what it assumes to do? And unless the public are enabled to do what the inventor says they can do by means of his invention—*i.e.*, the invention is useful for the purpose for which the inventor intended it—the patent is void.^(c)

The fact that one mode of carrying out the invention described by the patentee in his specification is preferable to, and more useful than, other modes described, all being useful, is no objection to the patent.^(d) When an invention does what it is intended by the patentee to do, and the end attained is itself useful, the invention is a useful one. A patent for such an invention is not to be held bad for want of utility, by comparing it with other known methods or things which may be preferred

^(u) Galloway's Patent, (1843) 1 W. P. C. 724; Bovill v. Moore, (1815) Dav. P. C. 361; Otto v. Linford, (1881) 46 L. T. N. S. 41; United Telephone Co. v. Bassano, (1886) 3 R. P. C. 313; Ehrlich v. Ihlee, (1888) 5 R. P. C. 450; Edison v. Holland, (1889) 6 R. P. C. 277; Wilson v. Union Oil Mills, (1891) 9 R. P. C. 70.

^(x) Badische Anilin und Soda Fabrik v. Levinstein, (1887) L. R. 12 App. Cas. 712; Ehrlich v. Ihlee, (1888) 5 R. P. C. 450; Kurtz v. Spence, (1887) 5 R. P. C. 182; Fawcett v. Homan, (1896) 13 R. P. C. 274.

^(y) Morgan v. Seaward, (1837) 1 W. P. C. 185; Tetley v. Easton, (1852) Macr. P. C. 56.

^(z) p. 95 *ante*: Fawcett v. Homan, (1896) 13 R. P. C. 274.

^(a) Lawrence v. Perry, (1885) 2 R. P. C. 184.

^(b) Tolson v. Speight, (1896) 13 R. P. C. 718.

^(c) Cornish v. Keene, (1835) 1 W. P. C. 507; Morgan v. Seaward, (1837) 1 W. P. C. 185; Easterbrook v. Great Western Ry. Co., (1885) 2 R. P. C. 210; 3 R. P. C. 94; Badische Anilin und Soda Fabrik v. Levinstein, (1887) 4 R. P. C. 462; L. R. 12 App. Cas. 712, 719, 720; Wilson v. Union Oil Mills, (1892) 9 R. P. C. 70; Fawcett v. Homan, (1896) 13 R. P. C. 268.

^(d) Miller v. Searle, (1893) 10 R. P. C. 106.

to it. An invention may be useful, although, owing to other circumstances, the public will not use it; but if they do use it no better proof of utility can be had,^(e) and the fact that a defendant has attempted to infringe a patent is most cogent evidence as to its utility.^(f)

Invention
must be
Useful as
Specified.

Upon the point that an invention must be useful, as specified, and for the purpose for which it is stated by the patentee to be useful, the following passage from the judgment of *Lindley, L.J.*, in *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co., Ltd.*,^(g) with reference to the facts of that case, may be quoted with advantage:—

Per Lindley,
L.J.

“The utility of the alleged invention depends, not on whether by following the directions in the complete specification all the results necessary for commercial success can be obtained, but on whether by such directions the effects which the patentee professed to produce could be produced, and on the practical utility of those effects. Can it be said that the invention, as described in the amended specification, was, in 1878, a practically useful addition to the then stock of inventions? To judge of utility the directions in the amended specification must be followed, and if the result is that the object sought to be attained by the patentee can be attained, and is practically useful at the time when the patent is granted, the test of utility is satisfied. Utility is often a question of degree, and always has reference to some object. ‘Useful for what?’ is a question which must be always asked, and the answer must be, ‘Useful for the purposes indicated by the patentee.’ See, per Lord Chief Justice *Tindal* in *Cornish v. Keene*, 1 W. P. C. on p. 507; *Edison v. Holland*, 6 R. P. C. 243; *Badische Anilin Fabrik v. Levinstein*, 12 App. Cas. on pp. 712, 719, 720. An invention may be useful as indicating the direction in which further progress is to be expected, and yet that same invention may be useless for any other purpose; useless, that is, as an invention without further developments and improvements which have not occurred to the patentee. This is, in my opinion, the real truth with respect to the plaintiff’s invention as now claimed by him. He made a distinct and important step in advance. The plaintiff was the pioneer; he showed others the road to be followed, but he did not give the traveller the information necessary to enable him to travel on it. There were difficulties to be overcome which the patentee did not foresee, and against which he naturally made no provision. There is an enormous

(e) *Fawcett v. Homan*, (1896) 13 R. P. C. 405. C. 155; *Miller v. Barker*, (1893) 10 R. P. C. 111.
(f) *Lucas v. Miller*, (1885) 2 R. P. C. (g) (1892) 9 R. P. C. 417.

Amount of
Utility.
Lack of
Utility in
Essential
Part.

mass of conflicting evidence upon the possibility of obtaining practically useful results by following the directions contained in his specification. Much of the evidence adduced against the patentee merely goes to show that by following the directions in the specification you cannot produce such good results as are produced by the defendants. This obviously is wholly immaterial. . . . I have studied the whole evidence with all the care I can bestow upon it, and have come to the conclusion that the plaintiff had not in 1878 invented what he now says he had—namely, a practical method of keeping the electro-motive force in the mains constant at about 100 volts by means of secondary batteries and dynamos used simultaneously as described.”

AMOUNT OF UTILITY.

Slight amount
of utility is
sufficient to
support a
patent.

The law does not require that an invention, to be worthy of a patent, must possess any definite amount of utility; but it has been decided, over and over again, that a very slight amount of utility will be sufficient^(h) provided that the Crown has not been deceived as to the extent of the utility of the invention.⁽ⁱ⁾ Thus, when the validity of *Galloway's* patent for improvements in steam-engines came into question, *Alderson*, B., told the jury, with regard to the utility of the invention, that the question for them to decide was, whether the steam-engine was a useful invention, and that he thought, if *Galloway's* engine was of a different construction from any other steam-engine, and of any use to the public, that was sufficient.^(k)

LACK OF UTILITY IN ESSENTIAL PART.

Lack of utility
in an essential
part is fatal.

If any material part of the representation, with regard to utility, upon the strength of which a patent was granted, turns out to be untrue, the patent will be void, because of the partial failure of the consideration,^(l) and also on the ground that the representation being false, the Crown has been deceived in its grant.^(m) In the words of *Dallas*, J.: “If any part of the alleged discovery, being a material part, fail (the

^(h) *Philpot v. Hanbury*, (1895) 2 P. O. R. 37; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 582; *Otto v. Linford*, (1881) 46 L. T. N. S. 35; *Scott v. Hamling & Co.*, (1897) 14 R. P. C. 123.

⁽ⁱ⁾ *Pirrie v. York Street Flax Spinning Co.*, (1893) 10 R. P. C. 39; 11 R. P. C. 429.

^(k) *Morgan v. Seaward*, (1836) 1 W. P. C. 172, 186.

^(l) *Hill v. Thompson*, (1817) 8 Taunt. 375; 2 B. Moore, 448; 1 W. P. C. 232; *Bloxam v. Elsee*, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93; *United Horseshoe and Nail Co. v. Swedish Horsenail Co.*, (1889) 6 R. P. C. 8.

^(m) *Morgan v. Seaward*, (1836) 2 M. & W. 561; 1 W. P. C. 172.

discovery in its entirety forming one entire consideration) the patent is altogether void.”(n)

Lack of
Utility in
Essential
Part.

Illustrations.

Thus, in the case of *Manton v. Parker*, 1815,(o) the whole purpose for which the invention, in the specification, was said to be useful, failed, and the patent was declared to be consequently void. The invention was “for a hammer on an improved construction, for the locks of all kinds of fowling-pieces and small arms,” and a material part of the invention consisted in a means of letting out the air from the barrel and causing a communication between the powder in the pan and in the barrel. The evidence, however, showed that the powder passed through the same hole as the air; and *Thomson*, L.C.B., held that the utility of the invention, and the purpose of the hole, as described in the specification, wholly failed; for the purpose of the hole as described was to let the air pass through, and, at the same time, secure the powder from passing through.

Again, in *Easterbrook v. The Great Western Railway Company*,(p) the main object of an invention of “improvements in machinery and apparatus for actuating and controlling railway points and signals” was to prevent points and signals being set antagonistic to each other. The defendants, who set up the invalidity of the patent, upon the ground (*inter alia*) of absence of utility in the invention, proved at the trial that the apparatus could be so worked as to give conflicting signals, or signals conflicting with the points. The Court held that the patent was bad, because the invention was not only not useful, but dangerous.

If a patentee claims several inventions under different heads, and it turns out that any one of them, which is essential, is useless, the patent is void.(q)

In *Turner v. Winter*(r) the plaintiff’s patent was declared void, on the ground that it claimed to produce three different things by one and the same process; and the evidence distinctly showed that the process would not produce one of them (white lead) at all. On a motion for a new trial, made in the Court of King’s Bench, *Ashurst*, J., laid down that: “If the process, as directed by the specification, does not produce that which the patent professes to do, the patent is void.” And *Buller*, J.: “If the patentee says that by one process he can produce three

(n) *Hill v. Thompson*, (1817) 8 Taunt. 375; 2 B. Moore, 448.

(o) Dav. P. C. 327; 1 W. P. C. 192 n., 484 n.

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

(q) *Morgan v. Seaward*, (1836) 1 W. P. C. 171; 2 M. & W. 558; *Simpson*

v. Holliday, (1866) L. R. 1 H. L. 315; *Templeton v. Macfarlane*, (1848) 1 H.

L. C. 595; *United Horsenail Co. v. Stewart*, (1885) 2 R. P. C. 122, 132.

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

Lack of
Utility in
Essential
Part.

Illustrations.

things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant."

Bloxam v. Elsec(s) was an action brought for the infringement of two patents belonging to the plaintiff. Both patents were, however, held void on the ground that the second depended on the first, which was bad for want of utility. The judgment of *Abbott, C.J.*, who tried the case, was to the effect that by the patent (the first patent) it appeared that the patentee had represented to the Crown that 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.(t)

(s) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

(t) *Morgan v. Seaward*, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187.

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 improvements 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.

Lack of Utility in Essential Part.

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 necessarily vitiate the patent.

If invention is useful for most purposes stated, the fact that it fails for one purpose within the statement is not necessarily fatal.

Thus, in *Haworth v. Hardcastle* (u) 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*, *Gaslee*, 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,(x) and a minor claim the subject of which is found not to be useful will not be fatal, provided there is no concealment.(y)

Lack of utility in non-essential part is no bar.

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

Each essential part is not required to be equally useful.

A patent is void if an essential part of the invention is impracticable and useless,(a) but if part of an invention, as described in a specification, turn out not to be necessary, the

(u) (1834) 4 M. & Sc. 720; 1 Bing. N. S. 182; 1 W. C. P. 480.

(x) *Morgan v. Seaward*, (1837) 2 M. & W. 544; *Mur. & H.* 55; 1 *Jur.* 527; 1 W. P. C. 187; *Lewis v. Marling*, (1829) 1 W. P. C. 490; *United Horsenail Co. v. Stewart*, (1885) 2 R. P. C. 122, 131.

(y) *United Horseshoe Co. v. Swedish Horsenail Co.*, (1888) 6 R. P. C. 1; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 450.

(z) *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 103.

(a) *United Horsenail Co. v. Stewart*, (1885) 2 R. P. C. 122, 132.

Utility of
Improvements.

inutility of that part will not vitiate the patent unless it is claimed as *essential*.^(b)

In *Lewis v. Marling*,^(c) the patent was for improvements 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 plaintiffs 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."

UTILITY OF IMPROVEMENTS.

Lack of utility in a prior invention is no bar to a patent for an improvement upon it.

In the case of a patent for an invention which is an improvement on a former invention, the want of utility in the

^(b) *Lewis v. Marling*, (1829) 10 B. & C. 22; 1 W. P. C. 493; *Morgan v. Seaward*, (1837) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153; *United*

Horsenail Co. v. Stewart, (1885) 2 R. P. C. 132.

^(c) (1829) 10 B. & C. 22; 4 Car. & P. 57; 1 W. P. C. 493.

former invention will not vitiate the patent for the improvement, which will be perfectly valid as regards utility, if the machine manufactured according to it is useful.(d)

Utility of
Improvements.

Bloxam v. Elsec (e) at first sight appears to be a decision contrary to the above proposition, but it must be observed that *Bloxam v. Elsec* 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.

(d) *Lewis v. Davies*, (1829) 3 Car. & P. 502; 1 W. P. C. 488; per Lord Tenterden, C.J.; *Tetley v. Easton*, (1852) Macr. P. C. 56; *Murray v. Clayton*, (1877) L. R. 7 Ch. 581; *Morgan v. Windover*, (1888) 5 R. P.

C. 303; *Jones v. Pearce*, (1832) 1 W. P. C. 121, 122; *Shaw v. Jones*, 6 P. O. R. 336.

(e) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93; see p. 148 *ante*.

CHAPTER V.

THE SPECIFICATIONS.

ORIGIN AND DEVELOPMENT.

Historical.

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 and the best means of performing it 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 the patent may be considered substantially as amounting to a bargain between the patentee and the Crown, according to which 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 monopoly is granted all may alike enjoy the benefits of the discovery, if minded to do so.^(a)

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, 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 is to be performed," and in inserting in the letters patent a declaration that an omission to do this

(a) p. 93 *ante*.

would render the grant null and void. This was the origin of the modern instruments known as specifications. Before this period of six months had elapsed, there being no provisional 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 and
Develop-
ment.
—

The Patent Act of 1852 introduced a further improvement by providing that would-be patentees should, at the time of application for letters patent, deposit a provisional specification, which is a very different instrument to that required after the grant under the earlier 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 the Act 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.

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 before filing his second and complete specification, in which he was required not only to "describe the nature of the 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.

The practice in this matter under the Patents, Designs, and Trade Marks Act, 1883, is practically the same as that under

(b) *Bailey v. Roberton*, (1878) 3 App. Cas. 1074, per Lord Blackburn.

The Title. the Act of 1852, excepting that the leaving of a complete specification is now always a condition precedent to the grant of a patent; and 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 TITLE.

Titles should be drafted in conformity with certain rules.

A specification, whether provisional or complete, must commence with the title,^(d) which is virtually a short and concise statement of the invention.^(e) Before the days of provisional specifications the title was of far greater importance than it is now. In those days its functions were largely those of the provisional specifications now, and a discrepancy between the title and the specification subsequently enrolled was a matter of vital importance, as it rendered the patent utterly void.

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 sixth 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. There is, in fact, no reported case since the Act of 1883 in which a patent has been declared void on the ground of a defective title, and there appears to be only one^(f) in which the question has been raised. Still, if the title after it has passed the examiner, or after amendment, remains defective, it may be an 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.

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

^(d) 46 & 47 Vict. c. 57, s. 5, sub-s. 5.

^(e) *Househill Co. v. Neilson*, (1843) 1 W. P. C. 678.

^(f) *Pirrie v. York Street Spinning Co.*, (1892) 10 R. P. C. 34.

The specification is to be construed as a whole, and a defect in the title may consequently be remedied in the body of the specification.^(g) Further, a patentee is entitled to frame the title in his own way, provided he does not infringe the rules of the statute.^(h) The Title.
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It is not uncommon for the Comptroller-General, or, on appeal from him, the law officer, to make the amendment of titles as originally drafted a condition of the grant of letters patent.⁽ⁱ⁾

Titles should be drafted in conformity with the following rules. As inferred above, the cases quoted in support of the rules were all decided before the Act of 1883, but under the present practice, assuming that the provision in the Act of 1883 for reference to an examiner has not removed the objection of defective title against a patent which has been accepted by the examiner,^(k) in the event of a title being defective, the principles of these cases would still apply; and the authorities at the Patent Office require titles to conform to the rules hereafter stated. Of course it is a question of fact in each instance whether the title is at variance with any one or more of the rules under consideration.

Rules in conformity with which titles should be drafted.

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.*

Thus, in *Cochrane v. Smethurst*,^(l) 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.^(m) And in *Felton v. Greaves*,⁽ⁿ⁾ 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

^(g) p. 247 *post.*

⁽ⁱ⁾ p. 294 *post.*

^(l) (1816) 2 Coop. Ch. Cas. 57; 1 Stark. R. 205.

^(m) See remarks of Tindal, C.J., *Cook v. Pearce*, (1844) 8 Q. B. 1054, 1062; 13 L. J. Q. B. 189.

^(h) *Brown's Patent*, (1887) Griff. L. O. C. 1.

^(k) See p. 154 *ante*; cf. 260 *post.*

⁽ⁿ⁾ (1829) 3 Car. & P. 611.

The Title.

Rules in conformity with which titles should be drafted.

edge to scissors, the patent was held to be bad for want of sufficiency.

In *Campion v. Benyon* (o) 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 sailcloth 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 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."

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

(o) (1821) 6 B. Moo. 71: 3 Brod. & Bing. 5.

patent, the objection being merely to the title of the patent, without fraud upon the Crown or detriment to the public." (p) The Title.

—
Rules in conformity with which titles should be drafted.

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.(q)

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

Thus, in *Croll v. Edge*,(r) 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.

In *Oxley v. Holden*,(s) 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

(p) *Nickels v. Haslam*, (1844) 7 M. & G. 378; 8 Scott, N. R. 97; 13 L. J. C. P. 146.

(q) *Derosne v. Fairie*, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476; 1 W.P. C. 154.

(r) (1847) 9 C. B. 479; 19 L. J. C. P. 261.

(s) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

The Title.

Rules in conformity with which titles should be drafted.

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*, (1847) 9 C. B. 479; 19 L. J. C. P. 261, where the patent was, in effect, for improvements in the apparatus for the manufacture, and also in that of the transmission, of 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."

III. *The title should not be vague or ambiguous.*

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,^(t) 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.^(u)

Thus, in *Sturz v. De la Rue* ^(x) 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.

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

IV. *The title should not contain a misdescription of the invention, for this may be a fatal objection if not corrected in the body of the specification.*

In *Rex v. Metcalf*,^(z) 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.^(a)

In *Bainbridge v. Wrigley*,^(b) Lord *Ellenborough* held a patent void which was for "certain improvements in the flageolet or

(t) Chap. vii.

(u) *Cook v. Pearce*, (1844) 8 Q. B. 1044; 13 L. J. Q. B. 189.

(x) (1828) 5 Russ. 322; 7 L. J. (O. S.) Ch. 47.

(y) (1841) 1 W. P. C. 295; 8 M. &

W. 806; 2 Coop. Ch. Cas. 61; 11 L. J. Ex. 20.

(z) (1817) 2 Stark. R. 249.

(a) See also *Neilson v. Harford*, (1841) 1 W. P. C. 333.

(b) (1810) Parl. Rep. 197.

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.

The Title.

Rules in conformity with which titles should be drafted.

In *Fisher v. Dewick* (c) the title of the patent in question was "improvements in machinery for the manufacture of 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 may be fatal to the validity of the patent, for the Crown may have been deceived in its grant.*

Thus, in *Morgan v. Seaward*, (d) 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.

In *Bloxam v. Elsec* (e) 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.

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

(c) (1838) 4 Bing. N. C. 706.

(d) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.

(e) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

The Title. method or process be entirely new, it may properly be called a new or improved method or process ; (*f*) whereas, if the method or process be not new, but improved, the patent with such a title will be bad. (*g*)

Rules in conformity with which titles should be drafted.

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.*

In *Hill v. The London Gas Light Company*, (*h*) 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.” (*i*)

In *The Electric Telegraph Company v. Brett*, (*k*) the defendant objected that the plaintiffs’ patent being described in the title as an “Invention of improvements in giving signals and sounding alarms 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 :

(*f*) *Beard v. Egerton*, (1846) 2 Car. & K. 667 ; 3 C. B. 97 ; 8 C. B. 165 ; 15 L. J. C. P. 270 ; 19 L. J. C. P. 36.

(*g*) *Gibson v. Brand*, (1842) 1 W. P. C. 634.

(*h*) (1860) 29 L. J. Ex. 409 ; 5 H. & N. 312.

(*i*) See also *Regina v. Mill*, (1851) 10 C. B. 389 ; 14 Beav. 312 ; 20 L. J. C. P. 16.

(*k*) (1851) 10 C. B. 838 ; 20 L. J. C. P. 123.

“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 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.”

Pro-
visional
Specifica-
tion.

THE PROVISIONAL SPECIFICATION.

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 between 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 ultimately filing a complete specification imposes upon him.

Provisional
specification
is optional.

Functions of Provisional Specifications.—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

Differences
between pro-
visional and
complete
specifications.

(l) 46 & 47 Vict. c. 57, s. 5, sub-s. 2; for forms of provisional and complete specification, see P. R. 1890, Form B. and Form C; p. 292 *post*.

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

Pro-
visional
Specifica-
tion.

Object of pro-
visional speci-
fication is to
avoid disputes
thereafter as
to what the
invention is
for which the
monopoly was
granted.

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; nor was it intended to contain a complete description of the discovery such as would enable a skilled person, and, therefore, much less a workman of mere 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 protection 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)

In cases of subsequent dispute the question is not whether the provisional specification is defective, but whether the complete specification is excessive.^(r) The provisional may go beyond the complete, and anything contained in the provisional may be dropped in the complete, provided the omission does not alter the nature of the invention.^(s)

There is the authority of Lord *Chelmsford*, L.C.,^(t) for the statement that "it is 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."

Further, as pointed out by *Lopes*, L.J.,^(u) a provisional

⁽ⁿ⁾ *Re Newall & Elliott*, (1858) 4 C. B. N. S. 269; 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; *Penn v. Bibby*, (1875) L. R. 2 Ch. 127, 132; *Lucas v. Miller*, (1885) 2 R. P. C. 155; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 241; *Morgan v. Windover*, (1887) 4 R. P. C. 422; 5 R. P. C. 295.

^(o) *Stoner v. Todd*, (1874) L. R. 4 Ch. D. 58; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; *Nuttall v. Hargreaves*, (1892) 8 R. P. C. 450; L. R. 1 Ch. 94; 6 L. J. Ch. 94.

^(p) *Stoner v. Todd*, (1874) L. R. 4 Ch. D. 58; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 718,

747; *Woodward v. Sansum*, (1887) 4 R. P. C. 166, 174; *Siddell v. Vickers*, (1888) L. R. 39 Ch. D. 92.

^(q) *Newall v. Elliot*, (1863) 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; 4 C. B. N. S. 269.

^(r) *Siddell v. Vickers*, (1888) L. R. 39 Ch. D. 92, 97; *Curtis v. Platt*, (1888) Griff. L. O. C. 53; 5 R. P. C. 87 n.

^(s) *Penn v. Bibby*, (1866) L. R. 2 Ch. 127; 36 L. J. Ch. 455; p. 166. *post.*

^(t) *Penn v. Bibby*, (1875) L. R. 2 Ch. 127.

^(u) *Woodward v. Sansum*, (1887) 4 R. P. C. 166.

specification was never intended to contain a complete and exhaustive description of the invention ; it was intended to be sufficiently specific to disclose the nature of the invention, so as to protect the inventor till the time for filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within what may be called the ambit of his invention as disclosed in his provisional specification.

Pro-
visional
Specifica-
tion.

And as observed by *Smith, L.J.*,^(x) " In a provisional specification no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out the invention ; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter with that of the complete specification which is to come thereafter may be ascertained."

Thus, 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.^(y)

It is not, however, necessary that all the details of the invention described in the final should be identical with those indicated in the provisional specification, provided that the invention remain substantially the same. The complete specification is, in a sense, supplemental to the provisional, 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 period of provisional protection, as to the manner in which the invention is to be performed.^(z)

Details stated
in the com-
plete may
differ from
those stated
in the pro-
visional,

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 ; 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.^(a)

or subordinate
matters may be
abandoned ;

(x) *The Cassel Gold Extracting Co. v. The Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 257.

(y) *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1055 ; *Crossley v. Potter*, (1853) Macr. P. C. 240.

(z) *Per Chelmsford, L.C.*, *Penn v. Bibby*, (1875) L. R. 2 Ch. 127.

(a) *Stoner v. Todd*, (1876) L. R. 4

Ch. D. 58 ; 46 L. J. Ch. 32 ; *Hutchinson v. Pattullo*, (1888) 5 R. P. C. 351 ; *Thomas v. Welch*, (1866) L. R. 1 C. P. 192 ; *Penn v. Bibby*, (1875) L. R. 2 Ch. 127, 134 ; *Everitt's Patent*, (1888) Griff. L. O. C. 27 ; *Pneumatic Tyre Co. v. East London Rubber Co.*, (1896) 14 R. P. C. 77, 573.

Pro-
visional
Specifica-
tion.

In *Thomas v. Welch* (b) 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 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.'"

but the pro-
visional cannot
be read to
supply an
omission in
the complete
specification.

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.

Thus, in *Mackelcan v. Rennie*,(c) 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." 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

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

(c) (1862) 13 C. B. N. S. 52.

mention of iron in the complete specification, *Erle*, C.J., held that the provisional specification could not be produced in aid for the purpose of supplying a defect 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.

Pro-
visional
Protection.

It must not be forgotten that a provisional, like a complete, specification, must be accompanied by drawings, if required; (d) 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.

Drawings may
be necessary.

Provisional Protection.—The Act of 1883 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. (e)

Provisional
protection is
limited to con-
sequences of
publication.

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. (f) It does not confer on the patentee 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. (g)

The effect of filing the provisional specification is therefore to secure nine months provisional protection, (h) 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

(d) 46 & 47 Vict. c. 57, s. 5, sub-s. 3.

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

(f) *Ex parte* Bates and Redgate, (1876) L. R. 4 Ch. 577.

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

(h) 46 & 47 Vict. c. 57, s. 8.

Variations
between
the Speci-
fications.

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 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 protection, as to the manner in which the invention is to be performed.⁽ⁱ⁾

The letters patent when granted bear date as of the day of application—*i.e.*, the date of the provisional specification in cases where the applicant avails himself of the advantages of filing a provisional specification.^(k)

VARIATIONS BETWEEN THE SPECIFICATIONS.

What are
legitimate
developments.

Legitimate Developments of the Invention.—If the complete specification, filed as it must be after the provisional, 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.^(l)

Lord *Blackburn*,^(m) commenting on the effect of experiments and developments 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 pro-

⁽ⁱ⁾ 46 & 47 Vict. c. 57, s. 8; p. 153 *ante*.

^(k) See p. 331 *post*.

^(l) *Watling v. Stevens*, (1886) 3 R. P. C. 151; *Newall v. Elliott*, (1863) 10 Jur. N. S. 955; 4 C. B. N. S. 269;

Foxwell v. Bostock, (1863) 4 De G. J. & S. 298; *Siddell v. Vickers*, (1888) L. R. 39 Ch. D. 92; 5 P. O. R. 81, 416.

^(m) *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1074.

visional 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 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 [*sic*, further] invention that is described in the other.⁽ⁿ⁾

Variations
between
the Speci-
fications.
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It will be seen hereafter (*o*) 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.^(p)

Improvements
in details.

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.^(q) The reason of this is that the patentee is bound to describe the

Better and
different
methods.

⁽ⁿ⁾ See also *Crampton v. Patents Investments Co.*, (1888) 5 R. P. C. 382, 393; *Siddell v. Vickers*, (1888) 5 R. P. C. 81, 426; *Woodward v. Sansum*, (1887) 4 R. P. C. 178.

^(o) Chap. vi.

^(p) *Per Lopes, L.J., Woodward v. Sansum*, (1877) 4 R. P. C. 178.

^(q) *Woodward v. Sansum*, (1887) 4 R. P. C. 175; *Lucas v. Miller*, (1885) 2 R. P. C. 155; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 241; *Morgan v. Windover*, (1887) 4 R. P. C. 422; 5 R. P. C. 295.

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fications.

best and latest method known to him of carrying out the invention.^(r) It is not only his privilege, but his duty to do this, for the object of the complete specification, whether filed with the application or subsequently, is to tell the public how the invention is to be best carried out. "That is the price which the man who wants to be a patentee has to pay to the public for it."^(s)

Legitimate
development
always a pure
question of
fact.

It is always a question of fact, to be determined with reference to the peculiar circumstances of each case, whether, when the complete specification differs from the provisional, the difference is merely a legitimate development and improvement made during the period of provisional protection, upon the invention foreshadowed by the provisional. Therefore, one case, though it may be a guide, is no authority for the decision of another case. In the note ^(t) at the foot of the page reference will be found to some important cases in which variations between the complete and provisional specifications have been held, upon the facts, to be merely legitimate developments and improvements.

Disconformity
is a fatal ob-
jection to
validity.

Disconformity.—The provisional specification, as appears from the foregoing pages, must contain a description of 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.^(u)

This is expressed in the phraseology of modern practitioners

^(r) p. 208 *post*.

^(s) Per Lord Field, then Field, J., *Crampton v. The Patents Investment Co.*, (1888) 5 R. P. C. 382; see 6 R. P. C. 287.

^(t) *Newall v. Elliott*, (1858) 4 C. B. N. S. 269; 27 L. J. Ch. 337; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; *Penn v. Bibby*, (1866) L. R. 2 Ch. 127, 135; 36 L. J. Ch. 455; *Lucas v. Miller*, (1885) 2 R. P. C. 155; *Watling v. Stevens*, (1886) 3 R. P. C. 37; *Horrocks v. Stubbs*, (1886) 3 R. P. C. 221; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 241; *Garland and Gibbs' Patent*, (1888) 5 R. P. C. 533; *Crampton v. The Patent Investments Co.*, (1889) 6

R. P. C. 294; *King, Brodie & Co. v. Anglo-American Brush Corporation*, (1889) 6 R. P. C. 414; 9 R. P. C. 313; *Gadd v. Mayor of Manchester*, (1892) 9 R. P. C. 516; *Miller v. Searle*, (1893) 10 R. P. C. 106; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 232, 257; *Pneumatic Tyre Co. v. East London Rubber Co.*, (1896) 14 R. P. C. 77; *Automatic Coal Gas Retort Co. v. The Mayor, &c., of Salford*, (1897) 14 R. P. C. 450; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 853.

^(u) *Foxwell v. Bostock*, (1863) 4 De G. J. & S. 298.

by saying that there must not be a disconformity between the specifications. Variations
between
the Speci-
fications.
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Ever since the Patent Act of 1852, which first introduced provisional specifications, disconformity has been held to be a fatal objection to the validity of a patent. It was at one time urged by some that the operation of sec. 9 of the Act of 1883^(x) which casts upon the Comptroller-General the duty of ascertaining whether the invention particularly described in the complete specification is substantially the same as that described in the provisional, was to render disconformity no longer an objection to the validity of the patent. This, however, is not so, for sec. 26 of the Act of 1883, which abolishes the proceeding by *scire facias* to repeal a patent, provides that "every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias*, shall be available by way of defence to an action of infringement, and shall be a ground of revocation." Disconformity was one of the grounds on which a patent could be repealed by *scire facias* before the Act of 1883,^(y) and therefore it is still fatal to the validity of a patent, and, as such, a defence to an action for infringement, and a ground on which a patent may be revoked on petition for revocation.^(z)

The point has been decided substantially as above stated by the Court of Appeal, but it has not yet called for a direct decision of the House of Lords, though a dictum of Lord *Halsbury*, L.C., supports the conclusion of the Court of Appeal.^(a)

If a specification is amended ^{Disconformity} ^{between an} ^{amended} ^{complete and} ^{a provisional} ^{specification.} ^(b) and there is a disconformity between the complete and provisional specifications as they stand after amendment, the objection is still fatal.^(c) An amended claim, however, when once allowed, even if it is for an invention substantially larger than or different to the invention originally claimed by the complete specification, will not vitiate the patent, provided that the invention comprised by the amended claim is to be found fairly foreshadowed and described within the provisional specification.^(d)

In arriving at a conclusion as to the question of fact, Method of

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

(y) *Bailey v. Robertson*, (1873) L. R. 3 App. Cas. 1055.

(z) See *Nuttall v. Hargreaves*, (1891) 8 R. P. C. 450; *Vickers v. Siddell*, (1890) 7 R. P. C. 292.

(a) See *Vickers v. Siddell*, (1890) 7 R. P. C. 292.

(b) See chap. vi. *post*.

(c) *Lane Fox v. Kensington and Knightsbridge Electric Lighting Company*, (1892) 9 R. P. C. 221, 413.

(d) See *Moser v. Marsden*, (1895) 13 R. P. C. 24; p. 260 *post*.

Variations
between
the Speci-
fications.

—
deciding ques-
tions of fact as
to discon-
formity.

whether in any particular instance there is a disconformity between two specifications, or is the alleged excess in the complete merely a legitimate development of the invention described in the provisional, it is well to consider separately the two questions: (1) What is the nature of the invention for which the patentee has obtained provisional protection—*i.e.*, what is the nature of the invention described in the provisional specification? (2) Is what is described in the complete specification an invention of a different nature from that described in the provisional? (*e*)

Thus, in a case where the proportions of the ingredients used in a process was not of the essence of the invention, and the complete specification stated and made a separate claim to definite suitable proportions, but the provisional did not refer to any specific proportion of the ingredients, the Court of Appeal held that there was no disconformity, since the proportions used in the process were not of the essence of the invention, and the real invention described in each specification was the same. (*f*)

The Acts of 1883 and 1888 (*g*) provide for the comparison of the complete specification with the provisional by an examiner at the Patent Office, and having regard to this fact the Courts do not decide against the validity of a patent on the ground of disconformity, unless the invention claimed by the complete specification is unmistakably different to that described in the provisional specification. "If a case is on the border line, the patent ought to be held good rather than bad." (*h*)

Effect of de-
tailing advan-
tages of the
invention in
the provisional
specification.

The patentee is not bound in the provisional specification to detail the advantages of his invention. If he does detail advantages, all of which are present when the invention is used for one purpose which is principally referred to in the provisional specification, the fact that only some of those advantages are present when the invention is applied to another purpose mentioned in the complete specification, is not a sound argument to support the proposition that the second purpose is an illegitimate extension, and so renders the

(*e*) See *Gadd v. Mayor of Manchester*, (1892) 9 R. P. C. 526, 529; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 257.

(*f*) *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 232, 257.

(*g*) 46 & 47 Vict. c. 57, s. 9; and 51 & 52 Vict. c. 50, s. 4.

(*h*) Per Lindley, L.J., *Gadd v. Mayor of Manchester*, (1892) 9 R. P. C. 527; in *Chaburn v. Mechan*, (1895) 12 R. P. C. 121. Romer, J., applied this principle to the facts of that case.

patent bad on the ground of disconformity.⁽ⁱ⁾ In the words of *Romer, J.*, "A patented invention may, owing to subsequent discoveries of others, prove more valuable and have a wider field of usefulness than what was contemplated by the patentee at the time of his invention; and yet the patentee is entitled to the full benefit of the use of his invention if taken and applied for the purpose of those subsequent discoveries, and if the subsequent discoveries have taken place after the provisional and before the final specification, there would be nothing improper in the patentee referring to them in the final, and there showing the manner in which his invention could be best applied to them."^(k)

Variations
between
the Speci-
fications.

And as pointed out by *Wills, J.*, it is settled law that "so far as the objection of want of conformity is concerned, the patentee, merely by condescending to particulars in respect of the things which he has thought out, never loses the benefit of general expressions in the provisional specification as to matters which he has not thought out. Of course he may use words which may tie his hands afterwards to detail. But that is merely saying that his language may be such as to exclude an area which might otherwise be within more general phraseology."^(l)

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.^(m) The following two cases may be taken as illustrations of patents which have been so vitiated.

Illustrative
cases in which
patents were
held bad for
disconformity.

In *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1055, 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

Bailey v.
Robertson.

(i) *Pneumatic Tyre Co. v. East London Rubber Co.*, (1896) 14 R. P. C. 77, 99.

(k) *Pneumatic Tyre Co. v. East London Rubber Co.*, (1896) 14 R. P. C. 101.

(l) *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 869.

(m) See *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1055; *United Telephone Co. v. Harrison*, (1882) L. R.

21 Ch. D. 743; *Horrocks v. Stubbs*, (1885) 3 R. P. C. 233, 236; *Hutchison v. Patullo*, (1888) 5 R. P. C. 351; *King, Brown & Co. v. Anglo-American Brush Corporation*, (1889) 6 R. P. C. 414; *Lane Fox v. Kensington Electric Lighting Co.*, (1892) 9 R. P. C. 221, 413; *Cera Light Co. v. Dobbie*, (1892) 11 R. P. C. 10; *Magee v. Tangyes*, (1897) 14 R. P. C. 255; *Brooks v. Lamplugh*, (1897) 15 R. P. C. 33.

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between
the Speci-
fications.

gravity '1070. 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 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.

United Tele-
phone Co. v.
Harrison.

In *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 743, *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 holding was 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, 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.”

Variations
between
the Speci-
fications.

The following cases may be taken as instances among many reported cases⁽ⁿ⁾ in which the objection of disconformity was not sustained.

Illustrative
cases in which
the objection of
disconformity
failed.

Newall v. Elliott, (1858) 4 C. B. N. S. 269; 27 L. J. C. P. 337, 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

Newall v.
Elliott.

(n) See *Newall v. Elliott*, (1858) 4 C. B. N. S. 269; 27 L. J. C. 337; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; *Penn v. Bibby*, (1875) L. R. 2 Ch. 127, 135; *Lucas v. Millar*, (1885) 2 R. P. C. 155; *Watling v. Stevens*, (1886) 3 R. P. C. 42; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 241; *Gaulard and Gibbs' Patent*, (1888) 5 R. P. C. 533; *Horrocks v. Stubbs*, (1886) 3 R. P. C. 221; *King, Brown & Co. v. Anglo-American*

Brush Corporation, (1889) 6 R. P. C. 414; *Crampton v. The Patent Investment Co.*, (1889) 6 R. P. C. 294; *Gadd v. Mayor of Manchester*, (1892) 9 R. P. C. 249, 516; *Miller v. Searle*, (1893) 10 R. P. C. 106; *Cassel Gold Extracting Recovery Co.*, (1895) 12 R. P. C. 232, 257; *Pneumatic Tyre Co. v. East London Rubber Co.*, (1896) 14 R. P. C. 77; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 853.

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fications.

of size, the smallest being at the top, and acting as a mouth-piece, 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 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 (*o*) 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."

Wright v.
Hitchcock.

In *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97, 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 sewing machine for producing the same." It was objected on behalf of the defendants that there was an inconsistency between the provisional

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

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.

Complete
Specifica-
tion.
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In *Pneumatic Tyre Co. v. East London Rubber Co.*, (1896) 14 R. P. C. 77, 573, which related to an infringement of *Welch's* invention of the method of securing a tyre to a bicycle rim by means of inextensible rings or rims, it was objected that the provisional specification did not describe that the invention was intended to relate to a pneumatic tyre, or a cover for a pneumatic tube or tyre, or for affixing a pneumatic tube or its cover to a wheel rim. It was also alleged that the inventions set out and claimed in certain claiming clauses, which related to pneumatic tyres, were inventions none of which were disclosed or hinted at in the provisional and were not legitimate developments of anything disclosed in the provisional.

Pneumatic
Tyre Co. v.
East London
Rubber Co.

These objections were overruled, both by the Court of first instance and the Court of Appeal on the ground that the real nature of the invention was sufficiently described in the provisional, and the use of it with pneumatic tyres as claimed in the complete specification was a legitimate development sufficiently hinted at in the provisional. As was pointed out by *Lindley*, L.J., (14 R. P. C. 581) it is easier to ascertain the nature of an invention from a complete specification, which shows how it is to be applied, than from a provisional specification which describes the nature of an invention in general language, but which seldom shows how it is to be performed.

THE COMPLETE SPECIFICATION.

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. (p)

Object of com-
plete specifica-
tions.

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

(p) s. 5, sub-s. 41; see P. R. 1890.

Complete
Specifica-
tion.

able to put the invention into practice, and thus enjoy the benefit of the discovery.^(q)

In fact, upon the view that letters patent are virtually a bargain between the Crown and the public, 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 expiration of the time for which the grant is made to have as free and unreserved use of the invention as he himself.^(r)

The title and provisional specification(s) 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.

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.

Complete
specification
is generally a
difficult docu-
ment to draft.

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,

(q) *Young v. Rosenthal*, (1884) 1 R. P. O. 31; *Macfarlane v. Price*, (1816) 1 Stark. N. P. 201; *Allen v. Durkett*, (1893) 10 R. P. C. 397.

(r) *Gibson v. Brand*, (1842) 1 W.P.C.

627; 4 M. & G. 179; 4 Scott, N. R. 844; 11 L. J. C. P. 177; *Wood v. Zimmer*, (1815) Holt, N. P. 58; 1 W. P. C. 82 n.

(s) p. 161 *ante*.

without the sanction of the patentee, during the continuance of the patent, and what they will be able to do after it has expired.

**Complete
Specifica-
tion.**

The conditions which the law requires the complete specification to satisfy may be conveniently considered under the following heads:—

**Requisites of
complete speci-
fication.**

- 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, or otherwise mislead the public.
- II. 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.
- III. 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. It is not required to 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 and how the same is to be performed.
- V. The complete specification need not describe any step or process which is necessarily implied.
- VI. The complete specification need not describe minutely any known thing to which it refers.
- VII. 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.
- VIII. The complete specification must describe the best method known to the patentee of performing the invention and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection prior to the date of filing the complete specification.
- IX. The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.
- X. 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.

Complete
Specifica-
tion.

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, or otherwise mislead the public.*

Patent a bargain with the public.

A patent may 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.^(t) 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.

Must not mislead by commission.

As stated by *Buller, J.*, in *R. v. Arkwright*,^(u) and acted upon by many Judges since, if the specification, in any part of it, be materially false and defective, the patent is against law and cannot be supported. Further, if certain things mentioned in the specification are of no use, and merely thrown in to puzzle, the patent is equally 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.^(x) Also 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.^(y)

or omission.

Further, 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.^(z)

Must not describe methods which will not answer.

Again, if the specification describes and claims two ways of doing a thing, and it turns out that by one of the ways specified

(t) Per Lord Eldon, *Cartwright v. Eamer*, (1890) 14 Ves. 131, 136; *Sturz v. De la Rue*, (1828) 5 Russ. 322; 7 L. J. O. S. Ch. 47.

(u) (1785) Dav. P. C. 61; 1 W. P. C. 64.

(x) *Turner v. Winter*, (1787) 1 T. R.

602; 1 W. P. C. 77; *Palmer v. Wagstaff*, (1853) Newtens' L. J. vol. xliii. p. 131.

(y) *Ibid*; see *Bickford v. Skewes*, (1838) 1 W. P. C. 211.

(z) *Lewis v. Marling*, (1829) 1 W. P. C. 493.

it cannot be done,(a) or that one of the alternatives is not new,(b) the specification is bad and the patent void. So also if the patentee, misled by theory, describes and claims as an essential step in a process—*e.g.*, a chemical process—the production of something which is in fact an impossibility, the patent is void.(c)

Complete
Specifica-
tion.

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 ;(d) but in the former the patent cannot be sustained.

Distinction
between a false
description;
and a claim to
something
useless.

Thus in *Neilson v. Harford*,(e) *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 :—(f)

“ 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 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* (g) the patent was for the “ invention of a neutral salt, under the name of *Seidlitz* powder,” and the

(a) *Beard v. Egerton*, (1846) 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. Cutler*, Macr. P. C. 137; *Savory v. Price*, (1823) Ry. & M. 1; 1 W. P. C. 83; *Kurtz v. Spence*, (1888) 5 R. P. C. 161, 184.

(b) *Pether v. Shaw*, (1893) 10 R. P. C. 293.

(c) *Monnet v. Beck*, (1897) 14 R. P. C. 777.

(d) *R. v. Cutler*, (1816) Macr. P. C. 137; *Lewis v. Marling*, (1829) 10 B. & C. 22; 1 W. P. C. 493.

(e) (1841) 1 W. P. C. 313; S. M. & W. 806.

(f) (1841) 1 W. P. C. 371.

(g) (1823) Ry. & M. 1; 1 W. P. C. 83.

Complete
Specification.
—

specification, to the misleading of the public, 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 and readily procurable. The specification further and properly stated the proportions in which these ingredients were to be mixed for compounding the *Seidlitz* powder. The plaintiff was nevertheless 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.”

Must not give
problems.

As has been said by *Jessel*, M.R.: “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.”(*h*)

It is to be observed that the patent might also have been declared void on the further ground that the patentee had not disclosed the best and most economical method of performing the invention with which he was acquainted.(*i*)

The invention
described must
be useful for
the object
stated.

It is also a fatal defect if the invention is not useful for the purpose for which the patentee says it is useful. The question always is, Does the invention really do when put in practice by a competent man what the patentee states it will do?(*l*)

If the specification contain what amounts to a false suggestion on the part of patentee—*e.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;(*l*) or if the specification give only an insufficient

(*h*) *Plimpton v. Malcolmson*, (1875) L. R. 3 Ch. D. 576; see also *Lewis v. Stirckler’s Patent*, (1897) 14 R. P. C. 24, 36. (*i*) See p. 205 *post*.

(*l*) *Morgan v. Seaward*, (1836) 1 W. P. C. 185; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) 4 R. P. C.

462; *Easterbrook v. Great Western Railway Co.*, (1885) 2 R. P. C. 210; 3 R. P. C. 94; *Fawcett v. Horman*, (1896) 13 R. P. C. 268, and cases following in the text; pp. 181–182 *post*.

(*l*) *Felton v. Greaves*, (1829) 3 C. & P. 611.

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 ;^(m) and in the latter it will be bad, because the statutory requirements have not been complied with.⁽ⁿ⁾ 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.^(o) A statement in a specification to the effect that a certain thing is important which is in fact not so,^(p) or that something is immaterial which is in reality material,^(q) will, it is submitted, amount to an attempt to deceive, and so render the patent void.

Complete
Specifica-
tion.
—

The following cases illustrate the application of the principles stated in the last paragraph. Illustrative cases.

Bloxam v. Elsee, (1825) 6 B. & C. 169; 1 C. & P. 558, is an instance of a specification which was rendered void, because the patentee thereby represented that the machine described was capable of doing 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*, (1825) Macr. P. C. 240, a 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."

Bloxam v. Elsee.

In *R. v. Metcalf*, (1817) 3 Car. & P. 611, 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 *R. v. Metcalf.*

^(m) *Travell v. Carteret*, 3 Lev. 135; *Alcock v. Cooke*, 5 Bing. 340; *Morgan v. Seaward*, (1837) 2 M. & W. 544.

⁽ⁿ⁾ See 1 W. P. C.; and cases there referred to.

^(o) *Cole v. Saqui*, (1888) 5 R. P. C. 494, *cf.* p. 236 *post.*

^(p) *Huddart v. Grimshaw*, (1803) 1 W. P. C. 85.

^(q) *Neilson v. Harford*, (1841), 1 W. P. C. 313.

Complete
Specifica-
tion.

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.

Felton v.
Greaves.

In *Felton v. Greaves*, (1829) 2 Stark. N. P. 249, 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 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*, (1810) Parl. Rep. 192; 1 Carp. P. C. 270, 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. *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.*

Complete
Specifica-
tion.

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 should express the invention in the clearest and most specific manner; so that the persons to whom it is addressed may be able to produce the thing intended, without the necessity of trying experiments,^(r) and, as was pointed out by *Dallus*, L.C.J.,^(s) if the instrument contains an ambiguity in a material point that is a ground on which it may be avoided altogether.

Must be clear
and unequi-
vocal.

Absolute or perfect precision in the language of 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.

Perfect pre-
cision in lan-
guage is not
possible.

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.”^(t)

If there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention,

^(r) Per Ashurst, J., *Turner v. Winter*, (1787) 1 T. R. 602; 1 W. P. C. 77; but see p. 189.

^(s) *Campion v. Benyon*, (1821) 6 B. Moo. 71; 3 Brod. & B. 5.

^(t) *Philpot v. Hanbury*, (1885) 2 R. P. C. 38; see also *Boulton v. Bull* (1795) Dav. P. C. 216; *Arkwright v. Nightingale*, (1785) Dav. P. C. 37.

Complete
Specification.
—

Must not include what will not as well as what will answer.

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.^(u)

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.^(v)

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.^(y) 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.^(z) It would be manifestly unfair to hold that language which, by the advance of knowledge, has come to include more than the patentee contemplated should vitiate the grant.

Thus, for instance, when the directions given in a specification for the preparation of the article, which is the subject-matter of the patent, necessitate the use of a practically chemically pure substance, and, at the date of the patent, the person to whom the specification is addressed would, by using the knowledge of the period, obtain the substance sufficiently pure and would succeed, it is no valid objection to the utility of the invention and the sufficiency of the specification that, at a subsequent date, the same person using the *then* commercial

^(u) Per Tindal, C.J., *Galloway v. Bleaden*, (1839) 1 W. P. C. 521.

^(v) *Ralston v. Smith*, (1865) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, (1857) 2 H. & N. 84; *Haworth v. Hardcastle*, (1834) 1 W. P. C. 484; *Saunders v. Aston*, (1832) 3 B. & Ad. 881, 886; 1 W. P. C. 75 n.; *Kurtz v. Spence*, (1888) 5 R. P. C. 161; *Stevens v. Keating*, (1848) 2 W. P. C. 194; *Muntz v. Foster*, (1844) 2 W. P. C. 109; *Hills v. London Gas Light Co.*,

(1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409; *Bailey v. Roberton*, (1878) L. R. 3 App. Cas. 1070.

^(y) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 410; 4 R. P. C. 449; *Crossley v. Beverley*, (1829) 3 Car. & P. 513; 1 W. P. C. 112.

^(z) *Tetley v. Easton*, (1852) Macr. P. C. 77; 18 C. B. 643; 25 L. J. C. & P. 293.

article (*which has only come into existence as a commercial product after the date of the patent*) would fail.(a)

In *Wegmann v. Corcoran* (b) the Court of Appeal upheld a decision of the Court below, which declared 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.

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,(c) 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.(d) The names of articles mentioned must be taken to be used in their ordinary commercial sense.(e)

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

(a) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 324, 326.

(b) (1879) L. R. 13 Ch. D. 66.

(c) *Bickford v. Skewes*, (1837) 1 W. P. C. 214; *Derosne v. Fairie*, (1835) 1 W. P. C. 154; *Elliott v. Turner*, (1845) 2 C. B. 446; *Wallington v. Dale*, (1852) 7 Exch. 888.

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

(e) *Simpson v. Holliday*, (1864) 2 Newton, L. J. 118; 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Stevens v. Keating*, (1847) 2 W. P. C. 183, 187; 19 L. J. Ex. 57; *Muntz v. Foster*, (1844) 2 W. P. C. 104; *Sturz v. De la Rue*, (1828) 1 W. P. C. 83; 5 Russ. 327; *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 710; (1887), 4 R. P. C. 449.

Complete
Specification.

E.g., proportions.

hydration), which would answer, and not to the anhydrous form, which would not answer; (*f*) 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. (*g*)

In the case of an invention of a new use of known substances in new proportions, (*h*) the patentee in his complete specification is bound to state the most suitable proportions within his knowledge, (*i*) but he is not obliged to limit his claim to the precise proportions mentioned. (*k*) Though proportions of substances used may be of importance, yet if the proportions specified as an instance yield good and satisfactory results, the fact that different proportions yield results differing in utility is not a fatal objection to the sufficiency of the specification. (*l*) If on the true construction proportions are claimed which will not yield without further experiment and discovery the result aimed at by the patentee, the patent is bad for insufficiency of the specification. (*m*) On the other hand, if the specification on its true construction is limited to certain definite proportions of the ingredients used, then, no doubt, it is no infringement to use proportions outside the limits stated. (*n*)

In *The Patent Type Foundry Co. v. Richards* (*o*) the patent was for "improvements in the manufacture of type," and the specification stated "the object of the invention is to make type harder, tougher, and more enduring, by employing tin in large proportions with antimony, and to greatly reduce or omit the use of lead. The best proportions I am acquainted with are seventy-five of tin and twenty-five of antimony, but this may be to some extent varied; and when lead is also used I find that it must not exceed fifty parts in one-hundred of the combined metals employed."

Wood, V.C., overruled a demurrer on the ground that this specification was bad for uncertainty, and said:—

"What I have to determine is whether this specification is so clearly and manifestly bad that no explanation by workmen or

(*f*) *Simpson v. Holliday*, (1866) 5 N. R. 340; L. R. 1 H. L. 315.

(*g*) *Sturz v. De la Rue*, (1828) 1 W. P. C. 83; 5 Russ. 327.

(*h*) p. 71 *ante*.

(*i*) See p. 205 *post*.

(*k*) *The Patent Type Foundry Co. v. Richards*, (1860) 6 Jur. N. S. 39.

(*l*) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 326.

(*m*) *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671. (*n*) *Ibid*.

(*o*) (1860), 6 Jur. N. S. 39; 1 Johns. 381; 2 L. T. N. S. 359.

other experts could induce the Court to hold that this is a new invention set forth with sufficient clearness and precision. A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say 'I limit my claim to these precise proportions.' Even if the patentee had in terms absolutely tied himself down to 25 per cent. as a minimum in the place of 1 or 2 per cent., supposing that to be the proportion previously used, a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent. It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a useful practice, whether anything of the kind was ever done before, and whether a variation from the given proportion to others slightly different would not be a colourable evasion. These are all questions for a jury. The only opinion I express is that the specification is not void on the face of it."

Complete
Specifica-
tion.

In *British Dynamite Co. v. Krebs*,^(p) the patent the validity of which was in question was 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 to use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous un-explosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into powder, which I call dynamite or *Nobel's* safety powder." Objection was taken at the trial to the specification, on the ground that the above statement was not a sufficient statement of the quantity of the nitro-glycerine to be used. The Judge of First Instance overruled the objection, but the Court of Appeal held it fatal to the validity of the patent. The House of Lords, however, held that, under the circumstances, the specification was sufficient upon the ground stated by Lord *Cairns*, L.C., thus^(q) :—

"Where you speak of a porous substance absorbing a fluid, if the porous substance is in one piece you naturally expect that the absorption will continue up to the point where the porous substance can hold no more; and when the absorbing substance is, and is to continue, a powder, the act of absorption itself will show the point at which the absorption must stop, lest the absorbing substance should become, not a powder but a paste."

^(p) (1875-1879). S. P. C. 88; 13 R. P. C. 190; *cf.* *Otto v. Linford*, (1881-82) per *Jessel*, M.R., 46 L. T. 40.

^(q) 13 R. P. C. 192.

Complete
Specification.

It is settled law that a person, to be entitled to the benefit 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.^(r) 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.

Test of
sufficiency.

In judging of the sufficiency of the specification, the proper criterion is whether a person to whom the specification is addressed, by using only the existing knowledge common to the trade at the date of the patent, would be able to exercise the invention without using information derived from any other source.^(s) *Tindal*, C.J., directing the jury in *Muntz v. Hoster*^(t) 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."^(u)

A statement, or claiming clause, which is so indefinite as to include what will not answer the purpose in view as well as what will is, in accordance with the principles above stated, fatal to the validity of the grant.

Example of a
specification
held bad as
including
something
which would
not answer.

For example, in *Sterens v. Keating*^(v) the Court of Exchequer upheld a 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 pearlsh in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the

^(r) Per Buller, J., *R. v. Arkwright*, (1785) Dav. P. C. 106; 1 W. P. C. 66, and note.

^(s) Per Alderson, B., *Morgan v. Seaward*, (1836) 1 W. P. C. 173, 174; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 710; 4 R. P. C. 463; *British Dynamite*

Co. v. Krebs, (1875) G. P. C. 88; 13 R. P. C. 190; *Neilson v. Harford*, (1841) 1 W. P. C. 371; *Rex v. Arkwright*, (1785) 1 W. P. C. 66.

^(t) (1844) 2 W. P. C. 109.

^(u) *British Dynamite Co. v. Krebs*, (1875-9) G. P. C. 90.

^(v) 2 W. P. C. 175; 19 L. J. Ex. 57.

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 none 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, on the plea of no infringement, for he used neither. The learned Chief Baron continued thus:—

Complete
Specifica-
tion.
—

"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*, (1819) 2 B. & Ald. 345, 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 may 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,^(y) provided that the patentee has given the best means known to him of carrying out the invention.^(z)

When neces-
sity for experi-
ments renders
a specification
bad, and when
not.

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

(y) *Neilson v. Harford*, (1841) 1 W. 128 n.; *Orto v. Linford*, (1881) 46 L. T. P. C. 295, 318; *Macnamara v. Hulse*, N. S. 39; *Edison v. Holland*, (1889) (1842) Car. & M. 471; 2 W. P. C. 6 R. P. C. 243. (z) p. 205 *post*.

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Specification.

in the specification. Thus, in *Crompton v. Ibbotson*(a) 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 anything would answer the purpose except the material which the patentee said he preferred, and the plaintiff was non-suited. 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*(b) a patent was held void on the ground of a similar ambiguity in the specification.

Leonhardt v. Kallé(c) indicates that the above two old cases would be differently decided by the Courts now. The invention consisted in the production of various colouring matters fast to alkali by the action of suitable oxidisable substances and free alkalies upon a certain substance under heat. It was objected that the specification was ambiguous and misleading on four points, viz.: (a) because it showed no means of ascertaining which oxidisable substances were not suitable; (b) because the proportions in which the various alternative oxidisable substances were to be used were not stated; (c) nor how the process could be varied to produce the several shades of colour mentioned; (d) the specification entirely failed to state the chemical nature of the compound, the product of the process. *Romer*, J., who tried the case, held that upon the facts all these objections failed, and as to some of them remarked that if they were held valid they would render it practically impossible to draw a specification for an invention like that of the patentee that could be free from objec-

(a) Dan. & L., (1828) 33; 6 L. J. O. S. K. B. 214.

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

(c) (1895) 12 R. P. C. 103.

tion. The reasons for holding the objections invalid were, shortly:—

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tion.

As to (a), It was unreasonable to suppose that the patentee ought to set himself down as a sort of dictionary to specify every known oxidisable substance, and to point out what could not give very useful results, or which might be disregarded. Having given numerous examples of different classes of oxidisable substances that could be used, he was entitled to say, as was true, that there were others which could be used. Following the directions of the specification and with such precautions as chemists would know how to use, oxidisable substances not expressly mentioned in the specification could be successfully used. As to (b), the patentee had given directions as to how to obtain the best results, in fact, with the different oxidisable substances specially mentioned which necessitated the use of the right proportions. He was not bound to enunciate any general theory. With regard to oxidisable substances not specifically mentioned, chemists would have no difficulty in ascertaining into which example or examples given any such unmentioned oxidisable substance fell, and in applying the directions given as regards the said example or examples. As to (c), the patentee had pointed out which colours his dyes produced; and also the colours that were produced from his process were rightly stated by the limits given in the specification. A person wanting to use the dyes could test the examples given without difficulty. Shades of colour vary infinitely, and are almost impossible to describe. The patentee was not bound to take every oxidisable substance and define what shade of colour it would produce. As to (d), this was an unfair objection, and the patentee was not bound to state anything of the kind, which, as a matter of fact, having regard to the state of chemical knowledge, it would have been impossible for him to do with any certainty.

III. *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. It is not required to 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.*

The often used statement to the effect that the specification is insufficient unless it be comprehensible to the "ordinary workmen" in the trade to which the invention relates is apt

Meaning of
"ordinary
workman."

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to lead to great confusion if it be not clearly borne in mind that the "ordinary workman" is to be regarded as a person of very different knowledge and skill according to the nature of the field of invention with which the patentee in a particular case is dealing. Thus, if the invention is merely the construction of a mechanical combination of parts for a purpose readily understood—*e.g.*, a bicycle—then the "ordinary workman" is, no doubt, a mechanic used to the construction of machines; but if the invention is the production of something by a process, or series of processes, to understand which the highest scientific knowledge and attainments are requisite, the "ordinary workman" then becomes a highly trained scientific person who may be called upon to give the necessary instructions to his less highly instructed and skilful subordinates to enable the process to be carried out by them—*e.g.*, if the invention relates to the production of a chemical product by a process or series of processes to the understanding of which a knowledge of the most recent developments of chemical theories and ascertained facts is indispensable, then the "ordinary workman" becomes a highly trained chemist who may be properly called upon to bring his special knowledge of the particular branch to which the invention relates into play for the purpose of giving minute directions to his less skilful subordinates so as to enable them to perform the operations necessary to the carrying out of the process which they by their lack of knowledge may not be able to fully appreciate.

If the above remarks be borne in mind, some of the statements of the law in the following pages, which might otherwise be considered conflicting, will at once appear in perfect harmony.

In *Morgan v. Seaward*,^(d) 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.^(e) Parke, B., in *Neilson v. Harford*,^(f) alluding to an invention relating to a machine, 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—

^(d) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.

^(e) See also *Gibson v. Brand*, (1842) 1 W. P. C. 631; *Sturz v. De la Rue*, (1828) 1 W. P. C. 83; 5 Russ. 327;

Beard v. Egerton, (1849) 8 C. B. 165; *Bickford v. Skewes*, (1839) 1 W. P. C. 218.

^(f) (1841) 1 W. P. C. 295; 8 M. & W. 806; 11 L. J. Ex. 20.

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 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.”

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tion.

The following passage, from the judgment of *Jessel, M.R.*, in *Plimpton v. Malcolmson*,^(g) in reference to patents for mechanical inventions, has been approved of in subsequent cases as a correct statement of the law as to whom a complete specification must be intelligible ^(h) :—

The same by
Jessel, M.R.

“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

^(g) (1875) L. R. 3 Ch. D. 531, 568; 44 L. J. Ch. 257.

^(h) *Edison v. Woodhouse*, (1887) 4 R. P. C. 79; *Moseley v. Victoria Rubber*

Co., (1887) 4 R. P. C. 242; *Bray v. Gardner*, (1887) 4 R. P. C. 400, 406; *Edison v. Holland*, (1889) 6 R. P. C. 243.

Complete
Specification.

—
The same by
Maule, J.

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

It is sufficient if the complete specification define the invention so that an ordinarily skilful workman can carry it out.(k) . Thus, *Maule, J.*, in reference to the specification of an invention relating to photography, said:—

“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.” (l)

Sufficiency of
specification
when the in-
vention can
only be appre-
ciated by
persons of
great skill and
knowledge.

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 in most cases 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 :(m)but in cases where the invention relates to a subject which only appeals to and can only be appreciated by persons of great skill and knowledge in some particular department of science, then the ordinary skilled workmen must be interpreted to mean a person possessed of the greatest skill and knowledge.(n)

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 invention, the patent will be upheld with respect to the sufficiency of the specification.(o)

(i) See also *Neilson v. Harford*, (1841) 1 W. P. C. 314.

(k) *Wallington v. Dale*, (1852) 7 Exch. 555; 23 L. J. Ex. 49.

(l) *Beard v. Egerton*, (1846) 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*, (1881) 46 L. T. N. S. 35; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 710, 713; 4 R. P. C. 449;

Moseley v. Victoria Rubber Co., (1887) 4 R. P. C. 241, 253.

(m) See *Edison v. Holland*, (1889) 6 R. P. C. 243, 280.

(n) See pp. 191-2 *ante*; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 875, judgment of Willes, J.

(o) *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) 12 App. Cas. 710; 4 R. P. C. 449.

The specification, in fact, 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. (p) **Complete Specification.**

Thus, Lord *Loughborough*, in *Arkwright v. Nightingale*, (q) 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. And in *Ree v. Arkwright*, (r) 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.

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. (s)

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, 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. (t)

In *Turner v. Winter*, (u) it appeared that in carrying out the

(p) *Huddart v. Grimshaw*, (1803) 1 W. P. C. 85, 87; *Bickford v. Skewes*, (1837) 1 W. P. C. 218; *Hornblower v. Boulton*, (1799) Dav. P. C. 221, 228; *Edison v. Holland*, (1889) 6 R. P. C. 243, 277, 278, 280; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 875.

(q) (1785) Dav. P. C. 39; 1 W. P. C. 60.

(r) (1785) Dav. P. C. 61; 1 W. P. C. 64.

(s) Per Lord Ellenborough, C.J., in *Harmar v. Playne*, (1809) Dav. P. C. 318; 11 East, 181.

(t) *Morgan v. Seaward*, (1837) 1 W. P. C. 174.

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

Complete Specification.

Specifications are not addressed to persons ignorant of the subject-matter.

Person to whom the specification is addressed is presumed to possess all the existing knowledge common to the trade, but not more.

Complete
Specification.
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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 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.

So also in the recent case of *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*,^(x) where the patentee directed that a certain process was to be carried out in "an autoclave," and it appeared that it was essential that the vessel in question should be of iron unenamelled, and it also appeared that at the date of the specification both unenamelled and enamelled autoclaves were in general use, the specification was held to be fatally insufficient on the ground that it did not point out that the use of an unenamelled iron autoclave was an essential element of success.

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.^(y) And in the words of Lord *Eldon*, L.C., "in order to support a patent, the specification 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."^(z)

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."^(a)

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.^(b)

(x) (1897) 14 R. P. C. 875.

(y) *Neilson v. Thompson*, (1841) 1 W. P. C. 283.

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

(a) *Holmes v. London and North Western Ry. Co.*, (1852) Macr. P. C.

13, 16; *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312, 340.

(b) *Derosne v. Fairie*, (1835) 1 W. P. C. 154, 157; *Minter v. Mower*, (1835) 1 W. P. C. 141; see also *R. v. Metcalf*, (1817) 1 W. P. C. 141 n.; 3 Car. & P. 611.

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

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tion.

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.^(d)

Errors in the
specification
and their
effect.

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 discovered and corrected in following out the instructions given, for such errors cannot possibly mislead;^(e) 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.^(f)

A workman is not to be called upon to correct any error unless there is something to correct it by.^(g) 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

(c) *Edison v. Holland*, (1889) 6 R. P. C. 280.

(d) *Simpson v. Holliday*, (1864) 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; *Otto v. Linford*, (1881) 46 L. T. N. S. 35; *Morgan v. Seaward*, (1836) 1 W. P. C. 176; *Derosne v. Fairie*, (1835) 1 W. P. C. 157; 1 W. P. C. 42 n. 41; *Gandy v. Reddaway*, (1883) 2 R. P. C. 52; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Hopkinson v. St. James's Electric Light Company*, (1892) 10 R. P. C.

46; *Miller v. Searle*, (1893) 10 R. P. C. 106.

(e) p. 178 *ante*.

(f) See remarks by Lord Westbury, L.C., in *Simpson v. Holliday*, (1864) 13 W. R. 577; 5 N. R. 340; 35 L. J. Ch. 811; L. R. 1 H. L. 315; p. 178 *ante*.

(g) *British Dynamite Co. v. Krebs*, (1875) G. P. C. 190; 13 R. P. C. 190; *Hinks v. Safety Lighting Co.*, (1876) 4 Ch. D. 615; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

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Specification.
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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 necessity for invention or much trouble.^(h)

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

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 répulsion*, and *vis de réaction*, for different screws, and *centimètres* for inches, was taken in *Bloxam v. Elsee*,^(k) but was not sustained, as it appeared that, although these terms would 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.^(l)

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,^(m) but a specification which does not contain sufficient information to enable this to be done without the necessity for experiments, involving the exercise of the inventive faculty of the experimenter, is absolutely fatal to the validity of the patent.⁽ⁿ⁾

^(h) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 615; 46 L. J. Ch. 185.

⁽ⁱ⁾ *Betts v. Neilson*, (1871) L. R. 5 H. L. 121; per Lord Westbury, L.C.

^(k) (1825) 1 Car. & P. 558; 6 B. & C. 169.

^(l) *Tetley v. Easton*, (1852) *Newton, L.J.*, vol. xlii. p. 58; 18 C. B. 643; 25 L. J. C. P. 293.

^(m) *Edison v. Holland*, (1889) 6 R. P. C. 243.

⁽ⁿ⁾ *Liardet v. Johnson*, (1778) 1 W. P. C. 53; *R. v. Arkwright*, (1785) 1 W.

P. C. 70; *Neilson v. Harford*, (1845) 1 W. P. C. 317; *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607; *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1055; *Pooley v. Pointon*, (1885) 2 R. P. C. 167; *Hutchison v. Patullo*, (1888) 5 R. P. C. 351; *Elkington v. Clark*, (1888), 5 R. P. C. 327; *Goulard v. Gibbs*, (1888) 5 R. P. C. 535; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531; 45 L. J. Ch. 505; *Simpson v. Holliday*, (1886) L. R. 1 H. L. 315; *The Lifeboat Co. v. Chambers*, (1891) 8 R. P. C. 418.

Effect of
statements
rendering
experiments
necessary.

It is to be observed that what in one particular case, having regard to the nature of the invention and the public to whom the specification may rightly be supposed to be addressed, is a mere affair of practice before being able to succeed, ought in another particular case to be regarded by the Court as a matter of experiment, the necessity for which is fatal to the patent on the ground of insufficiency of the specification. Thus *Willes, J.*, has stated that in his opinion a chemical patent dealing with very subtle and delicate reactions is entitled to the benefit of being tested by the results of its working in the hands of persons not merely practised in chemistry generally, but having acquired the necessary familiarity with the processes.^(o)

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Specifica-
tion.
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The following passage from the judgment of *Lindley, L.J.*, in *Edison v. Holland*,^(p) illustrates the point that, though trial may be necessary before success is attained, yet the specification may be sufficient:—

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

IV. *The complete specification must particularly describe and ascertain the nature of the invention and how the same is to be performed.*

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

Now a statu-
tory as well
as a common
law requisite.

(o) *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 891.
▲ (p) (1889) 6 R. P. C. 281.

(q) *R. v. Arkwright*, (1785) Dav. P. C. 61; *Macfarlane v. Price*, (1816) 1 Stark. N. P. 199; 1 W. P. C. 74 n.; *Gibson v. Brand*, (1842) 1 W. P. C. 640.

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tion.

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.

In *Hastings v. Brown*,^(t) 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^(u) 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 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

^(r) *Turner v. Winter*, (1787) 1 W. P. C. 77; 1 T. R. 602.

^(s) *Ibid.*

^(t) (1853) 1 Ex. B. 450; 22 L. J. Q. B. 161.

^(u) Fig. 2.

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."

Complete
Specifica-
tion.

It is a fatal defect if the specification does not disclose the object of the invention, and also how the same is to be effected.^(x)

Lyon v. Goddard (*y*) is a case which illustrates the importance of clearly stating on the face of the specification the purpose for which a combination, which is the subject-matter of the patent, is designed and claimed. In that case, after a great deal of argument, which might have been rendered unnecessary by a more clearly drawn specification, it was finally decided by the House of Lords that upon the true construction of the specification the machine which was the subject of the patent was specially designed for use with high-pressure steam, and the claim was limited to its use with high-pressure steam for the purpose of disinfecting. The consequence was that a certain prior machine which could be used with low-pressure steam only was no anticipation of the plaintiff's invention, and so this ground of attack upon his patent failed.

Whilst, in order to support a patent, it is necessary that the patentee should fully disclose to the public what is the nature and object of the invention, and how the same is to be carried out,^(z) 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.^(a)

Disclosure of nature and object of invention and how it is to be performed as far as patentee's knowledge at the time extends is sufficient.

Cresswell, J., stated, as the reason why a full disclosure is required, 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

(x) p. 199 *ante*; *Allen v. Duckett*, (1893) 10 R. P. C. 397.

(y) (1893) 11 P. O. R. 360.

(z) *Allen v. Duckett*, (1893) 10 R. P. C. 397; p. 199 *ante*.

(a) *Lewis v. Marling*, (1829) 10 B. & C. 22; 1 W. P. C. 496.

Complete
Specifica-
tion.

infringement of the patent, (b) and *Alderson, B.*, (c) laid it down 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. (d)

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

Sufficiency of
description
necessary
when inven-
tion consists
of several
parts.

If the invention consists 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.

Thus in *Morgan v. Seaward*, (f) *Alderson, B.*, charging the jury in terms which have never been questioned, told them 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 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

(b) *Gibson v. Brand*, (1841) 1 W. P. C. 627.

(c) *Morgan v. Seaward*, (1836) 1 W. P. C. 174, 179.

(d) *Philpot v. Hanbury*, per Grove, J., (1885) 2 R. P. C. 33; see also *Fairburn v. Household*, (1886) 3 R. P. C. 128, 263; *Rowcliffe v. Morris*, (1886) 3 R. P. C. 17.

(e) *Eades v. Starbuck Waggon Co.*, W. N. 1881, p. 160; p. 67 *ante*.

(f) (1836) 2 M. & W. 544; 1 W. P. C. 170; 6 L. J. Ex. 153; see also *Reg. v. Wheeler*, (1819) 2 B. & Ald. 345; *Macnamara v. Hulse*, (1842) Car. & M. 471; *Stevens v. Keating*, (1847) 2 W. P. C. 175; 19 L. J. Ex. 57.

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.

Complete
Specifica-
tion.

V. *The complete specification need not describe any step or process which is necessarily 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.^(g)

Things neces-
sarily implied
need not be
specifically
described.

In *Crossley v. Beverley* (*h*) 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* (*i*) 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.^(k)

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

For example, in the case of an invention which consists of an improvement on an existing machine, it would not be necessary

Not necessary
to describe
a known thing
referred to.

^(g) *Boulton v. Bull*, (1795) Dav. P. C. 162; 2 H. Bl. 498.

^(h) (1829) 3 Car. & P. 513; 1 W. P. C. 106.

⁽ⁱ⁾ (1832) 1 W. P. C. 459.

^(k) See also *Beard v. Egerton*, (1846) 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

Complete
Specifica-
tion.

for the patentee in the specification to enter into a minute description of the old machine, but it must not be forgotten that the language used must be such as will distinguish the invention from that which is old.^(l)

In *Harmar v. Playne* ^(m) 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.

VII. *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 of the vessel in which the air was heated was quite immaterial,

^(l) See 214 *post*.

^(m) (1809) 14 Ves. 130; 11 East, 101; Dav. P. C. 311.

and the Court of Exchequer ruled that, on the evidence, the specification was sufficient in that particular.⁽ⁿ⁾

Complete
Specifica-
tion.

VIII. *The complete specification must describe the best method known to the patentee of performing the invention, and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection, prior to the date of filing the complete specification.*

It is expressly enacted that the patentee must, in the complete specification, describe the manner in which the invention is to be performed,^(o) 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."^(p) 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,^(q) and place them in a position to derive the same benefit from it which he himself does.^(r)

Specification
must extend to
the best of the
patentee's
knowledge.

To use the words of *Gibbs*, C.J. : "There is another consideration 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, reserving to himself the more beneficial mode of practising it,

(n) (1841) 1 W. P. C. 295, 328.

(o) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.

(p) *Tetley v. Easton*, (1852) Mac. P. C. 48.

(q) *R. v. Arkwright*, (1785) Dav. P. C. 61 ; 1 W. P. C. 64.

(r) *Turner v. Winter*, (1787) 1 T. R. 602 ; 1 W. P. C. 77 ; *Bovill v. Moore*, (1815) 2 Coop. Ch. Cas. 56 ; Dav. P.

C. 361 ; 2 Marsh, R. 211 ; *Wood v. Zimmer*, (1815) Holt, N. P. 57 ; *Tetley v. Easton*, (1852) Mac. P. C. 48 ; *Savory v. Price*, (1823) 1 Ry. & Mo. 1 ; 1 W. P. C. 83 ; *Walton v. Bateman*, (1842) 1 W. P. C. 613 ; *Heath v. Unwin*, (1852) 2 W. P. C. 243 ; *Plimpton v. Malcolmson*, (1875) L. R. 3 Ch. D. 531, 582.

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Specifica-
tion.

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."(*s*) And in the language of *Alderson, B.*, "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."*(t)*

Patentee need not necessarily state the best way of carrying out the invention, but must state the best way known to him.

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.*(u)* Neither is it incumbent on the patentee to describe all the possible advantages which may in future accrue from the improved use of his invention. He is only bound, under the statute and the patent law, to give the world the benefit of such information as he actually possesses.*(w)*

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.*(y)* 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.*(z)* 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

(*s*) *Bovill v. Moore*, (1815) 2 Coop. Ch. Cas. 56; *Dav. P. C.* 361; 2 *Marsh, R.* 211.

(*t*) *Morgan v. Seaward*, (1836) 1 *W. P. C.* 174.

(*u*) *Neilson v. Harford*, (1841) 1 *W. P. C.* 317, 356; *The Househill Co. v. Neilson*, (1843) 1 *W. P. C.* 693; *Wood v. Zimmer*, (1815) *Holt, N. P.* 57; 1 *W. P. C.* 82 n.; *Savory v. Price*, (1823) 1 *Ry. & Mo.* 1; 1 *W. P. C.* 83; *Turner v. Winter*, (1787) 1 *W. P. C.* 81; *Morgan v. Seaward*, (1836) 1 *W.*

P. C. 170; *Sturtz v. De la Rue*, (1828) 1 *Carp. Rep.* 463; 5 *Russ.* 322; 1 *W. P. C.* 83; *Tetley v. Easton*, (1852) *Mac. P. C.* 76; *Derosne v. Fairie*, (1835) 1 *W. P. C.* 158; *Walton v. Bateman*, (1842) 1 *W. P. C.* 622; *Heath v. Unwin*, (1852) 2 *W. P. C.* 243.

(*x*) *Lyon v. Goddard*, (1893) 10 *R. P. C.* 345, judgment of *Bowen, L.J.*

(*y*) pp. 15-18 *ante*.

(*z*) *Plimpton v. Malcolmson*, (1875) 3 *Ch. D.* 531, 582.

the information which the agent received from the foreign inventor.(a)

Complete
Specifica-
tion.

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 the public every information which is necessary to enable them completely to perform every part of the invention, although it may be sufficient merely 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.

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.(b)

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 (c) 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."

It has been previously shown that a patentee suppressing anything, or misleading, thereby renders his specification bad,(d) and must not suppress anything essential thereto.

(a) *Wegmann v. Corcoran*, (1879) 13 Ch. D. 66; 41 L. T. N. S. 358.

(b) *Liardet v. Johnson*, (1778) 1 W. P. C. 53.

(c) *Morgan v. Seaward*, (1836) 1 W. P. C. 182.

(d) *Lewis v. Marling*, (1829) 10 B. & C. 22; 4 Car. & P. 56; 1 W. P. C. 496; *Savory v. Price*, (1823) Ry. & M. 1; 1 W. P. C. 83; p. 178 ante.

Complete
Specifica-
tion.

for it is the duty of a patentee, possessed of a mode of carrying on his invention in a beneficial manner, to disclose 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*,^(e) 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.

Examples.

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.^(f)

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 were old.^(g)

In *Derosne v. Fuirie* ^(h) 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 schistus used in the operation, and the complete specification did not state how this was to be done. The Court of Exchequer

^(e) (1815) Holt, N. P. 58; 1 W. P. C. 82 n.

^(f) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

^(g) *Mackelcan v. Rennie*, (1862) 13 C. B. N. S. 52.

^(h) (1835) 5 Tyr. 393; 1 W. P. C. 154.

set aside the verdict given for the plaintiff, and directed a new trial, on the ground 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. Further, 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, it was clear that 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*,⁽ⁱ⁾ 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.^(k) And in *Rex v. Arkwright* ^(l) 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., commenting 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

(i) (1841) 1 W. P. C. 317, 321.

(k) See also *Macnamara v. Hulse*, (1842) Car. & M. 471; 2 W. P. C. 128 n.

(l) (1785) 1 W. P. C. 70.

**Complete
Specifica-
tion.**

It is not requi-
site that all
processes
claimed shall
be equally
successful.

chance may direct." The jury gave a verdict against the patentee, the sufficiency of the specification being one of the issues.

Though it is essential that all the processes described and claimed should be successful,^(m) it is not necessary that all the processes described in a specification should prove equally successful, or of equal commercial value. 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.⁽ⁿ⁾

Lord *Herschell*, in his judgment in the House of Lords in *The Badische Anilin und Soda Fabrik v. Levinstein*,^(o) after having pointed out the causes which may give a different commercial value to a given product at given 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."

When an im-
proved method
discovered
during the
period of pro-
visional pro-
tection should
be included,
and when it
should not be
included.

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

^(m) *Beard v. Egerton*, (1846-9) 19 L. J. C. P. 39; *Derosne v. Fairie*, (1835) 1 W. P. C. 165; *Cole v. Saqui*, (1888) 5 R. P. C. 494.

⁽ⁿ⁾ *Otto v. Linford*, (1881) 46 L. T. N. S. 35; *Badische Anilin und Soda*

Fabrik v. Levinstein, (1887) 4 R. P. C. 449; L. R. 12 App. Cas. 710; *Thomson v. Batty*, (1889) 6 R. P. C. 84, 97.

^(o) (1887) 4 R. P. C. 466; L. R. 12 App. Cas. 710.

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 such an 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,^(p) 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.^(q)

Complete
Specifica-
tion.

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.

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;^(r) moreover, the patentee, by a general claim, cannot include in his patent improvements of which he was ignorant at the date of the patent.^(s)

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

(p) *Edison v. Woodhouse*, (1887) L. R. 32 Ch. D. 520.

(q) *Edison v. Woodhouse*, (1887) L. R. 32 Ch. D. 520; *Crossley v. Potter*, (1853) Mac. P. C. 240; *Bailey v. Robertson*, (1878) L. R. 3 & 5 App.

Cas. 1055; *Penn v. Bibby*, (1866) L. R. 2 Ch. 27; *Siddell v. Vickers*, (1888) 39 Ch. D. 105.

(r) pp. 168-175 *ante*.

(s) *Tetley v. Easton*, (1852) Macr. P. C. 77.

Complete
Specifica-
tion.

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.(*t*)

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.(*u*)

A patentee filing a provisional specification which shows the 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 to 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.(*x*)

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.(*y*)

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

(*t*) *Crossley v. Beverley*, (1829) 1 W. P. C. 117; 3 C. & P. 513.

(*u*) *Jones v. Heaton*, 1 W. P. C. 404 n.; see also *Crossley v. Beverley*, (1829) 1 W. P. C. 117; *Woodward v. Sansum*, (1887) 4 R. P. C. 166; *Crampton v. Patents Investments Co.*, (1888) 5 R. P. C. 397.

(*x*) *Woodward v. Sansum*, (1887) 4

R. P. C. 166; *Siddell v. Vickers*, (1888) L. R. 39 Ch. D. 92, 103; *Plimpton v. Malcolmson*, (1875) L. R. 3 Ch. D. 531, 580; *Moseley v. Victoria Rubber Co.*, (1887) 4 R. P. C. 241; *Crampton v. Patents Investments Co.*, (1888) 5 R. P. C. 382, 397; see pp. 166-175 *ante*.

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

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.(z)

Complete
Specifica-
tion.
—

IX. *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 the 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.(a)

No necessity
to state every
means of pro-
ducing a
desired result.

If the specification state the best method known to the patentee of carrying the invention into effect,(b) 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.(c)

(z) *Edison v. Woodhouse*, (1887) L. R. 32 Ch. D. 520.

(a) *Bickford v. Skewes*, (1838) 1 W. P. C. 211, 218.

(b) pp. 205-213 *ante*.

(c) *Neilson v. Harford*, (1841) 1 W. P. C. 356; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 24 Ch. D. 156; 4 R. P. C. 449; 12 App. Cas. 710.

Complete
Specifica-
tion.

X. *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.*

Distinct claim
to something
old is fatal.

The Act of 1883 (*d*) 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, which is the real invention, 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. (*e*)

Claim may be
only appa-
rently for
something old.

It is, however, to be observed that sometimes a claim may appear to include something which is old, whereas on the true construction of the specification it does not really amount to more than a statement that the invention is equally as useful for some purpose for which an alleged anticipation was useful as it is for the purpose which is the subject of the claim, and for which the alleged anticipation is wholly useless. Such a claim will not vitiate the patent, though it may be objectionable from the draughtsman's point of view as not being as clearly drawn as it might be. (*f*)

Claim to im-
provements on
old things, and
combinations
of old parts.

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

An improvement on an existing machine may be the subject-matter of a new patent; (*h*) 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 old machine. (*i*)

(*d*) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.

(*e*) Chap. iii. *ante*, p. 222 *post*.

(*f*) See *Lyon v. Goddard*, (1894) 11 R. F. C. 361.

(*g*) *Moore v. Bennett*, (1884) 1 R. P. C. 129, 142; *Foxwell v. Bostock*, (1864) 4 De G. J. & S. 298; *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Watling v. Stevens*, (1886) 3 R. P. C. 37; *Proctor v. Bennis*, (1887) 4 R. P. C. 333, 358; *Kaye v. Chubb*, (1888) 5 R. P. C. 641;

Clark v. Adie, (1873) L. R. 2 App. Cas. 315, 328.

(*h*) p. 65 *ante*.

(*i*) *Rex v. Else*, (1785) 1 W. P. C. 76; *Bovill v. Moore*, (1815) 2 Coop. Ch. Cas. 56; *Dav. P. C.* 361; *Potter v. Parr*, (1815) 2 B. & S. 216 n.; *Moore v. Bennett*, (1884) 1 R. P. C. 129, 143; *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Parkes v. Stevens*, (1869) L. R. 8 Eq. 358, 366.

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.^(k)

Complete
Specifica-
tion.

Thus, if a compensation pendulum were now for the first time invented, it would not do to patent improvements in clocks 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."^(l)

A new combination of old parts, or partly old and partly new parts, may form the subject-matter of a valid patent.^(m) 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.⁽ⁿ⁾ If, on the other hand, all the parts are old, the specification will be bad unless it claim only the new combination.^(o) 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.^(p)

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

^(k) Moore v. Bennett, (1884) 1 R. P. C. 129, 143; Philpot v. Hanbury, (1885) 2 R. P. C. 33, 39.

^(l) Per James, V.C., Parkes v. Stevens, (1869) L. R. 8 Eq. 358, 365.

^(m) p. 58 *ante*.

⁽ⁿ⁾ Bovill v. Moore, (1815) per Gibbs, L.C.J., Dav. P. C. 404.

^(o) Lister v. Leather, (1857) 3 Jur. N. S. 811; S. E. & B. 1004; Seed v.

Higgins, (1860) S. H. L. Cas. 550; Potter v. Parr, 2 B. & S. 216 n.; Kay v. Marshall, (1837) 2 W. P. C. 71; Moore v. Bennett, (1884) 1 R. P. C. 129; Proctor v. Binnis, (1887) 4 R. P. C. 333, 358; Clark v. Adie, (1873) L. R. 2 App. Cas. 315, 328.

^(p) Per Abinger, C.B., Carpenter v. Smith, (1841) 1 W. P. C. 530.

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Specifica-
tion.

specification will be consequently bad.(q) 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 a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new.(r)

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.(s)

In *Holmes v. The London and North-Western Railway Co.*(t) 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.

So in *Macfarlane v. Price* (u) 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* (v) a patent for "improvements in making buttons" was declared void on account of a like omission in the specification.(y)

Lord *Westbury*, L.C., in *Foxwell v. Bostock*,(z) 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

(q) *Tetley v. Easton*, (1852) Macr. P. C. 48.

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

(s) *Hill v. Thompson*, (1818) 1 W. P. C. 247; *Leggott v. McGeort*, (1893) 10 R. P. C. 429, 435.

(t) (1852) Macr. P. C. 4; 12 C. B. 831; 22 L. J. C. P. 57.

(u) (1816) 1 Stark. R. 199.

(v) (1832) 1 W. P. C. 75.

(y) See also *Mackelcan v. Rennie*, (1862) 13 C. B. N. S. 52.

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

Rule in
Foxwell v.
Bostock.

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

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Specifica-
tion.

If an improved machine is the result of several combinations, the claims may be so framed that the several combinations leading up to the one principal 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 the subject of a claim or separate letters patent, and also in their combination the several inventions, A, B, and C, may produce a total result which may also be the subject of a claim or separate letters patent.(a)

In *Lister v. Leather* (b) 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.

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.(c) The rule in *Foxwell v. Bostock*, 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

Explanation of
the rule in
Foxwell v.
Bostock.

(a) *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315, 327.

(b) (1857) 8 E. & B. 1031; 27 L. J. Q. B. 295; 4 Jur. N. S. 947.

(c) *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 576, 580; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333.

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Specifica-
tion.

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. (d)

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; (e) 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, before he is able to discover in what the new invention made by the patentee really consists. (f)

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

(d) *Moore v. Bennett*, (1884) 1 R. P. C. 129, 143; see pp. 65-71 *ante*.

(e) *Clark v. Adie*, (1873) 2 App. Cas. 315, 320; p. 476 *post*.

(f) *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas.

574, 579; *Parkes v. Stevens*, (1869) L. R. 8 Eq. 358, 365; *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315, 328; *Proctor v. Bennis*, (1887) 4 R. P. C. 333, 350; *Moore v. Bennett*, (1884) 1 R. P. C. 129.

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 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.*" (g)

Complete
Specifica-
tion.

Harmar v. Playne (h) 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.

An apparent but not real exception to the rule in *Foxwell v. Bostock*.

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 declaration 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? (i) 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 some-

Claim to an entire combination for a process protects all parts new and material for that process.

(g) *Proctor v. Bennis*, (1887) 4 R. P. C. 358; see also *Watling v. Stevens*, (1886) 3 R. P. C. 153; *Keely v. Heathman*, (1890) 7 R. P. C. 343; *Peckover v. Rowland*, (1893) 10 R. P. C. 118, 234.

(h) (1809) 11 East, 101; 14 Ves. 130; Dav. P. C. 311.

(i) Per James, V.C., *Parkes v. Stevens*, (1869) L. R. 8 Eq. 365; *Clark v. Adie*, (1873) L. R. 10 Ch. 674; L. R. 2 App. Cas. 315.

Claims. thing less more specifically than by merely describing and claiming the whole.^(k) 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.^(l)

THE CLAIMING CLAUSES.

Distinct claiming clauses are in practice required, but are not absolutely necessary.

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.^(m)

The Act of 1883, however, expressly provides ⁽ⁿ⁾ 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 not invalidate the patent.^(o) 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, sub-s. 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.^(p)

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.^(q)

^(k) Clark v. Adie, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315.

^(l) Rowcliffe v. Morris, (1886) 3 R. P. C. 17; Murray v. Clayton, (1872) L. R. 7 Ch. 570, 578; Westinghouse v. Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229, 241; Watling v. Stevens, (1886) 3 R. P. C. 37.

^(m) Lister v. Leather, (1857) 8 E. & B. 1004; Dudgeon v. Thomson, (1877)

L. R. 3 App. Cas. 34, 54; Plimpton v. Spiller, (1877) L. R. 6 Ch. D. 426.

⁽ⁿ⁾ S. 4, sub-s. 5.

^(o) Siddell v. Vickers, (1888) 5 R. P. C. 431-3; L. R. 39 Ch. D. 92.

^(p) *Ibid.*

^(q) Siddell v. Vickers, (1888) 5 R. P. C.; L. R. 39 Ch. D. 109; but see Smith's Patent, Griff. P. C. 268.

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.^(r) 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.*,

Claims.

 Claims operate as a security for the patentee.

“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 *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.”^(s)

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.^(t) 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,^(u) 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

A claim is by implication a disclaimer.

^(r) *Kay v. Marshall*, (1836) 2 W. P. C. 39.

^(s) *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 426; see *Edison v. Woodhouse*, (1886) 32 Ch. D. 520; *Daw v. Eley*, (1867) 14 W. R. 126; L. R. 3 Eq. 496; *Russell v. Cowley*, (1835) 1 W. P. C. 465; *Thomas v. Welch*, (1866) L. R. 1 C. P. 192; *Edison Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 401.

^(t) *Harrison v. The Anderston Foundry Co.*, (1876) 1 App. Cas. 574, 579; *Easterbrook v. Great Western Ry. Co.*, (1885) 2 R. P. C. 201, 208; *Lucas v. Miller*, (1885) 2 R. P. C. 159; *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607, 612; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 721, 741.

^(u) See p. 296 *post*.

Claims. he has claimed.(x) 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.(y) Again the omission to include an essential part in a combination claim may be fatal on the ground that the combination actually claimed is not useful, and is not subject-matter.(z)

Rules to be observed in drafting claiming clauses.

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

Claim which extends to what patentee has not invented or described is fatal.

If the patentee lay claim to anything he has in fact not invented,(a) or not described,(b) he will thereby render his patent bad, notwithstanding that the specification may describe and

(x) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607, 612; *Jackson v. Wolstenhulmes*, (1884) 1 R. P. C. 105; *Fairburn v. Household*, (1886) 3 R. P. C. 263; *Parkinson v. Simon*, (1895) 12 R. P. C. 406.

(y) *Harrison v. Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574, 578.

(z) *Weir v. Denny*, (1894) 11 R. P. C. 657.

(a) Chap. iii.; *R. v. Else*, (1785) 1 W. P. C. 76; *Thomas v. Foxwell*, (1858) 5 Jur. N. S. 37; 6 Jur. N. S. 271; *Crossley v. Potter*, (1853) Macr. P. C. 240; *Ralston v. Smith*, (1860) 9

C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, (1856) 2 H. & N. 84; *Saunders v. Aston*, (1832) 3 B. & Ad. 881; 1 W. P. C. 75; *Haworth v. Hardcastle*, (1834) 1 W. P. C. 484; *Jordan v. Moore*, (1866) L. R. 1 C. P. 624; *Patterson v. Gaslight and Coke Co.*, (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; *Bailey v. Robertson*, (1876) L. R. 3 App. Cas. 1055; *Cropper v. Smith*, (1884) 1 R. P. C. 81; *Gandy v. Reddaway*, (1885) 2 R. P. C. 49; *Leadbeater v. Kitchin*, (1890) 7 R. P. C. 235.

(b) *Monnet v. Beck*, (1897) 14 R. P. C. 777.

claim things which are new and of which he was the undoubted discoverer. Thus, 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, the patent cannot be supported, unless the claim is strictly limited to the method of using the machine.(c) So also a patent is void when upon the true construction of the specification the claim includes both a process and an apparatus for carrying it out, and the latter is old.(d) If the claim was for the process combined with the apparatus the lack of novelty in the apparatus would no doubt be no objection to the validity of the patent, for there would then be no separate claim to it.(e)

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,(f) and a principle alone cannot form the subject-matter of a valid patent;(g) moreover, if a claim be so wide in its terms as to amount to the enumeration of a known truth, it cannot be supported.(h)

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

Minter's patent for an improvement in the construction of chairs 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.

(c) *Hill v. Thompson*, (1817) 1 W. P. C. 232; *Tetley v. Easton*, (1852) 2 E. & B. 956; but see pp. 62-84 ante.

(d) *Tolson v. Speight*, (1896) 13 R. P. C. 718.

(e) See *ibid.* 721; p. 232 post.

(f) *Neilson v. Harford*, (1841) 1 W. P. C. 355.

(g) p. 37 ante.

(h) *Patterson v. Gas Light and Coke Co.*, (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239.

(i) *Hill v. Thompson*, (1817) 1 W. P. C. 232.

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Claim to something useless for purpose in view is fatal,

but not so a claim to something of only small utility.

Claims are construed with reference to the body of the specification, and after a consideration of it.

A claim to something which is useless for the purpose the patentee has in view is fatal. Thus a patent for extracting gold from ore by cyanide of potassium was held bad because the patentee claimed the use of all strengths of solution of cyanide, whereas the evidence established that a weak solution alone would do, and a strong solution was utterly useless for the purpose the patentee had in view.^(k)

On the other hand, a patentee who discovers a valuable invention does not invalidate his patent by a claim for a second purpose less valuable than the main purpose, unless the second purpose has absolutely no utility, or has been anticipated, or required no invention.^(l)

A claim may be so extensive, as of itself, quite independently of evidence, to vitiate a patent;^(m) 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.⁽ⁿ⁾

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.^(o) 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.^(p)

It is not right for the Court which has to construe the claim to look first at the claim and then at the full description of the invention; but the proper course is for the Court first to read the description of the invention in the body of the specification, so as to be prepared to understand what the inventor is about to claim, and then determine whether the claim really goes further than what is described.^(q)

Thus in *Leonardt v. Kallé*,^(r) the subject-matter of the patent was the production of various colouring-matters fast to

^(k) *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1894) 11 R. P. C. 638; 12 R. P. C. 232, 256; see also p. 144 *ante*.

^(l) See *Adamant Stone and Paving Co. v. Corporation of Liverpool*, (1896) 14 R. P. C. 11.

^(m) *Neilson v. Harford*, (1871) 1 W. P. C. 355; *Arnold v. Bradbury*, (1871) L. R. 6 Ch. 706.

⁽ⁿ⁾ *Arnold v. Bradbury*, (1871) L. R. 6 Ch. 706; *Wyeth v. Stone*, 1 Story, 273.

^(o) *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Parkinson v. Simon*,

(1894) 11 R. P. C. 238, 493; 12 R. P. C. 403; p. 247 *post*.

^(p) *Arnold v. Bradbury*, (1871) L. R. 6 Ch. 706; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Kay v. Marshall*, (1835) 2 W. P. C. 36; *Beard v. Egerton*, (1849) 3 C. B. 165, 215.

^(q) *Arnold v. Bradbury*, (1871) L. R. 6 App. Cas., judgment of Lord Hatherley, L.C., p. 712; *Edison-Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 389, judgment of Esher, M.R., pp. 395-396.

^(r) (1895) 12 R. P. C. 103.

alkali by the action of suitable oxidisable substances, and for alkalies upon a certain substance under heat. It was objected that the claim was too general, as it stated that oxidisable substances other than those specifically mentioned could be used, and this would include zinc dust, the action of which on the certain substance was already known, and further, because whilst claiming colouring matters the specification did not indicate the processes necessary to produce particular shades. But *Romer, J.*, who tried the case, held that this objection failed because the claim, read with the body of the specification, was limited to an oxidation by the zinc dust further—*i.e.*, more complete—than that already known; and the patentee having pointed out the limits of colours his process could produce, it was not incumbent on him to attempt the almost impossible task of defining shades of colour. A chemist would have no difficulty in selecting any shade he might require.

So 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.^(s)

If the patentee claims more 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 advantages arising from what is not, as well as what 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 not to cover things in prior use, though it does refer to advantages common to the use of old things and what the patentee has invented.^(t)

Also an inventor is entitled to claim not only the use of an improved apparatus for the purpose for which he primarily designed it, but also its use for analogous purposes; and it is no objection to such a claim that there are some analogous purposes to which the patentee's invention would not be applicable.^(u)

If the complete specification describe any method of carrying out the invention which will not answer, and so lead the

^(s) *Gandy v. Reddaway*, (1885) 2 R. P. C. 52; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107.

^(t) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48, 58.

^(u) *Chadburn v. Mechan*, (1895) 12 R. P. C. 120, 134.

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public to perform operations which must necessarily fail, the patent will be bad; (x) 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 any one of them turns out to be bad, the whole patent will be void. (y)

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

Purely speculative claims may prove fatal.

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. (z) Moreover, a claim which is general will not entitle a man to improvements of which he was ignorant at the date of the patent. (a)

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

Pollock, C.B., also, in a case where a patentee in his specification had described the use of atmospheric air in a particular way 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,

(x) p. 189 ante.

(y) *Patterson v. Gas Light and Coke Co.*, (1875) L. R. 2 Ch. D. 812, 833; L. R. 3 App. Cas. 239.

(z) *Tetley v. Easton*, (1852) Macr. P. C. 48, 76.

(a) *Ibid.*

(b) *Crossley v. Potter*, (1853) Macr. P. C. 256.

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 curving of the arms was a further invention and improvement, the patentee's claim failed. 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.(c)

If the patentee claims to perform an operation by the use of one or more of several substances, some of which will not answer, and the claim is so ambiguous that it may be read as including those which will not do as well as those which will do, the patent will be void.(d)

The following important cases may be given as illustrating this point (e) :—

Stevens v. Keating, (1847) 2 W. P. C. 181, 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

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A claim which is so ambiguous that it may be read as including what will not answer the purpose in view as well as what will, is fatal.

Examples.

Stevens v. Keating.

(c) *Tetley v. Easton*, (1852) Macr. P. C. 48.

(d) *Stevens v. Keating*, (1847) 2 W. P. C. 181; *Tetley v. Easton*, (1852) Macr. P. C. 48; *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312; *Ralston v. Smith*, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; *Booth v. Kennard*, (1857) 2 H. & N.

S4; *Haworth v. Hardcastle*, (1834) 1 W. P. C. 480; *Saunders v. Aston*, (1832) 13 B. & Ad. 881; 1 W. P. C. 75 n.; *Kurtz v. Spence*, (1883) 5 R. P. C. 161; *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671.

(e) See also other cases *ibid.*

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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." (f) And his Lordship directed a verdict for the defendant on the issue of the sufficiency of the specification, which was upheld by the Court of Exchequer.

In *Hills v. London Gas Light Co.*, (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409, 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.

In *Bailey v. Robertson*, (1878) L. R. 3 App. Cas. 1055, 1078, 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 to be bad, on the ground of ambiguity. It appeared that some of 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.

In *Booth v. Kennard*, (1856) 2 H. & N. 84; 26 L. J. N. S. Ex. 23, 305, 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.

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.*

If protection is desired for subordinate parts alone, they must be claimed separately.

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

(f) (1847) 2 W. P. C. 181.

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.(g)

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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 ;(h) and very little merit will do to support a claim to a subsidiary part of a great invention.(i)

Clark v. Adie is the leading case which illustrates the fact that a patentee who does not properly claim all he may be entitled to claim thereby loses protection in respect of subordinate parts which he might legitimately have claimed. The case may be epitomised from this point of view as follows:—

Patentee is protected only in respect of what he actually claims—not in respect of what he might have claimed.

In *Clark v. Adie*, (1873) L. R. 10 Ch. 667 ; 2 App. Cas. 315, 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,

Clark v. Adie is the leading case on this point.

(g) *Clark v. Adie*, (1873) L. R. 2 App. Cas. 320, 321 ; *Cropper v. Smith*, (1884) 1 R. P. C. 87.

(h) *Clark v. Adie*, (1873) L. R. 2 App. Cas. 320 ; p. 218 *ante*.

(i) *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

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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, 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, not having taken anything claimed by the patent, had committed no infringement.

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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 alleged 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.

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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.*

Subsidiary claims to old things.

A claim which is only subsidiary, even though the thing claimed is old, will not vitiate a patent if it is within the main claim or is only for one of the merits and advantages of the entire construction which the patentee has described, and does not enlarge the monopoly; but if the alleged subsidiary claim really enlarges the main claim and is for something old, then it will be fatal.^(k)

A claim which is subsidiary to the main claim may be really surplusage as being consequentially protected by the main claim. The patentee should avoid the objection of surplusage in drafting the specification, as he may thereby place himself in an unnecessary position of difficulty should he be called upon to support his patent in a court of law. This will appear from the judgment of Lord *Hatherley* in *British Dynamite Co. v. Krebs* ^(l) quoted below.^(m)

Leading cases.

The above stated principles, which are often of vital importance, are illustrated by the leading cases given in epitome as follows:—

British Dynamite Co. v. Krebs.

In *The British Dynamite Co. v. Krebs*, (1875) G. P. C. 88; 13 R. P. C. 190,⁽ⁿ⁾ 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 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 gun-

^(k) *Neilson v. Betts*, (1871) L. R. 5 H. L. 21; 40 L. J. Ch. 317; *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 286; 6 Ch. D. 412; *British Dynamite Co. v. Krebs*, (1875) G. P. C. 94; 13 R. P. C. 190; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437.

^(l) 13 R. P. C. 196; see also *Pneu-*

matic Tyre Co. v. Casswell, (1896) 13 R. P. C. 180.

^(m) p. 234 *post*.

⁽ⁿ⁾ See also *Thompson v. American Braided Wire Co.*, (1889) 6 R. P. C. 528; *Fawcett v. Horman*, (1896) 13 R. P. C. 398, in judgment of Rigby, L.J., p. 410.

powder. *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 (13 R. P. C. 193): "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

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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."

Lord *Hatherley* upon the same point spoke as follows (13 R. P. C. 196):

"The patentee having, as I have said, discovered a material which will not go off at a moment's notice, it is necessary to show that it will go off somehow or other. And in order that you may know how it will go off the patentee must tell you how to set it off. If he has discovered it he is bound to tell you the best way of doing it. Mr. *Nobel* accordingly tells you that one mode, amongst other modes, is by a percussion cap. That is a mode which has been used for exploding gunpowder and other things, but which, he said, he found would explode this new material called 'dynamite.' Having described his invention, he says in his claim at the end: '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.' It is a mode of 'special ignition.' He claims the mode of manufacturing safety powder or dynamite and the 'modes of firing the same,' that is the dynamite. The worst that can be said in the way of objection to this is that there is surplusage. The objection of surplusage must be admitted to be one which ought, no doubt, to be very carefully avoided by a patentee. The most that can be said adverse to the patent here is that the patentee might have been quite content to sit still and say: 'Now I have shown you how to make the dynamite. I have shown you what the dynamite is, and I have shown you how to set it off; that is the invention,' without mentioning the firing in the claim. But then, as was well urged by the learned counsel in argument, it cannot be said that this claim deprives any human being, past, present, or to come, of any possible right they might otherwise acquire, because they could not acquire any right in the dynamite without laying themselves open to an infringement of the letters patent in respect of the use of the dynamite. It is the firing of the dynamite, and only dynamite,

in this peculiar mode that is claimed; and you must make use of the patentee's dynamite before you can explode it. He says, 'I am not going to tell you a useless thing. If I did not tell you how to ignite it, you might say that my dynamite is useless, because when it is put in a quarry it will not go off at all, and so I tell you here is my dynamite, and here is my means of igniting it; if you are willing to pay me for it I will hand over to you the full benefit of my invention, first the mode of making the material itself, and then the mode of setting it off.'"

Claims.
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In *Plimpton v. Spiller*, (1875) 4 Ch. D. 286; 6 Ch. D. 412, Plimpton v. Spiller. it appeared that *Plimpton's* specification for the roller skate 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 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.

In *The United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705, United Telephone Co. v. Harrison. one of the 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. *Lry, J.*, was of opinion that the

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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.

Some subordinate claims are fatal.

It is important to bear in mind that the above statements of the law merely relate to the construction of the specifications in certain particular cases. When there are separate claims for different combinations, the first being for a general combination and the others for combinations of some of the integers which constitute the general combination, it is not right to say that the smaller claims 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.(o)

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.*

Claim to a use of a new thing may be good though the use in itself is not subject-matter.

Thus, in *Betts v. Neilson*,(p) 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.(q)

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

(o) *Cropper v. Smith*, (1884) 1 R. P. C. 88, 90, 91; *Murchland v. Nicholson*, (1893) 10 R. P. C. 417.

(p) (1868) L. R. 3 Ch. 429; 5 H. L. 1.
(q) See p. 71 *ante*.

Lord *Westbury*, addressing the House of Lords, said:—

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tion.

“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 manufactures 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 for the jury, if there be one, otherwise for the Judge acting as a jury.^(r) The determination of the second question is one of law, and is in all cases for the Court alone.^(s) The Judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result.^(t)

Construction of the specifications is usually necessary in legal proceedings.

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

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

Interpretation of language used in specifications.

^(r) *Walton v. Bateman*, (1842) 1 W. P. C. 621; *Beard v. Egerton*, (1846) 8 C. B. 165; 19 L. J. N. S. C. P. 36; *Hill v. Thompson*, (1817) 1 Web. P. C. 237; *Bickford v. Skewes*, (1837) 1 Q. B. 938; *Neilson v. Harford*, (1841) 1 W. P. C. 370; *Wallington v. Dale*, (1852) 7 Exch. 888; *Parkes v. Stevens*, (1869) L. R. 8 Eq. 358; L. R. 5 Ch. App. Cas. 36.

^(s) *Hill v. Evans*, (1862) 31 L. J. Ch.

460; *Neilson v. Harford*, (1841) 1 W. P. C. 370; *British Dynamite Co. v. Krebs*, (1875) G. P. C. 91; 13 R. P. C. 190; *R. v. Wheeler*, (1850) 2 B. & Ald. 345; *Seed v. Higgins*, (1860) 8 H. L. Cas. 561; *Bovill v. Pimm*, (1856) 11 Ex. 740.

^(t) Per Cresswell, J., *Beard v. Egerton*, (1849) 19 L. J. N. S. C. P. 38; see also *Neilson v. Harford*, (1841) 1 W. P. C. 370.

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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.^(u)

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.^(x)

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.^(y)

The Court ought to construe the specification like all written instruments, taking the words, and seeing what is the meaning 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.^(z)

The patent for the preparation of Lanolin ^(a) affords a good instance of the application of this principle. In that case one of the alternative processes for the further purification of raw Lanolin described was dissolution by a *solvent*, and amongst

^(u) British Dynamite Co. v. Krebs, (1875) G. P. C. 91; 13 R. P. C. 190; Clark v. Adie, (1873) L. R. 2 App. Cas. 436; Neilson v. Harford, (1841) 1 W. P. C. 313; Elliot v. Turner, (1845) 2 C. B. 446; Walton v. Potter, (1841) 1 W. P. C. 595; Harrison v. The Anderson Foundry Co., (1876) L. R. 1 App. Cas. 581.

^(x) Per Pollock, B., Kaye v. Chubb, (1887) 4 R. P. C. 299.

^(y) Hill v. Evans, (1862) 31 L. J. Ch. 460.

^(z) Per Lord Blackburn, Clark v. Adie, (1873) L. R. 2 App. Cas. 436; see also Betts v. Menzies, (1862) 10 H. L. Cas. 117; Simpson v. Holliday, (1866) 13 W. R. 577; L. R. 1 H. L. 315; Edison v. Holland, (1888) 5 R. P. C. 474.

^(a) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1894) 11 R. P. C. 93, 261.

other solvents specifically mentioned was methylated spirit. The defendants contended that this was not a useful solvent, as, though it might dissolve impurities and so be useful as a purifier, it did not dissolve except with difficulty the pure cholestrine fats, and they said that according to the strict wording of the specification a person would gather that all the raw Lanolin was to be dissolved. *Romer, J.*, decided at the trial that, upon the evidence adduced as to the scientific meaning of the word *solvent* and upon the true construction of the specification, the solvent referred to was to be used as a purifier according to its known properties, and no one would imagine that in every case it was essential to dissolve the whole of the raw Lanolin, and the Judge being satisfied that it could be used usefully as a purifier, though not so efficaciously as some of the other solvents specifically mentioned, the objection against the validity of the patent therefore failed. The patent was also upheld by the Court of Appeal.

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tion.

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.^(b)

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 indicated 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.^(c)

Variations in
meaning.

The former practice of construing specifications very strictly against the patentee and in favour of the Crown, which was indulged in by Judges 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

^(b) *Thomas v. Foxwell*, (1858) 5 Jur. N. S. 37; *Robertson v. French*, (1803) 4 East. 135, 136; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117, 152; *Hill v. Evans*, (1862) 6 L. T. N. S. 70; *Neilson v. Harford*, (1841) 8 M. & W. 806; 1 W. P. C. 331; *Hills v. The London*

Gas Light Co., (1857) 5 H. & N. 312; *Jupe v. Pratt*, (1837) 1 W. P. C. 144; *Walton v. Potter*, (1841) 1 W. P. C. 585; *Steiner v. Heald*, 6 Exch. 607.
^(c) *Betts v. Menzies*, (1862) 10 H. L. Cas. 152.

Construction. encouraged on the ground of public policy, drew from Lord *Tenterden*, C.J., (*d*) 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. (*e*)

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 at another time it may be to the advantage of the patentee to obtain a narrow construction, so that the specification may be held not to include something which is old. (*f*) 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. (*g*) 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 patentee must clearly define both the invention and the method of performing it. (*h*)

Construction must be logical, fair, and impartial.

The construction of the specification must be logical, fair, and

(*d*) *Huddart v. Grimshaw*, (1803) 2 B. & Ald. 377.

(*e*) *Stevens v. Keating*, (1847) 2 W. P. C. 177; *Russell v. Cowley*, (1832) 1 W. P. C. 465; 1 Cr. M. & R. 864; *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Young v. Rosenthal*, (1884) 1 R. P. C. 33; *Westinghouse v. The Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 229.

(*f*) *Stevens v. Keating*, (1847) 2 W. P. C. 194; *Downes v. Falcon Works*,

(1886) 3 R. P. C. 70; *Kaye v. Chubb*, (1887) 4 R. P. C. 289; *Hutchinson v. Patullo*, (1887) 4 R. P. C. 329; *Gosnell v. Bishop*, (1888) 5 R. P. C. 151, 158; *Ellington v. Clark*, (1888) 5 R. P. C. 319, 327.

(*g*) Per Lord Blackburn, *Dudgeon v. Thompson*, (1877) L. R. 3 App. Cas. 53; see remarks of Tindal, C.J., *Haworth v. Hardcastle*, (1834) 1 W. P. C. 480; 1 Bing. N. C. 182, 190.

(*h*) *Neilson v. Harford*, (1841) 1 W. P. C. 310.

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.⁽ⁱ⁾

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tion.

The adoption of such a construction, though it supports the validity of the patent, not unfrequently tells against the plaintiff on the question of infringement.^(k)

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.^(l)

Doctrine that patentee would not intend to claim anything which would render the patent void.

Thus in *Neilson v. Harford*,^(m) 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 was material. If the proper construction 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

(i) *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 612; 46 L. J. Ch. 185; *Plimpton v. Spiller*, (1876) L. R. 6 Ch. D. 422; *Russell v. Cowley*, (1832) 1 Cr. M. & R. 864; 1 W. P. C. 460; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 297,

307; *Morris v. Young*, (1895) 12 R. P. C. 463.

(k) *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671.

(l) *Clark v. Adie*, (1873) L. R. 3 Ch. D. 142. (m) (1841) 1 W. P. C. 331.

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tion.

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* (n) 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.

Limit to doctrine of construction according to patentee's intention.

The doctrine that the patentee intends his patent to be a good one must not be pushed too far in construing the specification. 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. The specification should be construed rather by trying to see what it says than by what the draughtsman meant, for frequently the draughtsman's object is to be as vague as possible without endangering the patent,(o) and what

(n) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

(o) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 320.

is put in the form of a claiming clause may in reality only be the statement of a method of carrying out the invention and not a claim at all. When this is so, the patentee will be protected against his own folly in not putting the description into the body of the specification instead of in the form of a claiming clause. (p)

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tion.

Thus the argument of absurdity cannot be used in favour of the patentee if the wording of the specification is perfectly clear. (q)

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. (r) 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. (s)

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

Court is not
astute to find
flaws.

In *Palmer v. Wagstaffe* (y) 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

(p) Per Kekewich, J., *Pneumatic Tyre Co. v. Casswell*, (1896) 13 R. P. C. 164, 181.

(q) *Cropper v. Smith*, (1884) 1 R. P. C. 90; *Clark v. Adie*, (1873) L. R. 2 App. Cas. 423, 437.

(r) *Clark v. Adie*, (1873) L. R. 3 Ch. D. 142.

(s) *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 307; *Needham v. Johnson*, (1884) 1 R. P. C. 58; *Vorwerk v. Evans*, (1890) 7 R. P. C. 167, 265.

(t) p. 241 ante; *Russell v. Cowley*, (1832) 1 W. P. C. 457; 1 Cr. M. & R. 864.

(u) *Otto v. Linford*, (1881) 46 L. T. N. S. 35, 39; *Plimpton v. Spiller*, (1876) L. R. 6 Ch. D. 422.

(x) *Russell v. Cowley*, (1832) 1 W. P. C. 470; *Palmer v. Wagstaffe*, (1854) 9 Exch. 494, 501. The above paragraph was referred to with approval by Kay, L.J., in *Edison-Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 400, and the principles therein involved were applied in that case.

(y) (1853) 8 Exch. 840; 22 L. J. Ex. 295; 9 Exch. 494; 23 L. J. Ex. 217.

Construction.

court below, it became necessary for him to contend that his 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.

Doctrine of benevolent construction.

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,^(z) but should be construed like all written instruments impartially according to its true meaning,^(a) unless the language is ambiguous,^(b) the Courts adopting a construction which will support the patent in preference to one which will not.^(c)

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,

^(z) *Harrison v. The Anderston Foundry Co.*, (1876) L. R. 1 App. Cas. 574; *Needham v. Johnson*, (1884) 1 R. P. C. 58; see p. 104; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 307.

^(a) *Clark v. Adie*, (1875) L. R. 2 App. Cas. 436; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117; *Simpson v. Holli-*

day, (1864) 13 W. R. 577; L. R. 1 H. L. 315; *Edison v. Holland*, (1888) 5 R. P. C. 474.

^(b) *Parkinson v. Simon*, (1895) 12 R. P. C. 406-407.

^(c) pp. 240-241 *ante*.

^(d) (1795) D. P. C. 162; 2 H. Bl. 463; 3 Ves. 143.

“*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.”

Construc-
tion.

The true limits within which the doctrine of benevolent construction may be applied in favour of the patentee are, it is submitted, clearly defined in the two following extracts from judgments of Sir *George Jessel*, M.R., and the late Lord *Bowen* respectively:—

True limits to
the doctrine.

In *Hinks v. Safety Lighting Co.*, (1876) L.R. 4 Ch.D. 607, 612, *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.” (*f*)

In *Cropper v. Smith*, (1884) 1 R. P. C. 89, *Bowen*, L.J., stated the duty of the Court in the following terms, which were quoted with approval by *Lindley*, L.J., in the subsequent case of *Benno Juffé und Darmstaedter Lanolin Fabrik v. Richardson & Co.*, (1894) 11 R. P. C. 271:—

“We were pressed very earnestly to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many Judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees

(e) *Thomas v. Foxwell*, (1859) 6 Jur. N. S. 272.

(f) See also *Plimpton v. Spiller*,

(1877) L. R. 6 Ch. D. 422; *Otto v. Linford*, (1881) 46 L. T. N. S. 39;

Cropper v. Smith, (1884) 1 R. P. C. 89.

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tion.**

must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as *Coke* and *Shepherd's Touchstone*, to the effect that the interpretation of a written document ought to be benevolent or benign. *Verba debent intelligi cum effectu ut res magis valeat quam pereat*. Now that is only a caution against excessive formalism, it only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is, as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by their deed, and you must not defeat it, if effect can be given to their intention by a fair construction of the whole document. It is almost always coupled with another maxim, which seems to be nearly the same thing in another shape: *Verbu intentioni debeat inservire*. You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim, that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly can never be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document, it is not an excuse to justify you in misconstruing a document."

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 which makes the patent utterly absurd; (g) but if it is established by the evidence before the Court that certain matters, which the specification upon a fair construction claims, were

(g) *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 422; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 98; *Cropper v. Smith*, (1884)

1 R. P. C. 81; *Haworth v. Hardcastle*, (1834) 1 W. P. C. 484; *Needham v. Johnson*, (1884) 1 R. P. C. 58; *Morris v. Young*, (1895) 12 R. P. C. 463.

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.^(h) 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."⁽ⁱ⁾

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In construing a claim, however, 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 useless.^(k) 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.^(l)

It may be pointed out that the considerations above discussed affect the question of the benevolent construction of the specification, a document prepared by the patentee himself, and that this is a different question to that of the benevolent construction of the grant contained in the actual letters patent.

Word used in a popular sense is not construed according to its exact 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.^(m)

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

Claims are construed with reference to the whole specification.

Thus, in the case of *Newton v. Vaucher* ^(p) it was material to

^(h) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 433, 437.

⁽ⁱ⁾ *Clark v. Adie*, (1877) 2 App. Cas. 431.

^(k) Per *Jessel*, M.R., *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 422.

^(l) Per *Jessel*, M.R., *Otto v. Linford*, (1881) 46 L. T. N. S. 39.

^(m) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 426.

⁽ⁿ⁾ *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68; *Newton*

v. Vaucher, (1851) 6 Exch. 859; 21 L. J. Ex. 305.

^(o) *Neilson v. Harford*, (1841) 1 W. P. C. 312, 373; *Lister v. Norton*, (1886) 3 R. P. C. 203; *Plimpton v. Spiller*, (1877) L. R. 6 Ch. D. 426; *Wegmann v. Corcoran*, (1876) L. R. 13 Ch. D. 65, 77; *Edison v. Woodhouse*, (1887) 4 R. P. C. 107; *Kaye v. Chubb*, (1888) 5 R. P. C. 641; *Parkinson v. Simon*, (1894) 11 R. P. C. 238, 493; 12 R. P. C. 403.

^(p) (1851) 6 Exch. 859; 21 L. J. Ex. 305.

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

Again, in *Montgomerie v. Peterson*, (1) the patent was for the discovery and preparation of a diastasic mixture and its application to or mixture with a batch of bread or other food, so as with the aid of heat to convert flour into maltose and predigest the food. The claim was "the mode and means and combination of mixtures with the special preparation of malt extract herein distinguished for manufacturing or making bread and biscuits substantially in the new or improved manner herein described." The defendant contended that this claim was wholly unintelligible, but that, construed in the most favourable sense, it amounted merely to a claim for the combining, or for the mode of combining (1) the described special mixture with (2) certain other described mixtures forming the bulk of the batch; and further, that if this combination involved no difficulty it had no merit, and was therefore not patentable, and if it did involve difficulty the mode of performing the operation was not described sufficiently to enable it to be successfully performed. The Courts, however, held that, looking at the specification as a whole, it could be gathered what the patentee meant—*i.e.*, he did not claim the mere combining of his special mixture (*i.e.*, the separate mixture in which the diastase was produced) with the various mixtures which he suggested as suitable for the dough forming the rest of the batch. What he did claim was the mode described of preparing the various mixtures forming the dough or bulk of the batch (a mode perfectly well described) and then the combining of those mixtures with his special or separate mixture, the mode of preparing which latter was also well described. The claim so read possessing novelty and utility, the patent was upheld.

Distinct effective meaning is, if possible, to be given to each claim.

When there are several claims, a distinct effective meaning must, if possible, be given to each, for the rule is that each part of the specification should be effectively construed, and if

(1) (1894) 11 R. P. C. 221, 633.

several claims mean the same thing they cannot be said to be effective.^(r) If, however, it is not possible to give a distinct effective meaning to all the claims, the fact that some are redundant does not invalidate the patent.^(s)

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tion.

The claims should specifically refer to all that is of the essence of the invention in respect of which the patentee desires to be protected. If, however, some essential feature is not directly mentioned in the claims, though the thing described *necessarily* possesses that essential feature, the claim is sufficient and the use of the essential feature in question would be an infringement.^(t) Thus, in *Tweeddale v. Ashworth*,^(u) one essential element in the success of the patentee's contrivance for an improved flat and fastener for securing carding cloth thereon, was that the material should be stretched, at the same time and by the same operation as completed the machine. Though this was not directly mentioned in the claim, it followed as a consequence from the thing claimed and described. The House of Lords held the patent valid, but that the defendant had not infringed, as he had not taken this essential feature in question. Lord *Halsbury*, L.C., said: "Now, my Lords, looking to the patent itself and the specification, I am unable to give any other construction to the patent here than that which involves the particular thing, with its own particular incidents, which is therein described; and I think that the fallacy of the argument which has been ingeniously suggested to us is this: It is said that there is no claim for the stretching. If by that is meant that there is in the claim no such word as 'stretching,' I agree the word 'stretching' does not occur; but what there is in the claim is this—there is a claim for a thing which is described and illustrated by the description in the letterpress and by the illustration which is given in the drawing, and both the letterpress and the drawing describe a machine, and describe the mode of manufacturing the machine, which, of itself, necessarily involves, as one of the merits of the invention, the power of stretching the material at the same time and by the same operation as completing the machine. That, I believe, is the merit of the invention, and a very material merit of the invention, and it appears to me that, that being one of the

Essence of an invention may be protected though the claim does not specifically mention it.

^(r) *Parkinson v. Simon*, (1894) 11 R. P. C. 502; *Jordan v. Moore*, (1866) L. R. 1 C. P. 624.

^(s) *Wenham Gas Co. v. Champion*

Gas Lamp Co., (1892) 9 R. P. C. 55.

^(t) See pp. 468-493 *post*.

^(u) (1892) 9 R. P. C. 127.

Construction. important elements forming the substance of the invention, it is one which the defendants have in no way invaded."

Again, in *Boyd v. Horrocks*,^(x) the House of Lords, upon the same principle, held that, though a claim in question was for an arrangement which attained an old result in a similar way to an alleged anticipation, it was not limited to the particular form of parts specified, but involved the possession of a certain essential and novel feature, by the taking of which the defendant had infringed the patent.

Principle of introducing claim by implication is employed with great caution.

It must be remembered that the Courts, in all cases, only apply this principle of introducing, by implication, a claim not expressly contained in a specification with the greatest possible caution.^(y)

Frequently claiming clauses end with such words as "*substantially as described*," or "*substantially as and for the purpose hereinbefore described*," which are usually introduced with the object of limitation. Whether such words have any or what effect depends in each case upon the construction of the specification as a whole.^(z)

Provisional cannot be called in aid to construe complete specification.

The complete specification must be construed without calling in the aid of the provisional to explain or enlarge its meaning; ^(a) though the Court may look at the provisional specification for the purpose of ascertaining the real object of the invention claimed in the complete.^(b)

Specification is construed with reference to

The specification is always construed by the Courts, with regard both to accuracy of definition and sufficiency of descrip-

^(x) (1892) 9 R. P. C. 77; see also *Moore v. Thompson*. (1890) 7 R. P. C. 325.

^(y) *Muirhead v. Commercial Cable Co.*, (1895) 12 R. P. C. 39, 56.

^(z) For instances see *Young v. Rosenthal*, (1883) 1 R. P. C. 33; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 241; *Lawrence v. Perry*, (1885) 2 R. P. C. 183; *Easterbrook v. Great Western Ry. Co.*, (1885) 2 R. P. C. 208; *United Telephone Co. v. Bassano*, (1888) 3 R. P. C. 295; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1895) 12 R. P. C. 232; *Parkinson v. Simon*, (1895) 12 R. P. C. 403.

In the following cases the words printed in italics were interpreted with reference to the rest of the specification in each case:—

As above described.—*Plating Co. v. Farquharson*, (1879) Griff. 191; *Barber v. Grace*, (1847) 1 Ex. 122.

As above set forth.—*Bray v. Gardner*, (1887) 4 R. P. C. 403.

Substantially as set forth.—*United Telephone Co. v. Bassano*, (1886) 3 R. P. C. 315.

As described and illustrated.—*Fairburn v. Household*, (1886) 3 R. P. C. 267.

Other substances.—*Crossley v. Beverley*, (1829) 9 B. & C. 63; *Bickford v. Skewes*, (1841) 1 Q. B. 948; 1 W. P. C. 218.

Any mechanical equivalent.—*Curtis v. Platt*, (1863) L. R. 3 Ch. D. 137 n.

Analogous.—*Brown's Patent*, Griff. L. O. C. 1.

More or less.—*Plating Co. v. Farquharson* (1879–1883); Griff. P. C. 187, 190.

Or.—*Simpson v. Holliday*, (1864) 20 Newton's Lond. Journal N. S. 108; *Elliot v. Turner*, (1845) 2 C. B. 446; 15 L. J. C. P. 49; *Hills v. London Gas Light Co.*, (1860) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409.

^(a) *Mackelcan v. Rennie*, (1862) 13 C. B. N. S. 52.

^(b) *Parkinson v. Simon*, (1894) 11 R. P. C. 502.

tion, 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.^(c)

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public knowledge at the date of the patent,

Thus in *Nobel's Explosives Company v. Anderson* (*d*) the question was whether the term "soluble" nitro-cellulose as used in the specification included a form of nitro-cellulose which the defendant at a later date claimed to use in the manufacture of an explosive as "insoluble" nitro-cellulose. The evidence was conflicting, but it was decided that the term "soluble" nitro-cellulose at the date of the plaintiff's patent did not, according to the meaning attributed to it then by chemists, include the form of nitro-cellulose used by the defendant and described by him as "insoluble," and so there was no infringement.

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.^(e)

and with reference to what it would lead the person to whom it is addressed to do.

In *Badische Anilin und Soda Fabrik v. Levinstein*, (*f*) 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, though these two isomers were known at the date of the patent, 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*,"

(c) *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 710; 14 R. P. C. 449; *Edison v. Woodhouse*, (1887) 4 R. R. P. 94; *Boyd v. Horrocks*, (1892) 9 R. P. C. 295; *King Brown v. Anglo-American Brush Corporation*, (1892) 9 R. P. C. 313, 317, 319, 321; *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 523.

(d) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

(e) *Kaye v. Chubb*, (1887) 4 R. P. C. 289. See p. 191 *ante*.

(f) (1883) L. R. 24 Ch. D. 156; L. R. 29 Ch. D. 366; L. R. 12 App. Cas. 710; 2 R. P. C. 73; 4 R. P. C. 449.

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tion.

taking into account only the state of public knowledge at the 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, (g) 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, (h) who supported the patent, thus upholding the decision of *Pearson, J.*, and reversing that of the Court of Appeal. (i)

Limit to the
latter canon
of construc-
tion.

The doctrine that the specification is to be construed to mean what an ordinary workman would understand it to mean must not be pushed too far. It is only applicable when there appears to be an ambiguity. If the Court is clear as to the meaning of a specification it will not accept the evidence of a workman, or anybody else, on the point, but will construe it as it is bound to do according to its own view. In the words of *Esher, M.R.*, the doctrine is applicable "only when a particular description of work mentioned in the specification, or something to be done, appears to be ambiguous. If you read it without knowledge it appears to be ambiguous, but then it is said: 'It appears to you to be ambiguous, but any workman of ordinary skill in the trade who would have to apply that description would understand it only in one way, and would be able to act upon it.' If that is true, then it is said that, although grammatically or with literary accuracy there might be a doubt about it, there is no real business doubt about it, and the one meaning and the only meaning which could attach to it is that which would strike an ordinary workman in the trade who would have to deal with it, and would strike him as the only way in which the work could be done. That does not apply to this case, for it is not suggested that any one of the many things which have been added to this instrument by this invention is described in any ambiguous way whatever."

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

(h) L. R. 12 App. Cas. 710.

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

In *Clarke v. Adie*,^(k) the question arose as to how far the Court is justified in looking at antecedent publications for the purpose of construing a specification in dispute, but the House of Lords refused to lay down any general rule, and so far none has been stated. Lord Cairns, L.C., however, pointed out 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.

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tion.

Effect of prior
publications on
construction of
specifications.

There are reported cases in which various Judges have acted differently in this matter. Thus in *Westinghouse v. Lancashire and Yorkshire Railway Co.*,^(l) 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.^(m) And in *Couchman v. Greener*,⁽ⁿ⁾ 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.^(o)

Prior public knowledge as disclosed by antecedent specifications, or otherwise, does undoubtedly in one sense affect the question of construction. Thus it is a well-established canon that, if two constructions are possible, the Court will adopt that which will support the patent in preference to one which will not,^(p) and with this object in view the Courts do consider the state of public knowledge at the date of the patent.^(q)

The law provides that both the provisional and complete specifications are to be accompanied by explanatory drawings, if required.^(r) 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 letterpress. In the words of *Abbott, C.J.*:^(s) "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

Drawings in
relation to
construction.

(k) (1873) L. R. 2 App. Cas. 423, 431.

(l) (1884) 1 R. P. C. 98, 101.

(m) See also *Ellington v. Clark*, (1888) 5 R. P. C. 325.

(n) (1884) 1 R. P. C. 197, 199.

(o) *Crosthwaite v. Steel*, (1889) 6 R. P. C. 190.

(p) p. 241 *ante*.

(q) See pp. 241-243 *ante*.

(r) 46 & 47 Vict. c. 51, s. 5, sub-s. 3 and 4.

(s) *Bloxam v. Elsee*, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. T. O. S. Q. B. 93; see also *Milles v. Searle*, (1893) 10 R. P. C. 106.

Construction.

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.^(t) 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.^(u) 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.^(x)

On the point as to how far the drawings may aid the description in the specification, the following observations of Lord *Blackburn* are instructive:^(y) "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 letterpress there is never an allusion to any curved or elastic plate 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 letterpress. 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 result-

(t) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 315; P. O. R.

(u) Per Rook, J., in *Boulton v. Bull*, (1795) D. P. C. 188, 189.

(x) Per Gibbs, C.J., in *Bovill v.*

Moore, (1815) D. P. C. 369; see also *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

(y) *Clarke v. Adie*, (1877) L. R. 2 App. Cas. 338.

ing from a curved plate was contemplated as being included in the invention at all.”(z) Construction.

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;(a) 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;(b) 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. Correction of errors by other parts of the specification.

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;(c) but the public, to whom 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.(d)

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.(e)

(z) See also *Otto v. Linford*, (1881) 46 L. T. N. S. 40.

(a) *Tetley v. Easton*, (1852) Macr. P. C. 47; *Wegmann v. Corcoran*, (1879) L. R. 13 Ch. D. 65.

(b) *Mackelcan v. Rennie*, (1862) 13 C. B. N. S. 52; p. 164 *ante*.

(c) *Otto v. Linford*, (1861) 46 L. T. N. S. 40; *Morgan v. Seaward*, (1836) 1 W. P. C. 174; *Simpson v. Holliday*, (1865) 13 W. R. 578; 12 L. T. N. S. 99; *Derosne v. Fairie*, (1835) 1 W. P. C. 157; *Gandy v. Reddaway*, (1883) 2 R. P. C. 52; *Edison*

v. Woodhouse, (1887) 4 R. P. C. 107; *Hopkinson v. St. James's Electric Light Co.*, (1892) 10 R. P. C. 46; *Miller v. Searle*, (1893) 10 R. P. C. 106.

(d) *British Dynamite Co. v. Krebs*, (1875) G. P. C. 90; 13 R. P. C. 190; *Hinks v. Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 616; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; *Muntz v. Foster*, (1844) 2 W. P. C. 108.

(e) *Simpson v. Holliday*, (1864) 5 N. R. 340; see also p. 178 *ante*.

CHAPTER VI.

AMENDMENT OF THE SPECIFICATIONS.

PART I.—GENERAL.

Certain amendments are allowable.

A PATENT is void and of no effect so long as there is a defect in the specification, but the law, in the interests and for the protection of patentees, allows certain amendments to be made in those documents from time to time; so a patent, otherwise 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.(a)

It is not the practice of the Patent Office however to allow the amendment of the provisional specification further than by the correction of mere clerical errors.(b)

Necessity for amendments should be avoided.

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.

Procedure when specification is published.

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, together with the Patents Rules 1890 made under the powers conferred by the Act of 1883. Where this procedure applies it is immaterial whether the Patent Office has, or has not, advertised its acceptance of the complete specification.(c) Consequently, when a complete specification has been accepted,

(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.

(b) Patent Office Circular of Information (1897).

(c) Jones' Patent, Griff. P. C. 313.

though the Patent Office has not by advertisement (*d*) signified its acceptance, it is not a valid objection to an amendment, once it is allowed, that the request for and the nature of the amendment were not advertised in the prescribed manner. (*e*)

Allowable Amendments.

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. (*f*)

If the specification describe and claim anything which is not subject-matter (*g*) or which is 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 may be 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 so long as the specifications remain tainted with any of the above defects. (*l*)

Defects which are fatal.

Nature of Allowable Amendments.—Before 1834, the date of the statute 5 & 6 Will. IV. c. 83, 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 it was repealed by the Act of 1883, (*m*) its provisions and the benefits which it extended to patentees, were, with further additions, re-enacted by that Act.

History of power of amendment.

From 1834 to the passing of the Act of 1883 patentees could only amend their specifications by way of disclaimer, (*n*) that is to say, they could only cut matter out which they considered to be superfluous as lacking utility or novelty, or as 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 descrip-

(*d*) 46 & 47 Vict. c. 57, s. 10.
 (*e*) *Ibid.*; 46 & 47 Vict. c. 57, s. 18;
 p. 277 *post.*
 (*f*) Cochrane's Patent, (1885) Griff.
 P. C. 304.
 (*g*) Chap. ii. *ante.*
 (*h*) Chap. iv. *ante.*

(*i*) Chap. iii. *ante.*
 (*k*) Chap. v. *ante.*
 (*l*) Chap. v. *ante.*
 (*m*) 46 & 47 Vict. c. 57.
 (*n*) Foxwell v. Bostock, (1864) 4 De
 G. J. & S. 298, 306.

Allowable
Amend-
ments.

tion 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.

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)

Amendments
allowed 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)

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)

^(o) Ralston v. Smith, (1865) 11 H. L. C. 223, 245.

^(p) Thomas v. Welch, (1866) L. R. 1 C. P. 192, 195.

^(q) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

^(r) 46 & 47 Vict. c. 57, s. 19; Hall's Patent, (1888) 5 R. P. C. 306.

^(s) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.

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

after which the procedure is the same as if no such action or proceeding for revocation were pending. (u)

Allowable Amendments.

The Comptroller-General and law officer have an absolute discretion as to granting or refusing leave to amend, and not being a "Court" prohibition does not lie to them. (x)

Discretion of Comptroller and law officer.

Leave to apply is no guarantee that the specification, when amended, will not still invalidate the patent. The patentee, it must be remembered, makes the amendment at his own peril. (y) Thus, in the case of *Deeley's Patent* (z) it appeared that three claims were, in an infringement action, held to have been anticipated, and the patentee then amended by striking out the three claims and entering a disclaiming clause. The defendant in the action thereupon petitioned for the revocation of the patent, and succeeded on the ground that one of the remaining claims was bad for want of subject-matter.

Leave to amend no guarantee of validity.

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. (a)

Amendment no evidence of prior invalidity.

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," (b) expressly states (c) 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."

Proposed amendments which extend the claim.

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. (d)

Disconformity after amendment.

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

(u) *Hall's Patent*, (1888) 5 R. P. C. 305.

(x) *Van Gelder's Patent*, (1889) 6 R. P. C. 22; *Ex parte Simon*, 4 Times Reports 754.

(y) *Lake*, (1887) Griff. L. O. C. 16; 5 R. P. C. 415.

(z) (1895) 12 R. P. C. 65, 192.

(a) *Stocker v. Warner*, (1845) 1 C. B. 148, 165; 9 Jur. 136, 138.

(b) s. 18, sub-s. 9. (c) s. 18, sub-s. 8.

(d) *Gaulard and Gibbs*, (1889) 6 R. P. C. 215; *Lane Fox v. Kensington Knightsbridge Electric Lighting Co.*, (1892) 9 R. P. C. 221, 413; see also pp. 168-175 ante.

**Allowable
Amend-
ments.**

Amended
specification
takes the place
of the original.

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.(e)

The Act of 1883 further provides (f) 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 (*inter alia*) that the 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.(g) If a successful plaintiff in an action for infringement is able to satisfy the Court on this point, the account or damages, as the case may be, will be ordered as from the date of the patent. (h)

Law officer's
decision is
final as to fact
of the exten-
sion of a claim
by amend-
ment.

It would also appear, on the authority of *Moser v. Marsden*,(i) a case decided by the House of Lords, that, though it is open to an opposer before the Comptroller and law officer to raise the question that the proposed amendment would make the claims, as amended, larger than the original claim, yet the decision of the law officer is final on this point, and the Courts will not review it. It is submitted, on the other hand, that in a subsequent action on the patent the amendment is not conclusive and may be questioned on the point as to whether the amended claim embraces something which is not to be found fairly described in the original provisional specification, and so creates a fatal disconformity between the amended complete specification and the former document.(k) That is to say, the decision of the law officer upon the question of amendment is only unreviewable so long as the amendment allowed is within the limits of the provisional specification as originally filed; if the amendment goes outside that, it would create a fatal disconformity to which the Courts would give effect. The older cases usually cited in favour of the proposition that an amendment which widens or alters the scope of the claims is fatal to

(e) *Hampton and Facer*, (1887) Griff. L. O. C. 13.

(f) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.

(g) 46 & 47 Vict. c. 57, s. 20.

(h) *Wenham v. Carpenter*, (1887) 5

R. P. C. 68; *Hopkinson v. St. James's and Pall Mall Electric Light Co.*, (1892)

10 R. P. C. 62.

(i) (1895) 13 R. P. C. 24.

(k) See p. 169 *ante*.

the validity of the patent must, in so far as they were decided upon the former Acts, be considered as not applicable to the Act of 1883, and in so far as those decided since the Act of 1883 are concerned must be considered as overruled on this point.^(l)

Allowable
Amend-
ments.

It is to be noticed that the question of the legality of a disclaimer or other amendment once allowed by the law officer was not argued in *Moser v. Marsden*,^(m) and it may be that upon argument the House of Lords might review their decision in that case so far as it affects the point under discussion, but it is submitted that the above statements embrace a true exposition of the law on the subject. In *Perry v. Société de Lunetiers* ⁽ⁿ⁾ the objection was taken that an amendment allowed by the law officer had enlarged the claims originally made. The objection however failed, and it was consequently not necessary for the Court to decide whether having regard to *Moser v. Marsden* the objection could be made at all. It is submitted that it could not; but, if in fact there had been an enlargement of the claim which went beyond the limits of the provisional specification, the patent might have been declared void on the ground of disconformity between the specifications.^(o)

Before the decision in *Moser v. Marsden*,^(p) the Comptroller-General and the law officers used to be guided in the matter of allowing amendments, which were said by opponents to make the specification, contrary to the provisions of s. 18, sub-s. 8 of the Act of 1883, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment, by the rule that in the event of doubt the patentee was to have the benefit of the doubt. This rule was based upon the then prevailing notion that the law officer's decision was not conclusive, and consequently if it was wrongly exercised in favour of the applicant it could be set right by the Courts, but, if it was wrongly exercised against the applicant, it was final and not open to review.^(q) When this ground of opposition is taken against a

Practice when
an amendment
is objected to
on the ground
that it extends
the claim.

^(l) The cases referred to are *Ralston v. Smith*, (1865) 11 H. L. C. 550; *Dudgeon v. Thompson*, (1877) L. R. 3 App. Cas. 55; *Re Gaulard v. Gibbs' Patent*, (1888) 5 R. P. C. 189; 6 R. P. C. 225; 7 R. P. C. 367; *Van Gelder's Patent*, (1889) 6 R. P. C. 22; *Farber Fabrik v. Bowker*, (1891) 8 R. P. C. 391; *Lane-Fox v. Kensington and Knightsbridge Elec-*

tric Lighting Co., (1892) 9 R. P. C. 221, 413.

^(m) See *Dellwick's Patent*, (1896) 13 R. P. C. 596.

⁽ⁿ⁾ (1896) 13 R. P. C. 664.

^(o) See p. 169 *ante*.

^(p) (1895) 13 R. P. C. 24.

^(q) *Bateman and Moore's Patent*, (1854) Macr. P. C. 116; *Lake*, (1886) Griff. L. O. C. 16.

**Allowable
Amend-
ments.**

proposed amendment in future the law officers will probably not be so ready to allow the amendment as formerly, but will require to be satisfied that the amendment will not infect the specification with the vice referred to in sub-s. 8 of s. 18 of the Act of 1883, before they will grant leave to apply at the Patent Office to make the amendment desired.^(r)

**Example of a
proposed
amendment
which extends
the claim.**

Walker's Application,^(s) selected from amongst other cases, 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.^(t)

In *Walker's Application*, (Griff. L. O. C. 22) it appeared that *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 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.^(u)

**Other
examples of
allowable and
non-allowable
amendments.**

It is competent for a patentee to claim a combination as a whole, and also a subordinate part or parts separately.^(v) When,

^(r) See Parkinson's Patent, (1896) 13 R. P. C. 512.

^(s) Griff. L. O. C. 22; see also Parkinson's Patent, (1896) 13 R. P. C. 509.

^(t) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

^(u) See also *Ralston v. Smith*, (1865) 11 H. L. C. 223, 254; Lucas' Patent,

(1854) Macr. P. C. 235; Gaulard and Gibbs' Patent, (1889) 6 R. P. C. 215; Heath and Frost's Patent, (1886) Griff. P. C. 311; Parkinson's Patent, (1896) 13 R. P. C. 509; Johnson's Patent, (1896) 13 R. P. C. 659.

^(v) See p. 228 *ante*.

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. (y)

Allowable
Amend-
ments.

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. (z)

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. (a)

A defect can not be amended unless it is consistent with the patentee intending to fully specify the invention and mode of carrying it out.

Leave to apply to amend may be refused on the ground that the ambiguity of the proposed amendment, if such be the case, would lead to litigation and be calculated to create uncertainty among persons interested in the patent. (b)

A patentee desirous of amending his specification is required to state in writing his reasons for the same, (c) but such reasons form no part of the specification when amended; (d) nor will leave to amend be refused merely on the ground that the reasons given by the applicant in his application are insufficient. (e) It is to be noticed that s. 18, sub-s. 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, (f) and therefore should be advertised.

Reasons for requiring amendments are to be stated in writing.

It will now be convenient to consider separately the different forms of amendment which the law allows.

(y) Serrell's Patent, (1889) 6 R. P. C. 101.
 (z) Bateman and Moore's Disclaimer, (1852) Macr. P. C. 116.
 (a) See Nordenfelt, (1885) No. S269, Griff. L. O. C. 18, 21.
 (b) Parkinson's Patent, (1896) 13 R. P. C. 509, 514.

(c) 46 & 47 Vict. c. 57, s. 18, sub-s. 1.
 (d) Cannington v. Nuthall (1871) L. R. 5 H. L. App. 205, 208.
 (e) Ashworth, (1878) No. 3513, Griff. L. O. C. 6, 7.
 (f) *Ibid.*

Disclaimer. **Disclaimer.**—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.(g) 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.”(h)

Disclaimers
which extend
the claim.

A disclaimer which extends the ambit of the claims, or makes the specification claim an invention substantially different to that originally claimed, should not be allowed by the Comptroller or law officer,(i) though the law officer's decision must now be regarded as final.(j)

When it is said by the opponent that a disclaimer or other amendment will extend the claim, the real question to be decided always is, not whether any particular claim is extended by the amendment, but whether the total grant is extended. Though one particular claim may be extended it may be that it is only made to include something which was originally included in another claim. In such a case the law officer does not refuse leave to apply to make the amendment desired,(k)

(g) *E.g.*, *Cochrane's Patent*, (1885) Griff. P. C. 304; *Rylands' Patent*, (1888) 5 R. P. C. 665; *Nordenfelt's Patent*, (1887) Griff. L. O. C. 18; *Allen's Patent*, (1887) Griff. L. O. C. 3.

(h) *Ralston v. Smith*, (1865) 11 H. L. C. 223, 243.

(i) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

(j) p. 260 *ante*.

(k) See *Cochrane's Patent*, (1885) Griff. P. C. 384; *Ashworth's Patent*, (1886) Griff. L. O. C. 6; *Rylands' Patent*, (1888) 5 R. P. C. 665; *Nordenfelt's Patent*, (1887) Griff. R. P. C. 18; *Lake's Patent*, (1887) Griff. R. P. C. 16; *Morgan's Patent*, (1886) Griff. R. P. C. 17.

for the object of amendment must be merely to take out and **Disclaimer.**
 remove part of, or to further explain, what had been claimed
 before, and the Act did not intend that, by striking out or
 altering part of the specification, the patentee should be able to
 give an extended and larger sense to what is left, so as to
 make it embrace something which it did not embrace before.^(l)

The words of sub-s. 1 of s. 18 of the Act of 1883, "by way
 of disclaimer, correction, or explanation," were meant to refer to
 disclaiming something which was originally wrongly inserted,
 or to explaining something which requires explanation, having
 regard to the statement made in the first instance by the
 patentee.^(m)

If there is a claim for A, B, C, D, E, and F, and the patentee
 by amendment confines it to F, the amended claim is narrower
 than the original, but it is not different, for it is included in
 it.⁽ⁿ⁾

A disclaimer which turns an ambiguous specification into a
 clear specification is allowable.^(o)

A disclaimer which, on the other hand, turns an insufficient
 description into a sufficient one will not be allowed when the
 patent was obtained on the personal application of the real
 inventor himself, though it might be allowed if the invention
 was one communicated from abroad, and the foreign real in-
 ventor came and satisfied the Comptroller or law officer that
 the actual applicant had made a mistake in writing out or
 translating the description furnished to him by the foreign real
 inventor.^(p)

In *Ralston v. Smith*,^(q) a case decided by the House of
 Lords under the repealed Acts, which is not an authority now
 upon the effect of the law officer's decision with reference to
 allowing an amendment, but which may be quoted as an instance
 of a so-called disclaimer really amounting to an extension, 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

^(l) See remarks of Blackburn, J., on
 the repealed statute, *Dudgeon v.*
Thomson, (1877) L. R. 3 App. Cas. 55.

^(m) Per Webster, A.G., *Johnson's*
Patent, (1896) 13 R. R. C. 660.

⁽ⁿ⁾ *Cochrane's Patent*, (1885) Griff.
 P. C. 305.

^(o) *Johnson's Patent*, (1896) 13 R.
 P. C. 661-2.

^(p) *Ibid.*

^(q) (1865) 11 H. L. C. 223; see also
 cases referred to in the footnote ^(u)
 p. 262 *ante*.

Disclaimer
 which turns
 an ambiguous
 specification
 into a clear
 specification
 is allowable,
 but not so a
 disclaimer
 which turns
 an insufficient
 into a suffi-
 cient descrip-
 tion.

Disclaimer. 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. 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.^(r)

Ralston v. Smith may be contrasted with *Seed v. Higgins*,^(s) 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, and the House of Lords held that the disclaimer was legitimate and saved the patent.

Rule ii. *Seed v. Higgins*.

The rule involved in *Seed v. Higgins* is that approved of by the Attorney-General in giving his judgment in an appeal from the decision of the Comptroller, in a case ^(t) decided upon the Act of 1883—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.

Thus in the case of *Rylands' Patent*, (1888) 5 R. P. C. 665, 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

^(r) *Ralston v. Smith*, (1869) 11 H. L. C. 255.

^(s) (1860) 8 H. L. C. 550.

^(t) In the Matter of *Rylands' Patent*, (1888) 5 R. P. C. 665.

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. So again, in *Ashworth's Application*, (1886) Griff. L. O. C. 6, 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.

During proceedings for the repeal of a patent for "improvements 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, and for the construction of inkstands. 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.^(u)

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 sufficient to distinguish what the invention was which the patentee claimed. The explanation given by the Court of Appeal^(x) of the concluding words of s. 5, sub-s. 8 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 dis-

Disclaimer does not operate as a claim to residue.

^(u) *R. v. Mill*, (1850) 10 C. B. 379.

^(x) *Siddell v. Vickers*, (1888) L. R. 39 Ch. D. 92 ; 5 R. P. C. 416.

Correction and Explanation. claimer 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; (*y*) nor does the reason 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. (*z*)

Corrections and explanations are allowable when they do not exceed

Correction and Explanation.—A mistaken method or description of a process may be corrected by amendment—*e.g.*, where a patentee directed that “the last traces” of a substance should be removed from solution by cooling by ice, and the evidence showed that *all* the substance could not be removed by ice cooling, he was allowed to substitute the words “as much as possible” for the words “the last traces.” Had the specification directed the removal of “the last traces” by “any well-known means,” or “by any means,” or “by the best means,” the amendment would not have been allowed, as it would then have made an original insufficient into a sufficient description. (*a*)

The patentee must in all cases 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. (*b*)

Morgan's Patent (*c*) 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.

the legitimate function of a correction or explanation.

The function of a correction or 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 ;

(*y*) Per Cresswell, J., *Tetley v. Easton*, (1852) 2 C. B. N. S. 706, 730.

(*z*) *Cannington v. Nuttall*, (1871) L. R. 5 E. & I. App. 205, 228.

(*a*) *Johnson's Patent*, (1896) 13 R. P. C. 663; p. 265 *ante*.

(*b*) *Nordenfelt's Patent*, (1887) Griff. L. O. C. 18.

(*c*) (1886) Griff. L. O. C. 17.

it is not intended that he should put in subsequently ascertained knowledge, and such an insertion will not be allowed.(d) Correction and Explanation.

An explanation which is requisite to remove an ambiguity as to the real meaning of the patentee is justifiable,(e) but an extensive amendment which amounts to a rewriting of the specification will not be permitted.(f)

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.(g) Clerical errors: jurisdiction of the Master of the Rolls.

Corrections were made, on the authority of the Master of the Rolls, where "October" was written by mistake for "November;"(h) where "Charles" was written for "George"(i) where reference numbers were transposed;(k) where "recovery" had been written for "covering;"(l) 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.(m)

The Master of the Rolls had never authority to permit or 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*,(n) 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*,(o) 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.(p)

(d) *Beck and Justice*, (1877) No. 4114, Griff. L. O. C. 10.

(e) *Ashworth's Patent*, (1886) Griff. L. O. C. 6.

(f) *Nairn's Patent*, (1891) 8 R. P. C. 444.

(g) *Sharp's Patent*, (1840) 1 W. P. C. 641, 646; 3 Beav. 245; *Johnson's Patent*, (1877) L. R. 5 Ch. D. 503.

(h) *Rubery's Patent*, (1837) 1 W. P. C. 649 n.

(i) *Dismore's Patent*, (1853) 18 Beav. 538.

(k) *Redmond's Patent*, (1828) 1 W. P. C. 649 n; 5 Russ. 44.

(l) *Nickell's Patent*, (1841) 1 W. P. C. 650; 4 Beav. 563.

(m) *Abel's*, (1874) No. 2081.

(n) (1875) L. R. 20 Eq. 346.

(o) (1840) 1 W. P. C. 641.

(p) *Re Gare's Patent*, (1884) L. R. 26 Ch. D. 105; *Re Morgan's Patent*, (1876) 24 W. R. 245; *Judicature Act*, (1873) s. 17, sub-s. 6.

**Correction
and Ex-
planation.**

Present prac-
tice is to allow
correction of
clerical errors
under s. 18 of
Act of 1883,
whether the
patent is
sealed or not.

In *Re Gare's Patent* (q) 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.

This section also regulates the correction of clerical errors as well as all other matters of legitimate correction after the patent is sealed, for the amendment of a clerical error is included in the term "correction" in s. 18, sub-s. 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.(r)

Delay may be
a bar to amend-
ment.

The amendment of a clerical error in a specification, as also other amendments, may be refused on the ground of delay.(s) Thus in *Re Blamond's Patent* (t) 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.

Amendment
by inserting
drawings.

So far there has been no reported case of an 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.(u)

Explanation
of ambiguous
claim.

When a claim is ambiguous it may be amended by way of

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|---|---|
| (q) L. R. (1884) 26 Ch. D. 105. | P. C. 469; Johnson's Patent, (1896) |
| (r) See Patent Rules, (1890) r. 16;
Form P., Appendix. | 13 R. P. C. 659. |
| (s) <i>Blamond's Patent</i> , (1860) 3 L. T.
N. S. 800; <i>Lacy's Patent</i> , (1890) 7 R. | (t) (1860) 3 L. T. N. S. 800. |
| | (u) But see <i>Re Pullan's Patent</i>
Johns. Pat. Man. 5th ed. p. 118. |

explanation, so as to make perfectly clear what was the real Conditions. 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.(x)

Conditions.—The Comptroller and law officer have the power to impose conditions when granting leave to apply at the Patent Office to amend ; (y) 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.(z)

Amendments are frequently only allowed on conditions framed for the protection of the public or individuals.

It is not an uncommon condition that no action shall be brought on the amended specification in respect of infringements committed before amendment,(a) or in respect of certain continued infringements after amendment,(b) 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.(c)

In *Re Hearson's Patent* (d) 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.

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.(e)

Any party is, however, at liberty to bring forward any

(x) Ashworth, (1878) No. 3513, Griff. L. O. C. 6.

(y) Hearson's Patent, (1884) 1 R. P. C. 214; Pietschman's Patent, (1884) Griff. P. C. 314.

(z) 46 & 47 Vict. c. 57, s. 19; p. 251 post.

(a) p. 272 post; Holmes v. L. & N. W. Ry. Co. (1852) Macr. P. C. 31;

Smith's Patent, (1855) Macr. P. C. 232; *Re Medlock's Patent*, (1865) Newton, L.J., vol. xxii. p. 69.

(c) 46 & 47 Vict. c. 57, s. 20; *Wenham v. Carpenter*, (1887) 5 R. P. C. 68.

(d) (1884) 1 R. P. C. 213.

(e) See cases in Griff. P. C.; Allen, (1887) Griff. L. O. C. 3.