

**Complete  
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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.*

**Meaning of  
"ordinary  
workman."**

The often repeated statement to the effect that the specification is insufficient unless it be comprehensible to the "ordinary

workman" in the trade to which the invention relates is apt 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* (*r*), 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 (*s*). Parke, B., in *Neilson v. Har-*

Statement of  
the law as to  
"ordinary

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

(*s*) See also *Gibson v. Brand* (1842), 1 W. P. C. 631; *Sturtz 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.

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*ford (t)*, alluding to an invention relating to a machine, laid down the following terms:—

workman”  
in a parti-  
cular case by  
Parke, B.

“You are not to ask yourselves the question whether persons of great skill—a first-rate engineer or a second-class engineer—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed—it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity on the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, whatever its shape was, according to the terms of this specification, then I think that this specification is good, and that the patent may be supported so far as it relates to that.”

The same by  
Jessel, M.R.

The following passage, from the judgment of *Jessel, M.R.*, in *Plimpton v. Malcolmson (u)*, 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 (*x*):—

“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

(*t*) (1841), 1 W. P. C. 295; 8 M. & W. 806; 11 L. J. Ex. 20.

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

(*x*) *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.

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. This is what I would say of the two first classes, which I call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. . . . It will be a bad specification if the first two classes only understand it, and if the third class do not" (*y*).

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

The same by  
*Maule, J.*

"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" (*a*).

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 (*b*): but

Sufficiency of  
specification  
when the  
invention can  
only be ap-  
preciated by  
persons of  
great skill and  
knowledge.

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

(*z*) *Wallington v. Dale* (1852), 7 Exch. 888; 23 L. J. Ex. 49.

(*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. 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.

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

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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 workman must be interpreted to mean a person possessed of the greatest skill and knowledge (*c*).

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 the person to whom the specification may be supposed to be addressed is one possessing merely ordinary knowledge on the subject, and has no difficulty in interpreting the invention, the patent will be upheld with respect to the sufficiency of the specification (*d*). Thus, when it appeared that a specification was addressed to the manufacturer of incandescent lamps, and not to the chemist, it was held that if it contained errors in chemistry they were unimportant, except to the extent to which they might mislead the lamp manufacturer, and that upon the facts of the particular case there were no such errors as would invalidate the patent (*e*).

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

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 (*f*).

Thus, Lord *Loughborough*, in *Arkwright v. Nightingale* (*g*), 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 *Rex v. Arkwright* (*h*), 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

(*c*) See p. 211, *ante*; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône* (1897), 14 R. P. C. 875, judgment of Willes, J.

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

(*e*) "Z" Electric Lamp Manufacturing Co., Ltd. *v.* Marples, Leach & Co., Ltd. (1910), 27 R. P. C. 305.

(*f*) *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.

(*g*) (1785), Dav. P. C. 39; 1 W. P. C. 60.

(*h*) (1785), Dav. P. C. 61; 1 W. P. C. 64.

be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

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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 (*i*).

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 (*k*). For example, if the proper dimensions of a part necessary to effect the patentee's object are a matter of calculation, the person to whom the specification is addressed may be called upon to make the calculation (*l*). There is the authority of the House of Lords (*m*) for the proposition that a person to whom the specification may be supposed to be addressed must be taken to have a knowledge of prior specifications (and *sic*, other documents) relating to the same subject-matter, even though only recently published; and the actual ignorance of one or more eminent scientific witnesses of a particular specification is unavailing to prove that the knowledge of others was equally defective (*n*).

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

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

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

(*l*) *Scott's Patent* (1902), 19 R. P. C. 273.

(*m*) *King, Brown & Co. v. Anglo-American Brush Corporation* (1892), 9 R. P. C. 313.

(*n*) See 9 R. P. C. 320; see also *Vidal Dyes Syndicate, Ltd. v. Levinstein, Ltd.* (1911), 28 R. P. C. 559.

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

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 (p). 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" (q).

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" (r).

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 (s).

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

Errors in the  
specification

All that is necessary is that the specification shall be in-

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

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

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

(r) *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.

(s) *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.

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

telligible 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 (*u*).

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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 (*x*); 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 (*y*).

A workman is not to be called upon to correct any error unless there is something to correct it by (*z*). Thus, in the case of *Hinks'* patent for the paraffin lamp the drawing did not show, and the letterpress did not describe, a certain small opening in the second burner which was necessary to the effective working of the lamp. *Jessel*, M.R., held this to be a fatal defect which a workman could not be called on to remedy. In the case of an invention the whole merit of which is very small indeed, if people are told how to do things better they must be

(*u*) *Simpson v. Holliday* (1864), 5 N. R. 340; *Otto v. Linford* (1881), 46 L. T. N. S. 35; *Morgan v. Seaward* (1836), 1 W. P. C. 176; *Derosne v. Fairnie* (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 Co.* (1892), 10 R. P. C. 46; *Miller v. Searle* (1893), 10 R. P. C. 106.

(*x*) P. 195, *ante*.

(*y*) See remarks by Lord Westbury, L.C., in *Simpson v. Holliday* (1864), 13 W. R. 577; 5 N. R. 340; p. 162, *ante*.

(*z*) *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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told properly, without the necessity for invention or much trouble (a).

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

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* (c), but was not sustained, as it appears 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 "dis-couleur," has been held not to be of sufficient importance to upset a specification (d).

Effect of  
statements  
rendering  
experiments  
necessary.

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; (e) 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 (f).

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

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

(c) (1825), 1 Car. & P. 558; 6 B. & C. 169.

(d) *Tetley v. Easton* (1852), Newton, L.J., vol. xlii. p. 58; 18 C. B. 643; 25 L. J. C. P. 293; but see *Bradford Dyers' Association v. Bury* (1900), 18 R. P. C. 161; 19 R. P. C. 1.

(e) *Edison v. Holland* (1889), 6 R. P. C. 243; *Haskell Golf Ball Co. v. Hutchison* (1905), 22 R. P. C. 493; *Watson, Laidlaw & Co., Ltd. v. Pott, Cassels and Williamson* (1910), 27 R. P. C. 541; 28 R. P. C. 565.

(f) *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. Roberton* (1878), L. R. 3 App.

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 *Wills, 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 (*g*).

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

“It 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.”

Cas. 1055 ; *Pooley v. Pointon* (1885), 2 R. P. C. 167 ; *Hutchison v. Pattullo* (1888), 5 R. P. C. 351 ; *Elkington v. Clark* (1888), 5 R. P. C. 327 ; *Gaulard and Gibbs's Patent* (1888), 5 R. P. C. 535 ; *Plimpton v. Malcolmson* (1876), L. R. 3 Ch. D. 531 ; 45 L. J. Ch. 505 ;

*The Lifeboat Co. v. Chambers* (1891), 8 R. P. C. 418.

(*g*) *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône* (1897), 14 R. P. C. 891.

(*h*) (1889), 6 R. P. C. 282.

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

Now a statutory as well as a common law requisite.

This was specially enacted by the Act of 1883, s. 5, sub-s. 4, which now constitutes s. 2, sub-s. 2, of the Act of 1907; but before that statute the public had a Common Law right to a fair, full, and true description (*i*); and it was laid down by *Ashurst, J. (k)*, 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. (l)*, 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.

It is a well recognized principle of patent law that a patentee is not bound to state the effect or advantage of his invention, if what he directs to be done or constructed necessarily produces the effect or advantage. Where, however, the patentee has to rely on the presence or absence of a certain effect or advantage as part of a necessary delimitation of his invention, he is compelled to refer to such effect or advantage for the purpose of adequately defining the invention claimed (*m*). This does not mean that where peculiar properties are relied on to give subject-matter to a patent those properties must be clearly set out in the specification (*n*).

In *Hastings v. Brown (o)*, 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

(*i*) *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.

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

(*l*) *Ibid.*

(*m*) See *Clay v. Alcock & Co., Ltd.* (1906), 23 R. P. C. 745.

(*n*) See *Hill v. Thomas & Sons* (1907), 24 R. P. C. 417.

(*o*) (1853), 1 Ex. B. 450; 22 L. J. Q. B. 161.

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 (p) 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 non-suit to be entered, on the ground that the specification was bad, Lord Campbell, C.J., saying:—

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"It is clear that the patentee ought to state distinctly what it is for which he claims the patent, and describe the limits of the monopoly. This is not done by this specification. The claim is for an invention by which a single windlass may raise cables of different diameter, which is allowed to be a great improvement. But is that pointed out by the specification? The words are at best equivocal. If he claims for a windlass that is fitted for one cable only, of whatever size, there is no novelty; and the vice of the specification is that it does not assert that more can be done by the invention. The title tells us nothing. The words of the specification are, 'a chain cable of any size.' 'A' applies to one only. At all events, the phrase is capable of that meaning; and the specification, if it be equivocal, is bad. I see nothing in the words, or in the drawing, that necessarily indicates the contrivance to be for fitting more than one cable. You might make a windlass according to the drawing, which would do no more than that."

(p) Fig. 2.

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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 (*q*).

In *Kopp v. Rosenwald* (*r*) the Court of Appeal held that the claim was, when properly construed, for a process of making a new article, which depended upon the use of a braiding machine having a particular number of heads and spindles according to the number of strips of whalebone selected to compose the new article, and that, as the specification only gave a prescription which would be found useful in the case of two strips of whalebone, and was silent as to the number of heads and spindles required in other cases, the patent was void.

*Lyon v. Goddard* (*s*) 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 the patent failed.

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.

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 (*t*), 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 (*u*).

*Sirdar Rubber Co. v. Wallington* (*x*) is an illustration of a patent being declared bad expressly on the ground that the specification did not particularly describe and ascertain the

(*q*) P. 220, *ante*; *Allen v. Duckett* (1893), 10 R. P. C. 397.

(*r*) (1902), 20 R. P. C. 154.

(*s*) (1893), 11 P. O. R. 360.

(*t*) *Allen v. Duckett* (1893), 10 R.

P. C. 397; p. 220, *ante*.

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

(*x*) (1905), 22 R. P. C. 257; 23 R. P. C. 132.

nature of the invention and the manner in which it was to be performed. The reason why a full disclosure is required, is that a party who obtains a patent is bound clearly to define in his specification what it is he claims as his invention, in order that the public may know with certainty what they may, or may not, do without incurring the risk of an action for infringement of the patent (*y*), and 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 (*z*).

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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 (*a*).

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 (*b*).

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.

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

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

(*y*) *Per* Cresswell, J., *Gibson v. Brand* (1841), 1 W. P. C. 627; see also *European Eibel Co., Ltd. v. Lloyd (Edward), Ltd.* (1911), 28 R. P. C. 349.

(*z*) *Per* Alderson, B., *Morgan v. Seaward* (1836), 1 W. P. C. 174, 179.

(*a*) *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.

(*b*) *Eades v. Starbuck Waggon Co.*, W. N. 1881, p. 160; p. 84, *ante*.

(*c*) (1836), 2 M. & W. 544; 1 W. P. C. 170; 6 L. J. Ex. 153.

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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 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.

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

Things neces-  
sarily implied  
need not be  
specifically  
described.

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 (*d*).

In *Crossley v. Beverley* (*e*) 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* (*f*) 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

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

(*e*) (1829), 3 Car. & P. 513; 1 W. P. C. 106.

(*f*) (1832), 1 W. P. C. 459.

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 (*g*).

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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 for the patentee in the specification to enter into a minute description of the old machine, or the preparation of a known compound though the same is but little known and its manufacture difficult (*h*); but it must not be forgotten that the language used must be such as will distinguish the invention from that which is old (*i*).

Not necessary  
to describe a  
known thing  
referred to.

In *Harmar v. Playne* (*k*) 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;

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

(*h*) See *Badische Anilin und Soda Fabrik v. Levinstein* (1887), 4 R. P. C. 469.

(*i*) See p. 236, *post*.

(*k*) (1809), 14 Ves. 130; 11 East, 101; Dav. P. C. 311; see also *Tubes, Ld. v. Perfecta Seamless Tube Co. Ld.* (1902), 20 R. P. C. 77, 97.



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

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.*

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

It is expressly enacted that the patentee must, in the complete specification, describe the manner in which the invention is to be performed (*m*), 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 improve-

(*l*) (1841), 1 W. P. C. 295, 328.

(*m*) 7 Edw. VII. c. 29, s. 2 (2).

ments, 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" (*n*). 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 (*o*), and place them in a position to derive the same benefit from it which he himself does (*p*).

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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, 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" (*q*). 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" (*r*).

Thus in *Savory v. Price* (*s*) the patent was for the "invention of a neutral salt, under the name of *Seidlitz* powder," and the 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

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

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

(*p*) *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.

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

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

(*s*) (1823), Ry. & M. 1; 1 W. P. C. 83.

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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 non-suited, *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.”

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 (*t*). 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 (*u*).

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

(*t*) *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.

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

him, and the grant is made to the agent, who is therefore in law the patentee (*x*). 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 (*y*). On the other hand, if the agent, the actual patentee, be possessed of knowledge not in the specification, it is no answer to an objection on the ground of insufficiency to say that the specification contains all the information which the agent received from the foreign inventor (*z*).

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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." 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 as 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 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 (*a*) 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 adjustments 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 men-

(*x*) Pp. 22—26, *ante*.  
(*y*) *Plimpton v. Malcolmson* (1875),  
3 Ch. D. 531, 582.

(*z*) *Wegmann v. Corcoran* (1879), 13  
Ch. D. 66; 41 L. T. N. S. 358.  
(*a*) *Morgan v. Seaward* (1836), 1 W.  
P. C. 182.

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tioned 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."

and must not  
suppress any-  
thing essen-  
tial thereto.

It has been previously shown that a patentee suppressing anything, or misleading, thereby renders his specification bad (*b*), 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* (*c*), 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 patent.

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 (*d*).

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

(*b*) *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. 195, *ante*.

(*c*) (1815), Holt, N. P. 58; 1 W. P. C. 82 n.

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

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 (e).

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In *Derosne v. Fairie* (f) 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 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 non-suit; 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* (g), that if the patentee knew that internal partitions

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

(f) (1835), 6 Tyr. 393; 1 W. P. C. 154.

(g) (1841), 1 W. P. O. 317, 321.

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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 (*h*). And in *Rex v. Arkwright* (*i*) 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 chance may direct." The jury gave a verdict against the patentee, the sufficiency of the specification being one of the issues.

It is not requisite that all processes claimed shall be equally successful.

Though it is essential that all the processes described and claimed should be successful (*k*), 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 (*l*).

Lord *Herschell*, in his judgment in the House of Lords in *The Badische Anilin und Soda Fabrik v. Levinstein* (*m*) 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

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

(*i*) (1785), 1 W. P. C. 70.  
(*k*) *Beard v. Egerton* (1846-49), 19 L. J. C. P. 39; *Derosne v. Fairie* (1835), 1 W. P. C. 165; *Cole v. Saqui* (1888), 5 R. P. C. 494.

(*l*) *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.

(*m*) (1887), 4 R. P. C. 466; L. R. 12 App. Cas. 710.

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."

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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 or means of carrying out the invention covered by the provisional specification, the omission of a description of it would render the final specification bad on the ground that the document did not contain the best method known to the patentee of performing the invention. 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, and a distinct claim to it *per se* in the final specification might 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, unless it were new at the time the complete specification was put in and the patentee was himself the inventor of it (*n*).

When an improved method discovered during the period of provisional protection should be included and when it should not be included.

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

(*n*) See p. 182, *ante*.



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possesses, so that the public may profit by it when the patent expires.

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

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 cause a disconformity between the specifications (*q*).

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

(*o*) *Crossley v. Beverley* (1829), 1 W. P. C. 117; 3 C. & P. 513.

(*p*) *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.

(*q*) *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; *Ward v. Hill* (1903), 20 R. P. C. 189; see pp. 182—192, *ante*.

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 (r).

Complete  
Specifica-  
tion.

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And when, during the interval between the filing of the provisional and complete specifications of an invention of an electric lamp which comprised a carbon filament in combination with other parts, the patentee lodged a provisional specification of an invention for a method of making the carbon filament, the Court held that it was no objection to the validity of the patent for the first invention that the patentee did not in the complete specification filed in respect of it, disclose the method of making the filament which formed the subject of the invention disclosed by the second provisional specification. The decision was based on the ground that the method of manufacturing the filament did not form the basis of any claim made under the first patent (s).

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;

No necessity  
to state every  
means of pro-  
ducing a  
desired result.

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

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

Complete  
Specifica-  
tion.

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 (*t*).

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 some-  
thing old is  
fatal.

The complete specification must particularly describe and ascertain the invention (*u*); 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 the 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 (*x*). He must make it perfectly clear what it is he claims as his monopoly. If what he claims is in fact new, his specification cannot be invalidated, because he has not specifically said that certain things which are referred to are old. This follows from the fact that a claim is a disclaimer of all that is outside it and only that which is claimed is included in the patent, the specification and claims being a condition precedent to the grant.

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

(*t*) *Rickford v. Skewes* (1838), 1 W. P. C. 211, 218.

(*u*) 7 Edw. 7; c. 29 s. 2 (2).  
(*x*) Chap. iv., *ante*; p. 246, *post*.

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 (*y*).

Complete  
Specifica-  
tion.

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 (*z*).

Claim to  
improvements  
on old  
things, and  
combinations  
of old parts.

An improvement on an existing machine may be the subject-matter of a new patent (*a*); 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 (*b*).

And if, in the case of a patent for a combination, in the sense of collocation of non-intercommunicating parts (*c*), 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 (*d*).

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" (*e*).

(*y*) See *Lyon v. Goddard* (1894), 11 R. P. C. 361.

(*z*) *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; *Patent Exploitation, Ld. v. Siemens Bros. & Co., Ld.* (1901), 21 R. P. C. 546-47; *British United Shoe Machinery Co., Ld. v. Fussell (A.) & Sons, Ld.* (1908), 25 R. P. C. 631.

(*a*) P. 82, *ante*.

(*b*) *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.

(*c*) See p. 73, *ante*.

(*d*) *Moore v. Bennett* (1884), 1 R. P. C. 129, 143; *Philpot v. Hanbury* (1885), 2 R. P. C. 33, 39; *British United Shoe Machinery Co., Ld. v. Fussell (A.) & Sons, Ld.* (1908), 25 R. P. C. 657.

(*e*) Per James, V.-C., *Parkes v. Stevens* (1869), L. R. 8 Eq. 358, 366.

**Complete  
Specifica-  
tion.**

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A new combination of old parts, or partly old and partly new parts, may form the subject-matter of a valid patent (*f*). 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 the claim includes the old combination separately (*g*). If all the parts are old, the specification will be bad unless it claim only the new combination (*h*). If the specification states simply the whole machinery which the patentee 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 be not new (*i*).

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 (*k*).

In *Holmes v. The London and North Western Railway Co.* (*l*) 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

(*f*) P. 78, *ante*.

(*g*) See *Bovill v. Moore* (1815), per Gibbs, L.C.J., Dav. P. C. 404.

(*h*) *Lister v. Leather* (1857), 3 Jur. N. S. 811; 8 E. & B. 1004; *Seed v. Higgins* (1860), 8 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. Bennis* (1887), 4 R. P.

C. 333, 358; *Clark v. Adie* (1873), L. R. 2 App. Cas. 315, 328.

(*i*) Per Abinger, C.B., *Carpenter v. Smith* (1841), 1 W. P. C. 530; *Tetley v. Easton* (1852), Macr. P. C. 48.

(*k*) *Hill v. Thompson* (1818), 1 W. P. C. 247; *Leggott v. McGeort* (1893), 10 R. P. C. 429, 435.

(*l*) 1852), Macr. P. C. 4; 12 C. B. 831; 22 L. J. C. P. 57.

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.

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tion.

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. So in *Macfarlane v. Price* (*m*) 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* (*n*) a patent for "improvements in making buttons" was declared void on account of a like omission in the specification (*o*).

Lord *Westbury*, L.C., in *Foxwell v. Bostock* (*p*), 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 general description of the entire machine; it must assign the *differentia* of the new combination.

Rule in  
*Foxwell v.*  
*Bostock.*

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 (*q*).

In *Lister v. Leather* (*r*) it was stated in the judgment of the Court delivered 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 (*s*).

(*m*) (1816), 1 W. P. C. 74; 1 Stark. R. 199.

(*n*) (1832), 1 W. P. C. 75.

(*o*) See also *Mackelcan v. Rennie* (1862), 13 C. B. N. S. 52.

(*p*) (1864), 4 De G. J. & S. 298, 313.

(*q*) *Clark v. Adie* (1873), L. R. 2 App. Cas. 315, 327.

(*r*) (1857), 8 E. & B. 1031; 27 L. J. Q. B. 295; 4 Jur. N. S. 947.

(*s*) 8 E. & B. 1017.

Complete  
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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 (*t*).

Explanation  
of the rule in  
*Foxwell v.*  
*Bostock*.

The decisions in *Foxwell v. Bostock*, and *Lister v. Leather*, deserve careful consideration, and have formed the subject of judicial explanation and comment. First, *Foxwell v. Bostock* must not be taken as deciding that where there is a patent for a combination there must be a discovery or explanation of the novelty of each respective part, and that the specification must also show what is the novelty and what the merit of the invention. On the contrary, in the case of a patent for a combination the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which must be proved by evidence. And the claim to it is a sufficient description (*u*). 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 of, or addition to, the parts previously combined, it will not do to claim the whole combination as new, but the patentee must condescend upon that which is improved. For example, if a machine exactly similar to another had been in long use in a particular trade, and some particular improvement, say, in the arrangement of a cog, or in the arrangement of some other portion of an old combination, which was new and useful, or an addition to the known machine, say, of the nature of a gridiron pendulum to a clock, 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, or an addition thereto, and the patentee must not claim the whole machine but he must indicate and claim the improvement or addition (*x*).

(*t*) 8 E. & B. 1023.

(*u*) *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; *Kynoch & Co. v. Webb* (1899), 17 R. P.

C. 100; *British Shoe Machinery Co. v. Thompson* (1904), 22 R. P. C. 198.

(*x*) *Moore v. Bennett* (1884), 1 R. P. C. 129, 143; *British Shoe Machinery Co. v. Thompson* (1904), 22 R. P. C. 198; see pp. 82—88, *ante*.

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 other parts as amounts only to a colourable imitation, be used (*y*); 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, 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 (*z*). The patentee must distinguish what is old from what is new by his claim, but he is not bound to distinguish what is old and what is new in his claim. If the combination, which he claims and for which he asks a monopoly, is novel, that is sufficient (*a*).

Lord *Bowen*, then *Bowen*, L.J., commenting on the decision in *Foxwell v. Bostock*, and in reference to the fact that the case was discussed and distinguished by the House of Lords

(*y*) *Clark v. Adie* (1873), 2 App. Cas. 315, 320. In the above statement "combination" must be taken to mean collocation of inter-communicating parts producing one specific result. (See p. 73, *ante*.)

(*z*) *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; *Kynoch & Co. v. Webb* (1899), 17 R. P. C. 100; *British Shoe Machinery Co. v. Thompson* (1904), 22 R. P. C. 177; *British United Shoe Machinery Co., Ltd. v. Fussell (A.) & Sons, Ltd.* (1908) 25 R. P. C. 631.

(*a*) See per Moulton, L.J., *British United Shoe Machinery Co. v. Fussell & Sons* (1908), 25 R. P. C. 631; *Lynch and Henry Wilson & Co., Ltd. v. Phillips (John) & Co.* (1909), 26 R. P. C. 403.



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Specifica-  
tion.

in *Harrison v. Anderston Foundry Co.* (b), in a subsequent case, said:—

“When a combination and nothing more is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to 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 in *Harrison v. The Anderston Foundry Co.*” (c).

The rule in *Foxwell v. Bostock* (d), as explained in the foregoing pages, was adopted and applied by the House of Lords in the more recent case of *Kynoch v. Webb* (e), where, reversing the Courts below, the House held the patent void on the ground that the patentee had not differentiated his invention from what was old, and that, upon its true construction, the claim was not limited to the novel feature of the machine which was the real invention. In *British United Shoe Machinery Co. v. Thompson* (f) the Court decided that the rule in *Foxwell v. Bostock* did not apply to the circumstances of that case, because there the invention was a new arrangement and user of the constituent parts of a known machine in a particular way so as to produce a novel and useful result.

An apparent  
but not real  
exception to  
the rule in  
*Foxwell v.*  
*Bostock.*

*Harmar v. Playne* (g) 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

(b) (1876), L. R. 1 App. Cas. 574.  
(c) *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; *Patent Exploitation, Ltd.*

*v. Siemens Brothers & Co., Ltd.* (1904), 21 R. P. C. 546.

(d) P. 239, *ante*.

(e) (1899), 17 R. P. C. 100.

(f) (1904), 22 R. P. C. 177, 198.

(g) (1909), 11 East, 101; 14 Ves. 130; Dav. P. C. 311.

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 gremio* of the new patent, the means of distinguishing the new from the old. The same point of view was adopted by the House of Lords in the more recent case of *Tubes, Ld. v. Perfecta Seamless Tube Co., Ld.* (*h*).

Complete  
Specifica-  
tion.

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The marginal note in *Lister v. Leather*, if hastily read, is calculated to give colour to the erroneous conclusion that a claim for a combination or arrangement is a distinct claim 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*)? *i.e.*, something which falls within the specific claim of the specification when properly construed. If the dictum of Lord Campbell in *Lister v. Leather* means more than this, it is erroneous and is now overruled (*k*). If a man is desirous of securing to himself protection by letters patent, in respect of not only the whole, but something less than the whole, of a new arrangement, construction, or combination of parts, he must clearly show that he claims that something less more specifically than by merely describing and claiming the whole (*l*). 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 (*m*).

Claim to an  
entire com-  
bination for a  
process pro-  
tects all parts  
new and  
material for  
that process.

(*h*) (1902), 20 R. P. C. 77, 87.

(*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.

(*k*) See *British United Shoe Machinery Co., Ld. v. Fussell (A.) &*

*Sons, Ld.* (1908), 25 R. P. C. 631.

(*l*) *Clark v. Adie* (1873), L. R. 10 Ch. 667; L. R. 2 App. Cas. 315.

(*m*) *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.*

Claims.

## THE CLAIMING CLAUSES.

Distinct claiming clauses are in practice required, but are not absolutely necessary.

Before 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, it was held 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 (*n*).

The Act of 1907, like that of 1883, however, expressly provides (*o*) 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 (*p*). 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 the Act, 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 (*q*).

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 (*r*).

(1884), 1 R. P. C. 229, 241; *Watling v. Stevens* (1886), 3 R. P. C. 37; *British United Shoe Machinery Co., Ltd. v. Fussell (A.) & Sons, Ltd.* (1908), 25 R. P. C. 361; pp. 239—243, *ante*.

(*n*) *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.

(*o*) S. 2, sub-s. 4.

(*p*) *Siddell v. Vickers* (1888), 5 R. P. C. 431-33; 7 R. P. C. 292; L. R. 39 Ch. D. 92; L. R. 15 App. Cas. 496; *Edison-Bell Phonograph Corporation v. Smith* (1894), 11 R. P. C.

148, 163, 389; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co. Ltd.* (1902) 2 R. P. C. 77.

(*q*) *Siddell v. Vickers* (1888), 5 R. P. C. 431-33; 7 R. P. C. 292; L. R. 39 Ch. D. 92; L. R. 15 App. Cas. 496; *Edison-Bell Phonograph Corporation v. Smith* (1894), 11 R. P. C. 148, 163, 389; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd.* (1902), 2 R. P. C. 77.

(*r*) *Siddell v. Vickers* (1888), 5 R. P. C.; L. R. 39 Ch. D. 109; *Bancroft's Patent* (1905), 23 R. P. C. 89.

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 (s). 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.**  


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 Claim operates 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” (t).

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 when a clear and 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 (u). And, consequently, if a patentee has described in his specification a num-

A claim is by implication a disclaimer.

(s) *Kay v. Marshall* (1836), 2 W. P. C. 39.

(t) *Plimpton v. Spiller* (1877), L. R. 6 Ch. D. 428; 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.

(u) *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.

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ber of distinct inventions which are all new and useful, but so related as properly to come within one patent (*x*), and he has chosen to claim only one, he has thereby made a present of the rest to the public, and he can only be protected in respect of the one he has claimed (*y*). 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 (*z*). 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 (*a*), or has been anticipated (*b*).

Rules to be observed in drafting claiming clauses.

The following are the chief features to be observed in drafting 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

If the patentee lay claim to anything he has in fact not

(*x*) See Vol. II., p. 9, *post*.

(*y*) *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.

(*z*) *Harrison v. Anderston Foundry Co.* (1876), L. R. 1 App. Cas. 574, 578.

(*a*) *Weir v. Denny* (1894), 11 R. P. C. 657.

(*b*) *Holms v. Associated Newspapers, Ltd.* (1910), 27 R. P. C. 136.

invented (*c*), or not described (*d*), he will thereby render his patent bad; notwithstanding that the specification may describe and claim things which are new and of which he was the undoubted inventor. 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 (*e*). Again, if the real invention be an ingenious new use of an old and known thing, and the claims are not limited to the new use, but are wide enough to definitely claim the old thing itself apart from the novel application, the patent is void (*f*). So also a patent is void when upon the true construction of the specification the claim includes both a process and separately an apparatus for carrying it out, and one or other is old (*g*). If the claim be for a process as carried out by an 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 (*h*).

If the claim, upon a true construction, be for a method as distinct from an apparatus and the method be old, the patent is void; in this connection it is not unimportant to remember that references to drawings may be construed as for the purpose of illustration only, and not as having the effect of restricting the claim to a particular apparatus (*i*). On the other hand, in some cases, the very contrary may be the effect of a reference to the drawings (*k*). A claim which, *nominatim*,

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what patentee has not invented or described is fatal.

(*c*) Chap. iv. p. 236, *ante*; *R. v. Elso* (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. Gas Light 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; *Kynoch & Co. v. Webb* (1899),

17 R. P. C. 100; *Dick v. Ellam's Duplicator Co.* (1900), 17 R. P. C. 196, 200.

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

(*e*) *Hill v. Thompson* (1817), 1 W. P. C. 232; *Tetley v. Easton* (1852), 2 E. & B. 956.

(*f*) *Dick v. Ellam's Duplicator Co.* (1900), 17 R. P. C. 196, 202.

(*g*) *Tolson v. Speight* (1896), 13 R. P. C. 718; *Kynoch & Co. v. Webb* (1899), 17 R. P. C. 100.

(*h*) *Tolson v. Speight* (1896), 13 R. P. C. 721; p. 254, *post*.

(*i*) See *British Motor Traction Co. v. Friswell* (1901), 18 R. P. C. 487.

(*k*) See *Hattersley v. Hodgson* (1904), 21 R. P. C. 517; 23 R. P. C. 192.

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refers to a method may upon its true construction be confined to the method when carried out by a particular machine—*e.g.*, where the method involves the performance of a process which a novel machine, the subject of the other claims, is expressly designed to effect, and the only instance of the performance of the process referred to in the specification is that effected by the use of the patented machine (*l*).

If a claim be so wide in its terms as to amount to the enumeration of a known truth, it cannot be supported (*m*).

*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 (*n*).

*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.

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 (*o*).

Claim to something useless for purpose in view is fatal,

(*l*) See *Gammons v. Battersby* (1904), 20 R. P. C. 540; 21 R. P. C. 322.

(*m*) *Patterson v. Gas Light and Coke Co.* (1875), L. R. 2 Ch. D. 812; 3 App. Cas. 239.

(*n*) *Hill v. Thompson* (1817), 1 W. P. C. 232.

(*o*) *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate* (1894), 11 R. P. C. 638; 12 R. P. C. 232, 256; see also p. 162, *ante*.

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 (*p*).

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but not so a claim to something of limited utility.

A claim may be so extensive, as of itself, quite independently of evidence, to vitiate a patent (*q*); 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 (*r*).

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 (*s*).

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 not mentioned to which the patentee's invention would not be applicable (*t*).

If the complete specification describe any method of carrying out the invention which will not answer, and so lead the public to perform operations which must necessarily fail, the patent will be bad (*u*); 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 (*x*).

(*p*). See *Adamant Stone and Paving Co. v. Corporation of Liverpool* (1896), 14 R. P. C. 11.

(*q*) *Neilson v. Harford* (1871), 1 W. P. O. 855; *Arnold v. Bradbury* (1871), L. R. 6 Ch. 706.

(*r*) *Arnold v. Bradbury* (1871), L. R. 6 Ch. 706; *Wyeth v. Stone*, 1 Story, 273.

(*s*) *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48, 58.

(*t*) *Chadburn v. Mehan* (1895), 12 R. P. C. 120, 134.

(*u*) P. 201, *ante*.

(*x*) *Patterson v. Gas Light and Coke Co.* (1875), L. R. 2 Ch. D. 812, 833; L. R. 3 App. Cas. 239.



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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 (*y*). Moreover, a claim which is general may not entitle the patentee to improvements of which he was ignorant at the date of the patent (*z*).

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 (*a*).

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.

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 (*b*).

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 com-

(*y*) *Tetley v. Easton* (1852), *Macr.* P. C. 48, 76.

(*z*) P. 355, *post*.

(*a*) *Crossley v. Potter* (1853), *Macr.* P. C. 256.

(*b*) See p. 248, *ante*.

bined in that particular way before, and C and D may be old parts. Now, in such a case, the inventor would in law be entitled to protection, both in respect of the whole invention, consisting of the combination A, B, C, and D, and also in respect of the subordinate inventions A and B; but he would not obtain such protection in respect of the subordinate parts alone by laying claim to the combination of the four elements. He must, if he desire it, specifically claim protection in respect of the new subordinate integers of the larger invention (*c*); and very little merit will do to support a claim to a subsidiary part of a great invention (*d*).

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 (*e*).

*Clark v. Adie* (*f*) 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. It is the leading authority for the proposition that the patentee is not protected against the use by others of what he might have claimed, but what he has, upon a fair construction, whether from timidity or any other cause, in fact not claimed. The case may be epitomised from this point of view as follows:—

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

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Patentee is protected only in respect of what he actually claims—not in respect of what he might have claimed.

(*c*) *Clark v. Adie* (1873), L. R. 2 App. Cas. 320, 321; *Cropper v. Smith* (1884), 1 R. P. C. 87; *Harrison Patents Co., Ltd. v. Nicholson (W. N.) & Sons, Ltd.* (1908), 25 R. P. C. 393.

(*d*) *United Telephone Co. v. Harrison* (1882), L. R. 21 Ch. D. 720.

(*e*) *Clark v. Adie* (1873), L. R. 2 App. Cas. 320; p. 241, *ante*.

(*f*) (1873), L. R. 10 Ch. 667; 2 App. Cas. 315.

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steel, with V-shaped cutters, traversed to and fro over the comb, being guided by steerers working in rectangular slots, cut parallel to its edge. The drawings showed the cutter-bar in plan and section, the latter view representing it as somewhat arched or convex in the middle, so as to take its bearing only at the edges. The specification, however, did not allude by any words of description to this peculiarity of form. The two handles were pivoted on a strong stem, set in a square hole in the comb-plate, and secured by a nut on the screwed end of the stud. One of these handles worked the cutter, and the other took its bearing at the rear of the comb-plate, and was capable of being set and clamped in different positions, to suit the convenience of the operator. At the end of the working handle a sliding block was pivoted, having slots corresponding with those on the cutter, and the comb could be regulated by means of nuts and washers. By the removal of the nuts on the stems and stud, the instrument could be readily taken to pieces.

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

fringement 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 tops 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.

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

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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 afterthought, 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.

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 (*g*).

A claim which is subsidiary to the main claim may be really

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

*Ehrlich v. Ihlee* (1888), 5 R. P. C. 437; *Parker v. Satchwell* (1901), 18 R. P. C. 299; *True and Variable Electric Lamp Syndicate v. Bryant Trading Syndicate* (1908), 25 R. P. C. 461.

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* (*h*), quoted below (*i*).

The above-stated principles, which are often of vital importance, are illustrated by the leading cases given in epitome as follows:—

In *The British Dynamite Co. v. Krebs* (*l*) 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 gunpowder. *Secondly*, without or during confinement by means of a special fulminating cap, containing a strong charge of fulminate, which is adapted to the end of a fuse and is strongly squeezed to the latter for the purpose of more effectually confining the charge, so as thereby to heighten the effect of the detonation. *Thirdly*, by means of an additional charge of ordinary gunpowder, the explosion of the latter will cause the dynamite to go off even when it is only partially confined.

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Leading cases.

British Dynamite Co. v. Krebs.

(*h*) 13 R. P. C. 196; see also *Pneumatic Tyre Co. v. Casswell* (1896), 13 R. P. C. 180.

(*i*) P. 257, *post*; see also *Thompson v. American Braided Wire Co.* (1889), 6 R. P. C. 528; *Fawcett v. Homan* (1896), 13 R. P. C. 398, in judgment of *Rigby, L.J.*, p. 410; *Van Berkel v.*

*Simpson* (1906), 23 R. P. C. 237; 24 R. P. C. 117; *Van Berkel v. Booth* (1906), 23 R. P. C. 573; *Lynch and Henry Wilson Co., Ltd. v. Phillips (John) & Co.* (1908), 25 R. P. C. 707; 26 R. P. C. 389.

(*k*) (1875), G. P. C. 88; 13 R. P. C. 190.

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The claim was: "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.*, 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 (*l*):—

"I will assume that the modes of firing by special ignition, or some of them, were known before the date of the patent, and therefore that if the patentee claimed them as independent inventions (inventions, if I may use the expression, *in gross*), his claim would be too large and his patent void. But is that what he here does or means to do? It is to be observed that the mere manufacture of an explosive substance, such as dynamite, would not, *per se*, have constituted an invention, or, at all events, a useful and practical invention, which could be protected by a patent. An explosive substance like dynamite would be of little or no utility unless there were the means of bringing to bear upon it a method of detonating explosion which would be at once economical and easily applied. . . . I look upon the means of explosion, even assuming them to be known as applicable to the other substances, to be part and parcel of the invention, which the patentee was bound to give to the public as a complete invention, and I understand him to claim these means of explosion only as part and parcel of this invention. He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he would not be allowed, under this patent, to claim them for any other purpose. In

other words, he claims, in the first claim, the dynamite, the substance itself; and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could be exploded, he might have omitted his second claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the use of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

Lord *Hatherley* upon the same point spoke as follows (*m*):—

"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,

(*m*) 13 R. P. C. 196.



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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.' "

*Plimpton v. Spiller.*

In *Plimpton v. Spiller* (n) 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.

(n) (1875), 4 Ch. D. 286; 6 Ch. D. 412.

In *The United Telephone Co. v. Harrison* (o) 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. *Fry, J.*, was of opinion that the claim related only to the mica diaphragm in combination with the rest of the instrument, and that the specification was good in regard to that objection. This ruling was upheld by the Court of Appeal, consisting of *Jessel, M.R., Lindley and Bowen, L.JJ.*

Claims.  
United Telephone Co. v. Harrison.

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 parts or combinations which will render the patent void if those subordinate parts or combinations are old (p).

Some subordinate claims are fatal.

(o) (1882), L. R. 21 Ch. D. 720; 51 L. J. Ch. 705.

(p) *Cropper v. Smith* (1884) 1 R. P. C. 88, 90, 91; *Murchland v. Nicholson*

(1893), 10 R. P. C. 417; *Electric Construction Co. v. Imperial Tramways Co.* (1900), 17 R. P. C. 537, 549, 552.

Claims.

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 material may be good though the use in itself is not subject-matter.

Thus, in *Betts v. Neilson* (l), 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 (m).

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.

Lord *Westbury*, addressing the House of Lords, said:—

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

## CONSTRUCTION OF THE SPECIFICATIONS.

Construction of the specifications is

During the course of proceedings in which the validity of a patent is contested, it usually becomes necessary to decide, first,

(l) (1868), L. R. 3 Ch. 429 ; 5 H. L. 1.

(m) See p. 88, *ante*.

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 (*n*). The determination of the second question is one of law, and is in all cases for the Court alone (*o*). The Judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result (*p*).

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usually neces-  
sary in legal  
proceedings.

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

The "ordinary workman" test (*q*) is the proper one to employ for the purpose of settling the question of sufficiency, as is manifest from the following words of Lord *Lindley*, then Lord Justice *Lindley*, taken from the judgment of the Court in *Edison and Swan Electric Lighting Co. v. Woodhouse* (*r*). "If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court, and not for a workman, to construe the specification; but, if a workman says it is sufficient guide to him, and the Court believes him, the Court must hold, as regards clearness of description, the specification is, in point of law, sufficient" (*s*).

Test of  
sufficiency.

When the language used in a claiming clause, either directly or by reference to the body of the specification, is dubious, the point of construction should, logically, be determined before the other issues raised in the action are gone into;

(*n*) *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.

(*o*) *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.

(*p*) 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.

(*q*) See p. 210, *ante*.

(*r*) (1887), 4 R. P. C. 108.

(*s*) See also per Halsbury, L.C., *Tubes, Ld. v. Perfecta Seamless Steel Tube Co., Ld.* (1902), 20 R. P. C. 95, 96.

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tion.

but for obvious reasons this course is rarely practicable under the present practice (*t*).

Interpretation  
of language  
used in speci-  
fications.

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

In construing specifications it is often important to remember that human language is, after all, an imperfect instrument for the embodiment of human thought. Both the context and the subject-matter dealt with must often modify and expound the meaning of a word—*e.g.*, it would be an intelligible distinction to say that Mont Blanc was a flat mountain compared with Monte Rosa, which is a sharp peak, though Mont Blanc is not flat and Monte Rosa is not sharp, in the sense of the word sharp, when a knife or razor is spoken of (*x*). Thus, in a somewhat recent case, there was much difference of opinion between the judges as to whether the core of a golf ball, filled with gelatine and water under pressure in the proportion of 15 to 85, was filled with an “incompressible fluid” within the meaning of a certain specification. The House of Lords, from the context of the document and the subject-matter of the invention came to the conclusion that the core was so filled (*y*).

Technical  
terms.

It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other

(*t*) *British Motor Syndicate v. J. E. H. Andrews* (1899), 16 R. P. C. 586, 587; 18 R. P. C. 93.

(*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; *Elliott v. Turner* (1845), 2 C. B. 446; *Walton v. Potter* (1841), 1 W. P. C. 595; *Harrison v. The*

*Anderston Foundry Co.* (1876), L. R. 1 App. Cas. 581.

(*x*) See per Halsbury, L.C., *Leeds Forge Co., Ltd. v. Deighton's Patent Flue and Tube Co., Ltd.* (1904), 21 R. P. C. 494.

(*y*) *Roger v. Cochrane (J. P.) & Co.* (1908), 25 R. P. C. 757; 26 R. P. C. 591; [1909] A. C. 285.

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, or the judge acting as a jury, to decide (z).

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 (a).

The patent for the preparation of Lanolin (b) 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 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 cholesterine 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. Lord Justice *Romer*, then *Romer, J.*, decided at the trial that, upon the evidence adduced

(z) *Hill v. Evans* (1862), 31 L. J. Ch. 460.

(a) 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; 5 N. R. 340; *Edison v. Holland* (1888), 5 R. P. C. 474.

(b) *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson* (1894), 11 R. P. C. 93, 261.

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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.

## Variations in meaning.

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 (*c*).

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 (*d*).

## Spirit in which specifications should be construed.

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 encouraged on the ground of public policy, drew from Lord *Tenterden*, C.J. (*e*), 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

(*c*) *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.

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

(*e*) *Huddart v. Grimshaw* (1803), 2 B. & Ald. 377.

defeat and not to sustain them;” and from *Barry, L.J. (f)*, the comment following: “I would wish to have made some observations upon the propositions of law and the authorities which have been so strongly pressed upon us, but which, in my opinion, seem to indicate, on the part of the source from which they emanate—I do not mean counsel at the bar, I mean the cases that were cited—a seeking for technical reasons for defeating the protection that a man is entitled to for the results of his industry, his skill, and his talent, rather than to promote any interest of the public. It seems to me that we hear a great deal too much about the danger of monopoly, and allowing the public to be deprived of the benefit of inventions. It seems to me that we ought rather to endeavour to give the public the benefit of an invention by protecting the inventor when he has invented something good.”

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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 (*g*).

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

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. 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 (*h*). The Courts

(*f*) *Dowling v. Billington* (1890), 7 R. P. C. 208.

(*g*) *Stevens v. Keating* (1847), 2 W. P. C. 187; *Harrison v. The Anderston*

*Foundry Co.* (1876), L. R. 1 App. Cas. 581.

(*h*) See per Lord Blackburn, *Dudgeon v. Thompson* (1877), L. R. 3



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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 (*i*).

Construction must be logical, fair, and impartial.

The construction of the specification must be logical, fair, and impartial. It is proper for the Courts, seeing that patents for a limited period operate as an encouragement to the production of useful inventions, of which the public get the benefit after the monopoly is expired, to endeavour, if it can fairly and honestly be done, to support the patent, and to adopt a construction of the specification which will give it validity when it can fairly be interpreted so as to achieve this result (*k*). Every modern patent contains an express direction "that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the patentee." This does not mean that the patentee's language is to be strained in his favour, but that, if the language can be fairly construed so as to render the patent valid, it is to be so construed (*l*).

Doctrine that patentee would not intend to claim anything which would render the patent void.

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 (*m*).

It is a proper assumption to make that a patentee would not be so absurd as to claim anything which he knew 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 (*n*).

Thus in *Neilson v. Harford* (*o*) 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

App. Cas. 53; and per Tindal, C.J., *Haworth v. Hardcastle* (1834), 1 W. P. C. 480; 1 Bing. N. C. 182, 190.

(*i*) *Neilson v. Harford* (1841), 1 W. P. C. 310.

(*k*) *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.

(*l*) See *Hathersley v. Hodgson* (1906), 23 R. P. C. 203.

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

(*n*) *Clark v. Adie* (1873), L. R. 3 Ch. D. 142; *Electric Construction Co. v. Imperial Tramways Co.* (1900), 17 R. P. C. 547.

(*o*) (1841), 1 W. P. C. 331.

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 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* (*p*) 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

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

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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 doc-  
trine of con-  
struction  
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 the construction adopted 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 (*q*). What 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 (*r*).

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

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 (*t*). The

(*q*) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 320.

(*r*) Per Kekewich, J., *Pneumatic Tyre Co. v. Casswell* (1896), 13 R. P. C. 164, 181.

(*s*) *Cropper v. Smith* (1884), 1 R. P. C. 90; *Clark v. Adie* (1873), L. R. 2 App. Cas. 423, 437.

(*t*) *Clark v. Adie* (1873), L. R. 3 Ch. D. 142.

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 (*u*). But the Court will not strain the language of the specification for the purpose of arriving at such a conclusion (*x*).

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

Court is not astute to find flaws.

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

(*u*) *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.

(*x*) *British United Shoe Machinery Co., Ltd. v. Cloughton (Hugh), Ltd.* (1907), 24 R. P. C. 33.

(*y*) P. 266, *ante*; *Russell v. Cowley* (1832), 1 W. P. C. 457; 1 Cr. M. & R. 864.

(*z*) *Otto v. Linford* (1881), 46 L. T.

N. S. 35, 39; *Plimpton v. Spiller* (1876), L. R. 6 Ch. D. 422.

(*a*) *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.

(*b*) (1853), 8 Exch. 840; 22 L. J. Ex. 295; 9 Exch. 494; 23 L. J. Ex. 217.

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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.

## Doctrines 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 (*c*), but should be construed like all written instruments impartially according to its true meaning (*d*), unless the language is ambiguous (*e*), the Courts then adopting a construction which will support the patent in preference to one which will not, where this can fairly and honestly be done (*f*).

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

(*c*) *Harrison v. The Anderston Foundry Co.* (1876), L. R. 1 App. Cas. 574; *Needham v. Johnson* (1884), 1 R. P. C. 58; see p. 271; *Automatic Weighing Machine Co. v. Knight* (1889), 6 R. P. C. 307.

(*d*) *Clark v. Adie* (1875), L. R. 2 App. Cas. 436; *Betts v. Menzies* (1862), 10 H. L. Cas. 117; *Simpson v. Holliday* (1864), 13 W. R. 577; 5 N. R.

340; *Edison v. Holland* (1888), 5 R. P. C. 474.

(*e*) *Parkinson v. Simon* (1895), 12 R. P. C. 406, 407; *Patents Exploitation, Ltd. v. Siemens Brothers & Co., Ltd.* (1904), 21 R. P. C. 549.

(*f*) Pp. 264—266, *ante*.

(*g*) (1795), D. P. C. 162; 2 H. Bl. 463; 3 Ves. 143.

(*h*) *Thomas v. Foxwell* (1859), 6 Jur. N. S. 272.

*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."

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tion.

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

In *Cropper v. Smith (k)*, Lord *Bowen*, then *Bowen*, L.J., stated the duty of the Court in the following terms, which were quoted with approval by Lord *Lindley*, then *Lindley*, L.J., in the subsequent case of *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson & Co. (l)*:—

"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

(i) (1876), L. R. 4 Ch. D. 607, 612.

(j) 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.

(k) (1884), 1 R. P. C. 89.

(l) (1894), 11 R. P. C. 271.

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tion.

old times a great many Judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special 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: *Verba intentioni debent inservire*. You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim, that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly 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 (*k*); but if it is established by the evidence before the Court that certain matters, which the specification upon a fair construction claims, were not new at the date of the patent, and were generally thought to be old, the Court is not, therefore, to narrow down the claim so as to exclude the old matters. Such a proceeding would be contrary to the decisions, and would afford a very simple precedent for saying that no patent is to be upset on the grounds of novelty (*l*). In the words of Lord *Hatherley*, "the Courts will not alter the construction in order to save a patent where the patentee has himself explained his meaning in the claiming clauses" (*m*).

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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 (*n*). 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 (*o*).

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, which by its express terms is to be considered in the most beneficial sense for the advantage of the patentee.

Benevolent construction of the grant.

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 mathe-

Word used in a popular sense is not construed according to its exact meaning.

(*k*) *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. Harcastle* (1834), 1 W. P. C. 484; *Needham v. Johnson* (1884), 1 R. P. C. 58; *Morris v. Young* (1895), 12 R. P. C. 463.

(*l*) *Clark v. Adie* (1877), L. R. 2 App. Cas. 433, 437.

(*m*) *Clark v. Adie* (1877), 2 App. Cas. 431.

(*n*) Per *Jessel, M.R.*, *Plimpton v. Spiller* (1877), L. R. 6 Ch. D. 422.

(*o*) Per *Jessel, M.R.*, *Otto v. Linford* (1881), 46 L. T. N. S. 39.



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Claims are construed with reference to the whole specification, and after a consideration of it.

mathematical sense, and that the word must be construed in that sense (*p*).

The claiming clauses of the specification are construed with reference to the title and the whole of the specification. 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 (*q*), and though the rest of the specification may be considered in order to assist in comprehending and construing a claim, yet each claim must state, either by express words or by plain reference, what is the invention for which protection is thereby demanded (*r*). The idea of allowing a patentee to use perfectly general language in the claim and subsequently to restrict or qualify what is therein expressed by borrowing this or that gloss from the other parts of the specification is wholly inadmissible to the extent that it is an attempt to construe the claim with reference to the specification, not in order to understand what the claim says, but to make it say things which it does not say at all (*s*). 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 (*t*); though the effect of narrowing down the generality of a claim by the particularity of the descriptive part of the specification may involve the failure of the plaintiff's case on infringement (*u*).

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 (*x*).

(*p*) *Clark v. Adie* (1877), L. R. 2 App. Cas. 426.

(*q*) *Edison v. Woodhouse* (1887), 4 R. P. C. 107; *Parkinson v. Simon* (1894), 11 R. P. C. 238, 493; 12 R. P. C. 403.

(*r*) *Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co., Ltd.* (1907), 25 R. P. C. 83.

(*s*) See *ibid.*, per Loreburn, L.C., at pp. 83-4.

(*t*) *Arnold v. Bradbury* (1871), L. R. 6 Ch. App. Cas. 706; *Edison v. Woodhouse* (1887), 4 R. P. C. 107;

*Kay v. Marshall* (1835), 2 W. P. C. 39; *Beard v. Egerton* (1849), 8 C. B. 165, 215.

(*u*) See *Corrigall v. Armstrong, Whitworth & Co., Ltd.* (1905), 22 R. P. C. 268.

(*x*) *Arnold v. Bradbury* (1871), L. R. 6 Ch. 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; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co., Ltd.* (1900), 17 R. P. C. 588.

Thus, in *Arnold v. Bradbury* (y), where the patentee in his specification professed to do by machinery what had never been done before by machinery, and described the machinery by which he did it, his claim was not too large on the face of it, merely because it claimed generally to perform the operation "by machinery." Lord *Hatherley*, L.C., reading the claim in conjunction with and after a consideration of the description of the invention in the body of the specification, construed it as meaning "I claim the producing of this by machinery, of which machinery I have given fuller details."

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

In *Montgomerie v. Paterson* (a) the patent was for the discovery and preparation of a diastasio 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—

(y) (1871), 6 Ch. App. Cas. 706.

Ex. 305.

(z) (1851), 6 Exch. 859; 21 L. J.

(a) (1894), 11 R. P. C. 221, 633.

Construction.

*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.

In *Leonhardt v. Kallé (b)*, the subject-matter of the patent was 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 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 specified 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.

In *Evans and Taunton, Ltd. v. Hoskins and Sewell, Ltd. (c)*, the invention was the arrangement of the coiled supporting springs of a wire mattress in an oblique or diagonal position, and in opposite directions from the centre of each end, in such a manner as to direct the tension from all the springs on to the middle portion of the wire-mesh. The defendants did not dispute that the plaintiffs' arrangement would produce the result desired, when the network of the mattress was diagonal; but they contended that with a network of square pattern made movable on its points of contact the diagonally

(b) (1895), 12 R. P. C. 103.

(c) (1904), 21 R. P. C. 675; 24 R. P. C. 517.

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arranged springs would not direct any strain on the centre, and, inasmuch as the specification stated that forms of network other than the diagonal one shown in the drawings could be used, the claim covered the square form with which the invention was useless. The Court decided that the answer to the argument was that the patentee had not claimed such an unworkable method of carrying his invention into effect; he described an arrangement for a diagonally directed strain to the centre of the bed, and showed in his drawings a proper way of doing it, and when he said that other patterns of linkwork would do, he obviously meant meshes which will carry diagonal strains. The evidence was that there are a very large number of meshes of patterns which will carry diagonal strains, and any engineer would say which mesh would carry diagonal strains and which would not. In the opinion of the Court, therefore, the patentee had not claimed a square mesh as carrying out his invention.

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 (*d*). It is always a question of evidence whether or not the ordinary workman, using only common knowledge, would eliminate the members of the class which would not do (*e*). In one case, where it was not discovered till the actual trial of an action upon the patent that one member of a class could not be used with success, the patent was held void (*f*).

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 several claims mean the same thing they cannot be said to be effective (*g*). If, however, it is not possible to give a

Distinct effective meaning is, if possible, to be given to each claim.

(*d*) *Gandy v. Reddaway* (1885), 2 R. P. C. 52; *Edison v. Woodhouse* (1887), 4 R. P. C. 107.

(*e*) *Ibid.*

(*f*) *Badische Anilin und Soda Fabrik*

*v. La Société Chimique des Usines du Rhône* (1897), 14 R. P. C. 875.

(*g*) *Parkinson v. Simon* (1894), 11 R. P. C. 502; *Jordan v. Moore* (1886), L. R. 1 C. P. 624; see *Cassel Gold*

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Essence of an invention may be protected though the claim does not specifically mention it.

distinct effective meaning to all the claims, the fact that some are redundant does not invalidate the patent (*h*).

The claims should specifically refer to all that is of the essence or substance 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 (*i*). Thus, in *Tweedale v. Ashworth (k)*, 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. In the subsequent case of *Tweedale v. Howard (l)*, the Court held that upon the facts the defendant had infringed, because he had adopted by a mere colourable imitation the essential element of the patentee's contrivance. In *Tweedale v. Ashworth (m)*, 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;

*Extracting Co. v. Cyanide Gold Recovery Syndicate* (1895), 12 R. P. C. 232, 257; *British Shoe Machinery Co., Ltd. v. Hugh Claughlon, Ltd.* (1906), 23 R. P. C. 321; 24 R. P. C. 33.

(*h*) *Wenham Gas Co. v. Champion Gas Lamp Co.* (1892), 9 R. P. C. 55.

(*i*) See pp. 340—373, *post*; and *Ashworth v. English Card Clothing Co., Ltd.* (1903), 20 R. P. C. 797; *Tweedale v. Ashworth* (1892), 9 R. P. C. 127; *Proctor v. Bennis* (1887), 4 R. P. C. 333; *Automatic Weighing Machine*

*Co. v. National Exhibitions Association* (1891), 8 R. P. C. 350, 351; 9 R. P. C. 41; *Incandescent Gas Light Co., Ltd. v. De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 330; *Bunge v. Higginbottom & Co., Ltd.* (1902), 19 R. P. C. 193; *Hattersley v. Hodgson* (1905), 21 R. P. C. 517; 23 R. P. C. 192.

(*k*) (1892), 9 R. P. C. 127.

(*l*) (1896), 13 R. P. C. 522.

(*m*) (1892), 9 R. P. C. 127.

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tion.

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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 important elements forming the substance of the invention, it is one which the defendants have in no way invaded.”

Again, in *Boyd v. Horrocks* (n), 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 (o).

And in *Aktiebolaget Separator v. Dairy Outfit Co.* (p), the Court of Appeal held in reference to a claim worded as follows: “In centrifugal separators or creamers the combination of the conical plates, c’ with the rotating drum or bowl, a substantially as described,” the *sine qua non* of the invention as claimed was the rigidity of the conical plates in the form of a solid block. In consequence of this construction the claim was held to have been infringed by a defendant who left out the suitable means described for forming the separator of conical plates into a solid block in the bowl, and used a block solid in itself but with inclined narrow radial passages intersecting it through which the cream and milk flowed, when centrifugal force was applied to the bowl, in the same manner as in the patented mechanism.

It must be remembered that the Courts, in all cases, only apply this principle of introducing, by implication, a claim

Principle of  
introducing  
claim by im-

(n) (1892), 9 R. P. C. 77.

(o) *Moore v. Thompson* (1890), 7 R. P. C. 325; and *Gormully and Jeffery Manufacturing Co. v. North British Rubber Co.* (1898), 15 R. P. C.

245, are other decisions of the House of Lords involving the application of this principle.

(p) (1898), 15 R. P. C. 327.

## Construction.

plication is employed with great caution.

not expressly contained in a specification with the greatest possible caution (*q*).

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 (*r*). If a patentee desires that the words "*substantially as described*," at the end of the claiming clause, should receive a wide construction so as to extend the scope of the claim beyond the structural details referred to, he should, in the body of the specification, point out what are the results sought for and obtained by the invention (*s*).

(*q*) *Muirhead v. Commercial Cable Co.* (1895), 12 R. P. C. 39, 56.

(*r*) For instances, see *Young v. Rowenthal* (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; *Brooks v. Lamplugh* (1897), 15 R. P. C. 33; 16 R. P. C. 41; *Marshalls, Ld. v. Chambers Patents Manufacturing Co., Ld.* (1901), 18 R. P. C. 403; *Baston v. Watts* (1907), 25 R. P. C. 25; *Rickerby v. Duncan* (1908), 25 R. P. C. 248; *Vidal, &c. v. Levinstein, Ld.* (1911), 28 R. P. C. 558.

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; *Hinks v. Safety Lighting Co.* (1876), L. R. 4 Ch. D. 607.

*As above set forth.*—*Bray v. Gardner* (1887), 4 R. P. C. 403.

*Substantially as described and illustrated.*—*Foden v. Wallis and Stevens, Ld.* (1908), 25 R. P. C. 786.

*Substantially as set forth.*—*United Telephone Co. v. Bassano* (1886), 3 R. P. C. 315; *Patents Exploitation, Ld. v. Siemens Brothers & Co., Ld.* (1904), 21 R. P. C. 547.

*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.

*In . . . of the kind described.*—*Lynch and Wilson (Henry) & Co., Ld. v. Phillips (John) & Co.* (1908), 25 R. P. C. 707.

*More or less.*—*Plating Co. v. Farquharson* (1879-83), Griff. P. C. 187, 190.

*Or.*—*Simpson v. Holliday* (1866), L. R. 1 H. L. 315; *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; see also *Patent Exploitations, Ld. v. Siemens Brothers & Co., Ld.* (1904), 21 R. P. C. 547.

*Causing.*—*British Motor Syndicate v. J. E. H. Andrews & Co.* (1889), 16 R. P. C. 577; 18 R. P. C. 85.

*Float.*—In a weaving patent, *Lister v. Dix* (1898), 16 R. P. C. 89.

*Should.*—*W. T. Glover & Co. v. American Steel and Wire Co.* (1902), 19 R. P. C. 110.

*Sharp.*—*Leeds Forge, Ld. v. Deighton's Patents, Ld.* (1904), 21 R. P. C. 487.

*Plastic.*—*Patents Exploitation, Ld. v. Siemens Brothers & Co., Ld.* (1904), 21 R. P. C. 541; *Patents Exploitation, Ld. v. American Electrical Novelty and Manufacturing Co., Ld.* (1905), 22 R. P. C. 316.

(*s*) See, e.g., *Foden v. Walter and Stevens, Ld.* (1908), 25 R. P. C. 783;

The complete specification must be construed without calling in the aid of the provisional to explain or enlarge its meaning (*t*); though the Court may look at the provisional specification for the purpose of ascertaining the real object of the invention claimed in the complete (*u*).

The specification is always construed by the Courts, with regard both to accuracy of definition and sufficiency of description, by reference to the knowledge of the world existing at the date of the patent; and the Court, for purposes of construction, will not take notice of any subsequently acquired information, but will endeavour to divest itself of such knowledge, and place itself in the position of the person to whom the specification may have been supposed to be addressed at the date of the patent (*x*); and generally the prior history of the art and the surrounding circumstances are matters to which the Court gives due weight, when necessary (*y*), in arriving at the true construction of the specification and what it includes and excludes (*z*).

Thus in *Nobel's Explosives Co. v. Anderson* (*a*), 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

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Provisional cannot be called in aid to construe complete specification. Specification is construed with reference to public knowledge at the date of the patent,

and with reference to what it would

*Crossthwaite Fire Bar Syndicate, Ltd. v. Senior* (1909), 26 R. P. C. 713.

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

(*u*) *Parkinson v. Simon* (1894), 11 R. P. C. 502.

(*x*) *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; *Jandus Arc Lamp and Electric Co., Ltd. v. Johnson* (1900), 17 R. P. C. 361, 376; *Welsbach Incandescent Gas Light Co. v. New Incandescent (Sunlight Patent) Gas Lighting Co.* (1900), 17 R. P. C. 23; see also p. 214, *ante*.

(*y*) See pp. 283, 481, *post*.

(*z*) See *Pneumatic Tyre Co., Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co.* (1898), 16 R. P. C. 58, 55.

(*a*) (1894), 11 R. P. C. 115, 519; 12 R. P. C. 164.



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lead the person to whom it is addressed to do.

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 (b).

In *Badische Anilin und Soda Fabrik v. Levinstein* (c), 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*," 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 (d), 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 (e), who supported the patent, thus upholding the decision of *Pearson, J.*, and reversing that of the Court of Appeal (f).

Limit to the letter canon

The doctrine that the specification is to be construed to

(b) *Kaye v. Chubb* (1887), 4 R. P. C. 289; see p. 210, *ante*.

(c) (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.

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

(e) L. R. 12 App. Cas. 710.

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

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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."

In *Clark v. Adie (g)*, 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 did not admit the evidence, on the ground that there was no ambiguity in the specification involved, and 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.

Effect of pub-  
lications on  
construction  
of specifica-  
tions.

In *Westinghouse v. Lancashire and Yorkshire Railway Co. (h)*, *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

(g) (1873), L. R. 2 App. Cas. 423, 431; see *Jandus Arc Lamp and*

*Electrical Co., Ltd.* (1900), 17 R. P. C. 370.

(h) (1884), 1 R. P. C. 98, 101.

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claim to a combination, or a claim to several distinct inventions (i): and in *Couchman v. Greener* (k), 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: and in *Leeds Forge Co. v. Deighton's Patent Flue and Tube Co.* (l) the Lords Justices expressly construed the specification, for the purpose of fixing the ambit of the claim, by the aid of prior knowledge as disclosed by the prior specifications cited in the particulars of objections, though the construction at which they arrived was not upheld by the House of Lords. On the other hand, *Manisty, J.*, in a case between licensor and licensee, in the absence of ambiguity in the licensor's specification or necessity for explanation, refused to admit evidence of the state of public knowledge at the date of the plaintiff's patent (m). And Lord Justice *Farwell*, then *Farwell, J.*, also in an action between licensor and licensee refused to admit prior specifications in evidence on the question of construction on the ground that the language used was perfectly plain and in nowise of a special nature requiring any skilled explanation, and, further, since the invention, in fact, was not a particular improvement on a prior invention, his lordship rejected the argument that the occurrence of the word "improvement" in the title gave the right to refer to prior specifications as an aid to construction (n).

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 (o), and with this object in view the Courts do consider the state of public knowledge at the date of the patent (p). When, however, the Court construing a claim, as it must do, like any other written instrument, comes to the conclusion that it unequivocally includes what is old, it is not competent

(i) See also *Ellington v. Clark* (1888), 5 R. P. C. 325; *British Motor Syndicate v. Andrews (J. E. H.) & Co., Ltd.* (1901), 18 R. P. C. 95.

(k) (1884), 1 R. P. C. 197, 199.

(l) (1902), 19 R. P. C. 285.

(m) *Crosthwaite v. Steel* (1889) 6 R.

P. C. 190.

(n) *Jandus Arc Lamp and Electric Co., Ltd. v. Johnson* (1900), 17 R. P. C. 370; see also *Davidson v. Sun Fan Co., Ltd.* (1906), 23 R. P. C. 499.

(o) P. 266, *ante*.

(p) See pp. 266—269, *ante*.

to the patentee to call in aid common knowledge as a reason why the Court should limit the claim by excluding that which was old and known (*q*).

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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 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" (*t*).

Drawings in  
relation to  
construction.

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 an ambiguous 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 (*u*). Drawings which are not put forward as descriptive, *i.e.*, defining the invention, are treated by the Courts as illustrating and not limiting the invention which is described in the letterpress (*x*). Moreover, the Act of 1907, like the repealed 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 (*y*). 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 (*z*).

(*q*) See pp. 270—273, *ante*; *Kynoch & Co. v. Webb* (1899), 17 R. P. C. 108; *Electric Construction Co. v. Imperial Tramways Co.* (1900), 17 R. P. C. 545, 546.

(*r*) 7 Edw. 7, c. 29, s. 2 (3).

(*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.

(*t*) See also *Hattersley v. Hodgson*

(1904), 21 R. P. C. 517; 23 R. P. C. 192.

(*u*) *Clark v. Adie* (1877), L. R. 2 App. Cas. 315; P. O. R.

(*x*) See *Watson, Laidlaw & Co., Ltd. v. Pott, Chasels and Williamson* (1910), 27 R. P. C. 541; 28 R. P. C. 565.

(*y*) Per Rook, J., in *Boulton v. Bull* (1795), D. P. C. 188, 189.

(*z*) 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.

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On the point as to how far the drawings may aid the description in the specification, the following observations of Lord *Blackburn*, made in reference to a case in which the drawing was ambiguous, are instructive (a): "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 resulting from a curved plate was contemplated as being included in the invention at all" (b).

If the drawing is unambiguous and not merely illustrative (*i.e.*, by way of example), but is put forward as descriptive (*i.e.*, by way of definition), of the invention and the claim is for a thing shown and described, the fact that there is no reference in the letterpress to an essential feature which is shown on the drawing will not invalidate the patent on the ground of insufficiency of specification, nor will it exclude the essential feature in question from the claim (c).

Correction of  
errors by  
other parts of

The specification is to be read as a whole, and if one part corrects what is evidently a slight error contained in another

(a) *Clark v. Adie* (1877), L. R. 2 46 L. T. N. S. 40.  
App. Cas. 338. (c) *Hattersley v. Hodgson* (1904), 21  
(b) See also *Otto v. Linford* (1881), R. P. C. 517; 23 R. P. C. 192.

part, it is proper to make the correction, and the presence of such an error will not vitiate the specification (*d*); 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 (*e*); 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.

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cation.

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 (*f*); 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 (*g*).

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 (*h*).

(*d*) *Tatley v. Easton* (1852), Macr. P. C. 47; *Wegmann v. Corcoran* (1879), L. R. 13 Ch. D. 65.

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

(*f*) *Otto v. Linford* (1861), 46 L. T. N. S. 49; *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. F. 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; *True and Variable Electric Lamp Syndicate v. Bryant Farady Syndicate* (1908), 25 R. P. C. 461.

(*g*) *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.

(*h*) *Simpson v. Holliday* (1864), 5 N. R. 340; see also p. 195, *ante*.

## CHAPTER VII.

## REVOCACTION ON PETITION TO THE COURT.

## THE PETITION.

Effect of  
grant of  
letters patent.

LETTERS PATENT for inventions are obtained on the faith of representations made by the patentee, and where there is no opposition they are rarely refused.

The Crown makes the grant at the patentee's peril, and does not guarantee its validity, if the representations contained in the applicant's declarations are not true, or if all the requirements of the law are not satisfied.

The grant of a patent for an invention operates as a curtailment of the rights of the public, for it prohibits all his Majesty's subjects, other than the patentee and his licensees, from using the invention, even if they should discover it independently for themselves (*a*). The justification for making the grant is the consideration that the patentee is the first to give the public a knowledge of the invention and the means of making practical use of it (*b*).

It is evident that, if a grant of letters patent for an invention be made, which is in fact void, so long as the grant remains unrevoked the public suffers an injury, and the patentee is in the enjoyment of a monopoly to which he is not entitled.

Validity may  
be questioned  
by defendant  
in an action  
for infringement.

In the event of a patentee bringing an action against a member of the public in respect of an act alleged to be an infringement of his rights under the grant, it is competent to the defendant to put in issue the validity of the patent on any one or more of the grounds which in law render it void, and so obtain the declaration of the Court on the point, which, if in the defendant's favour, is a complete answer to the action.

(*a*) P. 102, *ante*.

(*b*) P. 102, *ante*.

It is sometimes to the interest of a particular member of the public to obtain a revocation of a void patent, quite independently of any proceedings against him in respect of infringement. For instance, where an individual is using an invention, in respect of which another person claims to have a patent, which the unlicensed user believes to be invalid; or where a person is desirous of using an invention included in a patent which he has good reason to believe is defective. The law has long provided a means to enable an aggrieved member of the public to obtain the repeal of a void patent. Formerly the procedure was by *scire facias*; but now a void or improperly used patent may be revoked, according to circumstances, on a petition to the Court under sect. 25, an application to the Comptroller under sect. 26 or sect. 27, a petition to the Board of Trade under sect. 24, or a counterclaim under sect. 32 of the Patents and Designs Act, 1907.

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A member of the public may have an interest in obtaining a revocation.

The present chapter deals only with the revocation of patents by petition to the Court under sect. 25 of the Act.

The proceeding for the revocation of a void patent by way of petition to the Court was first established by sect. 26 of the Patents, Designs, and Trade Marks Act, 1883, which abolished the proceeding by *scire facias*. Sect. 25 of the Act of 1907 embodies the provisions of sect. 26 of the repealed Act of 1883.

Notwithstanding the statutory provision of procedure by petition to the Court for revocation of a patent, it may be that the Court would, under special circumstances, entertain and adjudicate upon a request for a declaration of invalidity (c); but there is no precedent which justifies an action for a declaration of invalidity as against a petition for revocation, whether the patent is current or has expired at the date of the proceedings (d). The mere fact that a patent has expired is not, in itself, a sufficient reason for the refusal of the Attorney-General's fiat authorising the presentation of a petition (e).

Declaration of invalidity.

The presentation of a petition for revocation, as did the prosecution of a *scire facias*, entails expense on the part of the

Former condition of letters patent.

(c) See *Leeds Forge Co., Ltd. v. Clayton & Sons, Ltd.* (1905), 22 R. P. C. 325; *Alexander Turnbull & Co., Ltd. v. Cruikshank* (1905), 22 R. P. C. 521; *North Eastern Marine Engineering Co., Ltd. v. Leeds Forge Co., Ltd.* (1905), 23 R. P. C. 96, 529; *Traction*

*Corporation, Ltd. v. Bennett* (1908), 25 R. P. C. 819.

(d) See *ibid.*

(e) See *North Eastern Marine Engineering Co., Ltd. v. Leeds Forge Co., Ltd.* (1906), 23 R. P. C. 534.



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person presenting it, and in order that the public might not be put to the trouble or cost of resisting an unlawful patent, the Crown, before the Act of 1907 and the Patents Rules, 1908, made under that Act, imposed a condition on the grantee of every letters patent for an invention. This condition was a proviso in the letters patent to the effect that, if at any time during the term for which the patent was granted it were made to appear to the King, his heirs, or successors, or any six or more of his Privy Council, that the grant was contrary to law, or prejudicial, or inconvenient to his Majesty's subjects in general, or that the invention was not a new invention as to the public use and exercise thereof, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee was not the first and true inventor thereof within the realm, the letters patent should forthwith determine and be void to all intents and purposes (*f*). There is no instance in modern times of the determination of a patent under this proviso, but it is probable that it was under some such proviso that Queen Elizabeth was enabled to recall patents for monopolies, which were found to be so grievous to the public during her reign. This proviso is not retained in the present form of grant which is prescribed by the Patents Rules, 1908.

Revocation in part of the United Kingdom is applicable to the whole.

The Act of 1907 defines the term "patent" as meaning letters patent for an invention (*g*); and the letters patent have effect throughout the United Kingdom and the Isle of Man (*h*). Therefore, if revocation be obtained in any portion of the United Kingdom or the Isle of Man, it is applicable to the whole area for which the patent was originally granted.

Revocation may be obtained in England, Scotland, or Ireland.

The words of sect. 25 of the Act of 1907 are: "Revocation of a patent may be obtained on petition to the Court" (*i*). In this section "the Court," subject to the provisions as to Scotland, Ireland, and the Isle of Man, means the High Court in England (*k*). In Scotland the corresponding proceedings for revocation of a patent are in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence

(*f*) 46 & 47 Vict. c. 57, 1st Schedule, Form D.

(*g*) Sect. 93.

(*h*) 7 Edw. 7, c. 29, s. 14 (1).

(*i*) Universities of Oxford and Cam-

bridge v. Richardson d'Ewes (1802), 652; 6 Ves. 712; judgment of Lord Eldon, L.C., Matthey's Patent, Darcy v. Allin (1602), Noy, R. 183.

(*k*) 7 Edw. 7, c. 29, s. 92 (1).

may be given on just cause shown only, and service of all writs and summonses in that action are to be made according to the forms and practice existing at the commencement of the Act (l), and "the Court" means any Lord Ordinary of the Court of Session (m). In Ireland "the Court" means the High Court in Ireland, and all parties have their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only (n).

There was some doubt as to whether the effect of sect. 92, sub-sect. (2), of the Patents and Designs Act, 1907, was to take away the right of appeal to the Court of Appeal and the House of Lords in the case of petitions presented to the Court under the provisions of sect. 25, which were, by the Act of 1883, substituted for *scire facias* (o). The Patents and Designs Act, 1908, was passed to remove this doubt and to make it clear that the right of appeal exists.

Before the Chancery of Lancaster Act, 1890, it was held that the Court of the County Palatine of Lancaster, not being a "Court" within the Act of 1883, was not competent to entertain a petition for revocation; but it would appear that under sect. 3 of that Act the Palatine Court can do so now (p).

Power of the Court of the County Palatine of Lancaster to revoke a patent on petition.

No proceeding by petition or otherwise lies for revocation of a patent relating to any improvement in instruments, or munitions of war, which has been assigned to the Secretary of State for War or the Admiralty, and in respect of which such Secretary of State or the Admiralty has, before the application for a patent, or before the publication of the specification or specifications, certified to the Comptroller that, in the interests of the public service the particulars of the invention and of the manner in which it is to be performed should be kept secret (q).

Improvements in munitions of war.

### THE PETITIONER.

It is to be noticed that sect. 25, sub-sect. 3, of the Act of 1907 authorises various persons in England to present a peti-

Persons who are entitled to take proceedings for revocation.

(l) 7 Edw. 7, c. 29, s. 94 (3).  
 (m) 7 Edw. 7, c. 29, s. 94 (4).  
 (n) 7 Edw. 7, c. 29, s. 95 (2).  
 (o) See Frost's "Patents and Designs Act, 1907," p. 44.

(p) 53 & 54 Vict. c. 23, s. 3; Proctor v. Sutton Lodge Chemical Co. (1888), 5 R. P. C. 184.  
 (q) 7 Edw. 7, c. 29, s. 30 (1) (3) (9).

The  
Petitioner.

tion for the revocation of a patent as of right; but under the provisions of sect. 94 (3) in Scotland, the only persons entitled to initiate proceedings for revocation, which must be in the form of an action of reduction, are the Lord Advocate and persons having an interest, with his concurrence.

The Act of 1907, by sect. 25, sub-sect. 3, provides that a petition for the revocation of a patent may be presented to the Court—

(a) by the Attorney-General or any person authorised by him; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

(iii) that he, or any person under or through whom he claims any interest in any trade, business or manufacture had publicly manufactured, used or sold, within the realm, before the date of the patent, anything claimed by the patentee as his invention.

If the petitioner is qualified under sect. 25, sub-sect. (3) (b), he presents his petition as of right; any other person must obtain the fiat of the Attorney-General authorising the presentation.

When once the petitioner has a *locus standi* to present the petition he can impeach the patent on any lawful ground he chooses. Consequently, if he is qualified to present the petition without the fiat on any one ground, he does not need the fiat if he wishes to add other grounds (*r*).

(*r*) Morgan's Patent (1887), 5 R. P. C. 186. In Müller's Patent (1907), 24 R. P. C. 465, the petition alleged that the petitioner company was entitled to present the petition as being the assignee of a certain patent: and the amended particulars of objections stated that the petitioner's assignors were the true and first inventors of the invention comprised in the said patent, which invention formed the subject-matter of Müller's Patent,

and that Müller's Patent was void on other grounds, including anticipation. Parker, J., doubted whether the petitioner was entitled to present the petition without the fiat (see also Traction Corporation, Ltd. v. Bennett (1908), 25 R. P. C. 822). With the leave of the judge the fiat was applied for and obtained, and treated as *nunc pro tunc*. It does not appear that Morgan's Patent, on the authority of which the above statement is made,

If there is any doubt as to whether a would-be petitioner is qualified as of right, he should take the precaution to arm himself with the fiat of the Attorney-General, for the Court will at the hearing refuse to go into the question whether the patent is good or bad, if it appear that the petitioner has no *locus standi* (s). But any person who presents a petition under any one of the above clauses is, as above stated, if he proves his right to do so, entitled to impeach the patent on any other lawful ground (t).

The  
Petitioner.  
Fiat of the  
Attorney-  
General where  
necessary.

In order to obtain the Attorney-General's fiat authorising the presentation of a petition for the revocation of a patent, it is necessary to lodge the following papers at the Law Officers' Department, Royal Courts of Justice.

Procedure to  
obtain the  
fiat of the  
Attorney-  
General.

1. Memorial to the Attorney-General asking for his authority and stating all the circumstances.
2. Statutory declaration on judicature paper verifying the statements in the memorial, and stating that there are no pending proceedings in the United Kingdom wherein the issues proposed to be raised by the petition or particulars of objections could be determined.
3. Two copies on brief paper of the proposed petition, and of the particulars proposed to be delivered with it, and prints of specifications and copies of documents referred to in the memorial, petition, or particulars (u).
4. Certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
5. Certificate of a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition.

Under the old practice in *scire facias* the fiat of the Attorney-General was necessary in all cases, and was not issued as of

was cited before Parker, J., in Müller's Patent. It is submitted that *bonâ fide* allegation and not proof of the facts referred to in sect. 25, sub-sect. 3 (b) (i) (ii) and (iii), is all that is necessary to give a *locus standi* to raise any other ground of invalidity upon petition for revocation.

(s) *In re* Avory's Patent (1887), L. R. 36 Ch. D. 307, 322; 4 R. P. C. 152, 322; see p. 294, *post*.

(t) *Morgan's* Patent (1888), 5 R. P. C. 186.

(u) For forms, see Appendix.

The  
Petitioner.

course (*x*); neither does a petitioner under the present practice obtain the fiat as of right, for the Attorney-General grants or refuses it at his discretion; though it is usual for the Attorney-General to exercise his discretion in favour of the petitioner when there is anything like a *prima facie* case (*y*).

In some cases the Attorney-General decides *ex parte* whether to grant or refuse his fiat, and in others he directs notice to be given to the patentee, and that the parties be heard before him.

Thus, where no other proceeding was pending, the Attorney-General's fiat was granted without a direction to give notice to the patentees (*z*); so likewise where an action for infringement of the patent had been commenced but abandoned (*a*). Where an action for infringement against the applicants was pending in Scotland, and the patentees objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, the Attorney-General's fiat was refused, pending the result of the action in Scotland, but leave was given to renew the application if necessary (*b*). Where the applicant was a licensee under the patent notice was directed to be given to the patentee (*c*); so also where the applicant was a defendant in an action for infringement at the instance of the patentee and the application was made during the interval after judgment in the Court of first instance and the hearing of an appeal (*d*); and where notice had been given to the patentee, the application was at the hearing ordered to stand over, on the patentee undertaking to commence an action for infringement within a month (*e*).

Attorney-  
General may  
grant his fiat  
*nunc pro tunc*.

The Attorney-General has authority to grant the fiat *nunc pro tunc*. Thus in cases where the fiat is necessary to give the petitioner a *locus standi* and the petition comes on for hearing without it, the practice is to grant an adjournment in order to allow the petitioner an opportunity of obtaining the fiat *nunc pro tunc* (*f*).

(*x*) 1 W. P. C. 671, n. ; R. v. Prosser, 14 Beav. 306.

(*y*) Shoe Machinery Co. v. Cutlan (1895), 12 R. P. C. 533.

(*z*) Gaulard and Gibbs' Patent, Griff. P. C. 320.

(*a*) Bothwell's Patent, Griff. P. C. 320.

(*b*) Bell and Coleman's Patent, Griff.

P. C. 320; see also *In re Young's Patent*, P. M. J. 2nd series, vol. vii. p. 44.

(*c*) Martin's Patent, Griff. P. C. 320.

(*d*) Watling's Patent, Griff. P. C. 320.

(*e*) Siddell's Patent, Griff. P. C. 320.

(*f*) Dedge's Patent (1895), 12 R. P.

The Act of 1907 gives the Attorney-General power to award the costs of proceedings before him (*g*), including a petition for his fiat, which is heard out; but it does not give him any authority over the costs of a petition presented to him praying for the grant of his fiat when the petition is subsequently abandoned (*h*). The costs of obtaining the Attorney-General's fiat, authorising the presentation of a petition for revocation which is successful, are properly allowed upon taxation where the Respondent is ordered to pay the costs of the petitioner.

**The  
Petitioner.**  
Costs of pro-  
ceedings  
necessary to  
obtain  
Attorney-  
General's  
fiat.

GROUNDS FOR REVOCATION.

On petition to the Court, under sect. 25 of the Act of 1907, a patent may be revoked on any ground on which—

Grounds on  
which patents  
are revoked.

- (a) a patent might immediately before the first day of January one thousand eight hundred and eighty-four (*i.e.*, the commencement of the repealed Act of 1883), have been repealed by *scire facias*; or
- (b) a patent may be revoked under the Act either by the Comptroller, or as an alternative to the grant of a compulsory licence.

A *scire facias* lay to repeal a patent in three cases according to the authority of the fourth Institute (*i*).

- (1) When the King by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent.
- (2) When the King granteth anything that is grantable upon a false suggestion, the King by his prerogative, *jure regio*, may have a *scire facias* to repeal his own grant.
- (3) When the King doth grant anything which by law he cannot grant, he, *jure regio* (for the advancement of justice and right), may have a *scire facias* to repeal his own letters patent.

C. 448; Jameson's Patent (1902), 19 R. P. C. 246.  
(*g*) Sect. 40.

(*h*) Martin's Patent, Griff. P. C. 320.  
(*i*) P. 58.

**Grounds for  
Revoca-  
tion.**

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It was laid down by another well-known authority (*k*) that the grounds on which a patent could be repealed by *scire facias* were: "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent" (*l*).

Thus a patent may be revoked on the grounds of prior grant, false suggestion, or that the patentee was not the true and first inventor, that the alleged invention is not proper subject-matter, or lacks the essential elements of utility or novelty, or that the specifications are insufficient, or abuse of privileges conferred. It may also be revoked on the ground that it was obtained in fraud of the rights of the petitioner (*m*).

**Recitals in  
the letters  
patent.**

Under the present practice, all letters patent contain a recital to the effect that the patentee has represented to the Crown that he is in possession of an invention of which he claims to be the true and first inventor, and that the same is not in use by any other person to the best of his knowledge and belief (*n*); and a further recital to the effect that the patentee has by and in his complete specification particularly described the nature of his invention (*o*).

**Distinction  
between a  
false repre-  
sentation re-  
cited in the  
patent and a  
false state-  
ment in the  
specification.**

The distinction between a false representation made by the patentee and recited in the letters patent and a false statement as an error in the specification, is of the greatest importance. A distinction must be drawn between an error in the specification, such as will make a suggestion in the letters patent false, and an error in a matter of direction or otherwise, such as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility (*p*).

**Inventions  
with the same  
objects.**

If a patentee invents an apparatus or process for achieving a given object, he will not necessarily be entitled to obtain (on the ground that he was the first and true inventor) the revocation of a subsequent patent for achieving the same object, when the invention comprised therein is a different method of arriving at the same result and the later patentee shows a different way of dealing with knowledge common at the date of the first

(*k*) Webster on the Law and Practice of Letters Patent for Inventions, p. 32.

(*l*) See *R. v. Cutler* (1847), *Macr.* P. C. 124; *R. v. Arkwright* (1785), 1

W. P. C. 66.

(*m*) P. 297, *post*.

(*n*) See Vol. II. p. 421.

(*o*) *Ibid*.

(*p*) See 1 W. P. C. 42, n.

patent (*q*). If, however, the prior patentee has discovered a new principle and a method of carrying it out, he may be entitled to the revocation of a subsequent patent for another and analogous method of carrying out the same principle, if the method apart from the principle is not subject-matter—*i.e.*, is not an invention (*r*).

Grounds for  
Revoca-  
tion

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The power of presenting a petition for revocation conferred on "any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims" relates only to cases of fraud. And in this connection the word "fraud" is construed in accordance with the ordinary meaning of the English language as involving dishonesty or grave moral culpability on the part of the person obtaining the patent (*s*). The existence of the element of moral turpitude on the part of the patentee may be inferred not merely from his conduct prior to and at the time of the application for the grant, but also from the use he makes of the grant when obtained, as, for example, by insisting, as against the true inventor, on treating the invention as his own (*t*). The expression "fraud of his rights" does not extend to cases of *bonâ fide* mistake, notwithstanding that the consequences of the mistake may be to deprive the inventor of his patent rights (*u*). Thus, where a subject of the United States of America, and resident there, gave a power of attorney to an English patent agent, with instructions to obtain a patent in this country, and the agent employed a sub-agent, who took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it, or any part of it, was a communication from abroad, and made a statutory declaration that he was the first and true inventor, the Court of Appeal held that, even if the patent was void by reason of the non-disclosure in the specification of the communication from abroad, as there was no proof of any intention on the part of the patentee to deprive the inventor of his rights, the petition could not be sustained on the ground of fraud, and it was dismissed, without prejudice to any petition which the

Patent  
obtained in  
fraud of peti-  
tioner's  
rights.

(*q*) *Walker v. Hydrocarbon Syndicate, Ltd.* (1885), 2 R. P. C. 3.

(*r*) See p. 55, *ante*.

(*s*) *Avery's Patent* (1887), L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(*t*) *Ibid.*; *Ralston's Patent* (1909), 26 R. P. C. 331.

(*u*) *In re Avery's Patent* (1887), L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.



**Grounds for  
Revoca-  
tion.**

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inventor might be advised to present as a person claiming to be the first and true inventor (*x*).

Under the following circumstances patents have been revoked on the ground that they were obtained in fraud of the rights of the petitioner. Where it appeared that the petitioner and respondent had jointly put in a provisional specification, which had been allowed to lapse, and the respondent had thereupon, without the knowledge of the petitioner, obtained the patent for the invention of which the petitioner was the first and true inventor (*y*). And where the evidence showed that experiments finally resulting in the invention were not made by one of two separate petitioners under the direction of the patentee as the patentee contended, but by the other separate petitioner assisted by the first petitioner, and the patentee, not being the true and first inventor, had obtained the patent in fraud of the latter petitioner's rights (*z*). And also where the petitioner was a workman in the employ of a company, one of the directors of which had asked him to invent a tap which would produce certain desired results, and the petitioner worked up the invention, made drawings and models, and perfected the tap in all details and was paid for overtime work on the models (*a*). This last case may be contrasted with another in which the facts were that the petitioner had merely suggested to the patentee a want which was hitherto unsatisfied, but had not given any indication as to the means of supplying it, and the petition consequently failed (*b*). Where the petitioner had communicated his invention to the patentee, who induced the employer of both to take up and use the invention, which the patentee before and after he obtained the grant insisted upon was his own, the Court found that the patent had been obtained in fraud of the rights of the true inventor, and revoked it (*c*).

A fresh patent may be granted to the

When a petitioner succeeds on the ground that the patent was obtained in fraud of his rights, the patent of the respondent

(*x*) *In re Avery's Patent* (1887), L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(*y*) *Gale's Patent* (1891), 8 R. P. C. 438.

(*z*) *Norwood's Patent* (1895), 12 R. P. C. 214; see also *Avery's Patent* (1887), 4 R. P. C. 152; L. R. 36 Ch. D. 307; *Norwood's Patent* (No. 2) (1898),

15 R. P. C. 99; *Marshall and Naylor's Patent* (1900), 17 R. P. C. 556.

(*a*) *Marshall and Naylor's Patent* (1900), 17 R. P. C. 553.

(*b*) *Jackson's Patent* (1905), 22 R. P. C. 384.

(*c*) *Ralston's Patent* (1909), 26 R. P. C. 313.

will be revoked, and a fresh patent may be granted to the petitioner (*d*), bearing the same date as the revoked patent, but no action can be brought for infringements committed before the date of the actual grant of such fresh patent (*e*). Such a patent will not be granted as a matter of course; the Comptroller-General has a discretion in the matter (*f*).

**Grounds for Revocation.**

petitioner when he succeeds on the ground that the original patent was obtained in fraud of his rights, but not when he succeeds on any other ground.

Where the petitioner succeeds on the ground that the patent was obtained in fraud of his rights it is proper for the Court, in addition to making an order for the revocation of the patent, to grant a declaration to the effect that the respondent was not the true and first inventor of the invention; that the petitioner was the true and first inventor thereof; and that the respondent obtained the invention from him, and obtained the grant of the letters patent in fraud of the rights of the petitioner (*g*).

When fraud is alleged, it is incumbent upon the petitioner to give strict proof of it, and if he fails to do so the petition cannot succeed (*h*).

When the petitioner succeeds on grounds other than that of fraud of his rights, the invention cannot be good subject-matter of a fresh patent (*i*).

In a case (*k*) where revocation of a patent for "improvements in the preparation of foods for infants and invalids" was sought, on the ground that the petitioner had for many years previous to the date of the patent been manufacturing foods by a process substantially similar to that of the patentee, and the evidence established the fact that the two processes were chemically the same, *Kay, J.*, in giving judgment for the petitioner said—

Invention publicly used by petitioner before the date of the patent.

"This is an application to recall a patent. It is made under the statute of 1883, which provides that a petition for revocation of a patent may be presented by, among other

(*d*) 7 Edw. 7, c. 29, s. 15 (2); Avery's Patent (1887), L. R. 36 Ch. D. 326; 4 R. P. C. 152, 322; Marshall and Naylor's Patent (1900), 17 R. P. C. 556.

(*e*) 7 Edw. 7, c. 29, s. 15 (2).

(*f*) Norwood's Patent (1895), 12 R. P. C. 219; Norwood's Patent (No. 2) (1898), 15 R. P. C. 99.

(*g*) Marshall and Naylor's Patent

(1900), 17 R. P. C. 553; Ralston's Patent (1909), 26 R. P. C. 338-9.

(*h*) Jameson's Patent (1902), 19 R. P. C. 254; Mark's Patent (1908), 25 R. P. C. 558.

(*i*) Norwood's Patent (1895), 12 R. P. C. 219; Norwood's Patent (1898), 15 R. P. C. 99.

(*k*) In the Matter of Haddan's Patent (1885), 2 R. P. C. 219.

Grounds for  
Revoca-  
tion.

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people, 'any person alleging that he or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.' Now, the justice and common sense of that is too apparent to need much comment. A man has been carrying on a particular manufacture for some time; and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore when anything of the kind happens the Legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court and have the patent revoked."

PRACTICE.

Parties.

The petition must be presented in the name of the person making the allegations in respect of which the revocation is sought, such person, when necessary, being duly authorised by the fiat of the Attorney-General (*l*); and all persons having an interest in the patent must be made respondents (*m*).

Under the old practice it was not competent for two persons to have a *scire facias* for the same patent (*n*), and if the patent had been originally granted to two persons jointly it was necessary to make them both parties, notwithstanding the fact that one had, before the issue of the suit, assigned his share to the other (*o*).

Under the present practice it is only necessary to make the persons respondents who have an interest in the patent at the time the petition for revocation is presented; and when the patent is assigned after the presentation of a petition the name of the assignee may, on giving security for costs, be substituted for that of the patentee as respondent (*p*).

(*l*) P. 292, *ante*.

(*m*) *Re Avery's Patent* (1887), L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(*n*) *R. v. Neilson* (1842), 1 W. P. C. 673.

(*o*) *R. v. Betts* (1850), 15 Q. B. 540; L. J. Q. B. 13, 53.

(*p*) *Re Haddan's Patent* (1885), 2 R. P. C. 218.

The petitioner is required to deliver with his petition particulars of the objections on which he means to rely, and must thereby clearly define every issue which it is intended to raise (*q*). These particulars may be, from time to time, amended by leave of the Court (*r*), and no evidence will, except by leave of the Court, be admitted in proof of any objection of which particulars have not been delivered (*s*). Further information as to particulars of objections will be found at pp. 422 to 435, *post*.

**Practice.**  
Particulars of objections.

Where the petition proceeds to trial, it is necessary for a successful petitioner to obtain the Judge's certificate of the reasonableness and propriety of his particulars, in order that his costs of such particulars may be allowed on taxation (*t*).

Certificate as to particulars necessary.

All persons interested in the patent ought to be made respondents and served with the petition (*u*).

Service of the petition, .

The Act of 1907 does not, however, provide any special procedure for the service of the petition out of the jurisdiction. It is therefore sufficient if such notice is given as is required by natural justice (*x*).

out of the jurisdiction.

In *Drummond's Patent* (*y*) it appeared that the patentee was resident and domiciled in Scotland. After a copy of the petition, together with the particulars of objection, was delivered to him personally in Scotland, he wrote to the petitioner's solicitors, stating that he did not intend to appear, and objecting to the jurisdiction of the English Court. On the application of the petitioner, the Court ordered that the case should be set down for hearing, unless by a certain day, of which notice was to be given to the respondent, he should appear and show cause to the contrary; it being open to him, if he appeared, to dispute the jurisdiction.

In *Goerz and Hough's Patent* (*z*) the respondents were both domiciled out of the jurisdiction, and on an application for directions as to service, *North, J.*, pointed out that the respondents could not be served at all, but that the proper thing

(*q*) R. S. C. O. 53A, rr. 11, 17.

Ch. D. 307; 4 R. P. C. 152.

(*r*) R. S. C. O. 53A, r. 19.

(*x*) See *King & Co.'s Trade Mark*, [1892] 2 Ch. 463.

(*s*) R. S. C. O. 53A, r. 11.

(*y*) (1889), 6 R. P. C. 756.

(*t*) R. S. C. O. 53A, r. 22.

(*z*) (1895), 12 R. P. C. 370.

(*u*) *Avery's Patent* (1887), L. R. 3

Practice. for the petitioner to do was to follow the procedure adopted in *Drummond's Patent* above referred to. The Judge also stated that he could not authorise the petitioner to do anything, but that if he (the Judge) was satisfied that the respondents had had proper notice he might proceed in their absence.

In *Hirschfeld's Patent* (a), on motion for directions as to service of the petition on a foreigner resident abroad, leave was given to the petitioner to send to the respondent by registered letter a copy of the petition, together with a notice that the petition had been ordered to go into the witness list. The respondent did not appear, and the patent was revoked in his absence.

In *Kay's Patent* (b) one of three respondent joint patentees was out of the jurisdiction, and the petition had been duly served on the other two within the jurisdiction. On motion for directions, it was ordered that the petition should go into the witness list; but unless the third patentee appeared by counsel on notice given to him (c) it should not come on for hearing without leave; and liberty was given to either party to apply.

In *Allison's Patent* (d) the foreign owners being resident abroad, and solicitors who had appeared for them in an action against the petitioners declining to undertake to appear, the petition, upon an application for directions, was ordered to go into the witness list and the petitioners were directed to give notice to the solicitors, and, by registered letter, to the owners abroad, with a copy of the petition.

The Court will not compel a respondent out of the jurisdiction to give security for costs, since he does not appear before the Court in consequence of his own application (e).

At the hearing of a petition for revocation the *onus* is on the respondent, who therefore has, under the rules of the Court, the right to begin and give evidence in support of the patent, and he has the right to reply, if the petitioner tenders evidence impeaching the validity of the patent (f).

(a) (1895), 11 R. P. C. 514.

(b) (1894), 11 R. P. C. 279.

(c) As in *King & Co.'s Trade Mark*,  
9 R. P. C. 350.

(d) (1900), 17 R. P. C. 297.

(e) *Miller's Patent* (1894), 11 R. P. C. 55; *La Société Anonyme Trade Mark* (1893), 10 R. P. C. 290.

(f) R. S. C. O. 53A, r 12.

Respondent  
out of the  
jurisdiction  
cannot be  
compelled to  
give security  
for costs.

Respondent  
has the right  
to begin at  
the hearing.

Practice.

In an action of *scire facias* the burden of proof was on the plaintiff, and in order to succeed he had to do more than establish a mere *primâ facie* case (*g*).

Petition is an action and tried like other actions.

A petition for revocation is, in every sense of the word, an action, except that it is commenced by a petition instead of a writ, and it will be tried in the way in which actions usually are tried—*i.e.*, by *vivâ voce* evidence—if either of the parties desires to have it so determined (*h*).

Mode and date of trial.

If it is desired to have the petition tried with witnesses the proper course is to make an application, on the day on which the petition is returnable, that the petition should go into the witness list, at or after a named date, to be tried on oral evidence (*l*). The parties, when arranging the date, should be careful to fix a date by which they are likely to be ready for trial, otherwise the petition may be struck out, though it may be set down again without the necessity of serving a fresh petition (*m*).

The day on which the petition is returnable and comes into the petition list is the proper time for the parties, or either of them, if they want discovery or inspection, or anything else, to say so, and the petition ought not to be put into the witness list until it is effective for hearing (*n*).

Discovery and inspection.

The petitioner is entitled to administer interrogatories to the respondent as in an action for infringement (*o*).

Interrogatories.

When the petition is to be tried by the Court on affidavit evidence, it is proper for the party who has the right to begin to file his evidence in chief first, and if there is any cross-examination of any of the witnesses of either side such cross-examination ought to be brought before the Court at the trial (*p*).

Trial on affidavit evidence.

The Court may, and on the request of either of the parties it must, call in the aid of an assessor specially qualified,

Trial with assessor.

(*g*) *R. v. Cutler*, Macr. P. C. 121, 133, 134.

19 R. P. C. 160.

(*h*) *In re Gaulard and Gibbs' Patent* (1886), L. R. 34 Ch. D. 396.

(*n*) *Scott's Patent* (1902), 19 R. P. C. 276.

(*l*) *Miller's Patent* (1894), 11 R. P. C. 55; *Borrowman's Patent* (1902), 19 R. P. C. 160.

(*o*) *Haddan's Patent* (1884), 54 L. J. Ch. N. S. 126; 51 L. T. N. S. 190; W. R. (1884) 192.

(*m*) See *Borrowman's Patent* (1902),

(*p*) *Gale's Patent* (1891), 8 R. P. C. 438.

- Practice.** and try and hear the case wholly or partially with his assistance (*q*).
- Trial without a jury.** Unless the Court otherwise decide, the petition is, by statutory provision, heard without a jury (*r*).
- Trial at assizes.** To suit the convenience of the parties to the petition for revocation and their witnesses, an order may be obtained directing the trial of the petition before a Judge without a jury at assizes (*s*).
- Hearing at same time as an action for infringement.** Again, if there is an action for infringement of the patent pending, an order may be obtained for the hearing of the petition at the same time as the trial of the action (*t*). If there is a pending appeal in an action on the patent, an order may be obtained, in a proper case, for the postponement of the hearing of the petition till after the determination of the appeal (*u*).
- Joint petitioners must appear by same counsel.** As a rule joint petitioners must appear by the same counsel, but in *Norwood's Patents* (*x*) two joint petitioners were, under the peculiar circumstances of the case, allowed to appear separately, and one conducted his case in person (*y*).
- Revocation when respondent consents.** Where the respondent consents, an order for revocation with costs is usually made when the petition comes on for directions (*z*), or for hearing (*a*). There may be cases in which the fact, if it be a fact, that the petitioner did not communicate his intention to present the petition to the respondent, so as to give him an opportunity of surrendering his patent under sect. 26, sub-sect. 3 of the Patents and Designs Act, 1907, will affect the question of costs (*b*). Judgment for revocation should be pronounced in open Court and not, even by consent, in Chambers (*c*).
- Revocation when respondent does not appear.** When the respondent does not appear the patent may be revoked at once on the petition coming on and the production of affidavits verifying the service and the grounds of revoca-

(*q*) 7 Edw. 7, c. 29, s. 31.

(*r*) *Ibid.*

(*s*) R. S. C. O. 36, r. 8; In the Matter of Edmond's Patent (1859), 6 R. P. C. 355.

(*t*) Edge's Patent (1890), W. N. 149.

(*u*) Hitchcock's Patent (1903), 20 R. P. C. 767.

(*x*) (1895), 12 R. P. C. 214.

(*y*) *Norwood's Patents* (1895), 12

R. P. C. 219, 221.

(*z*) Sleight's Patent (1893), 10 R. P. C. 447; Rendell's Patent (1894), 11 R. P. C. 277; Wilkinson's Patent (1894), 11 R. P. C. 298.

(*a*) Vautin's Patent (1907), 25 R. P. C. 176.

(*b*) See Aylott's Patent (1911), 28 R. P. C. 227.

(*c*) Clifton's Patent, [1904] 2 Ch. 357; 21 R. P. C. 515.

tion stated in the petition (*d*). And since petition is the only way open to a member of the public to obtain the revocation of a void patent, costs will be given against a respondent patentee who does not appear (*e*). Also costs will be given against a respondent who abandons his case (*f*).

Practice.

There is no estoppel against a petitioner for revocation who has been an unsuccessful defendant to an action for infringement of the patent brought at the instance of the respondent. The reason of this is, that the petitioner on the petition appears as a member of the public, and, consequently, there is no *res judicata* between him and the respondent in that capacity (*g*). And this fact will materially influence the Court of Appeal in exercising its discretion to allow fresh evidence of invalidity upon the appeal of an unsuccessful defendant to an action for infringement (*h*).

No estoppel against an unsuccessful defendant to an action for infringement.

The Court has power to stay proceedings on an order pending an appeal (*i*); and it is submitted that in all cases the order should, in view of questions which may arise as to its effect, be suspended until the disposal of an appeal or an application to amend the specification if the respondent asks for such suspension.

Stay of proceedings on order for revocation pending an appeal.

The proper form of order upon a successful petition varies according as the Court finds that all or only some of the claiming clauses of the specification are bad (*k*).

Form of order.

In a case decided before the Act of 1907, where the Court of first instance had found a patent void on account of want of novelty in respect of part of the invention, and had made an order for the unconditional revocation of the patent, and the House of Lords held that the patent was bad on certain grounds, but not on all the grounds alleged, and directed a postponement for the purpose of giving the patentee an opportunity of applying at the Patent Office for leave to amend and

Form of order for revocation.

(*d*) Hirschfeld's Patent (1894), 11 R. P. C. 514; Vaisey's Patent (1894), 11 R. P. C. 593; Ingram's Patent (1896), 13 R. P. C. 446; Corckel's Patent (1898), 15 R. P. C. 500; Part-ridge's Patent (1903), 20 R. P. C. 459; Lee's Patent (1906), 23 R. P. C. 233.

(*e*) Wallace's Patent (1895), 12 R. P. C. 444; Simmon's Patent (1895), 12 R. P. C. 446.

(*f*) Dedge's Patent (1895), 12 R. P. C. 448.

(*g*) Deeley's Patent (1895), 12 R. P. C. 192, 199; Shoe Machinery Co. v. Cutlan (1895), 12 R. P. C. 553; Lewis and Stirkler's Patent (1897), 14 R. P. C. 24, 35.

(*h*) Shoe Machinery Co. v. Cutlan (1895), 12 R. P. C. 530, 533.

(*i*) Armstrong's Patent (1897), 14 R. P. C. 755; Owen's Patent (1899), 17 R. P. C. 79; Deeley v. Perks (1896), 13 R. P. C. 587.

(*k*) See Vol. II. p. 483.



Practice.

so remove the invalid claims, the Comptroller-General, acting on the advice of the law officer, refused leave on the ground that, the patent having been revoked by the order of the Judge of first instance, there was no patent existing for him to deal with. The matter being again mentioned to the House of Lords, their Lordships did not decide the point as to the jurisdiction of the Comptroller under the above circumstances, but did justice by, instead of simply affirming the order of the Judge of first instance, making an order (which was of course *nunc pro tunc*) "that the patent be revoked, unless within three months or such further time as the Court may allow the patentee obtain leave to amend his specification," &c. (*l*).

When the Court finds all the claims bad, it is submitted, an unconditional order for revocation should be made, which, it is further submitted, should be stayed, in the event of an appeal being entered within a certain time, until the appeal is disposed of as in *Owen's Patent* (*m*); but when the Court finds that one or more of the claims are good and others bad, the proper order to make is that above referred to and adopted by the House of Lords in *Deeley v. Perks* (*n*), with the addition, if the respondent asks for it, that there be a stay of execution of proceedings until after appeal heard (*o*). But if the ground on which the patent is revoked be that it was wrongfully obtained in fraud of the rights of the petitioner, the proper course is to order the unconditional revocation of the patent, notwithstanding that the petitioner was not the true and first inventor of all the inventions included in the patent (*p*).

Effect of an order for revocation.

Under the old practice, if the trial of a *scire facias* resulted in favour of the Crown the Lord Chancellor had authority to order the patent to be restored into Chancery to be cancelled (*q*), but recent legislation has not provided for the delivering up of a patent which has been revoked by a decision of the Court.

(*l*) See *Deeley v. Perks* (1896), 13 R. P. C. 581.

(*m*) (1899), 17 R. P. C. 79; *Klaber's Patent* (1904), 22 R. P. C. 1, 405; *Bowden's Patent* (1904), 22 R. P. C. 49.

(*n*) (1866), 13 R. P. C. 590; see *Justice's Patent* (1900), 18 R. P. C. 248; *Scott's Patent* (1902), 20 R. P. C. 263.

(*o*) *Armstrong's Patent* (1897), 14 R. P. C. 755; *Miller's Patent* (1898), 15 R. P. C. 205.

(*p*) See *Ralston's Patent* (1909), 26 R. P. C. 338.

(*q*) *R. v. Newton, Hindmarch on Patents*, p. 427; *R. v. Eastern Archipelago Co.* (1853), 4 De G. M. & G. 199.

The judgment of the Court itself is a revocation of the patent, and the practice now is for the Comptroller to register the order on the application of the successful petitioner (*r*). If this order for revocation is reversed by a Court of Appeal, the order of that Court is then entered on the register, and the patent is resuscitated again (*s*). Practice.

It is to be noticed that a decision of the Court in an infringement action against the validity of the patent does not absolutely annul the patent, since it is not an order for the revocation of the patent (*t*); and it is open to a patentee by amendment of the specification to remove the ground on which the Court has held the patent to be bad (*u*); though it may still be liable to attacks by petition for revocation on other grounds (*x*).

It is provided by R. S. C. Ord. LIII. r. 22, that on taxation of costs in any petition for revocation of a patent under sect. 25 of the Act of 1907 if the petition proceed to trial, no costs shall be allowed in respect of any particulars of objections relating to the patent to the petitioner, except in so far as such particulars are certified by the Court to have been proven or to have been reasonable and proper without regard to the general costs of the case, but subject as aforesaid the costs of the issues raised by the particulars of objections shall be in the discretion of the Taxing Master. Costs.

The Court, acting under its general jurisdiction, awards the costs of the petition at its discretion (*y*), but does not specially include the costs (if any) occasioned by an application to the law officer of his fiat to present the petition (*z*), since such costs are properly allowed on taxation where the order is for the revocation of the patent with costs (*a*).

(*r*) P. R. (1908), r. 113.  
 (*s*) *Deeley v. Perks* (1896), 13 R. P. C. 586, 587; *Armstrong's Patent* (1897), 14 R. P. C. 755.  
 (*t*) *Deeley's Patent* (1894), 11 R. P. C. 75; *Deeley v. Perks* (1896), 13 R. P. C. 581; [1896] A. C. 498.  
 (*u*) Vol. II. p. 131.  
 (*x*) *Deeley's Patent* (1896), 12 R. P.

C. 192; 13 R. P. C. 581.  
 (*y*) In the *Matter of Haddan's Patent* (1885), 2 R. P. C. 218; In the *Matter of Edmond's Patent* (1889), 6 R. P. C. 358.  
 (*z*) *Rendell's Patent* (1894), 11 R. P. C. 279.  
 (*a*) *Poulton's Patent* (1906), 23 R. P. C. 571.

## CHAPTER VIII.

ACTION TO RESTRAIN THREATS OF LEGAL  
PROCEEDINGS.

## PART I.—GENERAL.

SECT. 36 of the Patents and Designs Act, 1907, enacts that:—

“Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.”

This section is a re-enactment of sect. 32 of the Patents, Designs and Trade Marks Act, 1883, with certain mere verbal variations, which effect no alteration in the law.

The principle embodied in this enactment seems to have been recognised by *Malins, V.-C.*, as early as 1871 (*a*), though the conclusion at which the learned Judge arrived—viz., that at that date the Court would restrain a patentee from issuing circulars threatening legal proceedings against alleged infringers unless he would undertake to commence proceedings to assert the validity of the patent—appears to have been based on the erroneous assumption that there is no presumption at law in

(*a*) *Rollins v. Hinks* (1872), L. R. 13 Eq. 355; *Axman v. Laud* (1874), L. R. 18 Eq. 330.

favour of the validity of a patent which has not been declared void (*b*). It was subsequently held by *Jessel*, M.R., and affirmed on appeal (*c*), that no such principle at that date existed, and that a patentee was, in the absence of *mala fides*, justified in giving notice that his rights were being infringed without following up such notice by an action for the alleged infringement.

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The Court has and always had power, by injunction, to restrain any person from making slanderous statements calculated to injure the business of another person, whether the statements complained of are oral or written (*d*), and damages for the slander of title may be obtained upon proof of the absence of privilege and the existence of express malice on the part of the slanderer (*e*).

Slanderous statements made by patentee may be restrained apart from sect. 36 of Act of 1907.

It is to be noticed that the foregoing section of the Act of 1907 does not apply to cases which are within either of the saving clauses—that is to say, to cases where the alleged manufacture, use, sale, or purchase to which the threats related are in fact an infringement of any legal rights of the person making such threats, and to cases where the threatening party with due diligence commences and prosecutes an action for the infringement of his patent.

Cases within either of the saving clauses of sect. 36 of Act of 1907 are governed by the law in existence before the Act of 1883.

Cases within either of the saving clauses of sect. 36 of the Act of 1907 are still governed by the law as it existed prior to the Act of 1883 (*f*).

The law thus referred to as applicable to such cases was, and is, that a patentee was not liable for issuing circulars or other threats warning persons against using articles which he alleged were infringements of his patent, provided that he issued such notices *bonâ fide* and in the belief that the articles in question were really infringements (*g*). Moreover, a patentee was not liable to be restrained by injunction from continuing

Statement of such law.

(*b*) Judgment of *Jessel*, M.R., *Halsey v. Brotherhood* (1880), L. R. 15 Ch. D. 520, 523.

582; *Riding v. Smith* (1877), L. R. 1 Ex. D. 91.

(*c*) *Halsey v. Brotherhood* (1880), L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

(*e*) *Ibid.*: *Montgomerie v. Paterson* (1894), 11 R. P. C. 221, 633.

(*d*) *Loog v. Bean* (1884), L. R. 26 Ch. D. 306; *Thomas v. Williams* (1880), L. R. 14 Ch. D. 864; *Beddow v. Beddow* (1878), L. R. 9 Ch. D. 89; *Saxby v. Easterbrook* (1878), L. R. 3 C. P. D. 339; *Thorley's Cattle Food Co. v. Massam* (1877), L. R. 6 Ch. D.

(*f*) *Temler v. Stevenson* (1897), 15 R. P. C. 24.

(*g*) *Wren v. Wield* (1869), L. R. 4 Q. B. 730; *Halsey v. Brotherhood* (1880), L. R. 15 Ch. D. 514; L. R. 19 Ch. D. 386; *Sharp v. Brauer* (1886), 3 R. P. C. 193; *Skinner v. Shew*, [1893] 1 Ch. 413.

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to issue notices that the articles complained of were infringements, unless such statements were proved to be untrue, so that the further issue of them would not be *bonâ fide*, and would damnify the person threatened (*h*).

Though the patentee was entitled to issue notices containing statements that articles being sold by others were infringements of his rights, if such statements were made with reasonable and probable cause (*i*), an action would lie if the statements were not simply allegations of infringements, but went on to allege, as matters of fact, assertions which were not true. A question of infringement is one of law, and, in the words of *Bramwell*, L.J. (*k*), "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts."

In some cases the patentee makes threats against persons making, using, selling, or purchasing articles which he considers to be infringements of his patent rights, as a means of protecting his own property; on the other hand, sometimes such threats are circulated maliciously, and *malâ fide*, with the intention of injuring the trade of the person against whom they are made.

Before the Act of 1883, it was held that if a statement as to infringement was made by the patentee in defence of his own property, although it injured and was untrue, it was a privileged statement; it was a statement that the patentee had a right to make, unless, besides its untruth, and besides its injury, express malice was proved—that is to say, want of *bona fides* and the presence of *mala fides* (*l*). In other words, if such a statement were made *bonâ fide*, though the party affected might be able to prove *damnum*, he could not at Common Law establish *injuria*, and consequently, it being merely a case of *damnum sine injuria*, he could not saddle the patentee with the commission of any tort (*m*). It was also

(*h*) *Burnett v. Tate* (1883), 45 L. T. N. S. 743; *Halsey v. Brotherhood* (1880), L. R. 15 Ch. D. 514; 19 Ch. D. 390; *Sugg v. Bray* (1885), 2 R. P. C. 224; *Dicks v. Brooks* (1880), L. R. 15 Ch. D. 40; 49 L. J. Ch. 812. As to Interlocutory Injunctions, see *Dredge v. Parnell* (1896), 13 R. P. C. 392.

(*i*) Per *Baggallay*, L.J., *Halsey v. Brotherhood* (1881), L. R. 19 Ch. D. 390.

(*k*) *Dicks v. Brooks* (1880), L. R. 15 Ch. D. 22.

(*l*) Per *Coleridge*, L.C.J., *Halsey v. Brotherhood* (1881), L. R. 19 Ch. D. 388; *Sugg v. Bray* (1885), 2 R. P. C. 243; see also *Skinner v. Shew*, [1893] 1 Ch. 413.

(*m*) *Commercial Development Corporation, Ltd. v. Castner-Kellner Alkali Co.* (1897), 14 R. P. C. 939.

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held that there was no obligation on the part of a person, who had issued notices stating that the acts of another were an infringement of his patent rights, to follow up such statements with an action for infringement against the person mentioned, for he might desist, and render such action unnecessary, or he might not be worth suing at all (*n*).

In the recent case of *Cars v. Bland Light Syndicate, Ltd.* (*o*), an injunction was granted on the ground of malicious and untrue statements made by the defendant.

If the plaintiff in an action to restrain the issue of threats of legal proceedings intends to rely on the old law and not on sect. 36 of the Act of 1907, he should disclose his case as to *mala fides* in his affidavits in support of his motion for an injunction (*p*).

Plaintiff intending to rely on the old law must disclose his case as to *mala fides*.

The Act of 1883 completely altered the law with regard to cases within sect. 32 (now sect. 36 of the Act of 1907) in favour of the public, for it provided that if a person claiming to be a patentee, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability, in respect of any alleged manufacture, use, sale, or purchase of the invention, and does not with due diligence commence and prosecute an action for the infringement of his patent, he is liable to be sued by the person or persons who are aggrieved by such threats, and an injunction restraining the continuance thereof may be obtained, and damages awarded against him, if it turns out that the alleged manufacture, use, sale, or purchase was not, in fact, an infringement of any of his legal rights (*q*).

Law altered by Act of 1883.

If the case is within sect. 36 of the Act of 1907, and a person aggrieved brings an action against the patentee to restrain the issue of threats of legal proceedings, or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, the question of the *bona fides* of the patentee does not affect the case one way or the other (*r*). The only defence open to the patentee, if he has not, at the date of the action, with due

*Bona fides* of the patentee immaterial when sect. 36 of Act of 1907 applies.

(*n*) *Halsey v. Brotherhood* (1880), L. R. 15 Ch. D. 518.

(*o*) (1911), 28 R. P. C. 33.

(*p*) *English and American Machinery Co. v. Gare Machine Co.* (1894), 11 R. P. C. 631.

(*q*) P. 308, *ante*.

(*r*) *Kurtz v. Spence* (1888), 5 R. P. C. 161; *Herrburger v. Squire* (1888), 5 R. P. C. 581; *Skinner v. Shew*, [1893] 1 Ch. 413; *Craig v. Dowling* (1908), 25 R. P. C. 259.

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diligence commenced and prosecuted an action for infringement of his patent, is to show that the allegations contained in the threatening notices were, in fact, true (*s*). Thus an injunction was granted where the defendant refused to bring an action for infringement or to test the validity of his patent which was put in issue by the plaintiff (*t*). The burden of proof that the patentee's statements are untrue lies, *primâ facie*, on the plaintiff (*u*), as it did before the Act of 1883 (*x*), though he may easily rebut it in a particular case, and throw on the defendant the burden of proving them to be true (*y*).

Equitable assignee, or a patentee who has obtained leave to amend, does not possess legal rights of which acts complained of in a threat could be an infringement.

A person who merely holds an agreement for an assignment of the patent upon terms does not possess legal rights of which the acts referred to in a threat could be an infringement (*z*); neither, it would appear, does a patentee who has applied for an amendment of his specification, for the fact of asking for leave to amend amounts to an admission that the patent is bad without amendment of the specification, and he is not, therefore, entitled to issue threatening notices till the amendment is actually made (*a*). In such a case an injunction restraining the issue of the threats may be obtained upon motion in the pending proceeding (*b*).

Threats by a licensee.

It would appear doubtful whether the section applies in the case of threats made by a licensee or other person having only a limited interest in the patent. It must be remembered that a mere licensee cannot sue alone for an infringement of the patent, and it is doubtful whether an exclusive licensee can do so (*c*), because the term "patentee" as used in the Act means the person for the time being entitled to the benefit of the patent (*d*), and it is doubtful whether this term would be held to include an exclusive licensee (*e*). If an exclusive licensee

(*s*) *Crompton v. Patents Investment Co.* (1888), 5 R. P. C. 382; 6 R. P. C. 287; *Automatic Weighing Machine Co. v. Combined Weighing and Measuring Machine Co.* (1889), 6 R. P. C. 120.

(*t*) *Willoughby v. Taylor* (1891), 11 R. P. C. 45.

(*u*) *Challender v. Royle* (1887), L. R. 36 Ch. D. 435; 4 R. P. C. 363; *Barney v. United Telephone Co., Ltd.* (1885), 2 R. P. C. 173.

(*x*) *Burnett v. Tate* (1882), 45 L. T. N. S. 743; *Anderson v. Liebig's Extract of Meat Co.* (1881), 45 L. T. N. S. 757, 759.

(*y*) *Challender v. Royle* (1887), L. R. 39 Ch. D. 435; 4 R. P. C. 363.

(*z*) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.* (1891), 8 R. P. C. 277.

(*a*) See *Fusee Vestu Co. v. Bryant and May* (No. 2) (1887), 4 R. P. C. 191.

(*b*) *Ibid.*

(*c*) Vol. II. p. 209.

(*d*) 7 Edw. 7, c. 29, s. 93.

(*e*) *Barnett v. Barrett's Screw Stopper Bottling Co.* (1884), 1 R. P. C. 9.

cannot justify an action for the infringement of the patent, he cannot avail himself of the proviso, and it is submitted, therefore, in such case the section could not be held to apply.

A person merely claiming to be the agent or licensee of a patentee is not a person claiming to be a patentee, and consequently the section does not apply to him (*f*).

**Person aggrieved.**—The right of action conferred by sect. 36 of the Act of 1907 is given to “any person aggrieved.” In founding the action, therefore, it is always necessary to consider whether the proposed plaintiff is really a person aggrieved. When threats are made against the customers of the person who supplies or agrees to supply the articles in respect of which the threats are made, that person is a person aggrieved and may bring the action (*g*), and he is none the less a “person aggrieved” because he has a binding contract with his customer which he might have enforced, if minded so to do (*h*). Also if the threats are made against the plaintiff’s licensee the plaintiff is a person aggrieved (*i*). In one case an injunction was granted where the threat was addressed to a person manufacturing for the plaintiff, but the point whether the plaintiff was a person aggrieved does not appear to have been argued (*k*).

**What is a threat?**—In considering the question what are threats within the meaning of sect. 36 of the Act of 1907, it is well to bear clearly in mind what the evil was which the enactment of the section was intended to guard against. Before the section became law, a person aggrieved by the issue of threats of legal proceedings, or liability, at the instance of a person claiming to be the patentee of an invention in respect of which the threats were made, could only obtain the injunction of the Court restraining such threats and damages in respect of them, if he was able to discharge the *onus* which was upon him of proving that the threats were issued *malâ fide*

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Who is a person aggrieved.

The evil which sect. 36 of the Act of 1907 was intended to guard against.

(*f*) *Temler v. Stevenson* (1897), 15 R. P. C. 30.

(*g*) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.* (1891), 8 R. P. C. 277; *Colley v. Hart* (1898), L. R. 44 Ch. D. 179; 7 R. P. C. 101; *Skinner v. Shew*, [1893] 1 Ch. 413; 62 L. J. Ch. 196;

10 R. P. C. 1.

(*h*) *Hoffnung v. Salsbury* (1899), 16 R. P. C. 375.

(*i*) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.* (1891), 8 R. P. C. 277.

(*k*) *Webb v. Levinstein* (1898), 15 R. P. C. 78.



What is a Threat?

Effect of the words "or otherwise" as used in sect. 36 of the Act of 1907.

Nature of threats which have been held to be within sect. 36 of the Act of 1907.

and without reasonable excuse. This *onus* of proof, which was upon the party aggrieved, almost nullified the remedy by injunction because of the extreme difficulty of proving that the patentee had put forward his assertion of patent rights maliciously and without just cause or excuse. The threat of a patent action is well calculated to paralyse the business of persons aggrieved, and in the words of *Bowen, L.J. (l)*, "the Legislature desires that threats of patent actions shall not hang over a man's head—that the sword of Damocles, in such a case, should either not be suspended or should fall at once, and it is with that view that the section seems to be framed." The object of the Legislature, therefore, was to prevent persons claiming to be patentees from issuing *any* kind of threat the result of which might be to paralyse a man in his trade by having an action on a patent suspended before his eyes without the opportunity of determining the suspense at once and bringing the question to a speedy and immediate issue (*m*). Upon this view of the evil which the section was designed to guard against, the Court of Appeal have held that the words "or otherwise," as used in the section, are not to be construed *eiusdem generis* with "circulars" and "advertisements," but that, on the contrary, the words "circulars" and "advertisements" enlarge the meaning of the words "or otherwise" so as to include within the section all threats of whatsoever kind made in respect of any alleged manufacture, use, sale, or purchase of an invention by a person claiming to be the patentee thereof (*n*).

Threats within sect. 36 may, as above stated, be made by circular, advertisement, or otherwise. It has been held that a threat contained in a solicitor's letter (*o*), in a private letter (*p*), and in a letter written without prejudice (*q*), or in answer to an inquiry as to whether the patentee considered a certain

(*l*) *Skinner v. Shew*, [1893] 1 Ch. 425.

(*m*) *Ibid.*

(*n*) *Skinner v. Shew*, [1893] 1 Ch. 413; *Bishop v. Inman* (1900), 17 R. P. C. 755.

(*o*) *Driffield v. Waterloo* (1886), 3 R. P. C. 46; L. R. 31 Ch. D. 638; *Crampton v. The Patents Investments Co.* (1888), 5 R. P. C. 393; *The Combined Weighing and Advertising Machine Co. v. The Automatic Weigh-*

*ing Machine Co.* (1889), 6 R. P. C. 502; *Edlin v. Pneumatic Tyre and Brooks Cycle Agency* (1893), 10 R. P. C. 312; *Hoffnung v. Salsbury* (1899), 16 R. P. C. 377; *Engels v. Hubert Unchangeable Eylet Syndicate* (1902), 19 R. P. C. 201.

(*p*) *Walker v. Clarke* (1887), 4 R. P. C. 113; *Burt v. Morgan* (1887), 4 R. P. C. 278.

(*q*) *Kurtz v. Spence* (1888), 5 R. P. C. 173.

article an infringement of his patent (*r*), is actionable. Further, a statement made by the patentee, or on his behalf, though it does not contain any direct reference to the patent, may, nevertheless, amount to a threat within the section. Thus, where the defendant wrote to probable customers of the plaintiff that they must not be surprised if he, the defendant, applied for an injunction against the plaintiff to restrain him from selling the articles in question, the Court held that such statement amounted to a threat in respect of the patent, and granted an injunction in the terms of the section (*s*). It is submitted that the Court has power under the section to restrain oral statements which contain threats of legal proceedings against, or liability on the part of, persons aggrieved by allegations made by the patentee to the effect that they have infringed his patent (*t*).

The question may arise as to how far a person who has issued threats within the meaning of sect. 36 of the Act of 1907, and brought himself within the proviso by, with due diligence, commencing and prosecuting an action for infringement, is justified in continuing the threats whilst the action is pending. In this connection there is the authority of *Kekewich, J.*, in *Fenner v. Wilson* (*u*), for the proposition that, quite apart from sect. 36 of the Act of 1907, a plaintiff in a pending action for infringement may, on motion in the action, be restrained from issuing advertisements warning the public that they are liable in damages for using the subject-matter of the plaintiff's patent, if such advertisements amount to statements that the pending action must succeed. The injunction is granted on the ground that the issue of such advertisements may prejudice the defendant, and so be an interference with the even course of justice (*x*); and in such a case the order ought not to contain any undertaking as to damages, since, though subject to appeal, it is not obtained on interlocutory proceedings in the true sense (*y*). It is submitted

Continuation of threats by a person within the proviso of sect. 36 of Act of 1907 pending action.

(*r*) *Skinner v. Shew*, [1893] 1 Ch. 413; but see *Beven v. Welsbach Incandescent Gas Light Co., Ltd.* (1902), 20 R. P. C. 69.

(*s*) *Douglass v. Pintsch's Patent Lighting Co.* (1896), 13 R. P. C. 673.

(*t*) *Kurtz v. Spence* (1888), 5 R. P. C. 161, 172, 173.

(*u*) (1893), 10 R. P. C. 283; see also *Goulard v. Lindsay* (1887), 4 R. P. C. 189.

(*x*) *Fenner v. Wilson* (1893), 10 R. P. C. 283; *Goulard v. Lindsay* (1887), 4 R. P. C. 189.

(*y*) *Fenner v. Wilson* (1893), 10 R. P. C. 287.

What is a Threat?

that there is at least great doubt upon the question of fact as to whether such a warning by a patentee could be an interference with the course of justice and as such a contempt of Court in respect of which the Court should issue an injunction (z). The Court of Appeal, in *Fenner v. Wilson*, without expressing any opinion on the proposition of law above formulated, stated that they could not consider the advertisements complained of in that case as amounting to contempt of Court (a). In *De Mare's Patent* (b) it was pointed out by *Byrne, J.*, that if, and so far as, threats might but for the section have been held, by reason of their being threats, to fall within the rule of the Court in reference to comment upon public proceedings, the section may have made a change in the case of a person who has brought himself within the proviso by with due diligence commencing and prosecuting an action for infringement. The learned Judge expressed himself to be clearly of opinion that the section was never meant, to a greater extent than possibly as above stated, to justify any public discussion on the merits of pending litigation.

*Bonâ fide* notice by plaintiff to customers of defendant in an infringement action.

The plaintiff in a pending action for infringement is entitled to give *bonâ fide* notice to the defendant's customers that, by dealing in the goods supplied by the defendant, they expose themselves to the risk of actions by the plaintiff, and that, in the event of the plaintiff succeeding against them in such actions, they are liable to pay damages and costs and to have their goods which were so purchased destroyed by order of the Court (c).

Question whether threat to be actionable under sect. 36 of Act of 1907 must relate only to an act done, or whether it may relate to something proposed to be done.

The question whether a threat, to be actionable under sect. 36 of the Act of 1907, must be not merely a warning about something that is going to be done, but must be a threat about an act done—*i.e.*, whether it must be a threat of legal proceedings in respect of an alleged actual manufacture, use, sale, or purchase of the invention, and not in respect of a proposed manufacture, use, sale, or purchase, cannot be said

(z) See *Haskell Golf Ball Co. v. Hutchison* (1904), 21 R. P. C. 497.

(a) *Fenner v. Wilson* (1893), 10 R. P. C. 287.

(b) (1899), 16 R. P. C. 530.

(c) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.* (1897), 14 R. P. C. 180; see also

*Dunlop Pneumatic Tyre Co. v. New Seddon Pneumatic Tyre and Self-closing Tube Co.* (1897), 14 R. P. C. 332; *Nähmaschinen Fabrik v. Singer Manufacturing Co.* (1893), 10 R. P. C. 310; *Dunlop Pneumatic Tyre Co., Ltd. v. Clifton Rubber Co., Ltd.* (1902), 19 R. P. C. 527.

to have been, as yet, definitely decided by the Courts. There are expressions in the judgments delivered by the Court of Appeal, especially in that of *Bowen, L.J.*, in *Challender v. Royle* (*d*), which, if read apart from the particular case, support the view that a threat in respect of a proposed manufacture, use, sale, or purchase, would not be a "threat" within the meaning of the section; but in the later case of *Johnson v. Edge* (*e*), the Court of Appeal without deciding the point, which was not necessary to the decision of that case, expressed grave doubts as to whether upon the true construction of the section it does exclude intended infringements which have not actually taken place, and as to whether the language used by *Bowen, L.J.*, in the judgment above referred to is to be taken to mean that, in all cases, such intended infringements are so excluded. It is submitted that the first part of the section should be construed as correlative with the proviso; and that consequently all threats of legal proceedings or liability in respect of any alleged past or future manufacture, use, sale, or purchase of an invention issued by or on behalf of a person claiming to be the patentee of such invention, are threats within the section, if the person claiming to be a patentee is in a position when the threats are issued to found an action for the infringement of his patent upon the past or future acts referred to therein. A patentee may found an action upon a threatened infringement, even though no actual infringement has taken place (*f*). And, it is submitted, sect. 36 must be interpreted as including any threat made by the patentee in respect of any alleged intended infringement, when the person threatened has actually done something which the patentee is justified in construing as an expression of an intention to infringe.

Sect. 36 of the Act of 1907, according to this view of its construction, does not in any way limit the right of every patentee to issue a general warning to infringers, and to advise the public that the patent to which he is entitled, and under which he claims, is one which he intends to enforce (*g*). It must,

General warning to infringers issued by a patentee.

(*d*) (1887), L. R. 36 Ch. D. 425.

(*e*) (1892), 9 R. P. C. 142; see also judgment of Kekewich, J., in *Kurtz v. Spence* (1888), 5 R. P. C. 171; and of Day, J., in *Willoughby v. Taylor* (1894), 11 R. P. C. 52.

(*f*) See p. 390, *post*.

(*g*) *Johnson v. Edge* (1892), 9 R. P. C. 142; *Challender v. Royle* (1887), L. R. 36 Ch. D. 428; *Crowther v. United Flexible Metallic Tubing Co., Ltd.* (1905), 22 R. P. C. 549.

What is a Threat?

however, be remembered that what at first sight appears to be a justifiable general warning may, in view of the peculiar circumstances of a particular case, well be construed as a threat directed against a particular individual, and so actionable under the section (*h*).

In the event of a patentee obtaining an injunction and damages against a manufacturer, he is entitled to warn purchasers from the manufacturer not to pay the purchase-money to him, and that, if the manufacturer fails to pay the damages, he (the plaintiff) will claim from the purchasers (*i*).

Use of a thing *simpliciter* as distinguished from use in a particular manner.

If the use *simpliciter* of a certain apparatus does not amount to an infringement of the patent, but the use of that apparatus in a particular manner does amount to such an infringement, the patentee cannot escape liability for issuing threats to the users of such apparatus, unless he makes it perfectly clear that what he complains of is not the use *simpliciter*, but the use in the particular manner specified (*k*).

Threat not withdrawn.

A threat which is not withdrawn is considered as continuing (*l*).

**The Proviso.**—Sect. 36 of the Act of 1907 provides that the remedy created by the section shall not be applicable, if the person making the threats complained of, with due diligence, commences and prosecutes an action for infringement of his patent.

Nature of infringement action which will secure the benefit of the proviso.

The question naturally arises, By whom and against whom and when must such an action be commenced and prosecuted, so as to bring the case within the proviso?

The proviso will not be satisfied unless the action for infringement is brought by the person making the threats—*e.g.*, an action brought by the equitable or legal assignee of the defendant to the threats action will not do (*m*). Also the proviso will not be satisfied unless the action for infringement is in respect of the patent to which the threats relate, but, if several patents relate to the same general subject-matter, it is not necessary that the patentee bring the action in respect of

(*h*) *Johnson v. Edge* (1892), 9 R. P. C. 142, 148; *Bishop v. Inman* (1900), 17 R. P. C. 760.

(*i*) *Cropper v. Smith* (1883), L. R. 24 Ch. D. 305, 312.

(*k*) *Burt v. Morgan* (1887), 4 R. P.

C. 278.

(*l*) *Driffield v. Waterloo* (1886), L. R. 31 Ch. D. 638, 613.

(*m*) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.* (1891), 8 R. P. C. 277.

all such patents (*n*). When the threat complained of was issued subsequently to the determination of one action of infringement adversely to the patentee, the proviso is satisfied by the commencement and prosecution with due diligence of a fresh action of infringement against another alleged infringer (*o*).

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It is not always possible for the defendant to a threats action to bring an action for the infringement of his patent against the person aggrieved by the threats. For instance, the patentee of a rival machine would necessarily be a person aggrieved if threats were made against him; but if such person does not manufacture and sell, but only licenses the manufacture and sale of such rival machine, there would be no means of bringing an action for infringement against him.

It would appear that what the words of the proviso point at is a case where some act has been done which can be tested whether or not it is an infringement. The words, "if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats," clearly point to an act done or contemplated which has been alleged to be, but as a matter of fact is not, an infringement of the patent of the person issuing the threat, and the mere fact that, where the owner of a rival patent is the aggrieved person, it is in many cases impossible that an action for infringement should be brought against him, precludes the notion that the action mentioned in the proviso must be confined to an action against the aggrieved party (*p*). On the contrary, the proper view seems to be that the proviso will be satisfied if an action for infringement of the patent be honestly brought and diligently prosecuted against any person to whom the threats complained of are applicable (*q*); and probably also if an action for infringement is commenced and prosecuted with due diligence against a person to whom the threats cannot be said to relate at all (*r*); but there is authority for saying that an action commenced against a third party in respect of

(*n*) *Temler v. Stevenson* (1897), 15 R. P. C. 24.

(*o*) *Waite and Saville, Ltd. v. Johnson Die Press Co., Ltd.* (1900), 18 R. P. C. 1.

(*p*) See p. 313, *ante*.

(*q*) *Challender v. Royle* (1887), L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Day v. Foster* (1890), 7 R. P. C. 54.

(*r*) See *Lycett Saddle and Motor Accessories Co., Ltd. v. J. B. Brooks & Co., Ltd.* (1904), 21 R. P. C. 656.

The Proviso.

infringements totally different to those alleged against the plaintiff to the threat action is not an action for infringement within the meaning of sect. 36 (s), though there is authority pointing the other way (t), and it would appear to be clear that if the article referred to in the threat is of a class which would come into the account in the event of the infringement action succeeding the proviso is satisfied (u).

Where an action for infringement is commenced in satisfaction of the proviso, but during the progress of the action the specification is amended pursuant to leave obtained from the comptroller, the action does not cease to be an action for infringement within the proviso, notwithstanding that the patentee may be entitled to give the amended specification in evidence in the infringement action (x).

If the action for infringement be brought, not against the party aggrieved, but against a third party, and if that action be not prosecuted with due diligence, or, if it be collusive, or if it be settled and the threats subsequently continued (y), then, no doubt, the person claiming an injunction to restrain threats would be entitled to contend that the case was within the section, and that such an infringement action did not bring it within the proviso (z). Thus, in a case where the defendant had commenced an action for infringement against the plaintiff, and undertook to prosecute it with due diligence, the Court refused an injunction to restrain the issue of a threatening circular, which, however, was granted subsequently, on the ground that the defendants were not, as a matter of fact, prosecuting their infringement action diligently (a).

An action against licensees for royalties in respect of articles which the defendant alleges were manufactured under another patent and not under the licence is an action for infringement within the meaning of the proviso to sect. 36

(s) *The Combined Weighing and Advertising Machine Co. v. The Automatic Weighing Machine Co.* (1889), 6 R. P. C. 502; L. R. 42 Ch. D. 665; 58 L. J. Ch. 709; per Smith, L.J., *Skinner v. Perry* (1892), 10 R. P. C. 8.

(t) *Lycett Saddle and Motor Accessories Co., Ltd. v. J. B. Brooks, Ltd.* (1904), 21 R. P. C. 656.

(u) *Ibid.*

(x) *Hall v. Stepney Spare Motor*

*Wheel, Ltd.* (1910), 27 R. P. C. 233.

(y) *Engels v. Hubert Unchangeable Eylet Syndicate* (1902), 19 R. P. C. 201.

(z) *Challender v. Royle* (1887), L. R. 36 Ch. D. 425, 439; 4 R. P. C. 363; see also *Engels v. Hubert Unchangeable Eylet Syndicate* (1902), 19 R. P. C. 201.

(a) *Household v. Fairburn* (1884), 1 R. P. C. 109; 2 R. P. C. 142.

of the Act of 1907 (*b*), and will so defeat the claim of the second patentee to an injunction to restrain threats based on the statement that the articles in dispute are infringements of (*i.e.*, included in) the licensor's patent.

A counterclaim in an action commenced under sect. 36 of the Patents and Designs Act, 1907, is sufficient to bring the case within the proviso, if on the facts the issue of infringement is raised with due diligence (*c*).

An infringement action which is not *bonâ fide*, and is a mere bogus action, is not within the proviso, but the *onus* of proof is on the plaintiff in the threats action (*d*).

In considering the question whether an action for infringement has been commenced and prosecuted with due diligence, so as to bring the case within the proviso of sect. 36, it must be noticed that the section is silent on the point whether it is necessary that the action for infringement must be commenced before or after the action for threats. An action for infringement commenced before the issue of the threats complained of is sufficient to bring the case within the proviso of sect. 36, if the alleged infringements are the same as those forming the subject of the threats (*e*). Due diligence.

In forming a conclusion as to whether an action for infringement has been commenced with due diligence after the issue of threats, account must be taken of the time that has elapsed since the threats complained of were first issued and the infringement action was commenced, and not of the time since the defendant first became aware that the plaintiff was doing the acts which are alleged in the threatening notices to be an infringement of the defendant's right (*f*).

There is no rule as to the length of time within which a patentee must bring an infringement action in order to escape liability in respect of threatened proceedings (*g*). If delay in

(*b*) *Day v. Foster* (1890), 7 R. P. C. 54.

(*c*) *Alfred Appleby's Twin Roller Chain, Ltd. v. Albert Eadie Chain, Ltd.* (1899), 16 R. P. C. 330.

(*d*) *Johnson v. Edge* (1892), 9 R. P. C. 142; *Craig v. Dawding* (1908), 25 R. P. C. 259; "*Z*" *Electric Lamp Manufacturing Co., Ltd. v. Osram Lamp Works, Ltd.* (1911), 28 R. P. C. 179.

(*e*) *Day v. Foster* (1890), 7 R. P. C.

54, 60; *Berliner v. Edison-Bell Consolidated Phonograph Co.* (1899), 16 R. P. C. 336.

(*f*) *Challender v. Royle* (1887), L. R. 36 Ch. D. 435, 437; 4 R. P. C. 363; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.* (1889), 6 R. P. C. 502; *Haskell Golf Ball Co. v. Hutchison* (1904), 21 R. P. C. 497.

(*g*) *Colley v. Hart* (1890), 7 R. P. C. 101, 106.



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bringing the infringement action were caused by negotiations between the parties, it would no doubt be held that the conditions of the proviso were satisfied (*h*). But where the defendants in a threat action did not commence an action for infringement till over two months after the threats complained of were issued, and then only issued writs against two persons, not the plaintiffs in the threat action, and subsequently entered a counterclaim in the threat action alleging infringement by the plaintiffs, they were held not to have commenced and prosecuted an action for infringement with due diligence (*i*); and where the defendants had issued a writ out of Court, but had expressed an intention not to serve it, and first raised the issue of infringement by way of counterclaim, a jury found that the infringement action commenced under such circumstances was not commenced with due diligence (*k*).

It has been held that an action commenced and subsequently discontinued by consent is not an action prosecuted with due diligence, so as to entitle a defendant in a threat action to exemption from liability (*l*); though this decision would appear to be wrong in view of the fact that subsequent cases have decided that an action which is abandoned because the defendant gives in, and desists from the infringement, or because the plaintiff is advised that the action must fail, is an action for infringement prosecuted with due diligence (*m*). Moreover, it cannot be contended that an action for infringement to come within the meaning of the proviso of sect. 36 of the Act of 1907 must be prosecuted down to a successful result; on the contrary, the action may be within the proviso though it is discontinued, or judgment is against the plaintiff (*n*), or it was originally in respect of several patents and was dropped in respect of some of them (*o*).

(*h*) *Edlin v. Pneumatic Tyre and Brooks Cycle Co.* (1893), 10 R. P. C. 311.

(*i*) *Herrburger v. Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194; but see *Challender v. Royle* (1887), L. R. 36 Ch. D. 437.

(*k*) *Alfred Appleby's Twin Roller Chain, Ltd. v. Albert Eadie Chain, Ltd.* (1899), 16 R. P. C. 318.

(*l*) *Crampton v. Patents Investments Co.* (1888), 5 R. P. C. 382, 393.

(*m*) *Colley v. Hart* (1890), 7 R. P. C.

101, 108, 110; *English and American Machinery Co. v. Gare Machinery Co.* (1894), 11 R. P. C. 627. As to continuation of threats after an action for infringement has been settled, see p. 320, *ante*.

(*n*) *Colley v. Hart* (1890), 7 R. P. C. 101, 109, 110; *English and American Machinery Co. v. Gare Machinery Co.* (1894), 11 R. P. C. 627.

(*o*) *Temler v. Stevenson* (1897), 15 R. P. C. 24.

The fact that a patentee, who has commenced an action for infringement against a person subsequently claiming an injunction restraining the continuance of threats, has not applied for an interlocutory injunction, is not evidence that he has not prosecuted his action with due diligence (*p*).

An action commenced to obtain an injunction to restrain the defendant from passing off his goods as and for the plaintiff's, and tardily, after the issue of the writ in an action under sect. 36, amended to an infringement action, is not commenced and prosecuted with due diligence (*q*).

A jury has held that a delay of several months in taking up an order for inspection, which, if acted upon, would have led to the discontinuance of the action on the ground of non-infringement, amounted to a lack of prosecution with due diligence (*r*). On the other hand, Lord *Alverstone*, L.C.J., in a case where delays amounting to eighteen months had occurred in the various steps of an infringement action, and there was pending, on the application of the defendants in that action, an application for leave to obtain evidence abroad, held that, under the circumstances, there had been no want of due diligence (*s*).

## PART II.—PRACTICE.

**Pleadings.**—Specimens of the pleadings in an action under sect. 36 of the Act of 1907 will be found in the Appendix (*t*). The action for breach of the statutory right created by sect. 32 of the Act of 1883 lies against individuals, and also against a corporation (*u*).

**Issues.**—In any action brought under sect. 36 of the Act of 1907 to restrain threats of legal proceedings, not only the issue of infringement may be raised, but also that of the validity of the patent to which the threats relate (*x*); and it is

Issues of ir-  
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may be raised.

(*p*) *Anderson v. Liebig's Extract of Meat Co.* (1881), 45 L. T. N. S. 757.

(*q*) *Johnson v. Edge* (1892), 9 R. P. C. 142.

(*r*) *Bishop v. Inman* (1900), 17 R. P. C. 749, 756, 759.

(*s*) *Voelker Incandescent Mantle v. Welsbach Incandescent Gas Light Co.* (1901), 18 R. P. C. 494.

(*t*) Vol. II. p. 475, *post*.

(*u*) *Combined Weighing Machine Co. v. Automatic Weighing Machine*

*Co.* (1889), L. R. 42 Ch. D. 669; *Fusee Vesta Co. v. Bryant and May* (1887), 4 R. P. C. 194; *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.* (1891), 8 R. P. C. 277; [1891] 2 Ch. 579.

(*x*) *Challender v. Royle* (1887), L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Kurtz v. Spence* (1887), 4 R. P. C. 427; *Herrburger v. Squire* (1888), 5 R. P. C. 589.

Issues.

therefore open to the plaintiff to prove, in either of two ways, that he has not infringed any legal right of the defendant. Either he may say, "The patent is valid, but I have not infringed it," or he may say, "The patent is invalid, and, therefore, I have not infringed any legal right of the person making the threats" (*y*). That is to say, in order to act on the above-mentioned section, the Court must be satisfied, at the hearing of the action, that the articles in respect of which the threats were made are not "an infringement of any legal rights of the person making such threats." The question, therefore, whether the patent of the person making the threats is a valid patent must come into consideration, if the plaintiff in the action seeks to have it considered, because, if the patent is invalid, there is no infringement of a legal right of the patentee (*z*).

It would appear to be the more correct course for the plaintiff not to plead the invalidity of the defendant's patent in the statement of claim, but to leave the defendant to raise the issue in the defence. The plaintiff is at liberty to deny the validity in the reply, and to deliver particulars of objections therewith, and such further pleadings as may be necessary are allowed (*a*). It is, however, competent to the plaintiff, if he is so minded, to raise the issue of the validity of the patent by a denial in the statement of claim (*b*).

The burden of proof of the fact of non-infringement is on the plaintiff, and the defendant may be allowed to begin (*c*).

Particulars of breaches and of objections.

**Particulars.**—The defendant may be ordered to furnish particulars of breaches, pointing out how the acts complained of are infringements of his patent, and pointing out, by reference to pages and lines of the specification, which parts of the invention therein described he alleges have been infringed (*d*); and the plaintiff, if he denies the validity of the defendant's

(*y*) Per Charles, J., *Herrburger v. Squire* (1888), 5 R. P. C. 589.

(*z*) See judgment of Cotton, L.J., *Challender v. Royle* (1887), L. R. 36 Ch. D. 435; 4 R. P. C. 363.

(*a*) *Dowson Taylor v. Drosophore Co.* (1895), 12 R. P. C. 95; see *Kopp v. Rosenwald* (1902), 19 R. P. C. 208; 20 R. P. C. 154.

(*b*) *Willoughby v. Taylor* (1894), 11

R. P. C. 47.

(*c*) *Ungar v. Sugg* (1889), 6 R. P. C. 337, 340.

(*d*) *Wren v. Weild* (1869), L. R. 4 Q. B. 213; *Union Electrical Power and Light Co. v. Electrical Power Storage Co.* (1888), 5 R. P. C. 329; *Law v. Ashworth* (1890), 7 R. P. C. 86; *Hoffnung v. Salisbury* (1899), 16 R. P. C. 378.

patent, may be required to deliver to the defendant particulars of his objections (*e*).

If the defendant is the owner of more than one patent, it is proper that he should deliver particulars of the patents on which he relies to support the threats before the plaintiff delivers his particulars, which may be confined to the patents mentioned in the defendant's list (*f*).

If the plaintiff pleads non-infringement of any legal right of the defendant, and the defendant, though not admitting the plea, does not allege infringement of any particular legal right, the plaintiff cannot claim particulars showing in what respect the defendant alleges the infringement of his legal rights, or in what respect he does not admit that the plaintiff does not infringe his (the defendant's) alleged legal rights (*g*).

The defendant is entitled to particulars of objections before he delivers his defence if invalidity is pleaded in the statement of claim (*h*).

When the plaintiff alleges that the threats were made by the defendant's agents, he may be compelled to give particulars of the names of such agents (*i*).

**Interlocutory Injunction.**—In cases where the defendant brings an infringement action which satisfies the conditions of the proviso of sect. 36 of the Act of 1907, it is the usual course for the Court, on motion by the plaintiff for an interlocutory injunction, to make no order except that the threats action be stayed until the trial of the infringement action or further order, and that the costs of the threats action be costs in the infringement action; and the defendant usually gives an undertaking to prosecute the infringement action diligently, and disclaims any intention of issuing new threats in the meantime (*k*). In the event of the defendant not prosecuting the

Usual course where defendant brings an action for infringement.

(*e*) *Union Electrical Power and Light Co. v. The Electrical Power Storage Co.* (1898), 5 R. P. C. 329; *Smith v. Laing* (1890), 7 R. P. C. 148.

(*f*) *Ibid.* Particulars of breaches and objections are discussed more fully at pp. 401 and 422, *post*.

(*g*) *Dowson Taylor v. Drosophore Co.* (1894), 11 R. P. C. 653.

(*h*) *Law v. Ashworth* (1890), 7 R. P. C. 86.

(*i*) *Dowson Taylor v. Drosophore Co.* (1894), 11 R. P. C. 536.

(*k*) *Mackie v. Salvo Laundry Co.* (1892), 9 R. P. C. 465; *Edlin v. Pneumatic Tyre and Booth's Cycle Agency* (1893), 10 R. P. C. 316; *English and American Machinery Co. v. Gare Machinery Co.* (1894), 11 R. P. C. 628; *Dowson Taylor v. Drosophore* (1895), 12 R. P. C. 95; *Wrightson v. Tayer, Maddox & Co.* (1907), 24 R. P. C. 347.

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infringement action with due diligence, the plaintiff has thus an opportunity of moving again (*l*).

An injunction to restrain threats of legal proceedings or liability in respect of alleged infringement of a patent will not, as a rule, be given on an *ex parte* application, and there does not appear to be any reported case in which this has been done, though no doubt, under very special circumstances, the Court might do so, if the interests of justice would not be otherwise satisfied.

It is usual to allow short notice of motion to be given in the ordinary way (*m*): but when threats are issued by an agent in this country at the instigation of a foreigner abroad, and the agent appears, though the foreign patentee has not been served, the practice is for the Court to grant an *ex parte* injunction against the foreigner, his servants, and agents. The order indicates that the agent defendant appears, and it is directed in particular against him as agent. The plaintiff should give an undertaking to accept short service of notice to dissolve the injunction (*n*).

*Primâ facie* case of non-infringement or invalidity is essential without which the Court does not consider the balance of convenience to the parties.

In an action to restrain threats under sect. 36 the Court will not grant an interlocutory injunction unless it is satisfied that the plaintiff has made out a *primâ facie* case to the effect either that he has not infringed the defendant's patent or that the patent is void; and, unless there is such a *primâ facie* case, the Court does not take into consideration the balance of convenience to the parties (*o*).

*Cotton*, L.J., commenting in the Court of Appeal on a decision (*p*) to the effect that the Court has power to grant an interlocutory injunction in a threat action, though it is not proved that the plaintiff has not infringed the defendant's patent, and also on the suggestion that the question whether

(*l*) See note (*k*), p. 325.

(*m*) *Wilson & Co. v. Walter E. Church Engineering Co., Ltd.* (1885), 2 R. P. C. 176.

(*n*) *Overton v. Burns* (1896), 13 R. P. C. 455.

(*o*) *Challender v. Royle* (1887), L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.* (1883), L. R. 25 Ch. D. 1; *Barney v. United Telephone Co.* (1885), L. R. 28 Ch. D. 394. In *Engels v. Hubert Un-*

*changeable Eylet Syndicate* (1902), 19 R. P. C. 201, *Byrne, J.*, granted an interlocutory injunction though the point as to *primâ facie* case does not appear to have been taken on behalf of the defendant; the judgment went on the ground that there was no pending action for infringement to satisfy the proviso of sect. 32 of the Patents Act, 1883.

(*p*) *Walker v. Clarke* (1887), 4 R. P. C. 111; *Challender v. Royle* (1887), L. R. 36 Ch. D. 428; 4 R. P. C. 363.

an interlocutory injunction should be granted depends upon the balance of convenience to the parties, said (q)—

Inter-  
locutory  
Injunction.

“It is very true that in all cases of interlocutory injunction the Court does consider, and ought to consider, the balance of convenience and inconvenience in granting or refusing the injunction. But there is another very material question to be considered: Has the plaintiff made out a *prima facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, although I quite agree that the Court ought not, on an interlocutory injunction, to attempt finally to decide the question whether the act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of those two points the plaintiff in the action has made out a *prima facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction, merely on the ground that it cannot do the defendant any harm. Injunctions ought to be granted only on a case made out entitling the plaintiff to that particular remedy.”

If the Court is satisfied, on a motion for an interlocutory injunction, that the plaintiff has made out a *prima facie* case of non-infringement, it will grant the interlocutory injunction restraining the defendant until the trial of the action from continuing to threaten any person with legal proceedings or liability in respect of the alleged manufacture, use, sale, or purchase of his invention (r). On the other hand, where the Court is of opinion that the plaintiff, by his affidavits, fails to raise a probable case of non-infringement, and that there is a conflict of testimony on the question, an injunction will be refused (s). The Court, in deciding whether the defendant has made out a *prima facie* case of infringement, takes into consideration the fact whether or not he has commenced an action for infringement, and, if he has not done so, this fact is evidence against him (t).

When there is a question as to whether the alleged threat is really a threat within the section which would be better

Other considerations on motion for interlocutory injunction.

(q) *Challender v. Royle* (1887), L. R. 36 Ch. D. 436; 4 R. P. C. 363.

(s) *Barney v. United Telephone Co.* (1885), 2 R. P. C. 173.

(r) *Colley v. Hart* (1889), 6 R. P. C. 17.

(t) *Colley v. Hart* (1889), 6 R. P. C. 17.

Interlocutory Injunction.

decided at the trial, and the defendant denies any intention of making threats, this circumstance induces the Court to order the motion to stand to the trial, with liberty to the plaintiff to bring it on again in the interval upon two days' notice (*u*).

Where (*x*) it appeared that the defendants were only exclusive licensees for a limited area of the patent referred to, and that the patentee had commenced an action for infringement against the plaintiff, in which the defendants were to be made co-plaintiffs, the Court ordered the motion for an injunction restraining the further issue of the circular to stand over till after the hearing of the infringement action (*y*).

Another circumstance which may influence the Court to grant an interlocutory injunction is the probable incapacity of the defendant to satisfy the plaintiff's claim if ultimately defeated (*z*).

Damages to be recoverable must result directly from the threat.

**Damages.**—Damages are only awarded when the plaintiff shows that he has really suffered loss owing to the defendant's conduct (*a*). Moreover, the defendant is only liable for damage directly caused by the threats. He is not liable for damage resulting from the mere rumour of legal disputes or legitimate general statements, or by threats unauthorised by him, though he may be liable in respect of a falling off in the plaintiff's general business traceable to the threats in respect of a particular article dealt in by the plaintiff (*b*).

When it can be shown that the plaintiff has lost a contract in consequence of the threats the measure of damage is the loss of profit (*c*), and the fact of breach is sufficient to entitle the plaintiff to an inquiry as to damages, notwithstanding that he might have enforced his contract, if so minded (*d*).

Similarly, if the effect of the threats was to compel the plaintiff to accept a contract at a lower price than he would otherwise have obtained, the damage is the difference between

(*u*) *Douglass v. Pintsch's Patent Lighting Co.* (1895), 13 R. P. C. 60.

(*x*) *Barnett v. Barrett's Screw Stopper Bottling Co., Ltd.* (1884), 1 R. P. C. 9.

(*y*) See also *Combined Weighing and Advertising Machine Co. v. Automatic Weighing Machine Co.* (1889), 6 R. P. C. 502.

(*z*) P. 447, *post*.

(*a*) *Driffield v. Waterloo* (1886), L.

R. 31 Ch. D. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*b*) *Ungar v. Sugg* (1891), 8 R. P. C. 385; 9 R. P. C. 113, in which the principles on which damages for threats ought to be assessed are discussed.

(*c*) *Skinner v. Perry* (1894), 11 R. P. C. 406.

(*d*) *Hoffnung v. Salsbury* (1899), 16 R. P. C. 375.

the price which the plaintiff would but for the threats have obtained and the price actually accepted (*e*). Damages.

If the Judge is able to assess the damages at the trial it is right that he should do so instead of sending the case to an inquiry (*f*).

**Certificate of Validity.**—It is submitted that an action which is in the form of one to restrain the issue of threats under sect. 36 of the Act of 1907, but in which the validity of the patent is put in issue and decided in favour of the patentee, is an “action for infringement” within the meaning of sect. 35, and that the Court has, therefore, jurisdiction to give a certificate of validity under that section. The authorities, however, appear to be in conflict (*g*). It is submitted that the object of the Legislature in framing sect. 35, which was sect. 31 of the Act of 1883, was to protect patentees, who have once established the validity of their patents in expensive litigation, from being unduly harassed by having the same question raised against them again by the parties to different proceedings; and that the section ought not to be so construed as to limit it to cases in which the action is one for infringement in the ordinary sense, and to exclude cases in which the action, though in substance one for infringement, is not so in mere form.

Can a certificate of validity be given in an action to restrain threats?

**Certificate as to Particulars.**—It does not appear to have been definitely decided whether or not in order for a successful party in an action under sect. 36, which has proceeded to trial, and in which the questions of infringement and validity of the patents were in issue, to be entitled to the costs of his particulars, it is necessary for him to obtain the Judge’s certificate under R. S. C., Ord. LIII A. r. 22, to the effect that such particulars delivered by him were proven or reasonable and proper (*h*). It is submitted that an action under sect. 36, in which the issues of infringement and validity of the defendant’s patent are properly raised, whether or not the defendant

Is certificate as to particulars necessary on taxation?

(*e*) See Alfred Appleby’s Twin Roller Chair, Ld. v. Albert Eadie Chain, Ld. (1899), 16 R. P. C. 318, 324.

(*f*) Ungar v. Sugg (1892), 9 R. P. C. 113; Herrburger v. Squire (1888), 5 R. P. C. 581; 6 R. P. C. 194; Kurtz v. Spence (1887), 5 R. P. C. 177; 57

L. J. Ch. 238.

(*g*) Kurtz v. Spence (1885, 1888), 5 R. P. C. 184; Crampton v. The Patents Investment Co. (1888), 5 R. P. C. 404; Herrburger v. Squire (1888), 5 R. P. C. 581.

(*h*) See Willoughby v. Taylor (1894), 11 R. P. C. 45.



**Certificates.** counterclaims for damages, is in all but mere form an action for the infringement of the patent and that the term "action for infringement" as used in R. S. C., Ord. LIII. r. 22, should be construed as including such an action, with the result that the Court has jurisdiction to grant the certificate in a threats action, which has proceeded to trial, and that, on taxation, no costs should be allowed in respect of any particular which has not been duly certified by the Court.

Scope of injunction.

**Breach of Injunction.**—It is submitted that a defendant, who is restrained from issuing threats of legal proceedings by an injunction which follows the terms of sect. 36 of the Act of 1907, does not commit any breach by circulating threats made by a third party, provided that such circulation is not a mere cloak to conceal threats really made by the defendant (*i*).

No doubt the Court would, if it thought fit, so word the injunction as to include the circulation, by the defendant, of threats made by a person or persons other than himself.

In a case where an undertaking had been given practically in the terms of the section, and subsequently an action for infringement had been brought, the Court, upon motion for sequestration against the defendant company and attachment of its directors, decided that the bringing of the infringement action was no breach of the undertaking (*k*).

There is no precedent for the extension of the injunction by the Court so as to include assignees of the defendant's patent, and in one case (*l*) an application for such extension was expressly refused. Under some circumstances the issue of threats by an enjoined defendant's assignee would amount to a contempt of Court (*m*).

Ordinary jurisdiction of the Court applies.

**Costs.**—The general costs of an action to restrain threats are dealt with by the Courts under their ordinary jurisdiction.

It is the duty of the defendant to a threat action who brings a cross-action for infringement to endeavour by arrangement

(*i*) See *Ellam v. Martyn* (1898), 16 R. P. C. 28, 33.

(*k*) *Beven v. Welsbach Incandescent Gas Light Co., Ltd.* (1902), 20 R. P. C. 69.

(*l*) *Engels v. Hubert Unchangeable*

*Eylet Syndicate* (1902), 19 R. P. C. 204.

(*m*) See *ibid.* For usual form of injunction see *Montain v. Parker* (1903), 20 R. P. C. 774.

to avoid causing unnecessary costs by trying the same action in two different forms (*n*).

Costs.

Where the plaintiff obtains judgment with costs the Master will, on taxation, tax in favour of the defendant any issues upon which he has been wholly successful (*o*); but see above as to costs of particulars of breaches and objections.

(*n*) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.* (1889), 6 R. P. C. 367, 502; *Colley v. Hart* (1890), 7 R. P. C. 101, 108, 189.

(*o*) *Herrburger v. Squire* (1888), 5 R. P. C. 596; *Longbottom v. Shaw* (1888), 5 R. P. C. 502.

## CHAPTER IX.

## ACTION OF INFRINGEMENT.

## GENERAL.

Former spirit  
of interpreta-  
tion of letters  
patent.

It was not for two hundred years after the Statute of Monopolies became law that the popular prejudices against patent privileges disappeared, and Judges began to determine questions arising between patentees and the public in a fair and impartial spirit. Formerly the Courts were only too ready to seize on any slight defects to declare a patent null and void. They were, no doubt, actuated by the deep-seated prejudice which was extremely general in the public mind, and which was the direct outcome of the monstrous oppression practised by means of patent grants before the statute of James I.

Modern spirit  
of interpreta-  
tion.

The Courts now recognise the principle laid down by Lord *Eldon*, L.C. (*a*), that the patent may be considered as in the nature of a bargain between the public (represented by the Crown) and the patentee, and the specification, therefore, must be construed on the same principle of good faith as that which regulates all other contracts. Consequently, all questions which arise between patentees and the public are determined between the parties without any bias or strained construction put upon the law or patent in favour of either.

The privilege conferred by letters patent for an invention, which is created by the law (*b*), would be of no practical use to the grantee if he did not possess legal remedies against persons found to have invaded it.

Remedies for  
infringement.

It is open to a patentee, whose exclusive privilege is being invaded, to bring an action for infringement against the offending party, and so vindicate his right by a proceeding in which, if he succeeds, he may be entitled, not only to an

(*a*) *Cartwright v. Eamer* (1807), cited and approved 14 Ves. 131, 136; *Tubes, Ld. v. Perfecta Seamless Tube Co., Ld.* (1902), 20 R. P. C. 95, 96. A

patent is, of course, not actually a contract: it is a royal grant, see *Feather v. Queen* (1865), 6 B. & S. 257. (*b*) Vol. II. p. 145.

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injunction of the Court restraining a continuance of the wrongful acts, but also to an account of profits made by the infringer, or damages against him, and the costs of the litigation, together with destruction of the infringing article. A patentee is also entitled to sue in one and the same action for the recovery of royalties from a defendant alleged to be a licensee, or in the alternative for the usual relief consequent on infringement (*c*).

A secret use by the patentee of an invention before the date of letters patent will not, at any rate if there has been no profit derived therefrom, invalidate the patent subsequently obtained (*d*). The question suggests itself, Can a patentee who has obtained letters patent for an invention, by an injunction of the Court, prevent another man from continuing what before the date of the patent had been the secret use of the invention? He could not do so, if the secret use were about the date of the patent, for the patent under such circumstances is invalid, because the requirements of the sixth section of the Statute of Monopolies are not satisfied, in that it cannot be said that the invention is one which falls within the class "which others at the time of making such letters patent and grants shall not use" (*e*). The prior secret user would no doubt be required to establish a very strong case, for the Courts would be inclined to the conclusion that an alleged prior secret use was merely experimental and incomplete, in which case it would not invalidate the subsequent patent for the completed invention (*f*). It is open to question whether or not a patentee could restrain a repetition of a use which had been secret and discontinued some considerable time before the date of the patent (*g*).

Secret use of an invention.

The man who uses an invention and keeps the method of performing it a secret really inflicts a hardship on the public, for, if he never discloses it, the public may have no further advantage of it beyond that which the secret user chooses to give. It is open to the secret user, if he be the true and first inventor, to obtain a patent and enjoy the exclusive privilege of using the invention during the term for which it is granted (*h*).

(*c*) *Wilson v. Union Oil Mills Co.* (1892), 9 R. P. C. 57.

(*d*) Pp. 122, 128, *ante*.

(*e*) P. 4, *ante*.

(*f*) P. 119, *ante*.

(*g*) See p. 130, *ante*.

(*h*) Pp. 122, 128, *ante*.

General.

If any person has *openly* practised an invention before the date of subsequent letters patent, he clearly cannot be prevented from continuing to do, after the patent, that which he did before it, since the patent is bad in law on the ground of lack of novelty (*i*).

Sale of goods  
in fraud of a  
patentee.

Besides the remedy of an action for infringement, patentees are entitled to bring an action at common law against any one who sells or otherwise passes off goods manufactured by himself or another in such a manner as to induce the purchasing public to believe that such goods are manufactured by the patentee or his nominees, when, in fact, they have not been so manufactured. It does not signify in what way the offender carries out his fraudulent purpose, whether by counterfeiting a name (*k*), word (*l*), mark, or device (*m*) upon the spurious articles themselves, or upon the wrappers in which they may be wrapped (*n*), or by using any other means to deceive the public into purchasing goods as the goods of the patentee when they are really not so (*o*).

A plaintiff who succeeds in showing that the defendant has sold goods in a manner calculated to make the public believe that they were, contrary to the actual fact, purchasing the manufacture of the plaintiff, is entitled to an injunction against the defendant, and also to an account or damages (*p*). And it is no answer for the defendant to say that the spurious goods are equal in quality to those made by the plaintiff (*q*).

Further, a person selling goods in a manner which induces the purchaser to believe that he is buying the goods of another is liable to an action, notwithstanding the fact that he in a sense makes no actual misrepresentation. Thus, in a case where it appeared that the plaintiff made and sold goods which he was accustomed to mark with the words "Sykes'

(*i*) P. 123, *ante*.

(*k*) *Ransome v. Bentall* (1834), 3 L. J. N. S. 161; *Singer Manufacturing Co. v. Loog* (1880), L. R. 18 Ch. D. 395, 422.

(*l*) *Knott v. Morgan*, 2 Keen, 213; *Wotherspoon v. Currie*, L. R. 5 E. & I. App. 508; *Ford v. Foster*, L. R. 7 Ch. App. 611; *Siegert v. Findlater*, L. R. 7 Ch. D. 801.

(*m*) *In re Worthington*, L. R. 14 Ch. D. 8; *Orr-Ewing v. Johnson*,

L. R. 13 Ch. D. 434; L. R. 7 App. Cas. 219; *Seixo v. Provezende*, L. R. 1 Ch. App. 192.

(*n*) *Blofield v. Payne*, 4 B. & A. 410; *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130.

(*o*) See *Reddaway v. Banham*, [1896] A. C. 204.

(*p*) See *post*.

(*q*) *Blofield v. Payne*, 4 B. & A. 410.

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patent," and the defendant (who was of the same name as the plaintiff) made and sold similar goods to retailers which he also marked with the words "Sykes' patent," and the patent-right had expired, the defendant was restrained by the injunction of the Court, on the ground that he was selling his goods as and for those manufactured by the plaintiff; and this notwithstanding the fact that he did not himself represent his goods to be of the plaintiff's manufacture (*r*). A rule *nisi* for a new trial was refused by the Court of King's Bench (*s*).

On the other hand, any person who becomes acquainted with the process of making an article which is merely a secret, and not the subject of an existing patent, is entitled to manufacture it; and, if the name of the first manufacturer has become descriptive of the article apart from its origin, any person is entitled to describe it by such name, provided he does not so use the name as to lead the public to believe that they are buying goods made by such original manufacturer (*t*).

A person is liable to be sued in one and the same action both for the infringement of a patent or copyright, or in the alternative for passing off his goods as and for those of the plaintiff (*u*), or for breach of contract (*x*).

Patentee may sue in one action in respect of infringement and passing off.

Different causes of action against different persons must not be joined, but where the action is limited to a cause of action resulting from the joint conduct of two persons, they may be joined as defendants (*y*).

The public are secured against the injurious effects of illegal patents by the following remedies which exist for their protection:—

Security of public against illegal patents.

*First*: Any member of the public against whom proceedings are taken by the patentee is entitled to show that the patent in question is void in the absence of any special estoppel (*z*), and so defeat the action, for there can be no in-

(*r*) *Sykes v. Sykes*, 3 B. & C. 541; cf. *Turton v. Turton* (1889), L. R. 42 Ch. D. 128.

(*s*) 3 L. J. N. S. 161.

(*t*) *Massam v. J. W. Thorley's Cattle Food Co.*, L. R. 6 Ch. D. 574; 14 Ch. D. 748.

(*u*) *Lees v. West London Cycle Works* (1892), 9 R. P. C. 300; *Hewett v. Nurse* (1900), 17 R. P. C. 264; *Chameleon Patents Manufacturing Co.*

*v. Marshalls* (1900), 17 R. P. C. 527; *Parker v. Satchwell* (1900), 18 R. P. C. 299; *Poulton v. Kelley* (1904), 21 R. P. C. 392; *Hill v. Thomas* (1906), 23 R. P. C. 375.

(*x*) *Gawthorp v. Mason* (1906), 23 R. P. C. 401.

(*y*) *Saccharin Corporation, Ltd. v. D. T. J. Lyle & Sons, Ltd.* (1904), 21 R. P. C. 604.

(*z*) See p. 415, *post*.

**Infringe-  
ment.**

fringement of an invalid patent; and, unless the patent has all the elements of validity in itself, it cannot be made the means of complaint by reason of an alleged infringement (*a*).

*Secondly*: Any person entitled as of right so to do, or authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, may obtain the revocation of an illegal patent on petition to the Court (*b*).

## INFRINGEMENT.

**Definition of  
infringe-  
ment.**

A person invades the exclusive rights of a patentee and commits an infringement when, without the licence of the owner for the time being of the patent, he directly or indirectly during the lifetime of the patent uses the art or invention which is the subject of the patent, and applies it in any way for his own profit or benefit, otherwise than for the purpose of *bonâ fide* experiment.

**Patentee may  
fix the ambit  
of his claim.**

Sometimes it is open to a patentee to claim more than he actually does claim, *e.g.*, he may be in a position to claim both a principle of construction and a particular machine (*c*), or mechanical arrangement (*d*), or a process and a machine (*e*), or a process and a result (*f*), but he prefers to limit his claim to the one or the other and not to make it wide enough to include both. There are obvious dangers in making too wide a claim and there are obvious disadvantages in making it narrower than the patentee is obliged to do, having regard to the validity of the patent (*g*).

It must be remembered that what is not embraced by the claim is to be considered as disclaimed, and, consequently, open to all the world (*h*).

(*a*) *Dudgeon v. Thomson* (1877), L. R. 3 App. Cas. 37.

(*b*) P. 291, *ante*.

(*c*) *Harrison Patents Co., Ltd. v. Nicholson (W. N.) & Sons, Ltd.* (1907), 24 R. P. C. 722; 25 R. P. C. 393; *Martin v. Consett Iron Co., Ltd.* (1907), 25 R. P. C. 27.

(*d*) *Brown v. Hastie & Co., Ltd.* (1906), 23 R. P. C. 361.

(*e*) See *Peters v. Owen* (1899), 16 R. P. C. 83.

(*f*) *Lancashire Explosives Co. v. Roburite Explosives Co.* (1897), 14 R. P. C. 311, 312.

(*g*) *Ibid.*; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.* (1899), 17 R. P. C. 146; *Martin v. Consett Iron Co., Ltd.* (1907), 25 R. P. C. 27; *Nicholls v. Kershaw* (1910), 27 R. P. C. 237.

(*h*) *Harrison v. Anderston Foundry Co.* (1876), L. R. 1 App. Cas. 581; *United Telephone Co. v. Harrison* (1882), L. R. 21 Ch. D. 741; *Jackson v. Wolstenholmes* (1884), 1 R. P. C. 108; *Lucas v. Miller* (1885), 2 R. P. C. 159; *Easterbrook v. G. W. Ry. Co.* (1885), 2 R. P. C. 208; *Ticket Punch*

Also, if a patentee in his specification points away from the use of a certain thing, he cannot complain of its adoption by an alleged infringer (*i*). Infringe-  
ment.

There is no infringement unless that which is protected by the patent—*i.e.*, that which is claimed—is taken without the leave and licence of the patentee (*j*). Thus, for example, it was held that a claim for a process for stiffening incandescent gas mantles, which was limited upon its proper construction to the use of suitable materials which set by cooling, was not infringed by the use of other suitable materials which set by evaporation (*k*).

Formerly there used to be an idea that it was possible to infringe upon the equity of a statute. If it were not possible to show that the words of the statute had been infringed, it was contended that the equity had been invaded; and, similarly, by a confusion of ideas a notion was prevalent that there might be an infringement of the equity of a patent. There is, however, no sound principle of this kind in the patent law; that which is protected is that which is specified and claimed, and that which is held to be an infringement must be an infringement of that which is specified and claimed, though it may not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding (*l*). No infringe-  
ment of the  
equity of a  
patent.

It is not material to consider the intention of a person who commits an infringement of a patent (*m*); evidence of intention may be material for the consideration of the jury, but if Intention  
and its effect.

Register Co. *v.* Colley's Patents (1895), 12 R. P. C. 171; Nobel's Explosives *v.* Anderson (1894), 11 R. P. C. 128, 525, 526; Davies *v.* Townsend (1899), 16 R. P. C. 497; Ashworth *v.* English Card Clothing Co. (1901), 18 R. P. C. 367; 20 R. P. C. 790; Pilkington *v.* Massey (1904), 21 R. P. C. 709.

(*i*) Nobel's Explosives Co. *v.* Anderson (1895), 12 R. P. C. 164; Morris *v.* Young (1895), 12 R. P. C. 466.

(*j*) See, *e.g.*, Bradford Dyers' Association *v.* Bury (1901), 19 R. P. C. 1; Bunge *v.* Higginbottom & Co., Ltd. (1902), 19 R. P. C. 187; see p. 340, *post*.

(*k*) Sunlight Incandescent Gas

Lamp Co. *v.* Incandescent Gas Light Co. (1897), 14 R. P. C. 757.

(*l*) Dudgeon *v.* Thomson (1874), 30 L. T. N. S. 244; L. R. 3 App. Cas. 34, judgment of Cairns, L.C. See also per Smith, L.J., Ticket Punch Register Co. *v.* Colley's Patents (1895), 12 R. P. C. 185; Lancashire Explosives Co. *v.* Roburite Explosives Co. (1889), 14 R. P. C. 311, 312.

(*m*) McCormick *v.* Gray (1861), 7 H. & N. 25, 30; 31 L. J. Ex. 42; Heath *v.* Unwin, 15 Sm. 552; Stead *v.* Anderson, 2 W. P. C. (1847) 156; 4 C. B. 834; Seed *v.* Higgins (1858), 5 Jur. N. S. 540; 8 E. & B. 771; Young *v.* Rosenthal (1884), 1 R. P. C. 29, 39.



Infringe-  
ment.

the invention be in point of fact adopted or imitated, whether in ignorance or with intention, an infringement is committed (*n*). Infringement is to be judged by what the alleged infringer does, not what he intends (*o*); and there may be an indirect infringement, as well as a direct one, though the intention of the party be perfectly innocent (*p*), and even though he may not know of the existence of the patent itself (*q*), or that the thing he was dealing with was an infringement (*r*). Neither is it a sufficient answer to a motion to commit, for breach of an injunction, to say that the defendant did not intend to infringe (*s*); nor is ignorance a valid defence (*t*).

Evidence of intention may be of some value to the Court when deciding whether to grant or refuse an injunction (*u*), and how to deal with the costs of the action (*x*).

Act done  
under  
subsequent  
patent an  
infringement  
of a prior  
patent for  
same inven-  
tion.

When there is more than one patent for the same invention, anything done under one of those of subsequent date is an infringement of that which bears the earliest date (*y*); and if an invention is shown to be new and useful, the fact that it is much more useful with a subsequent improvement affords no ground for infringing the original invention by using it with the subsequent improvement (*z*); neither can the infringer escape liability on the plea that the later patent was unsuccessfully opposed before the Comptroller by the plaintiff in the action. The proceedings before the Comptroller are irrelevant and immaterial to the action (*a*).

Necessity for  
a determina-

In determining whether an act complained of is really an

(*n*) 2 W. P. C. 227, *n*.

(*o*) *Stead v. Anderson* (1847), 2 W. P. C. 156; 4 C. B. 834; *Newall v. Elliott* (1864), 10 Jur. N. S. 954; *Nobel's Explosives Co. v. Jones* (1882), L. R. 8 App. Cas. 12, 13.

(*p*) *United Telephone Co. v. London, &c. Telephone Co.* (1884), 1 R. P. C. 117; L. R. 26 Ch. D. 766; *Adair v. Young* (1879), L. R. 12 Ch. D. 13.

(*q*) *Heath v. Unwin* (1854), 2 W. P. C. 228, 315; 5 H. L. C. 505; *Wright v. Hitchcock* (1870), L. R. 5 Ex. 37; *Young v. Rosenthal* (1884), 1 R. P. C. 39; *Saccharin Corporation, Ltd. v. Reitmeyer* (1900), 17 R. P. C. 612. But see p. 515, *post*.

(*r*) *Walton v. Lavater* (1860), 8 C. B. N. S. 162; *Wright v. Hitchcock* (1870), L. R. 5 Ex. 37; *Geary v. Norton* (1846), 1 De G. & S. 9; *Davenport v.*

*Rylands* (1865), L. R. 1 Eq. 302.

(*s*) *Plimpton v. Spiller* (1877), L. R. 4 Ch. D. 286, 288.

(*t*) *Upmann v. Forrester* (1883), L. R. 24 Ch. D. 231; *Wittman v. Oppenheim* (1884), L. R. 27 Ch. D. 260; *Wright v. Hitchcock* (1870), L. R. 5 Ex. 37; *Davenport v. Rylands* (1865), L. R. 1 Eq. 302; *Walton v. Lavater* (1860), 8 C. B. N. S. 162; *Geary v. Norton* (1846), 1 De G. & S. 9; *Young v. Morris* (1894), 11 R. P. C. 617.

(*u*) P. 501, *post*.

(*x*) P. 530, *post*.

(*y*) *Saxby v. Hennett* (1873), L. R. 8 Ex. 210.

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

(*a*) *Ticket Punch Register Co. v. Colley's Patents* (1895), 12 R. P. C. 1, 15.

infringement of a patent or not, it is always most important to ascertain from the specifications what is the exact invention protected. If this invention is taken by the defendant, an infringement is committed, and it will not save the defendant from the consequences that, though he has taken the invention, he has dressed it up colourably, added something to it, or taken something away from it, provided that of the whole it can be said that the machine or process is either the plaintiff's or differs from it only colourably (*b*). Thus in a chemical case, where the plaintiff claimed the use of a mixture of hydrocarbons obtained according to a defined process and distilling over between 170° and 200° C. for the purpose of preparing artificial musk, the use for the same purpose of one specific hydrocarbon boiling when pure at 200° to 202°, but small quantities of which would distil over from the mixture produced by the patentee at the temperature indicated by him, was held to be within the legitimate scope of his claim (*c*).

Infringe-  
ment.

tion of the  
exact inven-  
tion pro-  
tected.

The use of the word "colourable" or "colourably" in reference to an infringement is highly inappropriate, and apt to lead to great confusion, as connoting the idea that a patent may be infringed though the invention is not identically or substantially copied, if it is forgotten that the real question always is, Has the property of the patentee been taken (*d*)? The identity of the invention may be disguised, but there is no infringement unless what the infringer does is to take identically and substantially the patentee's invention. So a patent may be infringed by a colourable imitation, though

Objection to  
the use of  
the word  
"colourable"  
or "colour-  
ably."

(*b*) *Dudgeon v. Thomson* (1877), L. R. 3 App. Cas. 34; *Muntz v. Foster* (1843), 2 W. P. C. 95; *Walton v. Potter* (1841), 1 W. P. C. 585; *Gamble v. Kurtz* (1846), 3 C. B. 425; *Trotman v. Wood* (1864), 16 C. B. N. S. 479; *Hayward v. Pavement Light Co.* (1884), 1 R. P. C. 207; *Nordenfelt v. Gardner* (1884), 1 R. P. C. 61; *Walker v. Hydrocarbon Syndicate* (1885), 2 R. P. C. 8; *Sugg v. Bray* (1885), 2 R. P. C. 233; *United Telephone Co. v. St. George* (1886), 3 R. P. C. 321; *Richardson v. Castrey* (1887), 4 R. P. C. 265; *Ellington v. Clark* (1888), 5 R. P. C. 135, 319; *Wenham v. May* (1887), 4 R. P. C.

303; *Proctor v. Bennis* (1887), 4 R. P. C. 333; *Ehrlich v. Ihlee* (1888), 5 R. P. C. 198, 437; *Garrard v. Edge* (1889), 6 R. P. C. 372, 563; *Boyd v. Horrocks* (1889), 6 R. P. C. 152, 528; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.* (1889), 6 R. P. C. 121, 367; *Shaw v. Jones* (1889), 6 R. P. C. 328; *Winby v. Manchester, & Co. Steam Tramways Co.* (1889), 6 R. P. C. 359, 365; 7 R. P. C. 30.

(*c*) *Fabriques de Produits Chimiques de Thann et de Mulhouse v. Lafitte* (1899), 16 R. P. C. 61.

(*d*) See note (*b*).

Infringe-  
ment.

Right way to  
consider the  
question of  
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it be so limited in scope that there would be no infringement in the use of a mechanical or chemical equivalent (*e*).

The question of infringement is really a mixed one of law and fact (*f*). It is the duty of the Court to construe the specification and claims together (*g*), and thus to ascertain what is the invention protected by the patent; and this question must be determined by the Court independently of a jury, expert, or other witness. This is a rule which is often lost sight of by counsel in examining witnesses (*h*). Expert evidence may, however, be relied on to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of any differences between the plaintiff's invention and the alleged infringement (*i*), as also the relative importance of the different parts of the invention, in order to ascertain whether the substance has been appropriated (*k*). It is the duty of the Court to construe the specification quite apart from what the defendant has done. The first canon of construction is that the specification must be construed, like all other written instruments or business documents, as if the Court had to construe it the day after it was published; and the Court is bound to construe the specification as if it had to be construed before the defendant was born, if the patent was before that time (*l*).

Importance of  
ascertaining  
the principle

In this connection it is always most important to consider what is the principle of the invention (*m*). The reader must

(*e*) *Tweedale v. Howard and Bul-  
lough* (1896), 13 R. P. C. 536, in con-  
junction with *Tweedale v. Ashworth*  
(1892), 9 R. P. C. 121; also *Scott v.*  
*Hull Steam Fishing Co.* (1897), 14 R.  
P. C. 143, in conjunction with *Scott*  
*v. Hamling* (1897), 14 R. P. C. 123;  
*Tweedale v. Ashworth* (1900), 17 R. P.  
C. 625; also p. 356, *post*.

(*f*) P. 260, *ante*; *Seed v. Higgins*  
(1860), 8 H. L. C. 565; *Curtis v. Platt*  
(1866), 35 L. J. Ch. 852.

(*g*) P. 274, *ante*.

(*h*) *Brooks v. Steel* (1896), 14 R. P.  
C. 47; pp. 470, 480, *post*.

(*i*) *Brooks v. Steel* (1896), 14 R. P.  
C. 47.

(*k*) *Clark v. Adie* (1873), L. R. 10 Ch.

667; L. R. 2 App. Cas. 315; *Incandes-  
cent Gas Light Co. v. De Mare In-  
candescent Gas Light System* (1896),  
13 R. P. C. 302; *Consolidated Car*  
*Heating Co. v. Came* (1903), 20 R. P. C.  
765; pp. 343, 469, *post*.

(*l*) *Nobel's Explosives Co. v. Ander-  
son* (1894), 11 R. P. C. 523, judgment  
of Esher, M.R.

(*m*) *Chamberlain and Hookham v.*  
*Mayor, &c. of Bradford* (1903), 20 R.  
P. C. 684; *Consolidated Car Heating*  
*Co. v. Came* (1903), 20 R. P. C. 765;  
*Sandow v. Szalay* (1903), 21 R. P. C.  
33, 333; 23 R. P. C. 6; *Lambert Co. v.*  
*International Phonograph Indestruc-  
tible Record Co., Ltd.* (1904), 21 R. P.  
C. 247; *Thomson v. Moore* (1889)

observe that the word "principle," when thus used, is not intended to signify any of those first principles or laws of nature which cannot be the subject of a valid patent (*n*), but is intended to mean a practical application of one or more of those first principles which is properly denominated an art by means of which articles of commerce may be manufactured; and an art of this description is that which must necessarily be the subject of every valid patent (*o*). Thus, in the case of *Watt's* steam-engine, *Watt* invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate from the cylinder. Whenever it can be shown that any act done without the sanction of the patentee comes, in this sense of the word, within the principle of the invention, the act is an infringement of the patent, for it necessarily implies that the art invented by the patentee has been used contrary to the prohibition in the grant. The law intends a patent to reward the patentee for his invention by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege by making some mechanical variation from the mode of applying the invention for the construction of articles to be produced by means of it, as described in the specification, the object of the patent would be frustrated, for no one would pay the patentee a profit for the patented article if he could obtain an article substantially the same at a cheaper rate (*p*).

Thus, when a principle in the above sense is invented and the infringer takes the principle and alters the details, and yet it is obvious that he has taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing, the Court can look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can

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of the inven-  
tion pro-  
tected.

Adoption of  
the principle  
of the inven-  
tion protected,  
though details  
differ, is an  
infringement.

6 R. P. C. 426, 450; *Hoffman Manufacturing Co., Ltd. v. Auto Machinery Co., Ltd.* (1911), 28 R. P. C. 141.

(*n*) P. 47, *ante*.

(*o*) P. 31, *ante*.

(*p*) *Thomson v. Moore* (1889), 6 R. P. C. 426, 450.

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protect the inventor (*q*). In another class of cases, although a certain principle is common to a variety of manufactures, the subject-matter of the patent is really the particular mechanical mode by which that common principle is carried into effect (*r*), and such patents are only infringed when the particular mechanical mode which is the subject-matter of the patent is copied directly or by mere colourable imitation.

*Crossley v. Beverley* (*s*) may be given as an example of the point under discussion. In that case it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patented machine, the principles applied in the plaintiff's machine and in the defendant's being the same. The plaintiff accordingly obtained a verdict.

Baron *Alderson*, in a subsequent case, commenting on *Crossley v. Beverley*, said: "There never was a more instructive case than that. I remember very well the argument put by the Lord Chief Baron, who led the case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve. The scientific men, all of them, said the moment a practical scientific man has got that principle in his head he can multiply without end the forms in which that principle can be made to operate" (*t*).

In short, if the pith and marrow—*i.e.*, substance—of the patentee's invention be taken, an infringement is committed, and such a taking is none the less actionable because the in-

(*q*) *Tweedale v. Ashworth* (1892), 9 R. P. C. 126; *Moor v. Thomson* (1890), 7 R. P. C. 325; *British Vacuum Co., Ltd. v. Exton Hotels Co., Ltd.* (1908), 25 R. P. C. 617; *Badische Anilin und Soda Fabrik v. Levinstein* (1883), 24 Ch. D. 170; *Sellers v. Dickinson* (1850), 5 Ex. R. 312, 324, in which cases the infringement was quite outside the specification, but not the invention: see

also p. 278, *ante*.

(*r*) Per *Halsbury*, L.C., *Tweedale v. Ashworth* (1892), 9 R. P. C. 126; *Curtis v. Platt* (1863), L. R. 3 Ch. D. 135, n.

(*s*) (1829), 1 W. P. C. 106.

(*t*) *Jupe v. Pratt* (1837), 1 W. P. C. 146; see also *Chamberlain and Hookham v. Mayor, &c. of Bradford* (1903), 20 R. P. C. 684.

fringer has added something to the invention which constitutes an improvement (*u*). Further, it is not proper for the Court to determine the question whether or not the substance of an invention has been taken upon a consideration of the specification alone. In addition to a consideration of the specification, the Court must also regard the evidence as to existing knowledge on the subject at the date of the patent, and as to the operation of the machine or process (*x*).

It rarely happens that an infringer takes the identical thing described and claimed by the patentee. He usually modifies it or dresses it up with some additional matters. Nevertheless, if he has taken the substance or pith and marrow of the patentee's invention he is guilty of an actionable infringement, and this notwithstanding the fact that everything done by the patentee since the date of the patent may be an improvement upon it. The question is whether the defendant has taken the substance or pith and marrow of the plaintiff's invention as claimed in his specification; and this invention may be infringed although the defendant uses it in conjunction with an improvement which is not within the ambit of the patentee's claim (*y*), for where the defendant has taken the substance of the plaintiff's invention, it is no defence to say he has made an improvement (*z*). In the pertinent words of Lord *Bowen*, "the superadding of ingenuity to robbery does not make the operation justifiable" (*a*).

The relative importance of the different parts of the patentee's combination or process is a question to be settled by evidence (*b*). The fact, if such be the case, that the patentee in the specification attaches an undue importance to the use of something, handicaps him, no doubt, in a contest as to infringement, but has no further weight, and the Court is free to exercise its own judgment in weighing this fact with others when dealing with the question of infringement (*c*).

Relative importance of parts is a question to be settled by evidence.

(*u*) *Ehrlich v. Ihlee* (1888), 5 R. P. C. 437.

(*x*) See *Consolidated Car Heating Co. v. Came* (1903), 20 R. P. C. 745, which contradicts the view expressed by *Esher, M.R.*, in *Lyon v. Goddard* (1893), 10 R. P. C. 341; *Morris v. Young* (1895), 12 R. P. C. 456, 461.

(*y*) *Dudgeon v. Thomson* (1877), L.R. 3 App. Cas. 34; *British Liquid Air*

*Co., Ltd. v. British Oxygen Co., Ltd.* (1908), 25 R. P. C. 605, 606; 26 R. P. C. 509.

(*z*) *Ehrlich v. Ihlee* (1888), 5 R. P. C. 437.

(*a*) *Wenham Gas Co. v. Champion Gas Lamp Co.* (1890), 9 R. P. C. 56.

(*b*) *Consolidated Car Heating Co. v. Came* (1903), 20 R. P. C. 765; *infra*.

(*c*) *Incandescent Gas Light Co. v.*

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Though a claim to a process may mention *nominatim* the use of a specific thing, it may be none the less infringed by the adoption in the process specified of a manufacturing equivalent for the specific thing mentioned, when such specific thing is not of the essence of the invention—*e.g.*, the substitution of a depositing tank for the centrifugal separating machine mentioned in the claim for the patented process for the manufacture of lanolin (*d*).

With regard to the true way in which to determine what is important and what is of subsidiary consequence in reference to the patentee's invention, the following passage from the judgment of *Wills, J.*, in *Incandescent Gas Light and Coke Co. v. De Mare Incandescent Gas Light System* (*e*), may be quoted with great advantage as dealing with some of the older cases on the subject:—

“It is contended by the defendants that what is important and what is of subsidiary consequence can only be gathered from the specification itself. I am satisfied that that neither is, nor can be, the law. Certainly *Dudgeon v. Thomson* (*f*), which is cited as an authority to that effect, says nothing of the kind. ‘Additions and subtractions,’ says Lord *Cairns*, ‘may exist, and yet the thing protected by the specification may be taken notwithstanding.’ There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken except by seeing what they are worth as compared with the things which have been taken bodily from the invention. In the case of a patent for a combination, or for a series of operations, the specification very often contains no clue to the inventor's own view of the relative importance of the different elements in the combination. If he says nothing on the subject you must conclude that, as far as the specification goes, they are all presented as of equal importance, and all as essential parts of the combined whole, and yet there may be infringement

*De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 331, judgment of *Wills, J.* The judgment of *Kekewich, J.*, in *Bunge v. Higginbottom* (1901), 18 R. P. C. 201, appears to conflict with the above judgment of *Wills, J.*, and also with the dictum of *Vaughan Williams, L.J.*, at 19 R. P. C. 193.

(*d*) *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson* (1893), 11 R. P. C. 93, 261; see also *Aktiobolaget Separator v. Dairy Outfit Co.*, (1898), 15 R. P. C. 327; *Marconi v. British Telegraph and Telephone Co., Ltd.* (1911), 28 R. P. C. 181.

(*e*) (1896), 13 R. P. C. 330.

(*f*) (1877), L. R. 3 App. Cas. 34.

notwithstanding 'slight variations' (*g*). 'So again,' says *Cotton*, L.J. (*h*), 'omissions and additions may be very material in considering whether, in fact, the machine of the defendant is an infringement of the combination which the plaintiff claims.' Omissions and additions may even be improvements, but that fact 'does not enable you,' says *Bowen*, L.J., 'to take the substance of the plaintiff's patent' (*i*). 'If the instrument patented,' says Lord *Cairns*, 'consists of twelve different steps producing in the result the improved clipper, an infringer who had taken eight, nine, or ten of those steps might be held by the tribunal judging of the patent to have taken the substance, the pith and marrow of the invention, although there are one, two, three, four, five steps which might not actually have been taken' (*j*). In such a case, as far as the specification went, the patentee would, under ordinary circumstances, treat the whole of the twelve steps as essential parts of his combination, and, so far as the specification went, there would be nothing to indicate that any one of them was not indispensable or was of less importance than the others. In *Proctor v. Bennis* there was nothing to indicate that the patentee thought the parts of his combination omitted or varied by the defendant of anything but cardinal importance. How was the question suggested by *Cotton*, L.J., whether the variations were 'slight' to be ascertained, except by evidence as to the relative importance of the variations in question as compared with the patented combination as a whole? 'There is, or may be,' says *James*, L.J., and *Mellish*, L.J., 'an essence or substance of the invention underlying the mere accident of form: and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination' (*k*). Drop the word 'combination,' which is perfectly immaterial as regards the principle, and every word is applicable to the present case. Mr. *Bousfield* says I am not entitled to take this as an accurate statement of the law, as the case went to the House of Lords, and no such doctrine is, as he contends, enunciated

(*g*) *Cotton*, L.J., in *Proctor v. Bennis* (1887), L. R. 36 Ch. D. 740—754.

(*h*) *Ibid.* p. 756.

(*i*) *Proctor v. Bennis* (1887), L. R. 36 Ch. D. 756.

(*j*) *Clark v. Adie* (1873), L. R. 2 App. Cas. 315—320.

(*k*) *Clark v. Adie* (1873), L. R. 10 Ch. App. 667—675.



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by the Law Lords. This, however, is a mistake. Lord *Cairns* expressly says: 'I am quite satisfied with the judgment of the learned Lords Justices, and I should have been content to rest the decision of this case upon that judgment, but for its importance' (l).

Substance and principle of the invention is always the important question.

In each case the substance of the invention and the principle of the machine and not the mere form are to be looked to. If what the defendant does is in principle not the same but really different there is no infringement (m); and the question always is, not whether the substantial part of the process or combination said to be an infringement has been taken from the patentee's specification, but the very different one, whether what is done or proposed to be done takes from the patentee the substance of his invention as claimed. "A process might be wholly gathered from a specification and nowhere else, and yet be no infringement if it did not take substantially the thing invented (*sic* claimed)" (n).

Though it may be lawful to take the pith and marrow in one sense of a patented invention, it is never lawful to take its substance without licence.

Thus a person may be entitled to take the pith and marrow in one sense of the patentee's invention (o); what he is not entitled to do is to take its substance. The term "pith and marrow" used by Lord *Cairns* and many Judges since is, as *Wills, J.*, has pointed out, not so good a one to use as "substance of the invention," for it is very easy to misapply it, and it would be very likely to mislead a jury. To quote *Wills, J.*, again: "'Pith' is a great deal less than the substance of the vegetable structure of which it is part, and 'marrow' is a great deal less than the substance of the animal structure of which it is part. Metaphors are very apt to mislead, as they are seldom close enough to the things to which they are applied" (p).

The "pith and marrow" of the *Welsbach* process of gas

(l) (1877), L. R. 2 App. Cas. 326; see also *Consolidated Car Heating Co. v. Cane* (1903), 20 R. P. C. 765.

(m) *Morgan v. Seaward* (1836), 1 W. P. C. 171; *Ferrauti v. British Thomson-Houston Co., Ltd.* (1902), 19 R. P. C. 147; 20 R. P. C. 145; see also p. 338, *ante*.

(n) Per *Wills, J.*, *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 330; see also *Pneumatic Tyre Co. v. Tubeless Pneumatic Tyre and Capon*

*Heaton, Ltd.* (1897), 15 R. P. C. 74, 237; 16 R. P. C. 77; *Allen v. Abraham Pyatt & Co.* (1898), 15 R. P. C. 723; 16 R. P. C. 135.

(o) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.* (1896), 13 R. P. C. 345; *Lancashire Explosives Co. v. Roburite Explosives Co.* (1897), 14 R. P. C. 303.

(p) Per *Wills, J.*, *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 332.

illumination was the construction of a mantle or skeleton of materials which will incandesce when subjected to the heat of a flame, but the "substance" of the invention *claimed* in the *Welsbach* specification was moulding the illuminant into shape by a certain chemical process of reduction from salts of substances mentioned by the patentee or substances substantially the same as those, with the necessary consequence that the skeleton is homogeneous throughout. It was held that it was no infringement of this claim to produce a mantle which will incandesce, by a process consisting in first forming a mantle of alumina and zinconia homogeneous throughout and strong, but giving little incandescence, and secondly, coating this with a thin layer of oxide of chromium, which incandesces well, and is not a substance substantially the same as those mentioned and claimed by the patentee. In such a structure the illuminant is not (as in the *Welsbach* process) that portion of a homogeneous mantle which is exposed to the flame, but a foreign substance laid on in a thin film and quite absent from the bulk of the skeleton. Though this was an appropriation of the pith and marrow of the *Welsbach* invention, it was not such a taking of the substance of it as constituted an infringement of the claim. The patentee did not and could not claim the formation of a skeleton by other means and of other substances than those pointed out in the specification, or by means substantially identical and apart from the contemporaneous formation of the illuminants, and so the Court was reluctantly compelled to hold that there was no infringement (*q*).

On the other hand, it was held that to vary by omission and alteration the non-essential details of the chemical process claimed in the *Welsbach* specification, but at the same time to produce an illuminant which was homogeneous throughout, though in a form of a fringe of threads instead of a mantle as described in the specification, was to take the substance of the *Welsbach* invention and so to commit an infringement (*r*).

Again, in an action brought for the infringement of *Bartlett's* patent for "improvements in tyres or rims for cycles and other vehicles" (*s*), *Romer, J.*, held that the essence of *Bartlett's*

(*q*) *Incaudescant Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.* (1896), 13 R. P. C. 345.      *De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 301, 559.  
 (*r*) *Incaudescant Gas Light Co. v.*      (*s*) *North British Rubber Co. v. Macintosh* (1894), 11 R. P. C. 477.

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invention was the combination of an outside flexible tyre that can be easily removed, because it is not itself a complete tube, and of an inside complete tube capable of inflation, so that when the inside tube is inflated the flexible tyre is kept on to the grooved metal rim of the wheel by the pressure of the sides of the flexible tyre against the groove. The patentee in his specification pointed out that by thickening the sides or edges of the flexible tyre the grip could be increased; and obviously the more the grip was increased the more difficult it would be for the inside complete tube, if made elastic, to force the flexible tyre out of the narrow mouth of the grooved metal rim. The defendants took the patentee's idea and the essence or substance of his invention. All they did, by way of alteration, was to increase the size of the outside flexible tyre and the thickening of its edges, and to exaggerate the dovetailing of the metal grooved rim, so as to give a greater grip, and to render it more difficult for the flexible tyre to be forced out of the mouth of the groove, and thus they were enabled to employ for the inflatable inside tube a more elastic tube than that mentioned in the body of the specification. The Judge held that the defendants' tyre might be an improvement upon the plaintiff's, but still, in substance, it was the plaintiff's and an infringement of the patent. Other points incidental to the structure of the different parts of the combination used by the defendants were urged as differentiating it from the plaintiff's, but unsuccessfully, in face of the finding of the Court that the essence or substance of the plaintiff's invention was present in the defendants' combination (*t*).

(*t*) See also North British Rubber Co. v. Gormully and Jeffery Manufacturing Co. (1896), 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; Pneumatic Tyre Co. v. Tubeless Tyre (1897), 15 R. P. C. 74, 236; 16 R. P. C. 77; White v. Bertrams (1897), 14 R. P. C. 501, 735; Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co. (1898), 16 R. P. C. 16; and as to the true construction of the claims of the Welch patent for bicycle tyres and what was and what was not held to be an infringement, see the following cases: Pneumatic Tyre Co. v. Caswell (1896), 13 R. P. C. 164, 375; Pneumatic Tyre Co. v. East London Rubber Co. (1897), 14 R. P. C. 77, 573; Pneumatic

Tyre Co. v. Ixion Patent Pneumatic Tyre Co. (1897), 14 R. P. C. 853, approved by C. A., 16 R. P. C. 17; Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co. (1898), 16 R. P. C. 16; Dunlop Pneumatic Tyre Co. v. Wapshare Tube Co., Ltd. (1900), 17 R. P. C. 433; Dunlop Pneumatic Tyre Co. v. Clifton Rubber Co. (1902), 19 R. P. C. 433; 20 R. P. C. 393; Dunlop Pneumatic Tyre Co. v. United Rubber Works, Ltd. (1902), 19 R. P. C. 406; Dunlop Pneumatic Tyre Co. v. New Lamb Tyre Co. (1902), 20 R. P. C. 303; Dunlop Pneumatic Tyre Co. v. Hyde Rubber Co. (1904), 21 R. P. C. 208.

So also a patent for a chemical mixture or compound suitable for a beetle poison was held to be infringed by the addition of non-material ingredients to the material ingredients specified by the patentee (*u*). And in a case where the defendants took what was the merit of the plaintiff's improved sewing machine—*i.e.*, using a looper in such a way and with such a variety of machinery as to present the thread at a sufficient tension to the notch of the needle, though they introduced a portion of an alleged anticipating but useless machine, which was not necessary to the plaintiff's mechanism, they were held to have infringed (*x*).

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An arrangement, though it be an infringement of a prior patent, may be such as would itself support a patent on the ground of novelty. The criterion of novelty and infringement in this respect are not the same. This point was stated by *Pollock, C.B.*, in *Newton v. Grand Junction Railway Co.* (*y*). Thus:—

Criterion of  
novelty and  
infringement  
are not the  
same.

“It was agreed that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if in all its parts combined together it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purposes for which the patentee adapted his invention and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement” (*z*).

In further pursuance of the principle under discussion, *viz.*, that there is no infringement unless the substance of the invention claimed is pirated by the alleged infringer, the following remarks of Lord *Cairns, L.C.*, and Lord *Esher, M.R.*, made in reference to patents for combinations, may be usefully quoted:—

Combination  
may be in-  
fringed by an  
unlawful  
taking of its  
substance.

Lord *Cairns* in *Clark v. Adie* (*a*), speaking in the House

(*u*) *Lane v. Herold* (1892), 9 R. P. C. 447.

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

(*y*) (1846), Ex. R. 334; 20 L. J. Ex. 427, n.

(*z*) See p. 339, *ante*.

(*a*) (1877), L. R. 2 App. Cas. 320.

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of Lords on the different possible modes of infringing a patent for a horse-clipper which consisted of a combination of several parts, said: "One mode of infringement would be a very simple and clear one: the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument here described; he might make an instrument which in many respects might resemble the patent instrument, but would not resemble it in all its parts. And then the question would be, either for a Judge or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step, or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term "combination." Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, the invention must be described in that way; it must be made plain to

ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind and has intended to claim protection for those subordinate integers; and, moreover, he is, as was said by the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

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Lord *Esher*, M.R., speaking on the same question, in reference to the patent for the *Nordenfelt* gun in *Nordenfelt v. Gardner (b)*, said: "That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things, and, if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a

(b) (1884), 1 R. P. C. 61, 65.

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material element of the old combination, and the putting in of a new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C; but if the original combination is of A, B, and C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

In order to answer a charge of infringing a patent for a combination of several parts by the omission of one of them, it is not necessary for a defendant to prove that the part omitted was an essential element in the combination in the sense that the machine would not work without it; but he must at least show that it is a material element and not a mere detail which may be varied or omitted altogether without serious detriment to the successful working of the combination (*a*).

Thus, the substitution of a weighted valve for a water valve or column in a combination forming a milking machine was held to be an infringement (*b*). Also the substitution of a pump, though contrived with great ingenuity, for a bellows in a smoke-testing and fumigating apparatus (*c*). Again, a patent for an improved carriage lamp, in which the candle tube was prevented from falling out by means of a flat sliding bolt which engaged with a knob on the tube being pushed home by the coachman's hand, or simply by shutting the door of the lamp, and kept in its place by contact with the door when shut, was infringed by a sliding bolt with spring engaging with a collar on the tube and kept in position by the shut door of the lamp (*d*).

But if the defendant's combination is really a different one to the plaintiff's there is no infringement (*e*), *i.e.*, if an essential feature of the plaintiff's combination is not to be found in the defendant's combination (*f*).

(*a*) Consolidated Car Heating Co. v. Came (1903), 20 R. P. C. 766.

(*b*) (1893), 10 R. P. C. 417.

(*c*) Macdonald v. Fraser (1893), 10 R. P. C. 386; 11 R. P. C. 169.

(*d*) Howes v. Webber (1895), 12 R. P. C. 465; 13 R. P. C. 39.

(*e*) Automatic Diversions Syndicate v. Urry (1897), 14 R. P. C. 365.

(*f*) Griffiths v. The Birmingham Stopper and Cycle Components Co. (1899), 16 R. P. C. 383; Brooks v. Lamplugh (1898), 16 R. P. C. 41; Pneumatic Tyre Co. v. Tubeless Pneumatic Tyre and Capon Heaton, Ltd. (1898), 16 R. P. C. 77; Consolidated Car Heating Co. v. Came (1903), 20 R. P. C. 745; Hardmuth v. Baker

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ment.Special claims  
for subsidiary  
parts of a  
combination.

It has been explained (*g*) that in the case of a patent for a combination of several parts a claim may be made to the combination as a whole, and also to any one or more of the several parts separately, or in combination as a minor invention. The question whether the use of one or more of the component parts of a combination is an infringement or not, depends upon whether or not the parts are claimed separately, or whether taken together they are claimed as a subsidiary combination. It is not possible to say in the abstract whether the use of two parts, A and B, of a combination consisting of A, B, and C, is or is not using part of the invention; nor can it be decided in the abstract whether or not the specification shows that A and B is claimed separately or whether they are claimed together as a separate subordinate combination within the larger combination consisting of A, B, and C (*h*).

A patent for a combination is infringed by the use of a subordinate part only, if that part is new and material and is the subject of a claim (*i*); though, if the patent is for a combination of two or more old inventions, the use of only one of them will not be an infringement, since the patentable novelty claimed is the combination of the two (*k*).

Thus, if a man invents a machine consisting of three parts, of which one is a very useful invention, and the other two are found to be of less practical use, it is not free for a person to adopt the useful part, and contrive some other mode of carrying out the less useful parts (*l*). The question always is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (*m*).

(1904), 21 R. P. C. 66; *Stone & Co., Ltd. v. Broadfoot & Sons, Ltd.* (1909), 26 R. P. C. 361.

(*g*) P. 250, *ante*.

(*h*) *Clark v. Adie* (1877), L. R. 2 App. Cas. 335.

(*i*) *Lister v. Leather* (1857), 8 E. & B. 1004; *Parkes v. Stevens* (1869), L. R. 8 Eq. 358, 366; L. R. 5 Ch. App. 36; *Wright v. Hitchcock* (1870), L. R. 5 Ex. 37; *Foxwell v. Bostock* (1863), 12 W. R. 723; *Sellers v. Dickinson* (1850), 5 Ex. 312; *Newton*

*v. Grand Junction Ry.* (1846), 5 Exch. 331; *Smith v. London and North-Western Ry.* (1853), 2 E. & B. 69; *Young v. Rosenthal* (1884), 1 R. P. C. 33; *Clark v. Adie* (1873), L. R. 10 Ch. App. Cas. 667; 3 Ch. D. 134, 143; 2 App. Cas. 315, 327, 335; *Consolidated Car Heating Co. v. Came* (1903), 20 R. P. C. 763.

(*k*) *Smith v. London and North-Western Ry.* (1853), 2 E. & B. 69, 76.

(*l*) *Ibid.*

(*m*) See per Cotton, L.J., *Proctor v.*



**Infringe-  
ment.**

Equivalents  
substituted  
for specified  
parts.

When the ambit of the claim is not limited to the particular thing specified, the law will not allow a person in lieu of a part described by the patentee to employ a substitute in its place, for the purpose of effecting the same end, by means of an equivalent, using the skill and knowledge which he may possess to evade the patent (*n*).

In fact, when, having regard to the state of public knowledge, a narrow construction is not to be put upon the claim (*o*), it is an infringement to substitute mechanical equivalents for parts of the patentee's invention and add at the same time an improvement (*p*); or to omit some part or parts of a patented combination and add anything, whilst at the same time using the substance and essence of it (*q*).

Rule in  
*Sellers v.*  
*Dickinson.*

It is an accepted proposition of patent law, known as the rule in *Sellers v. Dickinson* (*r*), that if a portion of a patented new arrangement of machinery is in itself new and useful, and a person, for the purpose of producing the same effect as it produces, uses that portion of the arrangement, and substitutes another mechanical equivalent for the other matters combined with it, he thereby commits an infringement of the patent.

It is important to remember that the novelty connoted in the above paragraph may, in some cases, be the employment for the first time for a particular purpose of an underlying principle, and, in other cases, the novelty may be the employment of details whereby an old principle is carried into effect in a new way. The doctrine of infringement by the substitution of equivalents is applicable only to cases of the first of the above-indicated two classes (*s*).

*Bennis* (1887), L. R. 36 Ch. D. 254, 740; 4 R. P. C. 333; see also *Burnett v. Tate* (1882), 45 L. T. N. S. 143; *Murray v. Clayton*, L. R. 10 Ch. App. Cas. 675, n.; *Kaye v. Chubb* (1888), 5 R. P. C. 641; *Garrard v. Edge* (1889), 6 R. P. C. 372, 563; *Combination Hubs, Ltd. v. Seabrook* (1906), 23 R. P. C. 205.

(*n*) *Bateman v. Gray* (1853), Macr. P. C. 102; *Morgan v. Seward* (1837), 1 W. P. C. 171; *Thorn v. Worthing Skating Rink Co* (1876), L. R. 6 Ch. D. 415, n.; *United Telephone Co. v. Harrison Cox-Walker* (1882), L. R. 21 Ch. D. 720; *United Telephone Co. v. Bassano* (1886), 3 R. P. C. 295; *United*

*Telephone Co. v. St. George* (1886), 3 R. P. C. 321; *Hancock v. Moulton*, *Johns. Pat. Man.* 5th ed. p. 254.

(*o*) P. 356, *post*.

(*p*) *Proctor v. Bennis* (1887), 4 R. P. C. 333; L. R. 36 Ch. D. 740; *Ehrlich v. Ihlee* (1888), 5 R. P. C. 437, 454.

(*q*) *Proctor v. Bennis* (1887), 4 R. P. C. 333; 36 Ch. D. 740, 755; *Needham v. Johnson* (1884), 1 R. P. C. 49; *Gwynne v. Drysdale* (1886), 3 R. P. C. 65, 67; *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205.

(*r*) 5 Exch. 312, 326; 20 L. J. N. S. Ex. 417.

(*s*) See p. 341, *ante*, and pp. 356, 369, *post*.

In order, however, that the substitution of an equivalent for any part of a patented mechanical combination or process may constitute an infringement, the equivalent must, judged by the standard of public knowledge at the date of the patent, be obviously and demonstrably an equivalent. To produce the result arrived at by the patentee by the use of an equivalent means, which required subsequent discovery to demonstrate that it is an equivalent, may be perfectly good subject-matter for a subsequent grant of letters patent, and no infringement of the prior patent (*t*). Thus, rendering cast steel easy to weld and malleable by subsequently discovered equivalents—viz., the addition of coal tar and black oxide of manganese to a crucible containing bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, and heated to the proper heat for melting the materials—was held by the House of Lords (*u*) to be no infringement of a claim made by a prior patentee for doing the same thing by means of carburet of manganese, although there was evidence to the effect that carburet of manganese was formed by exposing the mixture of carbon and oxide of manganese to a high temperature. This decision of the House of Lords was based upon the fact that, at the date of the patent sued on, it was not known that coal tar and oxide of manganese would be chemical equivalents of the carburet of manganese claimed by the patentee (*x*), *i.e.*, judged by the light of public knowledge at the date of the patent coal tar and oxide of manganese were not obviously and demonstrably the equivalent of carburet of manganese. As stated by Lord *Abinger*, C.B., in the Court of Exchequer, the materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the composition was a new discovery or invention, and not within the claim of the letters patent (*y*). The foregoing remarks must not be taken to

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Equivalents  
not known at  
the date of  
the patent.

(*t*) *Heath v. Unwin* (1855), 5 H. L. C. 545; *Badische Anilin und Soda Fabrik v. Levinstein* (1883), L. R. 24 Ch. D. 156, 170—173; L. R. 12 App. Cas. 710; *Automatic Weighing Machine Co. v. Knight* (1889), 6 R. P. C.

113, 300; *Thomson v. Moore* (1889), 6 R. P. C. 426; 7 R. P. C. 329.

(*u*) *Heath v. Unwin* (1855), 5 H. L. Cas. 505.

(*x*) 5 H. L. C. 545, 548.

(*y*) *Heath v. Unwin* (1855), 2 W. P.

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ment.

imply that the substitution for a part in the patented combination or process of a subsequently invented or discovered equivalent, which itself may possibly be subject-matter for valid letters patent, is necessarily no infringement. Assuming a particular case to be one to which the doctrine of infringement by the substitution of equivalents is applicable (*z*), it is submitted the real point for determination is whether or not the newly invented or discovered equivalent is, when judged by the light of public knowledge at the date of the patent alone, clearly and obviously an equivalent *qua* the function of the part for which it is substituted. *Parker, J.*, applied this principle in the recent case of *Marconi v. British Radio Telegraph and Telephone Co., Ltd.* (*a*), and observed that it would be absurd to hold a person who had invented a new mechanical device which would have the same effect as, say, a cam, could lawfully make use of all patents in which a cam formed part of, or was a step in, the combination or process specified or claimed (*b*).

State of public knowledge affects the question whether or not the substitution of known equivalents is an infringement in a particular case, *i.e.*, public knowledge affects the true ambit of the claim.

With regard to the question of the infringement of patents by the substitution of equivalents for parts described by the patentee in the specification, it must be remembered that it is necessary first to determine the true construction of the specification, and so ascertain what is the real invention claimed (*c*). It must also be borne in mind that the true construction of the specification and ambit of the claim may be affected (*inter alia*) by the state of public knowledge at the date of the patent (*d*). The substitution of an equivalent in the place of a part mentioned in the patentee's specification may, or may not, be an infringement according as the state of public knowledge affects the true construction and ambit of the claim (*e*).

When the invention relates to the production of an old result by means of a novel combination of old parts, or to a machine of a known type, *i.e.*, a machine utilising an old principle or system, the patentee is protected only in respect of the particular means he sets forth in the specifica-

C. 217; 5 H. L. C. 545, 548; Nobel's Explosives Co. v. Anderson (1895), 12 R. P. C. 167, 168.

(*z*) See *infra*.

(*a*) (1911), 28 R. P. C. 181.

(*b*) *Ibid.* at p. 218.

(*c*) Pp. 260, 338, 354, *ante*.

(*d*) Pp. 281, 283, *ante*, and p. 480, *post*.

(*e*) See p. 343, *ante*, and p. 369, *post*.