

LETTERS PATENT FOR INVENTIONS.

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Sir John Hobbes
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From the author.

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ABSTRACT OF REPORTED CASES

RELATING TO

LETTERS PATENT FOR INVENTIONS.

BY

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P R E F A C E .

WITH a view to compress an abstract of the many long and complicated cases relating to patents for inventions within the limits of the present work, the writer has been careful to disentangle the real points in issue by a studied analysis of the decisions relating thereto, and has in every instance closely examined the specifications of the several patents now collected in the Library of the Patent Office.

It has been too much the practice, hitherto, to discuss the principles of law involved in a patent case without minute and trustworthy reference to the details of the particular invention as set forth by the express language of the specification and claim. But in order to understand the reasons which have influenced the Court or a jury in the decisions at which they have arrived, and in order to apply the principles involved in one case to the solution of a question arising in an analogous case, the patent itself must be before those dealing with the subject, or the arguments may be incorrectly founded, and the conclusion may be erroneous. The reference to a patent case is often eminently unsatisfactory, by reason that the statement of the invention or claim is given in general terms, and not in the words of the specification; from whence it may and often does arise that a proposition which is applicable to one existing state of facts is treated as if it were applicable to all other states of facts which come within the terms of a verbal definition, but are

really excluded from the primary meaning of the general proposition. One object of the present book has been to avoid this imperfect method of dealing with patent cases, and the plan which has been adopted may now be pointed out.

The pleadings are given, and the invention is described by following as closely as possible the language of the specification and by adding such information as may be necessary for its due comprehension. The claim is stated, together with the evidence at the trial, the direction of the judge, and the verdict or finding of the jury. Then follow the ulterior proceedings, which are extracted from the Reports, the only liberty taken being the allocation of detached sentences or parts of sentences, so as to cause the judgments of the learned judges to appear in each abstract as one continuous whole, though in an abbreviated form. Cases involving points of practice which have become obsolete are omitted; but some others, which might have been left out, are inserted as being of interest in recording the progress of patent law. Instead of an index, there is given a table of contents which may serve the purpose in view, and is so framed as to indicate to some extent the leading principles which govern the application of this branch of law. Having regard to the expected legislation upon patents for inventions, the cases before the Privy Council and caveats at the Great Seal have not been inserted.

T. M. GOODEVE.

GOLDSMITH BUILDING, TEMPLE:
July 1876.

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SUBJECT-MATTER OF A PATENT.

By stat. 21 Jac. I. cap. 3. sect. 6, all monopolies are rendered void except 'letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents or grant of such privilege hereafter to be made.'

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- 167 *Per* Lord Eldon, L.C.—Matter both of actual discovery and of useful discovery is the only proper subject for the protection of a patent.
- 108 *Per* Wood, V.C.—A thing of no value cannot be patented, but the invention must be a new and useful improvement in manufacture.
- 45 The word 'manufacture' commented on by Eyre, C.J.
- 94 The same by Pollock, C.B.
- 266 The same by Lord Westbury, L.C.
- 323 The same by Abbott, C.J.
- 180 *Per* Lord Kenyon, C.J. [referring to *J. Watt's* patent, A.D. 1769, No. 913].—I have no doubt in saying that this is a patent for a manufacture, which I understand to be something made by the hands of man.
- 45 Whether the manufacture be produced by accident or by art, is immaterial.
- 88 *Per* Tindal, C.J.—If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether of some lucky thought, or of mere accidental discovery.
- 45 There cannot be a patent for a mere principle.

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- 46, 227 But for a principle embodied with corporeal substances so as to produce effects in any art, trade, or manual occupation there may be a patent.
- 69 Thus, *per* Lord Westbury, the refrigerating effect of air upon the sides of a tank for holding melted glass, is a thing for which, *per se*, no patent could be claimed; but an apparatus so constructed as to bring into operation the cooling property of atmospheric air, and to produce a useful effect, is the subject-matter of a patent.
- 128 *Cooke & Wheatstone's* patent (A.D. 1837, No. 7,390), so far as it related to the giving of duplicate signals at intermediate stations—supported, as showing the manner in which a principle might be carried out in practice.
- 189 *Per* Alderson, B.—There may be a patent for a principle coupled with the mode of carrying the principle into effect, provided both the principle and the mode of carrying it into effect have been discovered by the inventor.
- 227 A claim to every mode of carrying a principle into effect is the same thing as a claim to the principle itself.
- 210 *Minter's* patent (A.D. 1830, No. 6,034)—supported.
- 211 But afterwards upset, the claim being too large.
- 238 *Newton's* patent (A.D. 1843, No. 9,724)—supported, as embodying a new principle in a new construction.
- 48, 217 A new addition to an existing machine is the subject of a patent.
- 47, 61, 198 A new combination of old parts is the subject of a patent.
- 66 *Pocheron's* patent (A.D. 1866, No. 1,297) for an apparatus to be used in melting glass, consisting of:—(1), a tank; (2), a fire placed laterally to the tank; (3), the forming of a channel round the tank for the free circulation of atmospheric air—supported.
- 87 *Crane's* patent (A.D. 1836, No. 7,195) for applying a hot-air blast to the smelting of iron by anthracite coal—supported, as a new combination.
- 222 *Per* James, L.J.—The word 'combination' is not properly applied in *Crane v. Price*; but no judge has ever questioned the principle laid down by Tindal, C.J. in deciding that case, viz., 'That if the result produced by a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute.'
- 80 Distinct improvements, for distinct purposes, are not to be classed together as parts of a combination.
- 89, 335 In point of law, there may be a valid patent for a combination which includes part of an invention already protected by a patent.
- 293 *Per* Lord Westbury, L.C.—A combination of known things

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- which is attended with results of such utility and advantage to the public as to be rightly denominated 'a substantial improvement' is the subject of a patent.
- 319 *Per Tindal, C.J.*—Although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose.
- 102 *Per Lord Westbury, L.C.*—Where an invention is nothing more than a particular means to attain to a given result, which is well known, then the invention is for the means; and you cannot say that the invention of one set of means interferes with the invention of another, any more than you could say originally that there ought not to be patents granted for the invention of distinct means to an end. The discovery of a particular road to attain a particular end, does not at all interfere with the discovery of another road to attain that end.
- 167 *Per Lord Eldon, L.C.*—There may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials.
- 145 A new process may be the subject of a patent.
- 267 The word 'manufacture' comprehends a new process, or an improvement of an old process.
- 45 *Per Eyre, C.J.*—New processes in any art producing effects useful to the public are to be classed as manufactures.
- 94 Observation by Pollock, C.B. to the same effect.
- 317 *Swinborne's* patent (A.D. 1847, No. 11,975) for a process of manufacturing gelatine—supported.
- 324 A known substance, produced by a new process, is 'a new manufacture.'
- 330 *Willcox's* patent (A.D. 1862, No. 448)—supported, as a patent for a process and not for a product.
- 42 An invention for dispensing with one part of a double process may be patented.
- 47 *Per Gibbs, C.J.*—In point of law, it is necessary that the plaintiff should prove that this is a new and useful invention, in order to entitle himself to the present action [for infringement of a patent].
- 215 *Per Alderson, B.*—If an invention be of any use to the public, that is sufficient to support a patent.
- 158 In *Haworth v. Hardcastle*, the jury found that the invention was useful upon the whole, but that in some cases it was not useful; whereupon the Court inferred that the invention was useful in the generality of cases, and supported the patent.

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- 206 In *Manton v. Parker* it was shown by experiments made in Court that the utility of the invention wholly failed, and the plaintiff was nonsuited.
- 214 Failure of utility in part of an invention. (*Morgan v. Seaward.*)
- 194 In *Lewis v. Marling*, a brush for raising the surface of cloth about to be shorn was claimed in the specification, but turned out to be useless; nevertheless the patent was sustained.
- 216 This case commented on by Parke, B.
- 265 *Per Erle, C.J.*—Although a patentee may have discovered how to use a known machine more beneficially than the owner knew, he cannot take a grant which virtually prohibits the owner from an existing right over his own property.
- 307 Judgment of Cresswell, J. to the same effect.
- 190 A more beneficial adjustment of the distance of certain working parts in a known machine is not the subject of a patent.
- 267 Every useful discovery is not the subject of a patent. The discovery must be shown to come within a fair extension of the meaning of the words, 'a new manufacture.'
- 219 *Per Tindal, C.J.*—Where unknown qualities possessed by a natural earth or stone, have, from the result of experiments, been applied to useful purposes of life, such application is a proper ground for a patent.
58. A new use of an old machine is not the subject of a patent.
- 59 *Per Lord Campbell, C.J.*—It may well be that a patent may be valid for the application of an old invention to a new purpose; but to make it valid, there must be some novelty in the application. In all cases in which a patent has been supported, there has been some discovery, some invention. It has not been merely the application of old machinery, in the old manner, to an analogous substance. That cannot be the subject of a patent.
- 104 *Cutler's* patent (A.D. 1841, No. 9,140) for such an application, repealed by *sci. fa.*
- 152 *Wild's* patent (A.D. 1853, No. 651) for a new use of channelled iron in fishing or jointing rails for railways—not supported.
- 62 *Bush's* patent (A.D. 1841, No. 9,094) for a new use of a caisson for working under water—not supported.
- 180 *Horton's* patent (A.D. 1851, No. 13,436) for the use of channelled iron in forming hydraulic joints for gas-holders—not supported.
- 187 *Jordan's* patent (A.D. 1849, No. 12,824) for application of a timber coating to an iron frame in ships—not supported.
- 190 *Kay's* patent (A.D. 1825, No. 5,226)—not supported.
- 201 *Losh's* patent (A.D. 1830, No. 5,989) for the use of iron wheels on railways—not supported.
- 212 *Morewood's* patent (A.D. 1843, No. 9,720)—left in doubt.
- 240 *Ormson's* patent (A.D. 1857, No. 2,441) for casting a boiler of known form in one piece—not supported.

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- 248 A spherical sliding door to a spherical glass lamp, where a cylindrical sliding door has been previously fitted to a cylindrical lamp, is not the subject of a patent.
- 260 *Potter's* patent (A.D. 1842, No. 9,366) held to be bad, as not distinguishing an improvement included in the patent, and published before the date thereof.
- 326 *Willis's* patent (A.D. 1851, No. 13,538) for a new use of a double-beat valve in organs—not supported.
- 297 *Steiner's* patent (A.D. 1843, No. 9,860)—left in doubt so far as the proceedings were carried.
- 248 The application of a well-known tool to work previously untried materials is not the subject of a patent.
- 261 If the means essential for a novel application of an old thing be new, the patent may be supported. (*Pow v. Taunton.*)
- 252 *Penn's* patent (A.D. 1854, No. 2,114), for hard-wood bearings for propeller shafts—supported, notwithstanding an objection that it was merely a new application of an old thing.
- 270 The use of a new material to produce a known article is not the subject of a patent.
- 19, 124 If the invention be new in *England*, though practised beyond the sea before, a patent may be granted.
- 19 It does not lie upon the first importer of an invention to prove that its introduction was meritorious.
- 21 If a man keeps his invention shut up for twenty years, he may still have a patent for it.
- 3 A subordinate improvement, suggested by a servant who is employed to carry out experiments, may be embodied in a patent by his master, in a case where the invention is complete without reference to the improvement. (*Allen v. Rawson.*)
- 5 Relation of master and servant in *Rex v. Arkwright.*
- 14 The same in *Barker v. Shaw.*
- 38 The same in *Bloxam v. Elsee.*

Patents (not otherwise specially referred to) supported in respect of the Subject-matter.

- 7 *Johnson's* patent (A.D. 1860, No. 600).
- 29 *Betts's* patent (A.D. 1849, No. 12,415). The objection being that a claim for the manufacture of capsules out of the patented material was bad.
- 51 *Bovill's* patent (A.D. 1849, No. 12,636).
- 83 *Sievier's* patent (A.D. 1833, No. 6,366).
- 87 *Crane's* patent (A.D. 1836, No. 7,195).
- 170 *Hills's* patent (A.D. 1849, No. 12,867).
- 193 *Lewis, Lewis & Davis's* patent (A.D. 1818, No. 4,196).
- 237 *Newton's* patent (A.D. 1843, No. 9,724).
- 293 *Stead's* patent (A.D. 1838, No. 7,645).

Patents (not otherwise specially referred to) upset as claiming something not the Subject-matter of a valid grant.

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| 42 | <i>Booth's</i> patent (A.D. 1852, No. 14,116). Claim:—'The making of gas direct from seeds,'—not in any mode pointed out in the specification, but generally. |
| 58 | <i>Brook & Hirst's</i> patent (A.D. 1856, No. 473). |
| 208 | <i>Metcalf's</i> patent (A.D. 1816, No. 4,065). |
| 304 | <i>Teiley's</i> patent (A.D. 1846, No. 11,081) held to be bad, both on this ground and also for want of novelty. |
| 313 | <i>Amet's</i> patent (A.D. 1856, No. 1,729), as claiming merely to substitute steel wire for whalebone in a known thing. |
| 325 | <i>White's</i> patent (A.D. 1864, No. 1,055) for sewing folds upon falls for bonnets in a specified manner. |

TITLE OF PATENT.

Objections to the title over-ruled in the following Patents:—

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| 18 | <i>Berry's</i> patent (A.D. 1839, No. 8,194) for the daguerreotype process. |
| 82 | <i>Cook's</i> patent (A.D. 1840, No. 8,392), where Tindal, C.J. referred to the ruling in <i>Cochrane v. Smethurst</i> . (See page 81.) |
| 117 | <i>Derosne's</i> patent (A.D. 1830, No. 6,002). The objection being that the double process set forth in the title was not duly specified. |
| 125 | <i>Cooke & Wheatstone's</i> patent (A.D. 1837, No. 7,390). |
| 135 | <i>Sneath's</i> patent (A.D. 1831, No. 6,208). |
| 167 | <i>Hills's</i> patent, after disclaimer (A.D. 1849, No. 12,867). |
| 208 | <i>Mill's</i> patent (A.D. 1846, No. 11,266), after disclaimer. |
| 225 | <i>Neilson's</i> patent (A.D. 1828, No. 5,701). |
| 239 | <i>Nickels's</i> patent (A.D. 1842, No. 9,252). The objection being that in a patent for 'improvements' only one improvement was specified. |
| 241 | <i>Oxley's</i> patent (A.D. 1858, No. 776), where the patent was for 'improvements in the doors and sashes of carriages,' and the specification described improvements applicable to doors and windows generally. |
| 293 | <i>Stead's</i> patent (A.D. 1838, No. 7,645). |
| 301 | <i>Christ's</i> patent (A.D. 1827, No. 5,463). |

Patents upset on objections founded on a comparison of the Title and Specification.

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| 12 | <i>Bainbridge's</i> patent (A.D. 1803, No. 2,693), where the consideration for the grant was not truly set forth. |
| 38 | <i>Gamble's</i> patent (A.D. 1801, No. 2,487) for the first machine for making paper. |
| 60 | <i>Brunton's</i> patent (A.D. 1813, No. 3,671). |
| 65 | <i>Campion's</i> patent (A.D. 1813, No. 3,682). |
| 81 | <i>Cochrane's</i> patent (A.D. 1813, No. 3,657). |
| 89 | <i>Croll & Richards's</i> patent (A.D. 1844, No. 10,096). Here the patentees specified an invention differing in part from that for which the |

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| | patent had been granted; and, further, recited the title incorrectly in the specification. |
| 133 | <i>Felton's</i> patent (A.D. 1827, No. 5,512). |
| 208 | <i>Metcalf's</i> patent (A.D. 1816, No. 4,065). |
| 214 | <i>Galloway's</i> patent (A.D. 1829, No. 5,805). |
| 323 | <i>Wheeler's</i> patent (A.D. 1817, No. 4,112). |

SPECIFICATION.

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| 5 | A specification is addressed to persons having skill in the subject-matter thereof. |
| 73, 167 | Obligation in specifying (<i>per</i> Lord Eldon, L.C.). |
| 6 | A specification must not require those working under it to make any new inventions or additions. |
| 214 | <i>Per</i> Alderson, B.—It may call upon a workman to exercise all the actual existing knowledge common to the trade, but not to exercise his ingenuity or invention. |
| 20, 318 | It must define the invention so that an ordinary and skilful workman may carry it out. |
| 320 | Whether it has done so or not will be a question for the jury. |
| 40 | <i>Per</i> Abbott, C.J.—An inventor of a machine is allowed to call in aid the drawings which he annexes to the specification. |
| 45 | It is only necessary that the nature of the improvement should be understood, and <i>Watt's</i> patent for a steam-engine (A.D. 1769, No. 913) was held good without a drawing. |
| 206, 300, 324 | A specification must not leave anything to experiment. |
| 220 | <i>Per</i> Tindal, C.J.—People are not to make experiments at a great expense to themselves which shall turn out to be bootless and fruitless; but they rely on an honest and open and candid exposition by the patentee of everything that is necessary for the certain and easy procurement of the commodity for which the patent was granted. |
| 227 | Although a specification is bad when no beneficial result can be obtained without experiments, it is otherwise when experiments are only needed for producing that beneficial result in a higher degree. |
| 119 | Any ingredient set down for use must not be detrimental. |
| 301 | <i>Per</i> Lord Lyndhurst, L.C.—There must be the utmost good faith in a specification. |
| 316 | It must describe the invention in the clearest and most unequivocal terms of which the subject is capable. |
| 145 | <i>Per</i> Cresswell, J.—A patentee is bound to define his invention clearly in the specification, in order that the public may know with certainty what they may or may not do without incurring the risk of an action for an infringement of the patent. |
| 306, 320 | A specification must give the best information within the knowledge of the patentee. |

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- 66, 141 It must not be ambiguous.
- 157 Nor equivocal.
- 90, 275, 316 Nor misleading.
- 6 The public have a right to demand a fair, full, and true discovery from one who gets so great a reward as a monopoly for fourteen years.
- 250 *Johnson's* patent for type metal (A.D. 1854, No. 817). Wood, V.C. held that a certain latitude in stating the proportions of the compound metal was permissible.
- 32 *Betts's* patent (A.D. 1849, No. 12,415)—supported on the ground that the proportions of lead and tin in the patented metal were sufficiently described by assigning the relative thicknesses of the plates of lead and tin before rolling. Such proportions are given rather as illustrations of the mode of user of the process than as definite *termini* which cannot be deviated from.
- 92 The public have a right to be put in possession of all that the patentee knows at the time of specifying.
- 48 There must be no fraudulent concealment.
- 6 *Per* Buller, J.—If a specification, in any part of it, be materially false and defective, the patent is against law, and cannot be supported.
- 93 The thing specified must be limited to the *bonâ fide* invention of the patentee.
- 268 Obligation in specifying where an invention is in part communicated from abroad.
- 84 Test of sufficiency of specification (*per* Tindal, C.J.).
- 284 *Medlock's* patent (A.D. 1860, No. 126) objected to, on the ground that the direction to take 'dry arsenic acid' was insufficient; but Lord Westbury, L.C. over-ruled the objection.
- 20, 285 A specification which describes two ways of doing a thing, whereof one is impracticable, cannot be sustained.
- 305 A mistake may be corrected by reference to the specification itself.
- 18 *Berry's* patent (A.D. 1839, No. 8,194)—supported on this ground.
- 284 But errors which are only discoverable by experiment and further inquiry are fatal to the patent.
- 226 A statement which is erroneous and untrue will vitiate a specification.
- 40, 118 Introduction of *French* words into specifications drawn by foreigners. Patents supported.
- 220 *Per* Tindal, C.J.—If the specification [of *Muntz's* patent, A.D. 1832, No. 6,325] is not only difficult to understand, but is actually false and incorrect in the statement of proportions of zinc and copper, there is an end at once of the patent.
- 205 The omission of a material statement cannot be corrected by reference to the provisional specification.
- 190 *Per* Lord Cottenham, L.C.—The claim is not intended to aid the

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- description, but is introduced for the security of the patentee, that he may not be supposed to claim more than he can support as an invention.
- 200 A specification may be good without a claim, and those matters which manifestly form no part of the invention need not be disclaimed.
- 211 The claim must not go beyond the invention.
- 242 Claim in *Oxley's* patent (A.D. 1858, No. 773) construed favourably for the patentee.
- 114, 277 After disclaimer the specification will be construed strictly.
- 265 But in *Ralston's* patent (A.D. 1858, No. 2,654, in part disclaimed), a claim to spiral grooves was held to include circular rings.
- 72 *Per* Lord Abinger, C.B.—A patentee should state what his invention is, what he claims to be new, and what he admits to be old.
- 307 *Per* Coleridge, J.—‘If a specification includes what is old as well as what is new, the patentee must be taken to claim all, unless he makes it clearly appear that he does not claim that which is old.’ Those parts which are notoriously old need not be disclaimed.
- 177 *Harrison's* patent (A.D. 1841, No. 8,818) upset for a breach of the above rule.
- 47 The like of *Bovill's* patent (A.D. 1811, No. 3,434).
- 204 The like of *McGregor's* patent (A.D. 1808, No. 3,189).
- 274 The like of *Saunders's* patent (A.D. 1825, No. 5,264).
- 299 *Martin's* patent (A.D. 1834, No. 6,688) upset for not distinguishing what acids and alkalis were claimed, and for not distinguishing those which would answer the purpose of the invention.
- 140 *Per* Lord Westbury, L.C.—The specification of a new combination or arrangement of machinery must assign the *differentia* thereof.
- 151 Or contain within itself the means of distinguishing the improvement. (See page 140.)
- 247 The specification of *Parke's* patent (A.D. 1865, No. 2,615) read with a prior specification of same inventor (A.D. 1862, No. 1,876), and supported.
- 260 Any part of an improved machine which has been previously published should be distinguished.
- 227 *Per* Parke, B.—The construction of the specification belongs to the Court alone, whose duty it is to construe all such instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained as facts by the jury. (See page 309.)
- 171 This proposition commented on by Lord Westbury, L.C.
- 27 *Per* Lord Westbury, L.C.—Where two documents profess to describe an external thing, the identity of signification between the two documents containing the same description must belong to the province of evidence, and not to the province of construction.
- 158 *Per* Tindal, C.J.—There is no rule of law which requires the Court

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to make any forced construction of a specification, but it is to be construed consistently with the fair import of the language used.

- 299 Direction of Pollock, C.B. to the same effect.
- 237 It should not be scanned as if it were a plea specially demurred to.
- 272 *Per Parke, B.*—The Court is bound to read the specification so as to support the patent if it can be fairly done.
- 310 The rule in construing being:—‘*ut res magis valeat quam pereat.*’
- 245 *Per Pollock, C.B.*—Where any expressions are ambiguous, we should endeavour to give effect to the intention; and, moreover, every patent should be expounded favourably to the patentee.
- 20 *Per Cresswell, J.*—The judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result.

Questions of Construction arising on the Specifications of the following Patents:—

- 7 *Johnson's patent* (A.D. 1860, No. 600).
- 18 *Berry's patent* (A.D. 1839, No. 8,194).
- 48 *Bovill's patent* (A.D. 1846, No. 11,342).
- 51 *Bovill's patent* (A.D. 1849, No. 12,636).
- 114 *De la Rue's patent* (A.D. 1849, No. 12,904).
- 125 *Cook & Wheatstone's patent* (A.D. 1837, No. 7,390).
- 129 *Elliott's patent* (A.D. 1837, No. 7,508).
- 136 *Judkin's patent* (A.D. 1852, No. 413), after disclaimer.
- 147 *Goucher's patent* (A.D. 1848, No. 12,343).
- 167 *Hills's patent* (A.D. 1849, No. 12,867).
- 189 *Jupe's patent* (A.D. 1835, No. 6,788).
- 241 *Oxley's patent* (A.D. 1858, No. 776).
- 252 *Penn's patent* (A.D. 1854, No. 2,114).
- 263 *Ralston's patent* (A.D. 1858, No. 2,654), after disclaimer.
- 271 *Whitehouse's patent* (A.D. 1825, No. 5,109).
- 277 *Seed's patent* (A.D. 1846, No. 11,293), after disclaimer.
- 282 *Medlock's patent* (A.D. 1860, No. 126).
- 291 *Spencer's patent* (A.D. 1860, No. 120).
- 304 *Tetley's patent* (A.D. 1846, No. 11,081), both before and after disclaimer.
- 311 *Thomas's patent* (A.D. 1853, No. 1,026), after disclaimer.
- 313 *Trotman's patent* (A.D. 1852, No. 14,076).
- 317 *Swinborne's patent* (A.D. 1847, No. 11,975).

Comparison and Construction of Specifications by the Court in the following selected Cases:—

- 3 *Williams's patent* (A.D. 1840, No. 8,387), and *Robertson's patent* (A.D. 1838, No. 7,608).
- 22 *Betts's patent* (A.D. 1849, No. 12,415), and *Dobbs's patent* (A.D. 1804, No. 2,761).

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- 43 *Booth's* patent (A.D. 1852, No. 14,116), and *Heard's* patent (A.D. 1829, No. 5,771).
- 49 *Bovill's* patent (A.D. 1846, No. 11,342), compared with *Gordon's* patent (A.D. 1844, No. 10,165).
- 62 *Bush's* patent (A.D. 1841, No. 9,094), and *Cochrane's* patent (A.D. 1830, No. 6,018).
- 167, 170 *Hills's* patent (A.D. 1849, No. 12,857), compared with those of *Heard* (A.D. 1806, No. 2,941), *Croll* (A.D. 1840, No. 8,577), and *Laming* (A.D. 1847, No. 11,944).
- 177 *Harrison's* patent (Jan. 28, A.D. 1841, No. 8,818), and *Handcock's* patent (Dec. 18, A.D. 1840, No. 8,745).
- 218 *Muntz's* patent (A.D. 1832, No. 6,325), and *Collins's* patent (A.D. 1800, No. 2,390).
- 220 *Murray's* patent (A.D. 1866, No. 1,581), and *Dahlke's* patent (A.D. 1863, No. 49).
- 272 *Whitehouse's* patent (A.D. 1825, No. 5,109), and *Russell's* patent (A.D. 1824, No. 4,892).
- 307 *Tetley's* patent (A.D. 1846, No. 11,081), and *Ruthven's* patent (A.D. 1841, No. 8,896).
- 309 *Thomas's* patent (A.D. 1846, No. 11,464), and *Fisher & Gibbons's* patent (A.D. 1844, No. 10,424).
- 329 *Willcox's* patent (A.D. 1862, No. 448), and *Orr's* patent (A.D. 1867, No. 3,093).

Specifications of certain Patents which have been held sufficient.

- 250 *Johnson's* patent (A.D. 1854, No. 817). Held good on demurrer; the objection being that the proportions of tin and antimony in a patented type metal were not sufficiently stated.
- 7 *Johnson's* patent (A.D. 1860, No. 600)—supported by the Court before issues granted.
- 22 *Betts's* patent (A.D. 1849, No. 12,415). The objection being—that the proportions of lead and tin in the plated metal were not stated.
- 37 *Bickford's* patent (A.D. 1831, No. 6,159).
- 51 *Bovill's* patent (A.D. 1849, No. 12,636).
- 91 *Clegg's* patent (A.D. 1815, No. 3,968).
- 167, 170 *Hills's* patent (A.D. 1849, No. 12,867).
- 180 *J. Watt's* patent (A.D. 1769, No. 913). The objections being—that a patent for a steam engine with a separate condenser was a patent for a principle, and that the description was insufficient.
- 218 *Muntz's* patent (A.D. 1832, No. 6,325).
- 225 *Neilson's* patent (A.D. 1828, No. 5,701) for the application of the hot-blast in smelting iron.
- 245 *Parkes's* patent (A.D. 1865, No. 2,615)—supported by reference to prior patent of same inventor.
- 252 *Penn's* patent (A.D. 1854, No. 2,114).
- 262 *Poupard's* patent (A.D. 1859, No. 166).

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- 271 *Whitehouse's* patent (A.D. 1825, No. 5,109).
 311 *Thomas's* patent (A.D. 1853, No. 1,026), after disclaimer.
 317 *Swinborne's* patent (A.D. 1847, No. 11,975).

Specifications insufficient.

- 5 *Arkwright's* patent (A.D. 1775, No. 1,111).
 47 *Brown's* patent (A.D. 1811, No. 3,434).
 117 *Derosne's* patent (A.D. 1830, No. 6,002).
 136 *Judkins's* patent (A.D. 1852, No. 413).
 156 *Johnstone's* patent (A.D. 1844, No. 10,446).
 204 *McCregor & Macfarlane's* patent (A.D. 1808, No. 3,189).
 204 *Macklean's* patent (A.D. 1857, No. 2,338).
 263 *Ralston's* patent (A.D. 1858, No. 2,654), after disclaimer.
 275 *Savory's* patent (A.D. 1815, No. 3,954).
 282 *Medlock's* patent (A.D. 1860, No. 126).
 298 *Martin's* patent (A.D. 1834, No. 6,688).
 315 *Turner's* patent (A.D. 1781, No. 1,281).
 323 *Wheeler's* patent (A.D. 1817, No. 4,112).

Relation between the complete and provisional Specifications.

- 136 *Judkins's* patent (A.D. 1852, No. 413).
 230, 233 *Newall's* patent (A.D. 1855, No. 1,091).
 252 *Penn's* patent (A.D. 1854, No. 2,114).
 311 *Thomas's* patent (A.D. 1853, No. 1,026).
 329 *Willcox's* patent (A.D. 1862, No. 448).
 167 Variance between the deposit paper and the specification.
 92 *Per Lord Tenterden, C.J.*—I do not see why time is allowed to the inventor to prepare his specification, unless it be to allow him to mature the mechanical parts of his invention.
 241 Effect of provisional specification when abandoned.

Questions relating to Disclaimers.

- 136 *Judkins's* patent (A.D. 1852, No. 413).
 208 Admissibility of disclaimer in evidence.
 263 Function and validity of disclaimer in *Ralston's* patent (A.D. 1858, No. 2,654).
 277 *Seed's* patent (A.D. 1846, No. 11,293).
 311 *Thomas's* patent (A.D. 1853, No. 1,026).

NOVELTY OF INVENTION.

- 237 *Per Alderson, B.*—In considering whether an invention is new, the proper mode is to take the specification and see whether the matter claimed *as a whole* is new. The question of novelty will depend on whether the whole taken together is new.
 69 Test of novelty (*per Lord Hatherley, L.C.*)
 88 *Per Tindal, C.J.*—If the invention be new and useful to the public,

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- it is immaterial whether it be the result of profound research or of accidental discovery.
- 60, 166, 303, 308 If any material part of an alleged discovery fail in novelty, the patent is altogether void.
- 182 *Per* Lord Lyndhurst, L.C.—The notorious public use of an invention before the granting of letters patent, although it may have been discontinued, is sufficient to invalidate the grant.
- 73 *Per* Alderson, B.—Public use means a use in public so as to come to the knowledge of others than the inventor. And, *per* Lord Abinger, C.B.—It means a use and exercise in public, not by the public.
- 73 It need not appear that the invention was used up to the time of taking out the patent.
- 85 If the secret covered by a patent has been previously publicly communicated to the world by any one, there is an end of the patent.
- 182 *Per* Lord Lyndhurst, L.C.—If the machine be published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent?
- 85 The same by Tindal, C.J.
- 7 Evidence of prior publication in *Rex v. Arkwright*.
- 145 If a man has borrowed an invention from some other person, or taken it from a book, or learnt it from a specification, he is not the true and first inventor.
- 28 A barren general suggestion, not capable of practical operation, will not avoid, for want of novelty, an invention which involves a practical truth productive of beneficial results.
- 31 In order to anticipate a patent the anterior description should enable those who work under it, and are of competent mechanical skill, to arrive at the same result as if they followed the process contained in the subsequent patent.
- 171 *Per* Lord Westbury, L.C.—The prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent.
- 22 Evidence of prior publication in *Betts v. Menzies*.
- 170 Evidence of prior publication in *Hills v. Evans*.
- 192 Evidence of prior publication in *Lang v. Gisborne*.
- 220 Evidence of prior user in *Muntz v. Foster*.
- 295 Observations (*per* Tindal, C.J.) on prior publication. (*Stead v. Williams*.)
- 296 The same by Parke, B. (*Stead v. Anderson*.)
- 241 *Oxley v. Holden*. Effect of provisional specification when abandoned.
- 217 The deposition (for sale) of patented articles in a warehouse, without actual sale, held not to be sufficient evidence of publication to defeat a claim for novelty of invention.

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- 25 *Betts's* patent (A.D. 1849, No. 12,415)—supported on the ground of novelty, although the patentee had manufactured large quantities of his capsules before the date of the patent.
- 30 In *Betts v. Neilson*, Lord Chelmsford, L.C. said that if the evidence established the fact that *Betts's* compound metal had, upon any occasion before the patent, been manufactured openly, not by way of experiment but in the course of business, although not a single piece of the material had been actually sold, he should hold that the patent was invalidated.
- 72 Where certain locks were made and sold in *England* (presumably for export) before being patented, Lord Abinger, C.B. was of opinion that the novelty of the invention was destroyed.
- 179, 327 Prior public sale.
- 164 *Per Erle, J.*—Where a manufacturer has used a process for profit, and has kept the method entirely secret, I am not prepared to say that another person could have a valid patent for the process. And, *per Lord Campbell, C.J.*—If a man makes a discovery, and uses it without taking out a patent, he need not suspend the use because another person subsequently makes the same discovery, and takes out a patent for it.
- 85 In *Cornish v. Keene*, Tindal, C.J. directed the jury:—If the defendants have shown that they practised the invention, and produced the same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done.
- 142 A mere course of experiments for the purpose of producing a result which is not carried on to perfection, and which rests in unsuccessful experiment, will be no bar to a subsequent patent for the completed invention.
- 145 It will not be enough that learned persons in their studies had foreseen or found out a discovery that is afterwards patented.
- 85 *Per Tindal, C.J.*—A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; but if he does not communicate them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, may take out a patent for the invention; and it will be no answer to him to say that another person before him had made the same experiments, and therefore that he was not the first discoverer.
- 122 *Dollond's* patent (A.D. 1758, No. 721)—supported on this ground.
- 337 Great Seal refused, where the invention had been used in view of the public before application for a patent.
- 86 Whether a discovery has rested in experiment or has come into public use is a question for the jury.
- 21 *Thornton's* patent (A.D. 1841, No. 9,207)—supported, where a machine for making wire cards had been lent for an experimental trial.

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- 232 *Newall's* patent (A.D. 1855, No. 1,091)—supported, although there had been prior experimental user of the apparatus.
- 141 *Galloway v. Bleaden*.
- 185 *Jones's* patent (A.D. 1826, No. 5,415)—supported, where an experimental wheel made on the suspension principle (as subsequently patented) had been publicly used, but abandoned as useless.
- 320 *Wallon's* patent (A.D. 1834, No. 6,584)—supported.
- 179 *Porter's* patent (A.D. 1838, No. 7,774)—not supported.
- 43 When the want of novelty appears distinctly on a comparison of two specifications, the Court will not submit the question of identity of the documents to the jury.
- 27 *Per Wilde, B.*—The Court can pronounce two identical descriptions to portray identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence.
- 222 *Per James, L.J.*—I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out a failure, can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines.

Patents supported for Novelty of Invention.

- 1 *Williams's* patent (A.D. 1840, No. 8,387).
- 15 *Bateman & Moore's* patent (A.D. 1848, No. 12,032).
- 22 *Betts's* patent (A.D. 1849, No. 12,415).
- 51, 53 *Bovill's* patent (A.D. 1849, No. 12,636).
- 66 *Pocheron's* patent (A.D. 1866, No. 1,297).
- 87 *Crane's* patent (A.D. 1836, No. 7,195)—supported, although it included the subject-matter of another patent then running and in force.
- 141 *Galloway's* patent (A.D. 1835, No. 6,887).
- 184 *Kneller's* patent (A.D. 1828, No. 5,718).
- 194 *Lewis, Lewis & Davis's* patent (A.D. 1818, No. 4,196).
- 214 *Galloway's* patent (A.D. 1829, No. 5,805).
- 218 *Muntz's* patent (A.D. 1832, No. 6,325).
- 220 *Murray's* patent (A.D. 1866, No. 1,581).
- 225 *Neilson's* patent (A.D. 1828, No. 5,701).
- 235, 237 *Newton's* patent (A.D. 1843, No. 9,724).
- 252 *Penn's* patent (A.D. 1854, No. 2,114).
- 262 *Poupard's* patent (A.D. 1859, No. 166).
- 271, 272 *Whitehouse's* patent (A.D. 1825, No. 5,109).
- 318, 320 *Walton's* patent (A.D. 1834, No. 6,584).
- 331 *Young's* patent (A.D. 1850, No. 13,292).

Patents upset for want of Novelty.

- 42 *Booth's* patent (A.D. 1852, No. 14,116).
- 60 *Brunton's* patent (A.D. 1813, No. 3,671). Here the patent was for three improvements, whereof one was old.

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| 62 | <i>Bush's</i> patent (A.D. 1841, No. 9,094). |
| 65 | <i>Campion's</i> patent (A.D. 1813, No. 3,682). |
| 103 | <i>Cutler's</i> patent (A.D. 1815, No. 3,873). |
| 121 | <i>Dobbs's</i> patent (A.D. 1838, No. 7,716). |
| 131 | <i>Else's</i> patent (A.D. 1779, No. 1,235). |
| 142 | <i>Gamble's</i> patent (A.D. 1839, No. 8,000). |
| 144 | <i>Campbell & Gibson's</i> patent (A.D. 1836, No. 7,228). |
| 163 | <i>Heath's</i> patent (A.D. 1839, No. 8,021), after prolongation. |
| 179 | <i>Porter's</i> patent (A.D. 1838, No. 7,774), where an anchor, similar to that patented, was sold in the regular way of business. |
| 201 | <i>Losh's</i> patent (A.D. 1830, No. 5,989). |
| 202 | <i>Brooman's</i> patent (A.D. 1850, No. 13,398). |
| 206 | <i>Macnamara's</i> patent (A.D. 1837, No. 7,324). |
| 211 | <i>Minter's</i> patent (A.D. 1830, No. 6,034). |
| 259 | <i>Potter's</i> patent (A.D. 1842, No. 9,366). |
| 274 | <i>Saunders's</i> patent (A.D. 1825, No. 5,264). |
| 304 | <i>Tetley's</i> patent (A.D. 1846, No. 11,081). |
| 308 | <i>Thomas's</i> patent (A.D. 1846, No. 11,464). |
| 326 | <i>Willis's</i> patent (A.D. 1851, No. 13,538). |
| 327 | <i>Zink's</i> patent (A.D. 1812, No. 3,519). |

INFRINGEMENT.

- 319 *Per Tindal, C.J.*—Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, either to obtain a patent for it himself, or to use it without the leave of the patentee.
- 214 *In Morgan v. Seaward*, Alderson, B. directed the jury:—The question simply is, whether the difference consists merely in the substitution of what are called mechanical equivalents for the contrivances resorted to by the patentee. You are to look at the substance and not the mere form.
- 79 *Per James, L.J.*—In a patent for a combination there is, or may be, an essence or substance of the invention underlying the mere accident of form; and the invention may be pirated by a theft in a disguised or mutilated form. It will be a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.
- 237 *Per Pollock, C.B.*—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 purpose for which the patentee has adapted his invention, and the jury are of opinion that the difference is merely colourable, it is an infringement.
- 16 *Per Martin, B.*—The law will not permit a person to take an article

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- that has been patented, and to give a substitute in place of it, for the purpose of effecting the same end, by the use of equivalents, using the skill and knowledge which he may possess to evade the patent.
- 226 In *Neilson v. Harford*, Parke, B. directed the jury:—Though unquestionably what the defendants have done is a great improvement upon the apparatus constructed under this patent, it appears to me that it would be an infringement of it.
- 273 In *Russell v. Ledsam*, the Court of Exchequer held that the defendant's mode of welding the edges of iron tubes without a mandril, although in some respects an improvement on *Whitehouse's* patent (A. D. 1825, No. 5,109), was in others the same, and was an infringement of it.
- 16 In *Bateman v. Gray*, Martin, B. directed the jury:—If you believe that the defendant's instrument was taken substantially from the plaintiffs', and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiffs, it is my duty to tell you that is an infringement of the patent.
- 199 A patent for a combination may be infringed by taking a part, provided it is a new and material part, of the combination. Also, the part must be new in itself, not merely in its application. (*Lister v. Leather.*)
- 200 But it must be applied to an analogous purpose.
- 325 The parts of a combination taken must themselves be new, or there is no infringement. (*White v. Fenn.*)
- 52 In *Bovill v. Keyworth*, Lord Campbell, C.J. said:—The defendants are liable for having used a material part of the process which was new for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process specified.
- 282 Judgment of Pollock, C.B. in *Sellers v. Dickinson*.
- 287 Judgment of Lord Campbell, C.J. in *Smith v. London and North-Western Railway Company*.
- 237 *Per Alderson, B.*—If an invention consists of something new, and a combination of that with what is old, then if an individual takes for his own and uses that which is the new part of the patent, that is an infringement of it. (*Newton v. Grand Junction Railway Company.*)
- 247 *Per James, L.J.*—To say that a patent for an entire combination is a valid patent for a part when that part would not of itself have been patentable, is, in my judgment, a *reductio ad absurdum* of the supposed principle in *Lister v. Leather*.
- 249 *Per Willes, J.*—The infringement of any part of a patented process is actionable, if the part of itself is new and useful, so that it

- might be the subject-matter of a patent, and is used by the infringer to effect the object, or part of the object, proposed by the patentee.
- 125, 329 Infringement by pirating part of an invention
- 146 Where a patent is for improvements, and one of them has been pirated, an action may be sustained.
- 80 Distinct improvements for distinct purposes are not to be classed together under the head of a combination. (*Clark v. Adie.*)
- 71 A new combination of machinery directed to a particular purpose is infringed by the adoption of the same combination for ministering to another and additional purpose. (*Cannington v. Nuttall.*)
- 69 Where an object the same as that patented is attained by the same process, introduced for the purpose of attaining it—there is an infringement.
- 189 In *Jupe v. Pratt*, Alderson, B. said:—If you have not only discovered a principle, but have also invented some mode of carrying that principle into effect, you are entitled to protect yourself from all other modes of carrying the same principle into effect, such modes being treated by the jury as a piracy of your invention.
- 162 *Per Parke, B.*—There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself.
- 186 A man may make a patented article for his own amusement or as a model without infringing.
- 165 There is no infringement of a patent unless a saleable article is produced. (*Higgs v. Goodwin.*)
- 235 But the thing constructed may infringe without being separately prepared and vendible, as in the case of fitting a ship for the reception and laying of a telegraph cable. (*Newall v. Elliot.*)
- 50 The claim of invention in an action for infringement is that which the plaintiff is legally entitled to make.
- 280 *Per Lord Wensleydale.*—The opinion of scientific witnesses that one machine is a piracy of the other is of no consequence whatever, for that is a question not in their province to decide. (*Seed v. Higgins.*)
- In this case the models were before the Court, and the learned judges formed their own opinion as to the infringement.
- 116 Cases distinguished—where the judge is bound to submit the question of infringement to the jury.
- 183 In *Huddart v. Grimshaw*, the production of a piece of rope, having the essential qualities of that made according to plaintiff's patent, was held to be *primâ facie* evidence of infringement.
- 245 In *Palmer v. Wagstaffe*, where the patent was for the mode of making a candle with wicks which did not require snuffing, the

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| | simple production of a candle was held not to be evidence of infringement. |
| 29 | <i>Betts v. Neilson.</i> Infringement by the user of the patented article <i>in transitu</i> through <i>England</i> . |
| 33 | <i>Betts v. De Vitre.</i> Personal liability of directors of a company for infringement. |
| 36 | <i>Betts v. Willmott.</i> No evidence of infringement; the plaintiff being unable to show that the capsules in question had not been made and sold by his own house in <i>Paris</i> . |
| 130 | <i>Elmslie v. Boursier.</i> Infringement by importation and sale of patented articles. |
| 322 | The same in <i>Walton v. Lavater.</i> |
| 331 | An exclusive right to 'vend' is given by a patent. |
| 144, 329 | Infringement by sale of patented articles. |
| 210 | Exposure for sale. |
| 242 | User by offering patented articles for sale. |

Evidence of Infringement in the following cases:—

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| 1 | <i>Allen v. Rawson</i> (where a drum was substituted for an endless apron in a felting machine). |
| 15 | <i>Boteman v. Gray.</i> |
| 51 | <i>Bovill v. Keyworth</i> (where a rotating upper millstone was substituted for a fixed upper millstone). |
| 107 | <i>Dangerfield v. Jones.</i> |
| 114 | <i>De la Rue v. Dickenson</i> (where the flaps of envelopes were blown down by jets of air for the purpose of being folded in a machine instead of being creased by separate folding instruments; and, further, where gum was taken from a reservoir instead of from the surface of an apron). |
| 125 | <i>Electric Telegraph Company v. Brett</i> (where the patent was for giving signals by electric currents transmitted through <i>metallic circuits</i> , and the infringement consisted in the use of a circuit, part of which was the earth itself). |
| 142 | <i>Gamble v. Kurtz</i> (where a patent for the use of iron retorts worked in combination for the manufacture of sulphate of soda was infringed by the use of two chambers, one of brick and the other of iron). |
| 147 | <i>Goucher v. Clayton.</i> |
| 165 | <i>Hill v. Thompson.</i> |
| 173 | <i>Hills v. Liverpool Gas Company</i> (where a patent for purifying gas by artificial hydrated oxide of iron was held to be infringed by the use of bog-ochre after it had been re-oxidised). |
| 219 | <i>Muntz v. Foster.</i> <i>Per</i> Lord Lyndhurst, L.C.—If the metals were originally combined in their greatest purity, the invasion is plain and direct. If they were purified in the course of the process, |

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- this, I think, would constitute a colourable invasion of the plaintiff's invention.
- 220 *Murray v. Clayton* (where, in adapting a brick-making machine, defendants made a transposition, and instead of moving the clay against the cutting wires, they moved the cutting wires against the clay).
- 230 *Newall v. Elliot* (where a telegraph cable was coiled around a cone of small vertical angle with a conoidal top, and defendants used a cylindrical core with a hemispherical cover).
- 235 *Newton v. Grand Junction Railway Company* (where a patent for soft metal bearings was infringed by rubbing a piece of tin on the inside of a brass bearing when sufficiently heated to melt the tin and produce a layer of soft metal).
- 263 *Ralston v. Smith* (where, in a machine for giving a *moiré antique* finish to fabrics, the patentee used a roller with from sixty-two to seventy-four circular grooves per inch, and defendant had a spiral groove on a similar roller with sixty-eight turns to the inch).
- 271 *Russell v. Cowley*.
- 272 *Russell v. Ledsum*.
- 281 *Sellers v. Dickinson* (where, in a patented apparatus for stopping a loom automatically when the shuttle remained in the shed, defendant adopted a material portion, viz., a friction break).
- 286 *Smith v. London and North-Western Railway Company* (where defendants imitated a mode of welding separate pieces to form an iron wheel by welding sectors to form the nave).
- 313 *Trotman v. Wood*.
- 329 *Wright v. Hitchcock*.
- 331 *Young v. Fernie*.

Cases where the Allegation of Infringement has not been sustained.

- 13 *Barber v. Grace* (where a patent for finishing hosiery by pressure between hot boxes was not infringed by the use of heated rollers).
- 48 *Bovill v. Pimm*.
- 78 *Clark v. Adie*. Sub-combination of parts.
- 97 *Curtis v. Platt*. Where different combinations of like elements are employed to produce a known result, the case should not be examined in a generic form without regard to the specific differences which exist between the two agents. It cannot be said that there ought not to be separate patents granted for the invention of distinct means to an end.
- 159, 160, 161 *Heath v. Unwin* (where a patent for the use of carburet of manganese in the manufacture of cast steel was held not to have been infringed by the use of coal tar and oxide of manganese).
- 202 *McCormick v. Gray* (where the patent was for a reaping machine, and the infringement consisted in the making and selling of a cutting blade similar to that used in the patented machine).

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- 212 *Morewood v. Tupper*—left in doubt.
- 245 *Parkes v. Stevens* (where the patent was for a globular lamp with a sliding door; and the Court held that the use of a sliding door in a lamp of different construction, but the same form, did not constitute an infringement).
- 277 *Seed v. Higgins* (where, after disclaimer, plaintiffs were restricted to the particular apparatus shown in the drawing).
- 324 *White v. Fenn* (where the infringement related to a part of the patent which was not new).

PARTICULARS OF BREACHES.

- 17 Sufficiency of particulars of breaches where the patented article (a cartridge) was made an exhibit.
- 124 Particulars of infringement refused.
- 134 Practice as to delivery of particulars of breaches.
- 224 In a patent suit the particulars of breaches, taken together with the bill, ought to give the defendant full and fair notice of the complaint made against him.
- 302 Sufficiency of particulars of breaches.

PARTICULARS OF OBJECTIONS.

- 53 Application for particulars of objections refused where issues were not granted.
- 134 But, *per* Jessel, M.R., the practice at law should be followed. Order for delivery of particulars of breaches, and of objections, in *Finnegan v. James*.
- 76 The particulars of objections under stat. 15 & 16 Vict. cap. 83, sect. 41, are confined to notices affecting the validity of the patent.
- 134, 186, 227 Sufficiency of notice of objections.
- 97, 176, 196, 213, 244 Sufficiency of particulars of objections.
- 111, 183, 243, 267 Admissibility of evidence under particulars of objections.
- 54, 252 Amendment of particulars of objections.
- 268 Leave given (by Wood, V.C.) to amend particulars of objections at the close of plaintiff's case.
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ABSTRACT
OF
PATENT CASES.

ADAMS *against* THE NORTH BRITISH RAILWAY COMPANY, A.D. 1873. }
29 L.T. N.S. 367. }

Practice in Patent Suits. Rights of an Agent for Patentee.

Suit to restrain from infringing a patent of 5th *Sept.* 1867, No. 2,520, to *A. V. Newton*, for 'improvements in safety valves for steam boilers' (a communication from abroad). It appeared, on the bill, that plaintiff was general agent for the owners of the patent. WICKENS, V.C. refused an injunction. Demurrer, for want of equity, allowed, with costs, including costs of the motion.

Per LORD SELBORNE, L.C.—This bill is not one to obtain the profits and royalties merely; it in fact alleges that there has been infringement, and asks for damages for the infringement, and an injunction to restrain future infringement. It is a patentee's bill, and it is filed by a man whose only right is against his own principals. There is nothing to constitute the plaintiff an assignee of the patent.

ALLEN *against* RAWSON, A.D. 1845. 1 C.B. 551.

Property of Inventor in Suggestions by his Servant. Comparison of Specifications. Novelty of Invention. Evidence of Infringement.

CASE for the infringement of a patent of 14th *Feb.* 1840, No. 8,387, to *T. R. Williams*, for 'improvements in the manufacture of felted fabrics.' Pleas: 1. Not guilty. 2. That the patentee was not the true and first inventor. 3. That the invention was not new. Issue.

The patent related to the manufacture of felt. Hitherto, in forming a layer or *bat* of wool to be subjected to the operation of felting, the practice had been to throw the wool, as taken from the carding machine, upon a hollow perforated cylinder. By exhausting air from within the cylinder, the wool, so projected, was caused to

adhere and collect itself in a layer upon the surface. The invention of *Williams* related to the formation of this *bat* in a different manner. The carded wool was taken direct from the carding engine, and received between two endless revolving aprons running at the same surface speed, and the sliver was caused to deposit itself layer over layer upon the upper apron, until a sufficient quantity had been accumulated. The felting or hardening was effected by passing the *bat* between a double tier of parallel rollers, each upper roller lying in the hollow between two adjacent lower rollers, and therefore pressing on two surfaces instead of one. The upper rollers were weighted, and driving gear was arranged for giving the rollers a reciprocating rotatory motion, but with a progressive motion added thereto, so that, on the whole, the *bat* was carried in a regular manner from end to end. This produced felting in a longitudinal direction, and, in order to increase the action, a system of *diagonal felting* was superadded. For this purpose, the cloth was fed into a second machine, similar to the first, except that the rollers which supplied the *bat* to the machine were placed diagonally to the feeding apron, and moved at a higher speed, whereby the cloth was fed upon the apron in a series of folds, arranged diagonally to the axes of the felting rollers, and the pressure took place in lines across the material. The specification described the machinery by reference to drawings, and in particular showed an arrangement for contracting the length of the machine by causing the upper apron to run to and fro in parallel lines between tightening rollers placed one above the other at each end of the machine; or otherwise, by using several aprons, forming a compound apron. It further described an arrangement of longitudinal guides for keeping the aprons distended. *Claim*: 'I claim the application of the double apron or aprons, or compound aprons, and rollers, for the production of *bats*, as herein described, from the long sliver, and the different means herein described for keeping these aprons, together with the *bats*, in a smooth and even condition.' Also: 'I claim the improved position of the rollers in the felting machine, for producing the double contact of each tier of rollers, and the combined reciprocating and progressive motion of these rollers, as well as the manner in which this motion is produced, as applied to the felting machine, and also the method of diagonal or cross felting, as effected by the feeding rollers as herein described.' There was a further claim relating to the use of soap and water in conjunction with rollers, as to which an objection was taken, but not sustained.

At the trial, defendant put in evidence (as anticipatory of the invention of diagonal felting) the specification of a patent of 4th

April, 1838, No. 7,608, to *W. A. Robertson*, for a method of felting diagonally by rollers, where the *bat* was passed longitudinally over a series of fixed semi-cylinders, and was hardened by the pressure of a large heavy rolling cylinder, which moved over the material sometimes longitudinally, and sometimes diagonally at an angle. It further appeared that one *Shaw*, a workman in the employ of a company of which *Williams* was a member, had suggested the use of the compound apron; and that one *Milner*, a workman in the same employ, had suggested the use of the longitudinal guides, both of which improvements were claimed.

The alleged infringement consisted in the adoption of machinery for hardening, which was substantially the same as that specified, except that defendant substituted a drum for the revolving apron.

ERLE, J. directed the jury:—I take the law to be that if a person has discovered an improved principle, and employs engineers, agents, or other persons to assist him in carrying out that principle, and they, in the course of the experiments arising from that employment, make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent; and, if so embodied, the patent is not avoided by evidence that the agent or servant made the suggestions of the subordinate improvement of the primary and improved principle. The learned judge further said:—That the improvement of *Shaw* was but a more convenient mode of carrying out the principle of the patentee, and that *Milner's* guide was one of those subordinate improvements, helping to carry out the general principle, which the patentee had a right to adopt. That the mode of diagonal felting described in *Williams's* specification was substantially different from that described in *Robertson's* specification. And he left it to the jury to say whether the substitution by defendant of the drum for the revolving apron was a colourable difference only, and a substantial infringement of *Williams's* patent. Verdict for plaintiff.

Rule for a new trial—on the grounds of misdirection by the learned judge, and that it was not left to the jury to say whether the present patent and that of *Robertson* were the same as to the method of diagonal felting—refused by the Court of Common Pleas.

Per COLTMAN, J.—On looking at the judge's notes, it appears that there was no evidence given to show that the two patents were the same; and standing as the question did nakedly on the two specifications, the construction of them, according to the authority of *Neilson v. Harford* (8 M. & W. 806), was for the judge, and not for the jury. We think, therefore, there is no ground for a rule on this point.

Rule nisi for a new trial on the ground that the patentee had no right to claim the improvements of *Shaw* and *Milner* as part of his invention, discharged by the Court of Common Pleas. (Tindal, C.J., Maule, Cresswell, Erle, JJ.)

Per TINDAL, C.J.—The real question is, whether or not the improvements suggested by *Shaw* and *Milner* were of such a serious and important character as to preclude their adoption by *Williams* as part of his invention. It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent, incorporating them, taken out by his employer. Each case must depend on its own merits. But when we see that the principle and object of an invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void. It seems to me that this was a matter much too trivial and too far removed from interference with the principle of the invention to produce the effect which has been contended for.

AMORY *against* BROWN, A.D. 1869. L.R. 8 Eq. 663.

Practice in Patent Suits. Averment of Novelty.

Suit to restrain from infringing a patent of 6th Feb. 1867, No. 331, to *C. E. Brooman* (a communication from abroad).

The bill stated the grant of the patent for an invention of a new method of manufacturing pearls, but contained no express allegation of novelty. Defendant, who appeared *in formâ pauperis*, objected that the pleading was defective; but JAMES, V.C. over-ruled the objection, and said:—‘The allegation of the grant and the production of the letters patent throw upon the defendant the *onus* of disputing the novelty, and, therefore, I consider the bill sufficient without it. But even if such an averment had been necessary, I should not have allowed the defendant to take advantage of a mere technical objection of that sort, but I should have allowed the hearing to stand over until the defect had been remedied.’

ARKWRIGHT *against* NIGHTINGALE, A.D. 1785. Dav. Pat. Ca. 37; }
1 Webs. Pat. Ca. 60. }

Sufficiency of Specification. To whom it is addressed.

CASE for the infringement of a patent of 16th Dec. 1775, No. 1,111, to *R. Arkwright*, for ‘certain instruments or machines which would be of public utility in preparing silk, cotton, flax, and wool

for spinning.' The patent related to improvements which form the foundation of the present mode of spinning cotton by machinery.

At the trial, five witnesses deposed that they had made the machine from the specification alone.

LORD LOUGHBOROUGH directed the jury:—There is no matter of favour can enter into consideration in a question of this nature. The law has established the right of patents for inventions; that law is extremely wise and just. One of the requirements is that a specification shall be enrolled, stating the nature of the invention: the object of which is, that after the term is expired the public shall have the benefit of the invention, but without that condition is complied with, the patentee forfeits all the benefit he derives under the Great Seal. The only objection in this case is, that the specification is not so intelligible that those who are conversant in the subject are capable of understanding it, and of perpetuating the invention when the term of the patent is expired. The clearness of the specification must be according to the subject-matter of it; it is addressed to persons in the profession having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible.

Verdict for plaintiff.

REX *versus* ARKWRIGHT, A.D. 1785. Dav. Pat. Ca. 61; }
1 Webs. Pat. Ca. 64. }

Novelty of Invention. Sufficiency of Specification. Master and Servant. Obligation in Specifying. Prior Publication of Part of the Invention.

Sci. fa. to repeal the same patent. The specification stated:—That the invention, as drawn in a plan, was composed of the following particulars. No. 1. A beater or breaker of seeds, in which a wheel with teeth, by acting upon a lever raised the hammer, the lever being moveable upon a centre. No. 3. A *feeder* or piece of cloth with wool, flax, &c., spread thereon as in the drawing. (The drawing showed a roll without any central roller or axis.) No. 4. A crank and connecting rod for giving a vibrating motion to the comb which discharged the cotton from the carding cylinder. No. 5. A carding cylinder with fillet cards. No. 6. Rollers fixed to a wooden frame, the contents of No. 5, going through, became of the proper size. (This combination formed the well-known *drawing rollers* for drawing out or elongating the sliver of cotton. The two rollers were figured as of unequal size, but it was nowhere stated that the surface speed of one pair was different from that of the other pair.) No. 7. A cylindrical box for twisting the contents of No. 6. No. 8. A box, having a roller and bobbin inside for twisting the contents of No. 6.

No. 9. A spindle and flier, being fixed to No. 6, for twisting the contents thereof. A bobbin (shown on the spindle) for communicating by a band with No. 10 at a conical or regulating wheel which moved the bobbin quicker or slower as required. No. 10. A spindle with pulleys, and a conical or regulating wheel, which being fixed to No. 6, worked No. 7, No. 8, or No. 9. There was no separate claim.

At the trial, one *Hayes* deposed that he had made the drawing rollers in 1767, that in 1769 he made them like those used by defendant; one was fluted wood with an iron axis, the other the same, only covered with leather; that one *Kay*, a clockmaker, from *Warrington*, made him a small model. Then *Kay* deposed that, before the patent, he got the model from *Hayes* and showed it to defendant, who took him into his employ, whereupon he worked at the discovery found out by himself and *Hayes*. It appeared that the crank and connecting rod were invented by one *Hargreaves*, and were publicly used in 1773. It further appeared, although the specification was silent on the subject, that Nos. 3, 4, 5 were the material parts of a carding machine, and that Nos. 6, 7, 10 referred to a roving machine.

BULLER, J. directed the jury:—It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret, and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for which the patent is granted, what the art is; and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it. If the specification, in any part of it, be materially false and defective, the patent is against law, and cannot be supported. It has been truly said by the counsel that if the specification be such, that mechanical men of common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

Here is a specification that states ten different instruments. Is there anything which states that these parts are for two machines, and how they are composed? About that the specification is totally silent. What is there in it that can lead you to say you must make use of three things for one of the machines and three for the other, and which three for one or the other? And even were it so, what is to become of the other four? If those are of no use, but to be thrown in merely to puzzle, I have no difficulty in saying, upon that ground alone, that the patent is void; for it is not that fair, full, true dis-

covery which the public have a right to demand from an individual who gets so great a reward as a monopoly for fourteen years together.

As to the other points, they are two; first, whether it is a new invention; and in the next place, whether it was an invention made by the plaintiff. As to No. 1, that is stated to be a beater or breaker of seeds; it is admitted that it is not a new discovery, for *Emerson's* book was produced, which was printed a third time in the year 1773, and that is precisely the same as this. Upon the part of the defendant there is no contradiction, and therefore I will pass it over as clear that it is not new. As to *Hayes* and *Kay*, there is no contradiction at all to the evidence they have given.

If upon any point you are of opinion with the prosecutor, you will find a verdict for him. Verdict for the Crown.

Rule for a new trial refused by the Court of King's Bench.

Per LORD MANSFIELD.—It is very clear to me, upon your own showing, that there is no colour for the rule; the ground of it is, if there is another trial, you may have more evidence. There is no surprise stated, no new discovery, but upon the material points in question you can give more evidence. A verdict has been found, which is satisfactory to the judge, and now you desire to try the cause again, only that you may bring more evidence. There is not a colour for it.

ARNOLD *against* BRADBURY, A.D. 1871. L.R. 6 Ch. 706.

Sufficiency of Specification. Practice as to granting Issues. Subject-matter of a Patent.

Suit to restrain from infringing a patent of 5th *March*, 1860, No. 600, to *J. H. Johnson*, for 'an improved ruffle and sewing machine' (a communication from abroad). Defendants admitted the infringement, but contended that the patent was invalid, and that its invalidity was apparent on the face of the specification. The answer stated:—'We are advised and submit that what is in fact claimed by the specification is the producing by machinery results which were before obtained by hand, but without any limitation as to the kind of machinery that may be used, and that the claims made by the specification are not the subject of a patent, and are so wide and general as to render the patent void.'

The patent related to machinery for producing ruffles or frills and gathered work. The gathers in a fabric were fed on by mechanism without being 'whipped' or scratched by a pointed instrument, as when formed by hand. The fabric was thereby uninjured. The mechanism for gathering might be used in combination with a

sewing machine. The gathered material was stitched, either by hand or by the sewing machine, to some plain fabric. The specification stated:—‘The said invention relates to an improved ruffle, frill, or gathered fabric, and to the machinery for making the same. The apparatus used in producing this ruffle or gathered fabric consists of a peculiar mechanism for gathering and feeding one of the fabrics operated on, which peculiar mechanism is used in combination with a sewing machine, the latter being modified to receive the additional mechanism.’ Then followed a description of the machine, and of the mode of using it, accompanied by drawings, whereof one showed ‘a sufficient portion of a sewing machine to illustrate its operation.’

Claims: 1.—The production by machinery of ruffles, frills, and gathered work, and the simultaneous attachment of the same to a plain fabric by means of a single series of stitches, which serve both to confine and stitch the gathers, and also to secure one fabric to the other.

2. The production by machinery at one operation of gathered work, which is simply gathered and secured on itself by stitches.

3. The combination of mechanism for forming ruffles, plaits, and gathering with the mechanism of a sewing machine, for the purpose of simultaneously gathering fabrics, and attaching the same by stitches to another fabric, or for the purpose of making gathered work which is simply gathered and secured on itself at one operation.

WICKENS, V.C. directed that the question of granting issues should be postponed to the hearing. On appeal, the Lord Chancellor reversed this decision, and directed issues.

Per LORD HATHERLEY, L.C.—I am of opinion that I cannot determine this case in the mode in which it is sought by the defendants to be determined, from a simple inspection of this specification. A claim must be very large and very vague indeed to justify any Court in saying that it is impossible to sustain a patent based upon it. It is a singular fact that no case has been cited from our English law books of any claim being held to be too large on account of the greatness of the claim, independently of the external evidence. The case of *Jordan v. Moore* (L.R. 1 C.P. 624), was, perhaps, the nearest.

I am invited to consider the first head of claim as a general claim of all machinery that ever may be invented hereafter, which can perform the operation which is here described. But the inventor introduces the claims by saying that his object is to state what he considers novel in his invention. He does not say that he is going to distinguish it from all possible future inventions of other people. I read the first claim thus: the inventor claims the production, by

machinery, of that which has not been done by machinery before. He says he has invented an improved ruffle and frill, and he states in what the improvement consists, and he describes the machinery—he does not call it improved machinery—by which it is produced; and he says, ‘I claim the producing of this by machinery, of which machinery I have given full details.’

The second head of claim is this: ‘The production by machinery at one operation of gathered work, &c.’ *Mr. Aston* says, that must be bad. I cannot come to any such conclusion. I cannot tell that the ruffle produced in this way, so as to be free from scratches, is not more durable and more elegant in its appearance than one which is subject to that defect. If the inventor produces a machine, and dispenses with a process which is avowed to be injurious, I cannot, in the absence of evidence, take upon myself to say that would not be the subject-matter of a patent.

The third head of claim is: ‘The combination of mechanism for forming ruffles, &c. with the mechanism of a sewing machine, for the purpose, &c.’ *Mr. Aston* objects that the patentee has not described the mode in which it is done, therefore either it is a thing so simple that it requires no explanation, and is not the subject-matter of a patent, or if it is not simple, he has not shown how it is to be done. The answer to this objection is, that it is simple enough when you have got the plaintiff’s machine to apply to a sewing machine. The patentee gives a drawing showing how it is done; and the reason of the simplicity of the combination is, that he has invented a machine which is so easily combined with a sewing machine, that a simple drawing is sufficient to explain it.

It is unfortunate that the case has been brought on in this way. When the issues are tried, it may turn out, as in *Jordan v. Moore*, that, after all, there have been previous inventions so similar to those of plaintiff, that the patent is invalid; but that is no ground for my holding it to be *per se* too large.

AXMANN *against* LUND, A.D. 1874. L.R. 18 Eq. 330.

Injunction. Threatening Legal Proceedings. Estoppel of Licensee.

Suit to restrain defendant from threatening legal proceedings for the infringement of a patent. It appeared on the bill that, in 1864, defendant obtained a patent for improvements in manufacturing jewellery, and entered into partnership with plaintiff for working the patent. In 1868, plaintiff and defendant obtained a further joint patent for improvements in the same manufacture. In 1873, the partnership was dissolved. Defendant then issued

circulars, addressed to customers of plaintiff, which made no distinction between the two patents, and threatened legal proceedings for the infringement of an assumed patent right, being in the form adopted and jointly issued during the existence of the partnership. Plaintiff now denied the validity of the patent of 1864. Injunction granted.

Per MALINS, V.C.—As to whether the patent is valid or invalid, I give no opinion; that is not the question before me. If it is valid at all, the defendant is entitled to restrain any person from manufacturing any article covered by it. If it is invalid, he has no right to use these threats to the public, which are calculated, not only as to the plaintiff, but as to everybody else, to destroy business. The terms of the notice are, in my opinion, wholly unjustifiable. There are two patents; and though after the dissolution both partners had an equal right to use the patent of 1868, no distinction was drawn between the two patents in these notices.

It remains to be considered whether the plaintiff has conclusively bound himself to admit the validity of the patent. Now, undoubtedly during the continuance of the partnership, the plaintiff had by contract, as licensee, according to *Crossley v. Dixon* (10 H.L. Ca. 293), precluded himself from disputing the validity of the patent. But after its expiration he became at liberty, just as much as the rest of Her Majesty's subjects, to dispute its validity, subject, however, to be answerable in damages, in case the defendant establishes the validity of the patent in any proceedings against the plaintiff. The defendant declines to undertake to take proceedings at law to establish the validity of his patent, and I retain the opinion I expressed in *Rollins v. Hinks* (L.R. 13 Eq. 355), that as he will not follow up the rights he asserts, by proceeding to establish the validity of the patent, he ought to be restrained from circulating threats.

BACON *against* SPOTTISWOODE, A.D. 1839. 1 Beav. 382.

Practice in Patent Suits. Injunction. Account. Principles which guide the Court.

Suit to restrain from infringing a patent for improvements in the common *Argand* gas-burner. Bill filed in 1835. After the bill was put on the file, plaintiff did not move for an interlocutory injunction; but, upon the answers coming in denying the validity of the patent and the infringement, he filed a replication and went into evidence. It appeared that defendants, who represented a gas company, had made no profits by the sale of the burners, which had been supplied to their customers at the manufacturer's prices. At

the hearing plaintiff failed to make out a clear title. On the close of the argument LORD LANGDALE, M.R. said:—The bill alleges that the defendants have sold and used, it being the fact that they have sold for no profit, and it not appearing that they have used otherwise than by furnishing the burners to their customers. I am not prepared to say, that although the defendants have sold the burners without profit, yet that they have not derived a collateral profit from the use of them by their customers; that case, however, is neither alleged by the bill nor is it proved. I am of opinion that even if the plaintiff is entitled to an injunction he is not entitled to an account.

On the next day his Lordship delivered judgment, dismissing the bill with costs, and said:—When a cause of this kind is brought to a hearing, it is for the purpose of having an injunction made perpetual, or continued during the legal right of the plaintiff under his patent; and it appears to me that, however unusual the circumstance may be, the plaintiff is not precluded from asking for an injunction by the fact of his not having applied for it on interlocutory motion. The plaintiff, if he omits to move for an injunction at an early period of the cause, first shows that he does not consider the injunction as immediately necessary for the protection of his interest, and next imposes upon himself the obligation of making out a clear and unexceptionable title at the hearing.

I think that at the hearing of the cause the Court has to look at the facts produced in evidence, for the purpose of considering whether a perpetual injunction should then be granted. On an interlocutory order, it has to look at the facts produced in evidence, for the purpose of considering whether an injunction should be granted till the right can be tried or further investigated. It is truly said, that where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court may interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law; but this interposition must nevertheless depend, to a considerable extent, on the circumstances of the case and the nature of the defence. The Court is not bound to grant an injunction, merely because a patent has been granted and exclusively enjoyed for some time; and when the case is brought to a hearing, I apprehend that the plaintiff ought to show his title clearly, and that if he fails in that, and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause, as evidence of a *primâ facie* case giving him a right to further delay, for the purpose of enabling him to establish more satisfactorily the legal title upon which alone his equity is founded.

BACON *against* JONES, A.D. 1839. 4 Myl. & Cr. 433.

Practice in Patent Suits. Injunction. Account.

Suit to restrain from infringing the same patent. The bill was filed in 1835, and, as in the previous suit, plaintiff did not apply for an injunction, but filed a replication and went into evidence. The Master of the Rolls dismissed the bill with costs, the judgment in *Bacon v. Spottiswoode* deciding this suit also. Appeal, in *Bacon v. Jones* only, dismissed by the Lord Chancellor with costs.

Per LORD COTTENHAM, L.C.—The jurisdiction of this Court is founded upon legal rights: the plaintiff coming into this Court on the assumption that he has the legal right and the Court granting its assistance on that ground. When the application is for an interlocutory injunction, the Court may at once grant the injunction, *simpliciter*, without more—a course which, though perfectly competent to the Court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff's title; or it may follow the more usual, and, as I apprehend, more wholesome practice, in such a case, of either granting an injunction, and at the same time directing the plaintiff to proceed to establish his legal title, or of requiring him first to establish his title at law, and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the defendant in the meantime keeping an account.

When the cause comes to the hearing, the Court has also a large latitude left to it, and I am far from saying that a case may not arise in which, even at that stage, the Court will be of opinion that the injunction may properly be granted without having recourse to a trial at law. The Court may, at the hearing, do that which is the more ordinary course; it may retain the bill, giving the plaintiff the opportunity of first establishing his right at law. There remains a third course, the propriety of which depends on the circumstances of the case, viz., that of at once dismissing the bill.

BAINBRIDGE *against* WIGLEY, A.D. 1810. Parl. Rep. 197.

False Suggestion.

CASE for the infringement of a patent of 2nd April, 1803, No. 2,693, to *W. Bainbridge*, for 'certain improvements in the flageolet or English flute, whereby the fingering will be rendered more easy, and notes produced that never were before produced.'

At the trial it appeared that the instrument had been greatly improved, but that only one new note was produced. LORD ELLENBOROUGH said:—That this was fatal to the patent, the consideration on which it was granted not being truly set forth. The patentee had stated that, by his improvements, he gave new notes, when in fact he had given but one new note.

BAIRD and OTHERS *against* NEILSON, A.D. 1842. 8 Cl. & F. 726.

Agreement by Licensee. Estoppel.

Appeal from a decree of the Court of Session. It appeared that, in 1830, appellants obtained a licence from respondent, *J. B. Neilson*, to use his patent of 1st Oct. 1838 (*Scotland*), for the application of the hot blast in smelting iron, and thereupon proceeded to manufacture iron according to a certain process resembling that of the patentee. Disputes, and eventually litigation, arose between the parties, and it was agreed in 1833, that, in consideration of a sum of money to be paid by appellants, both parties should withdraw from litigation, and that a royalty of 1s. per ton should be paid by appellants for all the iron made by them according to the mode they had before adopted, or by any other mode within the patent. The agreement not being carried out, respondent instituted a suit to compel the performance of it. Appellants instituted a cross suit to suspend proceedings, on the ground that the process of smelting by heated air, as used by them, did not fall within the patent. The Court of Session held that, after the agreement, this defence could not be set up. On appeal to the House of Lords, decree affirmed, with costs.

Per LORD CAMPBELL.—What is the ground of the suspension? The only real ground alleged is that the use that has been made of the hot air has not been according to the patent. But the very object of the agreement was to put an end to that question, and on the construction of the agreement I am of opinion that there is no ground at all for the suspension.

BARBER *against* GRACE, A.D. 1847. 1 Ex. R. 339.

Evidence of Infringement. Two modes of doing the same thing.

CASE for the infringement of a patent of 8th *March*, 1836, No. 7,017, to *W. Bates*, for ‘improvements in the process of finishing hosiery and other goods.’ Plea: Not guilty. And several other pleas. Issue.

The specification stated:—‘My invention consists in submitting hosiery and similar goods to the finishing process of a press heated by steam, hot water, or other fluid in the manner hereinafter mentioned.’ The specification then described the apparatus by reference to drawings, and showed pressing boxes, having flat sides, which were filled with steam from a boiler, and were brought together by the ram of an hydraulic press. If preferred, screws or other well-known means might replace the hydraulic press, and hot water might be used in the place of steam. *Claim*: ‘The submitting of hosiery and similar goods to the pressure of hot boxes or surfaces heated by steam, water, or other fluid, as above described.’

At the trial, it appeared that the alleged infringement consisted in pressing goods between cylindrical revolving rollers heated by steam. POLLOCK, C.B. directed the jury:—That they ought to find for defendant on the issue of not guilty, unless they were of opinion that the use of rollers was a mere colourable evasion of the patent. His Lordship also expressed an opinion that it was not. Verdict for defendant on the issue of not guilty, and for plaintiff on the remaining issues.

Rule nisi for a new trial discharged by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Rolfe, BB.)

Per POLLOCK, C.B.—This is obviously a discovery based upon a discovery. Rollers were adopted two or three years after boxes had been made the subject of a patent. Were the Court to hold that rollers are included in this patent, the effect of it would be that, if the party could have kept his process a secret in point of fact, and have given the public nothing but what they could gather from the specification, he might have had the exclusive use of rollers, under the protection of the law, for fourteen years, and at the end of that period the public would be wholly ignorant that rollers were capable of being used, and had been used, for such a process, or that they were the object of a patent. Upon looking at the description given of the machine, rollers are not in the most remote degree suggested as capable of being used. The figure represents an hydraulic press, by which two boxes heated by steam or hot water are made to meet, and between them the goods are to be placed. The pressure, as was observed by my brother Alderson during the argument, is to be continuous and not momentary, as it is in the case of rollers. It was contended by the plaintiff's counsel that the term 'boxes' includes rollers. A roller is a box in one sense of the word, but not, I think, in the sense used here. I am of opinion that rollers are not included in the specification.

Per PARKE, B.—It seems to me—and I own I feel not the least doubt about it—that this specification does not claim a general mode of applying hot surfaces to knitted fabrics, but that it is merely for the particular machine described in the specification, and that that particular machine has not been pirated by the defendant.

BARKER and HARRIS *against* SHAW, A.D. 1823. Holroyd, Pat. 60.

Master and Servant.

'In *Barker and Harris v. Shaw* (Cor. Holroyd, J., Lancaster 1823), which was an action for the infringement of a patent for an improved manner in making hats, one of the plaintiffs' men (*Thomas Walmsley*), whom they called as a witness, proved

that he himself invented the improvement which was the subject of the patent, whilst employed in their workshop. The plaintiffs were therefore held not to be the inventors, and were nonsuited.'

This case appears to have been cited under the name *Barber v. Walduck* (1 Car. & P. 567). But note, that there is a patent of 26th July, 1821, No. 4,574, to *T. Barker* (of *Oldham*, county *Lancaster*) and *J. R. Harris*, for 'improvements in clearing furs and wools, used in the manufacture of hats, from kemps and hairs.'

BATEMAN and MOORE *against* GRAY, A.D. 1853. 8 Ex. R. 906; }
 Macrory's Pat. Ca. 93. }

Evidence of Infringement. Novelty of Invention. Defective Pleading.

CASE for the infringement of a patent of 18th Jan. 1848, No. 12,032, to *J. F. Bateman* and *A. Moore*, for 'improvements in valves or plugs for the passage of water or other fluids.' Pleas: 1. Not guilty. 2. That plaintiffs were not the true and first inventors. 3. That the invention was not a new manufacture. Issue.

The patent related to a method of drawing off water from the *mains* in streets. For this purpose a light ball valve, either formed of, or coated with, indiarubber, was fitted inside an opening in the main pipe, and was forced up against its seat by the pressure of the water, so as to close the opening. A key, in the form of a hollow tube or stand-pipe, was locked by means of a catch to a socket in the valve-box, and was depressed by a screw, so as to force the ball valve downwards and allow the water to escape through the pipe. The specification described the apparatus by reference to drawings, and showed the method of applying and withdrawing the key.

Claims: (in substance)—*First.* The application for the purpose of drawing off water of a valve of less specific gravity than water, constructed of, or coated with, vulcanised indiarubber, or other elastic material, and which closes by the pressure of the water. *Secondly.* The application for similar purposes of a globular valve of the same or greater specific gravity than water, which, without mechanical aid, will close by the pressure of the water. *Thirdly.* The opening of valves by means of a key or tube, so applied as to force the valve open against the pressure of the water, and through which key or tube the fluid escapes, such tube being attached to the box of the valve without the aid of a screw.

At the trial, it appeared that the alleged infringement consisted in the use of a stand-pipe fitted with a ball valve and indiarubber seating, the valve being opened by a spindle inside the stand-pipe. It further appeared that both a stand-pipe and ball valve were well known before the date of the patent.

MARTIN, B. directed the jury:—If a person takes an invention of this kind and makes one like it, that is an infringement. It is my duty to tell you that the law will not permit a person to take an article that has been patented, and to give a substitute in place of it, for the purpose of effecting the same end, by the use of equivalents, using the skill and knowledge which he may possess to evade the patent. If you believe that the defendant's instrument, though he might have employed skill and knowledge upon it, was taken substantially from the plaintiffs, and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiffs, it is my duty to tell you that is an infringement of the patent. If that were not the law no patent would be safe. . . . It seems to me that the true construction of the specification is, that the patent is for an improved method of opening valves and plugs for the passage of water. In my judgment, the claim is for the entire apparatus altogether, for the purpose of getting water from the main. It is for you to ask yourselves whether the invention, as specified—that is, the ball valve with the external adjuncts—was invented by the plaintiffs in the year 1848.

The jury found that each of the three separate parts was old, but that the invention was for the combination, and that it was new and useful.

Verdict for plaintiffs.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Exchequer. (Pollock, C.B., Alderson, Platt, Martin, BB.)

Per POLLOCK, C.B.—It was contended that the claim in the specification was, that of the three parts of the machinery therein mentioned, each was new; and that the invention claimed was not the combination, which alone the jury found to be new. This point was argued before us, and we are disposed to think there is much weight in the objection to the validity of the specification on this point. But we do not think it necessary to decide this question, because it does not arise on the present pleadings. The only issues on the record are the infringement (about which there is no doubt) and the novelty of the invention.

We think that what was the invention was a question for the jury, and that the production of the specification did not conclude it. It was evidence to be considered by the jury, but no more, that the plaintiffs had so described their invention. But it may be, even if the defendant's construction be the true one, that the invention was new as a combination, and yet the description of it in the specification erroneous. Now here the jury have clearly found the invention to

be that of a new combination of old parts; and if this be so, the real and true objection which was open to the defendant was that the plaintiffs had not complied with the condition in their patent, by truly and correctly describing it in the specification which they had filed. But this could only be taken advantage of by a plea to that effect. There was no such plea upon the record, so that the defendant cannot now avail himself of this objection.

BATLEY *against* KYNOCK, A.D. 1874-5. L.R. 19 Eq. 90, 229; }
L.R. 20 Eq. 632. }

Practice in Patent Suits. Inspection. Particulars of Breaches. Costs.

Suit to restrain from infringing a patent of 4th Oct. 1865, No. 2,542, to J. and J. F. Jones, for improvements in cartridges for breechloading fire-arms.

The patent related to the manufacture of central-fire cartridges. The specification described the improvements as consisting in a combination of parts:—First, a tube or case of paper, cotton, wood pulp, &c.; then, a metal head, having a cup or chamber formed in one piece therewith, for the reception of a percussion cap; then, an anvil placed within the cap, for receiving the blow of a piston and causing the ignition of the fulminate. The anvil did not fill the cap, but gave passage along its sides for the flame to reach the body of the cartridge. The specification contained fifty-five figures, showing the construction of the cartridge, the forms of anvil, and the attachment of the head and cup. The claims, fifteen in number, related to the mode of making and arranging the several parts of the cartridge.

(1.) Plaintiff applied for an inspection of defendants' manufactory. BACON, V.C. refused an order, and said:—'I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendants; and if that fact can be made out, the plaintiff's case is clearly established. The mode of making that out is by examination of the cartridges. Upon the evidence before me there is no allegation by the plaintiff that the inspection is necessary for the purpose of his suit; and it is alleged by the defendants, and not contradicted, that no such necessity exists. I cannot, therefore, order the inspection. The costs to be costs in the cause.'

(2.) Plaintiff having delivered particulars of breaches, charging infringement by the making and selling of cartridges (whereof one was made an exhibit), having cases and metal heads, together with cups or chambers formed as described in the specification, defendants

moved for further and better particulars. BACON, V.C. refused the motion, with costs, and said:—‘Here the very thing in dispute, which is no bigger than one’s thumb, and is not a complicated machine, is made an exhibit. What ground therefore is there for the objection as to insufficiency of the particulars, when a plaintiff produces the exhibit, and says, “I hold in my hand the very article by which you infringe”?’ It would be only hampering the plaintiff to compel him to specify minutely the particular portions of his specification alleged to have been infringed; and I am of opinion that the defendants, by the pleadings and particulars of breaches, have had full, fair, and sufficient notice of the case intended to be raised against them.’

(3.) The trial of the issues was fixed for 19th *Feb.* 1875, and briefs were delivered. On 12th *Feb.* 1875, plaintiff obtained the common order at the Rolls, dismissing his bill, with costs. The costs were taxed as between party and party, and the taxing master reduced the allowance of remuneration to scientific witnesses, and also the charge for a model. On a summons that it might be referred to the master to review his taxation, BACON, V.C. refused the application, with costs, and said:—‘The master has applied his discretion to the subject, and in no particular can I disturb his conclusion.’

BEARD *against* EGERTON, A.D. 1846–9. 2 Car. & K. 667; 3 C.B. 97; }
8 C.B. 165; 19 L.J. C.P. 36. }

Pleading, demurrer. Imported Invention. Title of Patent. Sufficiency of Specification. Obligation in Specifying.

CASE for the infringement of a patent of 14th *Aug.* 1839, No. 8,194, to *M. Berry* (a communication from a foreigner residing abroad), for ‘a new or improved method of obtaining the spontaneous representation of images received in the focus of the *camera obscura*.’ The declaration alleged that *M. Berry* was the true and first inventor of a new manufacture within this realm, to wit, &c. Pleas: 5. That one *Daguerre* invented the method which was the subject of the patent; that one *Niepce* practised the invention in *France*; that *Daguerre* and *Niepce* were *aliens*; that they retained *M. Berry*, as their agent, to procure letters patent in his own name, upon trust for their use and benefit; that *M. Berry* was no otherwise, than as aforesaid, the true and first inventor, whereby the letters patent were void. 10. That the title of the patent was ‘a new or improved method, &c.’ and that therefore the patent was void. 12. That the specification was insufficient. Demurrer to pleas 5 and 10. Joinder in demurrer. Judgment for plaintiff by the Court of Common Pleas. (Tindal, C.J., Cresswell, Erle, JJ.)

Per TINDAL, C.J.—The cases decided before stat. 21 Jac. I. cap. 3, prove that grants by the Crown to persons who have brought any new trade within the realm were good at common law. And the exception contained in the 6th section of the statute was made in affirmance of the common law, introducing no other alteration than the restriction, in point of time, for which such grants might extend. It was argued that, to come within the statute, the person who takes out the patent should be the *meritorious* importer, not a mere clerk or servant or agent to whom the communication was made by the foreign inventor. No authority is cited for such distinction. We see no reason or principle which should prevent an *alien amy*, if the Crown thought proper, from receiving such a grant, either in his own name, or in the name of another in trust for him. In the case of *Chappel v. Purday* (14 M. & W. 318), the Court, in their judgment, assume it to be clear in point of law that a foreigner may hold a patent, if the Crown chooses to grant it to him.

[The learned judge here referred to a portion of the judgment delivered by *Pollock, C.B.* in the case cited, which was the following:—Under stat. 21 Jac. I. cap. 3, against monopolies, the 6th section, which leaves as they stand at common law all the letters patent, for fourteen years, of new manufactures granted to the first inventors, it has been decided that an *importer* is within the clause, and if the manufacture be new in the realm he is an inventor, and may have a patent, though he is not the assignee of the foreign inventor, and though he may be a foreigner himself, if the Crown chooses to grant him a patent. The authority for this is to be found in *Edgeberry v. Stephens* (2 Salk. 447).]

As to the 10th plea, we think the objection to the title of the patent is answered by reference to the decided cases of *Neilson v. Harford* (8 M. & W. 806) and *Nickels v. Haslam* (7 M. & G. 378).

The action now came to be tried on the remaining issues, the issue on the sufficiency of the specification being that on which the case turned.

The patent related to the so-called *Daguerreotype* process, consisting in the following operations:—1. The silver surface of a plate was cleansed with dilute nitric acid, dried by powder of pounce, and lightly rubbed with cotton wool. 2. The surface was rendered sensitive to the action of light by exposing it to the vapour of iodine. 3. It was transferred to the camera, and received the impression of an image. 4. The latent picture was developed by the vapour of mercury. 5. It was finally washed with a weak solution of hyposulphite of soda, and became fixed. The specification stated:—‘The first part of the operation may be done at any time.

This will allow of a number of plates being kept prepared up to the last slight operation. It is, however, *considered indispensable, just before the moment of using the plates in the camera, or the reproducing the design, to put, at least once more, some acid on the plate, and to rub it lightly with pounce, as before stated.* The specification further stated:—‘After this second operation is completed, the plate is to be passed to the third operation, or that of the *camera obscura*. Whenever it is possible, the one operation should immediately follow the other; the longest interval between the two should not exceed one hour.’

At the trial it appeared that no picture could be taken if the plate were washed with acid after exposure to the iodine vapour. WILDE, C.J. was of opinion that the specification was bad, as directing acid to be applied just before the moment of using the plates in the *camera*, and directed a verdict for defendants on the issue on the 12th plea. Verdict for plaintiff on the other issues. Leave reserved.

Rule nisi to enter a verdict for plaintiff on the issue as to sufficiency of the specification made absolute by the Court of Common Pleas.

During the argument MAULE, J. said:—‘If so much nicety of description were 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.’

‘If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad.’

Also, in reply to counsel, CRESSWELL, J. said:—‘The judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result.’

Per WILDE, C.J.—It is to be observed that, when the plate is not intended to be used immediately (and where it has previously been partially, but not entirely, prepared for the iodine), this last application of acid is still to *precede the second operation*. It is plain that the patentee did not intend any separate operation to intervene between the application of iodine and the introduction of the plate into the *camera*. This, we think, is the fair construction of the language of the specification; and, although there may, at first sight, be some appearance of obscurity in it, we think that is cleared away by a consideration of the whole, and that it is sufficiently plain to be understood by an operator of fair intelligence.

BEESTON *against* FORD, A.D. 1830. 2 Coop. Ch. Ca. 58.

Practice in Patent Suits. Long Enjoyment of Patent.

Per LORD LYNTHURST, L.C.—There may be considerable doubt as to the validity of a patent; still, if there has been a long exclusive enjoyment, the doctrine of the Court is that an injunction shall go to protect the patent, until the question of its validity is duly determined at law.

BENTLEY *against* FLEMING, A.D. 1844–5. 1 Car. & K. 587; }
1 C.B. 479. }

Experimental User of Machine before Patent granted.

CASE for the infringement of a patent of 21st Dec. 1841, No. 9,207, to *W. C. Thornton*, for ‘improvements in machinery for making cards for carding cotton,’ &c. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. Issue.

At the trial it appeared that, some five or six weeks before the grant of the patent, the inventor had lent the machine in question to one N., in order that he might try whether it would set the teeth of cards. The machine was placed in N.’s room in a mill, and men were constantly going backwards and forwards to and from the room. It also appeared that the machine had been in complete working order for some weeks before it was lent to N.

It was contended on behalf of defendant: (1) That the patent was avoided by the public use of the machine in a public room before the grant. (2) That a machine which was in complete working order for a long period before the grant was not the subject of a patent.

CRESSWELL, J. over-ruled both these objections, and said:—‘There is no evidence that the machine was lent to N. for the purpose of giving it publicity. The evidence merely is that *Thornton* lent the machine to N., in order that he might discover whether it was worth while to take out a patent for it or not. And as to the second objection, you cannot contend that if a man were to keep his invention shut up in a room for twenty years, that circumstance merely would deprive him of his right to obtain a patent for it.’

Verdict for plaintiff.

The report in the C.B. series refers to a miscarriage in recording the verdict.

REGINA *versus* BETTS and STOCKER, A.D. 1850. 15 Q.B. 540.

Sci. fa. Joinder of co-patentees as defendants.

Sci. fa. to repeal a patent of 30th Dec. 1844, No. 10,449, to *W.*

Betts and A. S. Stocker, for improvements in the mode of stoppering bottles. The writ stated the grant of the patent to defendants, and suggested that they did not invent the supposed invention, and were not the true and first inventors thereof. Plea: (in abatement) by defendant *Betts*, that *Stocker* had assigned all his interest in the patent to *Betts* before the writ was sued out, and had not since any interest therein. General demurrer, and joinder. Judgment of *respondeat ouster* by the Court of Queen's Bench. (Lord Campbell, C.J., Patteson, Coleridge, Erle, JJ.)

Per LORD CAMPBELL, C.J.—This plea is clearly bad. The Crown has a right to call upon those who obtained the patent to show why it should not be cancelled. If the proceeding is, in any instance, an abuse of process, application may be made to the Court for its summary interference.

BETTS *against* MENZIES, A.D. 1857–62. 3 Jur. N.S. 357; }
8 E. & B. 923; 1 E. & E. 990, 1,020; 10 H.L. Ca. 117. }

Practice in Patent Suits. Injunction after long Enjoyment of Patent. Evidence of prior Publication. Misdirection of Judge. Novelty of Invention. Manufacture for sale before the Patent.

Suit to restrain from infringing a patent of 13th *Jan.* 1849, No. 12,415, to *W. Betts*, for 'a new manufacture of capsules, and of a material to be employed therein, and for other purposes.'

The patent related to a method of plating lead with tin, in imitation of tinfoil. For this purpose, ingots of lead were cast in plates about 30 inches long, 3 inches wide, $\frac{3}{4}$ inch thick. These strips were reduced by rolling to about $\frac{1}{4}$ inch in thickness. The tin was also cast and rolled into strips about $\frac{1}{10}$ th the thickness of the lead, and of equal breadth therewith. A strip of tin was then folded over a strip of lead, so as to cover it completely on both sides, and the compound strip was passed between rolls, and subjected to a very considerable pressure. The two metals united perfectly by molecular cohesion, and their relative thicknesses were preserved during any subsequent lamination by rolling between polished rolls. When the material was reduced to the substance of tinfoil, the lead remained perfectly coated with tin, and the surface had a brilliant metallic lustre. If preferred, the lead could be coated on one side only. After describing the process of manufacture, and the precautions necessary for success, the specification stated:—'For the manufacture of capsules the material so prepared is cut into discs of the required size, and the manufacture is conducted as described in the specification of a patent of 16th *March*, 1843, No. 9,665, to *J. T. Betts*. I am aware that it has been proposed to cover lead with tin, by

applying the tin, when in a state of fusion, to the lead when adequately heated, but the adhesion of the two metals in my new material is produced by the agency of mechanical pressure.'

Claims: 1. '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. 2. The manufacture of capsules of the new material of lead and tin combined by mechanical pressure, as herein described.'

Defendant contended that the invention had been anticipated by a prior patent, viz., that of 4th *May*, 1804, to *T. Dobbs*, No. 2,761, for 'a new article of trade, which I denominate *Albion Metal*, and which I apply to the making of cisterns, linings for cisterns, covering and gutters for buildings, boilers, vats, coffin furniture, worms for distillers, and such other things as are required to be made of a flexible, a wholesome, or a cheap metallic substance.' The specification stated:—'I take a plate or ingot of lead and a plate of tin, of equal or unequal thicknesses, and laying them together, their surfaces being clean, pass them between the rolls of a flattening or rolling mill with what is technically termed a hard pinch, so as to make the metals cohere. If after the first passage the plates do not sufficiently cohere, I pass them a second or third time or more between the rolls, until a sufficient degree of cohesion is produced. After a plate of lead had been coated on one side with tin, it might, if desired, be doubled with the lead side inwards and rolled as before, so as to produce a plate of lead coated on both sides with tin. N.B. It will be useful, if not necessary, to have the rolls and the metals hot when the cohesion of the metals is to be effected by their passage between the rolls.'

Injunction granted, plaintiff to proceed forthwith to a trial at law.

Per Wood, V.C.—As to enjoyment, there never was a clearer case than the present. It has been long undisputed, and it is clear, on the defendant's own evidence, that it is still a very valuable enjoyment.

I think that if a man sits down, and takes out a patent from his own conjectures, without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method described by the earlier patent is practically useless. Take, for instance, the electric telegraph. Many ingenious persons had talked of the means of communicating between two places by electricity, and had discussed the mode of carrying out that idea before Messrs. *Wheatstone* and *Cooke* showed a practically useful way of doing it. The law of this Court is, that where the patentee has had long enjoy-

ment, there he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful; much more ought he to have the injunction here, when I have considerable doubts whether the fact of *Dobbs's* patent would affect the plaintiff's rights.

Action at law in pursuance of the order of the Court. Pleas: 1. That plaintiff was not the true and first inventor. 2. That the invention was not new. 4. That the specification was insufficient. Issue.

At the trial defendant gave in evidence the specification of the patent of 1804, No. 2,761, to *T. Dobbs*. It appeared that there had been no actual user of metal made under *Dobbs's* patent, but defendant relied upon the comparison of the two specifications, as showing that plaintiff's process was not new. Evidence was given on both sides as to the practicability of producing plaintiff's metal by following only the instructions given in *Dobbs's* specification.

Whereupon, LORD CAMPBELL, C.J. asked the jury, 'Whether by the specification of *Dobbs*, or anything done under it, there was made known to the world the process in the specification of the plaintiff.' The jury having hesitated for some time, he finally asked them, 'whether they thought that a person of ordinary skill, reading *Dobbs's* specification, and having no other information on the subject, could at once proceed to make *Betts's* metal.' The jury answered in the negative, whereupon the learned judge directed them to find for plaintiff on the issues upon the first and second pleas. Plaintiff had also a verdict on all the other issues.

(8 E. & B. 923.) Rule nisi for a new trial on the ground of misdirection, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—The way in which I first left it to the jury was, I think, right. Now, I think that though a mode of coating the lead with tin was described in each specification, yet if the plaintiff's specification described a new *modus operandi*, that would be a proper subject for a patent. I think that the test which I finally proposed was defective. That was a proper test only upon the question whether *Dobbs's* specification was good or bad. But the specification might be bad, and yet might disclose enough to show that what the plaintiff specified was not a novelty.

New trial of the same action. The pleadings were the same as before. Defendant again put in evidence the specification of a patent of 14th *May*, 1840, No. 2,761, to *T. Dobbs*. It now appeared that, owing to some unforeseen delay in obtaining the patent, plaintiff had manufactured a quantity of capsules according to his invention, but

this was done by his own workmen under strict injunction that none should be sold, and none were sold until after the patent had been granted. Witnesses also deposed that the patented material had been publicly used before 1849. The scientific evidence went to the same points as in the previous action, and was entirely contradictory on the one side and on the other.

ERLE, J. left it to the jury to say whether the invention was new, and he pointed out that *Dobbs's* specification comprised lead coated with tin by mechanical pressure; that the plaintiff's specification was not confined to any one particular proportion of lead and tin; and that the defendant was entitled to a verdict if the jury were of opinion that *Dobbs's* specification was sufficient to enable a competent person to produce the material subsequently patented by the plaintiff, or that the material had been both produced and used, or sold in public before 1849. The jury found that the new material had been made by pressure prior to the plaintiff's patent, but had not before then been publicly used or sold by a manufacturer in the way of his business. Verdict for plaintiff. Leave reserved.

(1 E. & E. 990.) Rule nisi to enter a verdict for defendant, on the grounds:—1. That plaintiff had manufactured large quantities of the capsules for sale before the date of the patent. 2. That plaintiff's invention, or some material part thereof, was included in *Dobbs's* specification. 3. That the specification was defective in not stating the proportions between the two metals. 4. And in not distinguishing the new from the old. Or for a new trial on the ground of misdirection, on the question raised as to the sufficiency of the specification in respect of the proportions of lead and tin, and that the verdict was against the evidence. Rule to enter a verdict for defendant made absolute by the Court of Queen's Bench (Lord Campbell, C.J., Wightman, Erle, Crompton, JJ.), and Rule for a new trial enlarged until after the judgment of the Court of Error on the previous points.

Per LORD CAMPBELL, C.J.—Upon the first point my opinion is clearly in favour of the plaintiff. I quite agree that if you look at the 6th section of the Statute of Monopolies, it abolishes monopolies altogether, and that there was no power in the Crown after that statute passed to grant monopolies, except with the conditions that are imposed by the reservation; but the reservation which must be relied on here is this, 'which others at the time shall not use.' Now others had not used this before the patent was granted. It was used only by the inventor, the patentee himself; for the use of it by the servants and mechanics whom he employed, must be considered his use; and therefore it was not used by others. But still, if it could

be shown that the effect was really to extend the term of the monopoly, that would be fatal. But Mr. *Hindmarch* has entirely failed in showing that, because any person might have used this manufacture lawfully until the patent was sealed and the fourteen years had begun to run, there was a period of more than fourteen years during which the monopoly existed. That period was not in the slightest degree exceeded.

I come now to the next objection. Notwithstanding *Dobbs's* patent, I am of opinion that it would have been open for another discoverer to have found out certain proportions in which the tin and lead might have been applied to each other, and a new mode of operating, whereby a beneficial result might be obtained. It seems to me that the proportions were not considered as uniformly essential, and that the patentee, by his specification, gives the proportions for the manufacture of the material for the capsules only; intimating, as I think very plainly, that where it was to be applied to other purposes, those proportions might infinitely vary. He claims as his invention the uniting these surfaces by rolling or other mechanical pressure. That is disclosed, and most amply, by *Dobbs*; and therefore I find that the plaintiff claims what *Dobbs* had before described. On that ground I think that the patent is bad.

The other judges concurred.

(1 E. & E. 1,020.) Error brought from the Court of Queen's Bench. Judgment affirmed by the Court of Exchequer Chamber. (Pollock, C.B., Williams, Willes, Keating, JJ., Martin, Bramwell, Channell, BB.)

Per WILLIAMS, J. (dissentiente).—I think that the judgment of the Court of Queen's Bench ought to be reversed. It appears to me that although *Dobbs* made public his notion that lead and tin might be usefully combined into a new material by mechanical pressure, yet inasmuch as he did not make known, or know, by what means that notion could be carried into effect, he, in fact, made no discovery, and was no inventor at all. I have yet to learn that the publication of a notion that a certain useful art may be discovered, without any information or knowledge of the means of discovery, is to preclude a subsequent first inventor of those means from taking out a patent for the entire art.

WILLES, J., concurred in this judgment.

(10 H.L. Ca. 117.) Error was then brought in the House of Lords. The judges were summoned, and Pollock, C.B., Wightman, Williams, Byles, Blackburn, JJ., and Wilde, B., attended. The Lord Chancellor proposed the following questions to the learned judges:—

1. Does it appear, on a comparison of the two specifications, that

a material part of *Dobbs's* specification is claimed by *Betts* in his specification?

2. If so, can the Court pronounce *Betts's* patent to be void, simply on the comparison of the two specifications, without evidence to prove the identity of the inventions, and also without evidence that *Dobbs's* specification described a practicable mode of producing the result, or some part of the result, described in *Betts's* patent?

There was some difference of opinion in the answers given to the first question, but all the learned judges concurred in answering the second question in the negative, WILDE, B. saying:—‘The Court can pronounce two identical descriptions to pourtray two identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence.’

Ordered.—That the judgment of the Court of Exchequer Chamber be reversed, and that the judgment or rule of the Court of Queen's Bench, so far as it orders that the verdict obtained in the said Court be set aside and a verdict entered for the defendant instead thereof, be also set aside.

Per LORD WESTBURY, L.C.—The answer of the learned judges to the second question involves two conclusions which are extremely material to the patent law. One is, that even if there is an identity of language in two specifications, and (remembering that those specifications described external objects) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification and denote the same external objects at the date of one specification as they do at the date of the other.

In all cases where two documents profess to describe an external thing, the identity of signification between the two documents containing the same description must belong to the province of evidence, and not to the province of construction.

I pass on to the next conclusion, which is also of great importance to the law of patents, because it results from that opinion that an antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery. Here we attain at length to a certain, undoubted, and useful rule. The effect of that opinion I take to be this, if your Lordships shall affirm it, that

a barren general description, probably containing some suggested information, or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding, for want of novelty, a subsequent specification or invention which involves a practical truth, productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical and useful information.

Now it will be evident, upon a comparison of these two specifications, that the one was a mere general suggestion, while the other is a specific, definite, practical invention. It is possible that a suggestion, such as that contained in the one, may lead to the discovery of the invention contained in the other. But it is this latter alone which really does add to the amount of useful knowledge; it is the latter alone which, by its practical operation, confers a benefit upon mankind within the meaning of the patent law.

In the present case, there was not only no evidence to show that that which is contained in *Dobbs's* specification was capable of practical operation, but in reality that conclusion was negatived by the verdict of the jury. It results, as a necessary consequence, that the decision of the Court of Queen's Bench and of the Court of Exchequer Chamber ought to be reversed.

Per LORD WENSLEYDALE.--I entirely agree with Mr. Justice Williams and Mr. Justice Willes in their opinion given in this case, that the mere publication of a notion that a particular article might be made, without any information or means of knowledge communicated to the public, does not prevent a subsequent first inventor of those means from taking out a patent.

BETTS *against* CLIFFORD, A.D. 1860. 1 J. & H. 74.

Practice as to Costs where a Suit is abandoned. Three Counsel allowed.

Suit to restrain from infringing the same patent. Motion for injunction ordered to stand over till after the trial of an action at law which was then pending, nothing being said about costs. Plaintiff abandoned his original action against defendants, and began a new one, which resulted in a verdict for defendants on the validity, and for plaintiff on the infringement. A rule for a new trial was afterwards refused by the Court of law. The bill was finally dismissed with costs, for want of prosecution. In taxing defendants' costs the master allowed the costs of opposing the motion for injunction, and the costs of bringing into Court a third counsel, who had been retained at law in the previous actions on the patent. On appeal, the master's decision was upheld.

BETTS *against* NEILSON, A.D. 1868–1871. 3 De G. J. & S. 82;]
L.R. 3 Ch. 429; L.R. 5 H.L. 1.]

Evidence of Infringement. Evidence of prior Publication. User of patented Article. Sufficiency of Specification. Statement of Proportions. Subject-matter of a Patent. Practice as to Account, or Damages.

Suit to restrain from infringing the same patent by the user of certain capsules for covering the corks of bottles.

The defences raised were, (1) prior publication of the invention by *Dobbs's* patent of 1804, No. 2,761; (2) prior user of the invention; (3) that the specification was bad in not stating the proportions of lead and tin; (4) that the manufacture of capsules from the patented material was not the subject-matter of a patent; (5) denial of the infringement.

As to the infringement, it appeared that defendants were the managers of Messrs. *Tennant*, brewers, in *Scotland*, and obtained capsules from a manufactory near *Nuremberg*. Plaintiff produced proof by a workman who was employed in the said manufactory, and saw the capsules made by a process not distinguishable from the patented process. On analysis, the proportions of lead and tin were found to differ from those stated in the patent. Defendants commonly sold the capsuled bottles to persons in *Glasgow*, but in some instances they sent the same to *England*, on their own account, for exportation.

Injunction granted, with account and inquiry as to damages.

(3 De G. J. & S. 82.) On appeal to the Lords Justices, judgment affirmed, with costs.

Per TURNER, L.J.—The liquid comes into this country in bottles, having upon them the patented article, or an article operating in precisely the same way, and so closely resembling the patented article that the use of it in *England* would be an infringement of the patent. I cannot say that the retaining upon the bottles when they are in this country the article so applied to them abroad does not constitute a use of the article in *England*. The case of *Caldwell v. Vanvlissengen* (9 Hare, 415) may be in some respects distinguishable from the present, but I think that it disposes of the present question. The distinction attempted to be drawn between that case and the present is this, that in that case there was an active use of the patented article; and here it is said, and I have no doubt truly said, that the use of the patented article is passive and not active. But it does not appear to me that the question whether the user is active or passive can have any bearing on the question whether the patented article is used or not.

(L.R. 3 Ch. 431.) On further appeal to the Lord Chancellor, judgment affirmed, with costs.

Per LORD CHELMSFORD, L.C.—I am of opinion that *Dobbs's* specification was not such a publication of the invention patented by the plaintiff as to invalidate his patent.

But the defendants say, that there is a great body of evidence to prove a use of the invention long prior to the date of the plaintiff's patent. If the evidence which I am about to examine establishes the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that *Betts's* patent was invalidated.

His Lordship then proceeded to examine the evidence, and held that the defence on this ground entirely failed.

He then continued :—The infringement of a patent is a *tort*, and all persons who are in any way acting towards it are jointly answerable. I do not appreciate the distinction which was pressed upon me in argument between the active and passive use of a thing. In my opinion there was an active use of the capsules by those who first placed them upon the bottles, and by those who had them in their possession afterwards, with the power of either continuing or removing them.

His Lordship then examined the objection to the decree, on the ground that it ordered an account and also an inquiry as to damages, and stated that he should hold the decree of the Vice-Chancellor to be right in this respect.

(L.R. 5 H.L. 1.) Appeal to the House of Lords. The patent expired on 13th *Jan.* 1868, and the judgment of the Lord Chancellor was given on 8th *Feb.* 1868. By the expiry of the patent the injunction fell to the ground. There remained only the demand for damages, and the question of costs. Decree varied by striking out the order for an account, otherwise affirmed. Appeal dismissed, with costs.

Per LORD WESTBURY.—The question of user was argued at some length, but I think unnecessarily. The user which is admitted to have been made by the appellants of these foreign capsules is this, that, after having applied them to their bottles of beer, they have, in some cases, sent the bottles so capsuled to their agents in *England* for exportation from *England*. As soon as the bottles passed the border there was a user of the capsules by the appellants, and the capsule was performing its proper function during the whole time of the transit of the bottles through *England*, and their remaining in *England* until they were exported. There is here evidence of a user of the patented article prejudicial to the patentee, which is sufficient

in itself to justify and support the injunction and the direction as to damages; and it is not necessary to enter into the inquiry as to the extent to which this has been done, it being clearly proved, and in fact admitted, that it has been done to a certain extent, and in a manner that must have been injurious to the patentee.

In ordinary cases of pirated patents in *England*, Courts of Equity have been in the habit, where there is a difficulty in obtaining proof, of granting a limited order of access and inspection of the machinery possessed, or the manufacture carried on, by the individual who is charged with the piracy. The opportunity of doing that is not enjoyed by the respondent here by reason of the locality of the foreign manufacture. But the opportunity of describing the actual process pursued there was possessed by the appellants to the full extent, and they might have entirely rebutted the *prima facie* evidence given by the respondent, if it was in their power to do so, by producing conclusive proof that the process of the foreign manufacture was substantially different from the process described in the respondent's patent. That, however, they have not done, nor have they assigned any satisfactory reason for not having done so.

The objection to the validity of the patent, on the ground of want of novelty, rests, first, on an old patent of *Dobbs*, which was granted in 1804. Your Lordships came to the decision that if you took *Dobbs's* specification in the one hand, and *Betts's* specification in the other, you could not upon a comparison of the two *per se*, arrive at the conclusion that the one anticipated the other. The point therefore has been conclusively settled by your Lordships' House, that the invention of the one taken *per se*, did not forestall or anticipate the invention of the other.

I will merely note for a moment some little difficulty that appears to have been felt about an opinion I expressed in the case of *Hills v. Evans* (31 L.J. Ch. 457), as to what it was necessary to find in the anterior publication. My opinion was that the antecedent process, if it be relied upon as forestalling the second, must be so clearly and distinctly described, that those who read it, bringing to it competent mechanical skill, would be enabled to work it out to the same result as that arrived at by the process contained in the subsequent patent. Lord Lyndhurst required for the anterior description of the machine that it should be distinctly and clearly described in a manner corresponding with the description in the specification.

Now that being the obligation lying upon those who appeal to a prior patent as having already given to the world the necessary and useful information which is contained more fully in the subsequent patent, the appellants have sought to discharge themselves of that

obligation by bringing two descriptions of evidence—one, the evidence of scientific witnesses, who, taking up in the years 1866 and 1867, when they were examined, the specification of *Dobbs*, have tried to work it in such a manner as to produce results substantially identical with the material of *Betts*, and therefore to prove that, in reality, it forestalled *Betts's* discovery. The other consists of evidence applicable to the fact of there having been in reality a prior user of *Betts's* process anterior to the patent.

I must say that when we come to examine the scientific evidence, I think I never met with a case where I was more pained to observe the manner in which the efforts of the men examined had all been directed, after their minds were fully informed of *Betts's* invention, to endeavour to strain the description of *Dobbs*, so as to include in the application made of *Dobbs's* design and *Dobbs's* processes, something which should approximate to the invention of *Betts*. Upon the evidence I have desiderated, but have been unable to find proof that by the process of *Dobbs*, without anterior lamination, which belongs to *Betts's* invention, there has been produced a material substantially identical with *Betts's* material, and capable of similar application.

We pass on to the other evidence which has been given of prior user. It appears that the proof of prior user has been reduced by the present appellants to what took place at four mills. The whole of this evidence was gone through by the Vice-Chancellor, and also by the Lord Chancellor. I entirely concur with the observations made by both those learned judges, namely, that the evidence was not to be relied on. That plain and distinct proof which might have been given, if the truth was so, is wholly wanting.

My Lords, that brings us to the consideration of the last two objections to this patent. If, it is said, a particular detailed process be claimed, the claim is defective and void, for the proportions of the ingredients used are not given. Now, in the first place, certain proportions are given by *Betts* in his patent, and they consist in the relative thickness of the lead and tin. But he assigns these relative proportions not as things which are in themselves unchangeable, but as being the best for the purpose which he desired to accomplish, and they are given rather as illustrations of the mode of user of the process, than as certain definite termini which could not be exceeded or diminished either on the one side or the other. I find, therefore, no objection to the validity of the patent on this ground.

The last objection to the patent 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 inde-

pendently 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 user of it, comprehended in the general user claimed, cannot for a moment be accepted as a ground for vitiating the patent.

I have only further to observe that the decree of the Court below directed not only an inquiry as to damages, but also an account of profits. The two things are hardly reconcilable, for if you take an account of profits, you condone the infringement. I therefore think, my Lords, that we were right in calling upon the respondent's counsel to elect between the two which he would adopt. He has adopted the inquiry as to damages, and the other, the account of profits, must be struck out of the decree. But that ought not to alter the result of this appeal, and I trust therefore that your Lordships will concur in the motion I have to make, that this appeal should be dismissed, with costs.

BETTS *against* DE VITRE, A.D. 1865-73. 34 L.J. Ch. 289; }
 11 Jur. N.S. 9; L.R. 3 Ch. 429; L.R. 6 H.L. 319. }

Practice in Patent Suits. Account or Damages. Personal liability of Directors of a Company for Infringement. Costs.

Suit to restrain from infringing the same patent, brought against *Wimshurst's Metal Foil Company*, and its directors.

The case was tried by the Court without a jury, on the issues of validity and infringement, both of which were found for plaintiff, who prayed an account and inquiry as to damages.

Wood, V.C. granted the injunction with the usual account, but (following the decree of Lord Westbury, L.C., in *Hills v. Evans*, 31 L.J. Ch. 457) allowed plaintiff to proceed at law for damages if he chose to waive the account. Subsequently, however, it was discovered that the decree drawn up in *Hills v. Evans* directed 'an account of profits made by the defendant by infringing the plaintiff's patent, and of such other compensation as was fit to be awarded to the plaintiff in respect of such infringement.' Whereupon his Lordship ordered an account, together with inquiry into damages, and granted the injunction with costs.

(11 Jur. N.S. 9.) Application was then made for costs as between solicitor and client, and that the directors should be made personally liable for the same. Full costs refused, but the directors held personally liable.

Per Wood, V.C.—As regards the point about the defendants being made personally liable for the costs, I really have no doubt on the subject. The case being distinctly stated and proved, I have not the least doubt that the decree must be against them, both as to the injunction and account, and that they must be decreed personally to pay the costs. I see no ground for exempting them from any possible penalty which the law may impose.

His Lordship then recapitulated the proceedings which had taken place in *Betts v. Menzies*, by stating that the judge gave his certificate at the trial that the right had come in question, and the verdict then was with the plaintiff; that after the judgment of the House of Lords, the Court of Queen's Bench directed a new trial, which, however, did not take place, in consequence of a compromise between the parties; and continued:—That being the only certificate I have, I think, regard being had to stat. 15 & 16 Vict. cap. 83, sec. 43, that where there is a wilful act against the rights of a patentee after he has obtained a verdict, and the certificate of a judge that his title came in question, all the world must be taken to know that if they infringe the patent, they infringe it with a liability for costs. That being the meaning of the Act of Parliament, I have not enough before me here to direct these costs to be paid as between solicitor and client.

(L.R. 3 Ch. 429.) On appeal to the Lord Chancellor, decree affirmed, and appeal dismissed, with costs.

Per LORD CHELMSFORD, L.C.—The alleged infringement of the plaintiff's patent took place in the company's works, and in the course of the performance of the proper duties in which the workmen were engaged. Those who have the control of the working are responsible for the acts of their subordinates, and it is not sufficient for them to order that the work shall be so done that no injury shall be occasioned to any third person. That, of course, must be avoided, whether orders to that effect are given or not; but the directors were bound to take care that their orders were obeyed, and if there was a violation of them, whether openly or secretly, they are liable for the consequences.

(L.R. 6 H.L. 319.) Appeal to the House of Lords. The decree of Lord Chelmsford, L.C. was the same as that pronounced in *Betts v. Neilson* (L.R. 3 Ch. 429). In *March*, 1871, the House of Lords varied the decree of the Court below in the latter case by striking out the double order for an account and inquiry as to damages, and put Mr. *Betts* to his election between the two. On 26th *Jan.* 1872, the solicitors for appellants informed the solicitors for respondent that they could no longer dispute the validity of the

patent or its infringement, and that they would withdraw the appeal and pay the costs up to that time, if respondent would consent to abandon the double claim to an account and damages, and would elect between the two; and that otherwise they should apply for the costs occasioned by his refusal. This proposal was not accepted, and the case went on; but appellants adhered strictly to their proposition, and stated the same to their Lordships.

Decree appealed from varied, with special directions as to costs.

Per LORD CAIRNS.—As I understand the order in *Neilson v. Betts*, if it decided anything it decided this, that, not by reason of any peculiarity in that particular case, not by reason of the inquiry as to damages being sufficient for that particular case as distinguished from other cases, but on the general principle that the recent power given to the Court of Chancery to grant an inquiry as to damages (see 21 & 22 Vict. cap. 27, sects. 2, 5), was not intended to be super-added to, and could not coexist with the old relief administered by the Court of Chancery of granting an inquiry as to profits, upon that ground your Lordships decided that the decree in that case should be varied; and, my Lords, that is a ground which applies not to that case alone, but to every case of an infringement of a patent.

The decree must be varied in the way it was varied in *Neilson v. Betts*. The only other question is, what is to be done with regard to the costs? It was brought home to the mind of the respondent that after the decision in *Neilson v. Betts* there was no longer anything to be argued in this case, or anything which your Lordships could attend to or listen to for a moment. The offer was then fairly made to reimburse all expense the respondent had incurred up to that time, and from that time forward it became, not a question of what the Court below had done, but a question of misconduct on his part in maintaining the defence to an appeal which, when it was narrowed to this one single point, he no longer ought to have maintained. My Lords, on this ground, which stands high and dry from the infringement of any rule of your Lordships' House, I entirely concur in the motion made by my noble and learned friend that in this case, according to the offer made by the appellants, they should pay the costs of the appeal up to 26th *Jan.* 1872, and from that date the costs of the appeal should be ordered to be borne by the respondent.

BETTS *against* GALLAIS, A.D. 1870. L.R. 10 Eq. 392.

Practice in a Suit where the Patent has expired.

Suit to restrain from infringing the same patent, for an account, and compensation in damages. Bill filed on 8th *Jan.* 1868. The

patent (extended for five years) expired on 13th *Jan.* 1868. No application had been made for an *interim* injunction. The validity of the patent was admitted. Bill dismissed, with costs.

Per JAMES, V.C.—I am of opinion that this bill cannot be sustained. I agree with every word which fell from Vice-Chancellor Wood in *Davenport v. Rylands* (L.R. 1 Eq. 302). But I think he never intended to give countenance to such an application as this, where the patent expired a few days after the bill was filed; and the plaintiff must have known it was utterly impossible he could have obtained any equitable relief before the patent expired. At the time of filing this bill there was a mere claim for damages.

BETTS *against* WILLMOTT, A.D. 1870–1. 18 W.R. 946; L.R. 6 Ch. 239.

Evidence of Infringement.

Suit to restrain from infringing the same patent. Plaintiff complained that defendant, a retail chemist, had sold a bottle of *Rimmel's* toilet vinegar, having a capsule similar to those manufactured under the patent. It appeared that plaintiff had capsule manufactories abroad, and he could not say that the capsule in question had not been made and sold by his own house in *Paris*. JAMES, V.C. dismissed the bill, without costs, neither side having, in his opinion, so conducted themselves as to become entitled to costs. Appeal from this decision dismissed, with costs.

Per LORD HATHERLEY, L.C.—When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his license to sell the article, or to use it whenever he pleases as against himself.

I am of opinion that, if the plaintiff cannot show that he has not himself sold the very article, the use of which he now seeks to prohibit, he cannot succeed by way of injunction in this Court any more than he would in an action at law.

BEWLEY *against* HANCOCK, A.D. 1855. 6 De G. Mac. & G. 391.

Construction of Agreement to work certain Patents.

Suit to obtain a declaration that a patent of 29th *July*, 1848, No. 12,223, to C. Hancock, for 'improvements in machinery for giving shape and configuration to plastic substances,' was subject to the trusts of a deed of 21st *Jan.* 1846, executed in pursuance of an agreement of 31st *May*, 1845, made between plaintiff, defendant, and two other persons, who were all interested in certain patents relating to the manufacture of gutta percha, whereby it was agreed

that all patents thereafter taken out by any of the parties 'in relation to the preparation and application of gutta percha, or the manufacture of any articles therefrom,' should be assigned to trustees, and held for their common benefit. STUART, V.C. made the decree as prayed. Appeal dismissed by the Lord Chancellor, with costs.

Per LORD CRANWORTH, L.C.—I do not doubt the accuracy of the proposition maintained at the bar, that there may be a wide distinction between a patent for the invention of any useful article of commerce, and a patent for the invention of machinery by which such an article may be manufactured. A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance valuable for medical or other qualities, would afford a good ground for a patent. A discovery of some machinery whereby such a mixture may be more quickly or more effectually accomplished, might be the foundation of another patent, and instances might be almost indefinitely multiplied. When, however, we look at the subject-matter of this patent, it is plain that such a distinction never could be supported. Looking at the specifications of the patents clearly included in the agreement, it appears that they all, or almost all, describe as part of the invention the machinery by which the proposed manufacture is to be accomplished.

The defendant, however, contends that his patent is not within the agreement, because it is not a patent for the application or manufacture of gutta percha, but of plastic substances generally. This, however, is a distinction which it is impossible to maintain. The discovery had relation to the application and manufacture of articles from gutta percha, though it may be that it also had reference to the application and manufacture of articles from other substances. So far as it relates to gutta percha it is within the agreement, and so far as it relates to any other substances the defendant's rights are saved by the decree.

BICKFORD *against* SKEWES, A.D. 1837-9. 1 Webs. Pat. Ca. 211; }
2 Coop. Ch. Ca. 59; 4 Myl. & Cr. 498; 1 Q.B. 938. }

Practice in Patent Suits. Injunction. Action at Law. Sufficiency of Specification.

Suit to restrain from infringing a patent of 6th *Sept.* 1831, No. 6,159, to *W. Bickford*, for 'an instrument called the miner's safety fuse.' Injunction granted. Order for action at law.

'VICE-CHANCELLOR.—An order that the plaintiff shall undertake, in case it shall turn out that he is wrong, to compensate the defendant for injury in stopping his manufactory, is not usual.' *December*, 1838 (2 Coop. Ch. Ca. 59.

An application being made to compel plaintiff to proceed to trial

at an early date, LORD COTTENHAM, L.C. refused to make any order, and said:—If the patentee has been long in possession the Court will not look into the title, but will give credit to it until displaced by a trial at law, and will put the plaintiff upon proceeding to trial and exercise absolute control over the parties, according as they may or may not do that which the Court has directed.

Action at law. Plea: That the specification was insufficient. Issue.

The patent related to the manufacture of a *fuse*, formed of several strands of flax, hemp, &c., and enclosing within the interior a small core of gunpowder. The gunpowder was fed in by a funnel at the point where the strands were twisted into a cord. The specification 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 pyrotechnic manner of fireworks for the discharging of ordnance.’

At the trial, it appeared that gunpowder was, in fact, the material used by plaintiff; one witness, however, expressing an opinion that detonating powder would answer, but not so well as gunpowder. It was objected that the specification was bad as referring to other combustibles besides gunpowder, when gunpowder alone could be used; and also that the words ‘flax, hemp, cotton, or other suitable material, spun, twisted, &c.’ were too vague, and might extend to materials which would not give effect to the invention, it being in evidence that glass fibres might be spun, but could not be employed for making the cord. COLERIDGE, J. left it to the jury to say, upon the evidence, whether the specification in its several parts sufficiently explained the invention. Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial discharged by the Court of Queen’s Bench.

BLOXAM *against* ELSEE, A.D. 1825–7. 1 Car. & P. 558; }
9 Dowl. & Ry. 215; 6 B. & C. 169. }

Master and Servant. Assignment by operation of Law. Drawings called in aid of description. Variance between Title and Specification. False Suggestion.

CASE for the infringement of two patents, viz., of 20th April, 1801, No. 2,487, for ‘an invention of making paper in single sheets, without seam or joining, from 1 to 12 feet and upwards wide, and from 1 to 45 feet and upwards in length,’ and of 7th June, 1803,

No. 2,708, for improvements and additions to the machine described in the first patent, each to *J. Gamble*. By stat. 47 Geo. III. cap. 131, the grants were enlarged, on condition that the patentee should enrol a further specification containing all improvements made in the machine (see No. 3068*, specification enrolled by *H. & S. Fourdrinier* and *J. Gamble*), and subject to the proviso, that if the patent should at any time become vested in or in trust for more than five persons, otherwise than by devise or succession, the privilege should cease and determine. Plea: Not guilty. Issue.

The patents related to the invention of a machine for making paper, which afterwards became the type of machinery in use at the present day. The specification of the patent of 1801 described the invention by reference to drawings, and showed an endless sheet made of copper wire (replacing the wire moulds used in making paper by hand) and supported by wooden rollers. A film of liquid pulp was continuously supplied to this copper sheet, and carried on thereby till it passed between two brass pressing cylinders, which squeezed out the water and so far dried the film of paper that it was capable of being at once rolled in a continuous sheet upon a light wooden roller. The specification stated:—‘On both sides of the copper sheet are seen copper clasps, affixed at equal distances, and the said sheet is bordered on both sides with eel-skins, cut into strips or ribands.’ This edging to the endless web determined the width of the paper. There was also a description of a machine for pressing the recently made paper by passing it on to an endless cloth and compressing it by a roller.

The specification of the patent of 1803 stated:—‘Instead of limiting the breadth of the piece by the facing or edge of eel-skin attached to the edge of the circulating piece (or web), I do limit the said breadth by two gauges, one on each side, consisting of pieces of wood.’ The gauges were then described. The specification enrolled under the Act of Parliament (No. 3068*) stated:—‘The width of the paper is determined by two pieces of wood, set edgeways upon the web.’ It went on to describe the dimensions of the pieces (which were about 4 feet in length), and the adjustment of them. One was placed over the web on each side thereof, and an endless strap carried on revolving pulleys ran between the guide and the web at the same surface velocity as the web. Additional guides and straps were placed underneath, so as to grasp the web and prevent the liquid pulp from running over its edge. The machine described in the final specification was greatly improved in construction, and was competent to manufacture paper of varying widths.

At the trial, it appeared that *Gamble* had obtained his knowledge

from one *Didot*, an *alien enemy*, whose trustee he was at the time of taking out the patent. Also that the improvements mentioned in the third specification were made by one *Donkin*, an engineer, employed by the patentee and his partner for the purpose of bringing the machine to perfection. It was objected that improvements so made were not the invention of the patentee and could not be claimed as such. It further appeared, on the evidence of Mr. *Donkin*, that the machine described in the first specification would work to one width only, and it was objected that the first and subsequent grants were therefore void for false suggestion. It also appeared that, upon the bankruptcy of the patentee in 1810, his creditors, exceeding five in number, had proved under the commission, and an objection was taken on this ground, but was over-ruled.

An objection being further raised that the patent was void as being held in trust for an *alien enemy*, ABBOTT, C.J. said:—‘I shall reserve that point.’

The specification contained references to *French* words, e.g., ‘*vice of pression*’ for ‘*adjusting screw*,’ ‘*centimetres*’ for ‘*inches* ;’ but it appeared that although these terms would not be understood by *English* mechanics, yet that a skilful workman could construct the machine by the aid of the drawings annexed to the specification, and his Lordship observed:—‘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 drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient.’ His Lordship then left it to the jury to say whether the invention was useful, and whether the defendant had infringed; and further observed that by the 6th section of the Act of Parliament the final specification was to be taken as a substitute for the former specifications, and if good (which it was) that would cure all defects and omissions in the former ones. Verdict for plaintiff. Leave reserved.

Rule for a new trial on the ground that the patent was void, as being vested in trust for more than five persons, refused by the Court of King’s Bench. (Abbott, C.J., Bayley, Holroyd, Littledale, JJ.) .

Per ABBOTT, C.J.—I am clearly of opinion that the proviso can be construed only as applying to acts of the parties by which the interest in the patent shall be divested, and does not apply to an assignment by operation of law, which is the effect of a commission of bankruptcy. The assignees represent the bankrupt by operation of law.

Rule nisi for a new trial, granted on the remaining objections taken at the trial, but made absolute on the ground that the specification of the original patent was insufficient.

Per ABBOTT, C.J.—I think one of the objections which has been taken in this case is valid, and must prevail, and consequently it is not necessary to give any opinion upon the others. By the patent it appears that the patentee had represented to the Crown that he was in possession of a *machine* for making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation, the patent is granted. The consideration for the grant is the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration has failed in part, and the grant is consequently void, and a defendant in an action for infringement has a right to say that it is so. If the representation be (as I think it is) that paper of various widths may be obtained from one and the same machine, I must look to the evidence to discover whether the patentee was possessed of a machine, or of the invention of a machine, capable of accomplishing this object. And, unfortunately, the evidence shows that he was not. The patentee was at the time possessed of one machine, and one only, and this adapted to one degree of width, and one degree only. And he was not then possessed of any method by which different degrees of width might be manufactured by that machine or by any other. If the first machine had been capable of working at different degrees of width, though clumsily and imperfectly, the latter machine would have been an improvement of it; but as the first, whether considered as existing actually or in theory, was wholly incapable of this, the latter machine does not in this respect furnish an improvement of anything previously existing, but an addition of some new matter not existing or known at the date of the first patent, and which, nevertheless, is therein represented as existing or known, and which cannot but be considered an important part of the representation then made, and of the consideration for the grant. If the first grant was void, the subsequent grants by the patent and by the statute must fall to the ground, as having nothing to support them. I think myself compelled therefore to yield to this objection. If, however, the law in this respect should not be in the opinion of my learned Brothers that which I own it has appeared to me to be, still there must be a new trial, because the question ought to have been left to the jury. I do not think it necessary to give any opinion on the point about the *alien*.

BOOTH *against* KENNARD, A.D. 1856-7. 1 H. & N. 527; }
 2 H. & N. 84. }

Subject-matter of a Patent. Novelty of Invention. Claim too large.

CASE for the infringement of two patents, viz., of 12th Nov. 1850, No. 13,334, and of 8th May, 1852, No. 14,116, each to *G. R. Booth*, for 'improvements in the manufacture of gas.' Plea 8: That the alleged invention or inventions were not, nor was either of them, the subject of a patent. Issue.

The patent of 1850 related to the manufacture of gas from oil. The oil was projected directly upon the incandescent surface of a retort, and the soot which formed and impeded the conversion into gas was burnt out at intervals.

The patent of 1852 related to the manufacture of gas direct from seeds containing oil. One apparatus described was a perforated vessel for holding the material, the whole being enclosed in a retort heated by a furnace. *Claim*: 'The making gas direct from seeds and matters herein named, for practical illumination, instead of making it from oils, resins, or gums, which had been previously extracted from such substances.'

POLLOCK, C.B. directed the jury:—That the invention comprised in the patent of 1852 was not the subject-matter of a patent. Verdict for defendant on 8th issue, so far as it related to the patent of 1852.

Error on bill of exceptions to this direction. Judgment of *venire de novo* by the Court of Exchequer Chamber. (Cockburn, C.J., Coleridge, Wightman, Erle, Williams, and Crompton, JJ.)

Per COCKBURN, C.J.—We all think that the direction of the Lord Chief Baron was erroneous, and that there must be a *venire de novo*. The patent claims the making gas directly from seeds and other oleaginous substances, instead of making it from oils. By this means, the patentee gets rid of one of two processes. Previously to the date of the patent, gas had been obtained by a particular apparatus from oils, which were first separated from the substances containing them by pressure. The patentee has discovered that the first process may be dispensed with. That is a useful invention, and the patent is sustainable if the invention is new.

New trial of same action. Pleas: 1. Not guilty: 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. 6. That the specification was insufficient. 8. As to patent of 1852, that the invention was not a new manufacture. Issue.

At the trial, defendant put in evidence the specification of a patent of 12th Feb. 1829, No. 5,771, to *E. Heard*, wherein the patentee claimed the distilling of gas from a variety of substances, and *inter*

alia, 'from beech-nuts, or mast, cocoa-nuts, and all others abounding in oil.' POLLOCK, C.B. directed a verdict for defendant on the issues as to novelty and sufficiency of the specification of the patent of 1852. Verdict accordingly. Leave reserved.

Rule nisi to set aside the verdict, and enter a verdict for the plaintiff, discharged by the Court of Exchequer.

Per POLLOCK, C.B.—We think that *Heard's* specification clearly shows that as a general fact (*viz.*, making gas direct from seeds and other oily matters) the invention was not new, and it was decided in *Bush v. Fox* (5 H.L. Ca. 707) that where the want of novelty appeared distinctly from documents or written instruments, such as a prior patent or specification, it was for the Court to take notice of the identity of the two supposed inventions, and the want of novelty therefore in the second. That *Heard* had discovered and had communicated to the world that gas might be made direct from nuts and other oily and fatty substances, appears to us to be quite clear from his specification enrolled. We think that it was not necessary to submit this to the jury, and take their opinion on it. It is, we think, the plain meaning of the written document, and we think it is for the Court to construe it; and as this is part of the invention claimed by the plaintiff in his second patent, we think that the plaintiff's invention is so far not new, and therefore that the invention as a whole cannot be claimed as new.

We are also of opinion that the claim is too large, and cannot be supported. It is a claim to make gas direct from seeds—not in any mode pointed out in the specification, but generally. After the publication of *Heard's* specification, no patent could be taken out for the process generally, though a patent might be taken out for a particular method of doing it. We think the plaintiff's second patent was not for any particular method of doing it, but for the doing of it by any method; and we think that even if it had been new (which it turns out not to be), such a mode of specifying and claiming the invention cannot be sustained as a good specification.

BOULTON AND WATT *against* BULL, A.D. 1793-9. 2 H. Bl. 463; }
3 Ves. 140; Dav. Pat. Ca. 162. }

Sufficiency of Specification. Drawing or Model not essential. Subject-matter of a Patent. Practice in Patent Suits. Injunction.

Suit to restrain from infringing a patent of 5th *Jan.* 1769, No. 913, to *J. Watt*, for 'a new invented method of lessening the consumption of steam and fuel in fire-engines.' The term of the patent was extended by stat. 15 Geo. III. cap. 61, to a period of

twenty-five years. Injunction granted. Action at law in the Court of Common Pleas. Plea: Not guilty. Issue.

The patent related to the invention of a separate condenser for steam-engines, at that time called *fire-engines*. Previously, the practice had been to admit steam and cold water alternately into the cylinder of a steam-engine, and a great waste of fuel was the result. The invention of *Watt* consisted in condensing the steam in a separate vessel, and in keeping the cylinder as hot as the steam which entered it. The specification did not describe the actual construction of an engine, but stated:—‘My method of lessening the consumption of steam, and consequently fuel, in fire-engines consists in the following principles. *First*. That vessel in which the powers of steam are to be employed to work the engine, which is called the cylinder in common fire-engines, and which I call the steam-vessel, must, during the whole time the engine is at work, be kept as hot as the steam that enters it. (1) By enclosing it in a case of wood or other materials that transmit heat slowly; (2) by surrounding it with steam or other heated bodies; (3) by suffering neither water nor any other substance colder than steam to enter or touch it during that time. *Secondly*. In those engines that are to be worked wholly or partially by condensation of steam, the steam is to be condensed in vessels distinct from the cylinders, though occasionally communicating with them. These vessels I call *condensers*, and whilst the engines are working they ought to be kept as cool as the air in the neighbourhood by the application of water or other cold bodies. *Thirdly*. Whatever air or other elastic vapour is not condensed by the cold of the condenser, and may impede the working of the engine, is to be drawn out of the steam-vessels or condensers by means of pumps wrought by the engines themselves or otherwise.’ There was no drawing annexed to the specification, nor was there any separate claim.

At the trial, it appeared that the title of the Act of Parliament for extending *Watt's* patent, was ‘An Act for vesting in *James Watt*, engineer, &c., the sole use and property of certain steam-engines, commonly called fire-engines, of his invention,’ &c. The jury found that the specification was sufficient to enable a mechanic acquainted with fire-engines to construct an engine capable of producing the effect of lessening the consumption of fuel and steam upon the principle invented by *Watt*. Verdict for plaintiffs, subject to a case stated for the opinion of the Court of Common Pleas. The questions for the opinion of the Court were—(1) Whether the patent was good in law, and continued by the Act of Parliament above mentioned; (2) Whether the above specification of plaintiff, *James Watt*, was, in point of law, sufficient to support the patent.

The main objection was that the patent was for a principle. The Court was divided, and no judgment was given. Eyre, C.J. and Rooke, J. supported the patent, but Heath and Buller, JJ. were of opinion that there ought to be judgment for defendant.

Per ROOKE, J.—As to the objection of the want of a drawing or model, that at first struck me as of great weight. But I have satisfied my mind thus: infringement or not is a question for the jury; in order to decide this case they must understand the nature of the improvement or thing infringed. If they can understand it without a model I am not aware of any rule of law which requires a model or drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement merely because no drawing or model is annexed.

Per BULLER, J.—The very statement of what a principle is proves it not to be a ground for a patent. It is a first ground and rule for arts and sciences, or, in other words, the elements and rudiments of them. A patent must be for some new production from those elements, and not for the elements themselves. This brings us to the true foundation of all patents, which must be the manufacture itself, and so says the statute (21 Jac. I. cap. 3). Whether the manufacture be with or without principle, produced by accident or by art, is immaterial. In most of the instances of the different patents mentioned by my brother *Adair*, the patent was for the manufacture, and the specification rightly stated the method by which the manufacture was made; but none of them go the length of proving that a method of doing a thing, without the thing being done, or actually reduced into practice, is a good foundation for a patent.

Per EYRE, C.J.—It was admitted in the argument at the bar that the word '*manufacture*' in the statute (21 Jac. I. cap. 3) was of extensive signification, that it applied not only to things made, but to the practice of making, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under things made we may class, in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art producing effects useful to the public. In the list of patents with which I have been furnished there are several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced are the saving of

time and expense, and thereby lowering the price of the article and introducing it into more general use. Now, I think these methods may be said to be new manufactures.

An improper use of the word '*principle*' in the specification set forth in this case has, I think, served to puzzle it. Undoubtedly there can be no patent for a mere principle: but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. The substance of the invention is a discovery that the condensing the steam out of the cylinder, and protecting the cylinder from the external air, and keeping it hot to the degree of steam heat, will lessen the consumption of steam. This is no abstract principle, it is in its very statement clothed with practical application; it points out what is to be done in order to lessen the consumption of steam. It can hardly be supposed that a workman capable of constructing a fire-engine would not be capable of making such additions to it as should be necessary to enable him to execute that which the specification requires him to do. This difficulty is put an end to, because the jury have found that a workman can execute the improvement in consequence of the specification. Some machinery, it is true, must be employed, but the machinery is not of the essence of the invention, but incidental to it.

Supposing the difficulty upon the patent itself and the specification to be got over, the Act of Parliament remains to be considered. The objection, stated in the strongest manner, would amount to this, that the Act continues a patent for a machine when, in fact, the patent is for a process. The specification calls a method of lessening the consumption of steam in fire-engines a *principle*, which it is not; the Act calls it an *engine*, which perhaps also it is not; but both the specification and statute are referable to the same thing, and when they are taken with their correlative are perfectly intelligible. I am therefore of opinion that the Act has continued this patent.

Upon motion, LORD LOUGHBOROUGH, L.C. directed another action at law, and refused to dissolve the injunction, or to impose any terms in bringing the action, saying:—'I cannot put the patentees upon the acceptance of terms that, upon collateral reasons, they think may be disadvantageous to the exercise of the right of *which they are in full possession*; neither can I put them out of possession upon the difference of opinion of the Court. It is of notoriety that this fire-engine has been erected in many parts of the country with great advantage.'

For the second action, see *Hornblower v. Boulton* (8 T.R. 95).

BOVILL *against* MOORE, A.D. 1815-6. 2 Coop. Ch. Ca. 56; }
 Dav. Pat. Ca. 361; 2 Marsh. R. 211. }

Inspection of Machinery. Sufficiency of Specification. Obligation in Specifying.
An Improvement must be distinguished. A Patent for a new combination of
old parts is valid.

Suit to restrain from infringing a patent of 24th *April*, 1811, No. 3,434, to *J. Brown*, for 'a machine for the manufacture of bobbin lace or twist net.' Order for a trial at law and an inspection.

Per LORD ELDON, L.C.—There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The manufactory of the defendant is carried on in secret. The evidence of the piracy at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously, in a great measure, conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine and to see it at work.

Action at law in pursuance of the order of the Court. Plea: Not guilty. Issue.

The patent related to a method of interlacing and twisting the longitudinal or warp threads and the diagonal or bobbin threads in lace weaving. The specification stated:—'My invention consists, as represented by the drawings hereto annexed, and as hereinafter described.' Then followed a description of the entire machine. There was no separate claim.

At the trial, it appeared that up to the point at which the bobbin in *Brown's* machines travelled round a longitudinal thread to form the twist, the operation was the same as that in previous machines, but beyond that point it was different. It was therefore contended that the patent should have been for an improvement only, and not for the entire machine. It further appeared that a contrivance used in the patented machine for preventing entanglement of the threads had not been described in the specification.

GIBBS, C.J. directed the jury:—In point of law, it is necessary that the plaintiff should prove that this is a new and useful invention, in order to entitle himself to the present action,—that, I think, he has satisfactorily done. The next question is, whether the specification would enable a workman of common skill to make the machine. Upon the evidence adduced to you, I think there is no doubt it would.

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. If Mr. *Brown*, since he obtained his patent, has discovered an improvement, he may apply that improvement, and his patent will not be affected by his using his own machine in that improved state; but if at the time when he obtained his patent he was apprised of this more beneficial mode of working, and did not by his specification communicate this more beneficial mode of working to the public, that will have been a fraudulent concealment from the public, and that will render his patent void. If you think that he has invented an engine which consists of a perfectly new conformation of parts, though all the parts were used before, yet he will be entitled to support his patent for a new machine. If a combination of a certain number of parts existed up to a given point before, and Mr. *Brown's* invention sprung from that point, and added other combinations to it, then I think his specification, stating the whole machine as his invention, is bad. You will say, first, whether you think there is any fraudulent concealment in the specification, and next, if there was not, whether you think he has, in his specification, described an invention to a greater extent than the proof goes to establish. If he inadvertently did not state the whole in his specification, he must answer for his inadvertence; but it might be a subsequent discovery.

The jury found, that the combination of the parts up to the crossing of the threads was not new. Verdict for defendant.

Rule for a new trial refused by the Court of Common Pleas. (Gibbs, C.J., Dallas, Park, JJ.)

Per DALLAS, J.—As to the law, it is quite clear that if the invention set up be an addition, the patent must be for that addition only, as in the case of the invention of a particular movement of a watch.

Per PARK, J.—The law was most fully and most correctly laid down to the jury by his Lordship. Nor is this new doctrine; for in *Re v. Else* (Bull. N.P. 76) Mr. Justice Buller held that the patent must not be more extensive than the invention, and therefore that, if the invention consisted of an addition or improvement only, a patent for the whole machine was void.

BOVILL *against* PIMM and RANDS, A.D. 1856. 11 Ex. R. 718.

Novelty of Invention. Construction of Specification. Evidence of Infringement.

CASE for the infringement of a patent of 18th Aug. 1846, No. 11,342, to *G. H. Bovill*, for 'improvements in manufacturing wheat and other grain into meal and flour.' Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. 4. That the specification was insufficient. 5. Not guilty. Issue.

The patent related to the use of a blast of air thrown between millstones in grinding flour. In the old system of grinding wheat between millstones, a large quantity of the finest flour was produced on first crushing the grain; but this flour did not at once pass away, and was, in fact, continually reground with the unreduced particles before it was discharged at the edge of the running stone. It followed not only that the flour was overground, but also that it became heated to such an extent that its quality was deteriorated. The patentee closed the eye of the running stone, and sent a blast of air, under pressure, into the cavity at the centre of the stones; this blast passed through the space between the stones and carried away all the finest particles of meal as soon as they were formed. Thus the stones performed their legitimate function of grinding only the unreduced particles, the grist being discharged in a cool state and ready for immediate dressing. The specification showed the method of closing the eye of the running stone by a plate of iron or leather, and of introducing a blast of air into the central cavity.

Another mode of carrying out the invention was also described, which consisted in the application of a set of ventilating screw vanes, placed in an air chest at the centre of the running stone, and sucking down a current of air for sustaining a similar blast. The wheat, as well as a quantity of air, passed through the ventilating screw, which virtually replaced the separate plate and blower used in the primary combination. If preferred, the ventilator might be placed in the bed stone.

Claims: 1. Closing the eye of the running stone, and combining therewith a blast of air, above the pressure of the atmosphere, at or near the centres of millstones, so that the pressure of the air is sustained to carry out the meal from between the grinding surfaces, as produced.

2. The application of ventilating screws or vanes for blowing and sustaining the necessary blast of air between the grinding surfaces of millstones, as herein described.

At the trial, defendants put in evidence the specification of a patent of 30th April, 1844, No. 10,165, to *R. Gordon*, for a like invention. Here a blast of air was set up by a revolving fan, and the current was discharged at the eye of the bed-stone. The eye, however, was not closed. The alleged infringement consisted in the use of an apparatus constructed according to a patent of 19th Dec. 1851, No. 13,867, to *C. Rands*, who left a circular chamber in the centre of the stones, and placed therein a revolving fan with radial arms, which forced a blast of air from the centre outwards.

POLLOCK, C.B. directed a verdict for plaintiff on all issues except the 5th; on that for defendants. Leave reserved.

Rule nisi to enter a verdict for plaintiff on the 5th issue discharged by the Court of Exchequer; and rule for a new trial, on the ground that the verdict was against the evidence, suspended till the result of an appeal (if any) was known.

Per POLLOCK, C.B.—After this patent of *Gordon's* no one could claim exclusively the use of a fan or the introduction of a current of air (above the pressure of the atmosphere) at the eye of a millstone by means of such a fan. The next patent is that of the plaintiff; and an attempt was made to show that the first part had been infringed. It was argued by the plaintiff's counsel that the first part of the plaintiff's invention was performed by the second, and that the ventilating screw, by driving the air in one direction, viz., inwards, and thereby preventing it from escaping, was, in fact, 'a closing of the eye.' We think it is really an abuse of language to call what is done in the second part of the invention a 'closing of the eye,' because the air is compelled to go in one direction only; but the claim to close the eye in the plaintiff's specification must be understood to mean closing it *actually*, physically, and in the manner shown in the drawing; and if it be said that the first claim does not refer to the drawing, and may therefore include closing the eye (if in any sense that can be called closing), the answer is that *Gordon* has done that before; his current of air as much closed the eye as *Bovill's*, and the patent would therefore be void for claiming an invention already published by another.

The question then remains, is the invention of the defendant *Rands* within the second part of the patent and specification of the plaintiff? and we are of opinion that it is not. It appears to us that, where a subject is not new, as this certainly was not, viz., 'the cooling of substances undergoing the process of grinding,' any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase. *Bovill's* invention can be described, no doubt, in terms so vague and general as to include *Rands's* method, but then, also, it would include *Gordon's*, whose patent was taken out some years before. We think that the patents, as they appear before us, are respectively independent original improvements.

We think the claim of invention in the action must be considered as the claim which the plaintiff is legally entitled to make; and then the question between the parties arises on the plea of not guilty,

which also raises the question as to the extent of the Queen's grant to the plaintiff, and to what extent that goes and how much it embraces; in other words, what is the true meaning and construction of the specification? We think this is a question of law where the facts are not disputed. If the verdict be entered for the plaintiff by the Court of Appeal, then the rule for a new trial will be made absolute, but in the meantime it must stand over.

BOVILL *against* KEYWORTH and SEELY, A.D. 1857. 7 E. & B. 725.

Subject-matter of a Patent. Sufficiency of Specification. Evidence of Infringement.

CASE for the infringement of a patent (in part disclaimed) of 5th June, 1849, No. 12,636, to G. H. Bovill, for 'improvements in manufacturing wheat and other grain into flour.' Pleas: 1. Not guilty. 4. That the invention was not a new manufacture. 6. That the specification was insufficient. Issue.

The patent related to an improvement of great value to millers which consisted in the combination of a blast of air between the millstones used in grinding corn, with an exhausting apparatus attached to the chamber in which the stones were enclosed. The exhaust-pipe carried away the dust or stive into a separate chamber, where the same was deposited, and the finely-ground flour fell into its proper receptacle. The top stone was fixed, and the lower one rotated. The specification stated:—'I introduce a pipe to the millstone case from a fan or other exhausting machine, so as to carry off all the warm dusty air blown through between the stones to a chamber. And this part of my invention relates only to sucking away the *plenum* of dusty air forced through the stones, and not to employing a sufficient exhausting power to induce a current of air between the millstones, without the blast, this having been before practised.'

Claims: (as amended by disclaimer) 1. Fixing the top stone, and causing currents of air either by exhaustion or pressure to pass between the grinding surfaces of millstones when the top stone is so fixed, and the introduction of the ventilating pipes in the stones, as herein described.

2. Exhausting the dusty air, when the same has been blown through the grinding surfaces of the millstones, from the cases or chambers receiving the meal as herein described.

At the trial, it appeared that the alleged infringement consisted in the use of apparatus similar to that specified, except that the lower stone was *fixed*, and the upper one rotated. Defendants gave in evidence the specification of a patent of 11th Feb. 1846, No.

11,084, to *A. V. Newton*, for drawing a current of air between the stones by an exhausting apparatus. Verdict for plaintiff.

Rule nisi to enter a verdict for defendants or for a new trial discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—The whole of the plaintiff's process, if the combination be new, is certainly the subject of a patent; and so would the part (No. 2) be, if taken separately. The combination of the *exhaust* with the blast so as to carry off the warm dusty air blown through between the stones to a chamber above, while the pure flour, in a dry condition, without the stive, descended into a chamber below, added to the quantity and improved the quality of the flour produced in grinding.

Still, if the specification does not point out the mode by which this part of the process is to be conducted, so as to accomplish the object in view, it would be the statement of a principle only, and the patent would be invalid. But we are of opinion that the specification cannot be pronounced, in point of law, to be bad in this respect, and that the evidence adduced at the trial shows it to be quite sufficient. The specification says:—'And this part of my invention relates only to sucking away the *plenum* of dusty air forced through the stones, and not to employing a sufficient exhausting power to induce a current of air between the millstones without a blast.' The exhaust is to be proportioned to the *plenum* caused by the blast, care being taken not to introduce the inconvenient current of air, against which a caution is given. How can a judge take upon himself to say that this may not be enough to enable a workman of competent skill to construct the machinery? According to the evidence, the specification was abundantly sufficient for this purpose.

The defendants contend that the patent was granted for one process comprising several successive and connected parts, the use of fixed upper millstones being one of them. We do not think it necessary to give any positive opinion upon this question, for, supposing the patent to be for a combination, consisting of several parts for one process, we are of opinion that the defendants are liable in this action for having used a material part of the process which was new for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process specified.

The defendants admit that they used the part of the process (No. 2) as described in the specification; and they rest their defence on the fact that they did so only in a mill with a rotating upper millstone. We are of opinion that they cannot lawfully use No. 2 for the same purpose by substituting a rotating upper millstone for

a fixed upper millstone, or by resorting to any other equivalent for any other separate part of the process specified. This case seems to us to be governed by *Lister v. Leather* (8 E. & B. 1,004), and therefore that there ought to be judgment for the plaintiff.

BOVILL *against* HADLEY, A.D. 1864. 17 C.B. N.S. 435.

Practice as to Certificate for Costs.

CASE for the infringement of the same patent (extended for five years). At the trial a compromise was made upon terms that there should be a verdict for 40s., and costs, *with all usual certificates*. The certificate of the judge, under stat. 15 & 16 Vict. cap. 83, sect. 43, given in a former trial of *Bovill v. Keyworth*, was then handed in to Erle, C.J., who endorsed on the record a certificate whereby plaintiff became entitled to full costs.

Rule nisi to deprive plaintiff of full costs made absolute by the Court of Common Pleas. (Erle, C.J., Williams, Willes, Byles, JJ.)

Per WILLES, J.—The compromise put an end to the case. The plaintiff could not have full costs under stat. 15 & 16 Vict. cap. 83, sect. 43, without putting the record and the certificate in the former action in evidence.

BOVILL *against* GOODIER, A.D. 1865–7. L.R. 1 Eq. 35; }
L.R. 2 Eq. 195; 36 L.J. Ch. 360. }

Practice in Patent Suits. Issues. Novelty of Invention. Prior Publication. Amendment of Particulars of Objection.

Suit to restrain from infringing the same patent (extended for five years). The answer raised the questions of novelty, prior user, sufficiency of specification, and infringement; but the Court refused to direct issues. Replication filed, when plaintiff applied for particulars of objections to be relied on at the hearing. ROMILLY, M.R. refused the application, and said that this decision must not be taken to apply to cases where issues had been granted; in such cases he had himself ordered particulars of objections to be furnished.

Hearing of the suit. It appeared that after plaintiff had recovered judgment against *Keyworth*, in the previous action, he proceeded against other infringers, all of whom submitted. In 1863 the patent was extended for five years.

Defendant now sought to prove the invalidity of the patent by reason of the expiration in 1860 of a certain *French* patent; but the Court refused to entertain the objection on the ground that it had not been raised by the pleadings. It appeared that three *French* patents, alleged to have anticipated the invention, had been described in a book deposited in the library of the *British Museum* and sold by a bookseller in *London* before the date of the patent.

Injunction granted, and issue at law directed as to novelty only; defendant to deliver, within seven days, particulars of objections to be relied on at the trial of the issue.

Per LORD ROMILLY, M.R.—The history of the plaintiff's invention is an instance of the troubles which, in the present state of the law, await a successful inventor. The patent in question was taken out by the plaintiff in *June*, 1849. Since then he has been engaged in constant and expensive litigation up to 1863, when the patent was prolonged by the Privy Council for five years. This, however, has not produced any termination to the litigation, of which the present suit is an instance. Much of this is incidental to the nature of things. The claim of having made an invention is not to preclude others from using an old process and old machines; nor ought the fact that one person who has infringed the patent was ignorant of the want of novelty, to preclude another person from showing that the invention had before been known and been in use. The consequence is that, in almost every instance, the patentee has to establish his case from the beginning against any fresh person who chooses to impugn the patent and to contest its validity.

His Lordship here stated his opinion that the *French* patents differed essentially from that of the plaintiff, and expressed his concurrence with the judgment in *Bovill v. Keyworth* (7 E. & B. 725). He then proceeded:—I am of opinion that I cannot properly compel the defendant to submit to the decision of the Court of Queen's Bench, or to acquiesce in any opinion I may have formed. He was no party to the suit of *Bovill v. Keyworth*, he is not bound by the proceedings in that case, and many cases are on record where, after the plaintiff has established the validity of the patent in one case, it has been decided to be invalid in a second. I think myself bound by the authorities to direct an issue to try whether the plaintiff is the first and true inventor of the processes described in his specification. I direct no issue as to the utility of the invention, or as to the sufficiency of the specification.

Trial of the issue of novelty in the Common Pleas. New trial of the same issue, directed by the Master of the Rolls. Defendant now applied for leave to deliver further particulars of prior user and publication of the alleged invention. Order made by LORD ROMILLY, M.R., who said:—'The object was that the real facts should be put in issue, and no technical difficulties should be allowed to obstruct this. If any new facts were discovered they might be brought forward, but not by surprise, and on giving proper notice to the other side. The defendant must deliver new particulars within a fortnight. Costs to be costs in the cause.'

BOVILL *against* CRATE, A.D. 1865. L.R. 1 Eq. 388.

Practice where there are several Infringers. Laches.

Suit to restrain from infringing the same patent (extended for five years). It appeared that plaintiff was aware of the infringement in *August*, 1864, but did not file a bill until *July*, 1865. Also that eighty-nine persons had combined together for the purpose of infringing plaintiff's patent. Injunction refused on the ground of delay. Account ordered. The costs to be costs in the cause.

Per WOOD, V.C.—I do not think the plaintiff is put in so great a difficulty as he alleges with reference to filing bills. He might take this course:—After getting information of case after case of infringement, he might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them: 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise, I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object, I shall file a bill against only one of you.' I do not think any Court could complain of a patentee for taking the course I am suggesting.

BOVILL *against* SMITH, A.D. 1866. L.R. 2 Eq. 459.

Practice in Patent Suits. Discovery.

Suit to restrain from infringing the same patent (extended for five years). The bill stated a variety of proceedings, both at law and in equity, in which plaintiff had obtained perpetual injunctions and recovered damages against infringers, and charged that the defences as to prior user and failure of novelty relied on by defendant were identical with some of those already disproved, as would appear if discovery were made. Accordingly, plaintiff interrogated defendant as follows:—1. Who does defendant allege to have been the true and first inventor? 2. When, where, and in what manner does defendant allege that plaintiff's invention, or any part thereof, was publicly used before the date of the patent? Defendant declined to answer fully, and plaintiff excepted. WOOD, V.C. over-ruled the exceptions, and said that the plaintiff was not entitled to inquire generally into the way in which the defendant shaped his case, though he might have asked if his process was the same as that used by A. B., or any one person specifically named, who had been a defendant in some former suit.

BOVILL *against* HITCHCOCK, A.D. 1868. L.R. 3 Ch. 417.

Practice as to Trial by Jury in Patent Suits.

Suit to restrain from infringing the same patent (extended for five years). Application, that certain questions of fact might be tried by the Court with a special jury, refused by ROMILLY, M.R. On appeal to the Lords Justices, decision affirmed.

Per LORD CAIRNS, L.J.—If the Court thinks it best that a question should be tried before a jury, a jury can be had; but if, in the opinion of the Court, a trial without a jury is preferable, neither party can claim a jury as a matter of right.

BOVILL and ANOTHER *against* FINCH, A.D. 1870. L.R. 5 C.P. 523.

Divisibility of grant of Patent after Prolongation.

CASE for the infringement of the same patent (prolonged for five years). The declaration stated the grant of the patent for *England* in *June*, 1849, the prolongation of the term, and the filing of a disclaimer. Pleas: 14. As to the infringement after prolongation, averring the grant and expiration of separate patents for *England*, *Scotland*, and *Ireland*, the prolongation by new letters patent, and that the letters patent for *Scotland* were and always had been void by reason of prior public user in *Scotland*.* 15. A similar plea alleging that the Scotch patent was void on account of prior user in *England*. Demurrer, and joinder. Judgment for plaintiffs by the Court of Common Pleas. (Keating, Montague Smith, Brett, JJ.)

Per MONTAGUE SMITH, J.—It must be taken, for the purpose of the demurrer, that the original *Scotch* patent is bad for want of novelty, and the question is, whether the grant is divisible, and may be sustained so far as it extends the term of the *English* patent. It has no doubt been decided that letters patent are wholly void where part of the invention claimed is not new, on the principle stated by Parke, B. in *Morgan v. Seaward* (2 M. & W. 544), viz., that ‘the consideration for the grant is the novelty of all; and the consideration failing, or in other words, the Crown being deceived in its grant, the patent is void.’ See also *Hill v. Thompson* (2 Taunt. 375), *Brunton v. Hawkes* (4 B. & Ald. 541). The distinction between these decisions and the present case is, that in them the want of novelty in a part of the invention affected the grants throughout their whole territorial limit; whereas in the present case it only affects the grant so far as *Scotland* is concerned. We do not, how-

* By the operation of stats. 15 & 16 Vict. cap. 83, and 16 & 17 Vict. cap. 115, sect. 7, the new letters patent were sealed with the Great Seal of the United Kingdom, and had effect throughout *Scotland* and *Ireland*.

ever, deem it necessary to decide what would be the effect of the want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal, because we think this grant of an extended term in the three original patents is divisible. We think, notwithstanding that the new letters patent are in one instrument, they ought to be regarded as granting three separate prolongations of three distinct patents; and that as a consequence, although the prolongation may be invalid as to the *Scotch* grant, by reason of the want of novelty in *Scotland* at the time of the original letters patent, it may be good as to the *English* grant; or, in other words, that the grant for each country may stand or fall by itself.

There being nothing to show any want of novelty, or other failure of consideration for the prolongation of the term of the *English* patent, or that the Crown was deceived in any way as to that patent, we think the judgment on this demurrer should be for the plaintiffs.

BOWMAN *against* TAYLOR and OTHERS, A.D. 1834. 2 Ad. & E. 278; }
1 Webs. Pat. Ca. 292. }

Estoppel of licensee.

COVENANT. The declaration, after setting out so much of the recitals in the deed as stated that plaintiff had invented certain improvements in looms, and had obtained letters patent for the same, stated that plaintiff had agreed with defendants to let them use the said invention on certain terms. Pleas: 1. Setting out the patent, and averring that the invention was not new. 2. That plaintiff was not the true and first inventor. 3. That no sufficient specification was enrolled, whereby the patent became, and was at the time of making the indenture, void and determined. Demurrer, and joinder. Judgment for plaintiff by the Court of King's Bench. (Lord Denman, C.J., Taunton, Patteson, Williams, JJ.)

Per LORD DENMAN, C.J.—The plaintiff contends that these pleas are bad because the defendants are estopped by their deed from pleading them. It is answered, as to the first plea, that it is not inconsistent with the deed; but we think it is so, and if not, that it is no defence. So, as to the second plea, the answer is the same as that just given. The third plea puts a fact in issue in direct contradiction to the recital of the deed.

BRIDSON *against* McALPINE, A.D. 1845. 8 Beav. 229.

Practice in Patent Suits. Injunction.

Suit to restrain from infringing a patent of 26th *May*, 1838, No. 7,653. Action at law. Verdict for plaintiff, and tender of bill

of exceptions. Motion for injunction ordered to stand over until bill of exceptions disposed of. Account in the meantime.

Per LORD LANGDALE, M.R.—There are many cases in which it is not clear either that the patent is legally valid or that it has been infringed. It depends on the degree of doubt which exists on these questions whether the Court will grant the *interim* injunction. In such cases it will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction. According to the doubt which may exist in the mind of the Court upon the facts, and according to the degree of inconvenience to the parties, the Court, not thinking fit to grant the injunction at the time, may take one of several courses: it may either refuse to grant the injunction simply, or it may refuse it on the terms of the party undertaking to keep an account, or it may direct the motion to stand over, on the terms of the plaintiff proceeding to a trial at law. When it has been determined that the plaintiff must first establish his right at law, the Court does not generally interfere with the mode of trying the legal question, though in some instances it may require the parties to make the necessary admissions of fact in order to facilitate the trial. I must, however, qualify this by saying that in cases of overwhelming mischief the Court has authority to interfere at any time.

BRIDSON *against* BENECKE, A.D. 1849. 12 Beav. 1.

Practice in Patent Suits. Injunction refused for delay.

Injunction to restrain from infringing the same patent, refused on the ground of delay. It appeared that plaintiff discovered the alleged infringement in *Jan.* 1848, but did not file a bill until 30th *Dec.* 1848.

Per LORD LANGDALE, M.R.—I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established against the party who is alleged to have infringed it, ought to come at an early period. The rule of this Court is very strict, that you must apply in proper time.

BROOK *against* ASTON, A.D. 1857. 8 E. & B. 478; 28 L.J. Q.B. 175.

Subject-matter of a Patent. New use of an old Machine.

CASE for the infringement of a patent of 23rd *Feb.* 1856, No. 473, to *C. Brook* and *J. Hirst*, for 'improvements in finishing yarns of wool or hair, and in the finishing of woven fabrics.' Pleas: 3. That the invention was not new. 4. That it was not the working or making of any manufacture for which letters patent could by law be granted. Issue.

The specification stated:—‘This invention has for its object an improvement in finishing yarns of wool or hair, and consists in causing *yarns of wool or hair*, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers, by which such yarns will be burnished or polished on all sides.’ Then followed a description and drawings of the machinery, showing the manner in which the threads were distended and kept separate, and were passed over a revolving circular brush, on their way to some rapidly revolving beaters or burnishers, which gave smoothness to their surface. *Claim*: 1. ‘Causing yarns of wool or hair, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers, whereby the fibre is closed and strengthened, and the surface effectually polished.’

At the trial, defendant put in evidence the specification of a patent (in part disclaimed) of 25th Nov. 1853, No. 2,745, to *W. L. Brook and C. Brook*, for certain improvements in finishing cotton and linen yarns, and in the machinery connected therewith. The specification stated—‘Our improvements relate, first, to a method of finishing *cotton and linen* yarns by the application of friction, produced by a peculiar combination of horizontal brushes with revolving beaters or burnishers, the yarns being extended from end to end, instead of being dressed in the hank or skein, by which means a more perfect adhesion of the fibre with smoothness and a *glacé* effect is produced. The yarns or threads are wound upon a roller at one end of the machine, and pass through the operation of sizeing, as in common use, and thence to the finishing end of the machine.’ LORD CAMPBELL, C.J. left the case to the jury. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit, on the ground that the invention was not new, and was not the subject of a patent, made absolute by the Court of Queen’s Bench. (Lord Campbell, C.J., Coleridge, Wightman, JJ.)

Per LORD CAMPBELL, C.J.—It may well be that a patent may be valid for the application of an old invention to a new purpose; but to make it valid, there must be some novelty in the application. Here there is none at all. In all the cases in which a patent has been supported, there has been some discovery, some invention. It has not been, as in this case, merely the application of the old machinery, in the old manner, to an analogous substance. That cannot be the subject of a patent; and this patent claiming it is void.

Per COLERIDGE, J.—I am of the same opinion. It is admitted that the mere application of old machinery is not the subject of a

patent. Reading the plaintiff's claim, and then reading the former specification, we find the processes the same in principle and detail. The threads are kept separate, and are operated on in the same way; the only difference being that one is applied to cotton and linen only, and the other to wool and hair.

(28 L.J. Q.B. 175.) Error brought in the Court of Exchequer Chamber. (Cockburn, C.J., Williams, Crowder, Willes, JJ., Martin, Bramwell, Watson, Channell, BB.) Judgment affirmed.

Per COCKBURN, C.J.—Our duty is to look to the two specifications, and, construing them in the best manner, to see whether the second involves any infringement of the first. I am of opinion that it does. The second patent includes every material portion of that which was the subject-matter of the first. *Mr. Bovill* has argued on the assumption that the sizeing process, which is omitted in the second patent, was an essential part of the first. But I cannot look upon it in that light. There is a *glacé* appearance produced on the linen and not on the wool. But the main purpose, which is to give strength to the matter operated on, is the same in both. The polish is no essential part of the patent.

Per MARTIN, B.—The question is, whether there was any evidence to go to the jury at the end of the plaintiff's case. I quite concur in the judgment of the Court of Common Pleas in *The Patent Bottle Envelope Company v. Seymer* (28 L.J. C.P. 22), that the application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes, in fact, a tool. I am therefore of opinion that the application of this machinery to woollen yarn is not the subject of a patent.

Per BRAMWELL, B.—The two specifications are substantially identical. Doing to wool identically the same thing which has been done to linen or cotton is not, in my opinion, a new manufacture.

BRUNTON *against* HAWKES, A.D. 1820-1. 4 B. & Ald. 541.

Failure of Novelty in part of an Invention renders a Patent void.

CASE for the infringement of a patent of 26th *March*, 1813, No. 3,671, to *T. Brunton*, for 'improvements in the manufacture of ships' anchors, windlasses and chain cables.' Plea: Not guilty. Issue.

The patent related to three separate improvements.

1. *Ships' anchors*.—Heretofore each arm of an anchor had been separately welded to the shank. The specification described a different manufacture. The two arms were formed in one piece, having a conical opening in the centre, through which the shank

was passed, the coned end of the shank being welded to the arm-piece. The patentee relied, for strength, on the impossibility of drawing a thick conical piece of iron through the smaller aperture of a conical opening into which it was fitted.

2. *Chain cables*.—Here each link was oval, and was stayed across the centre by a pin, the ends of which spread out so as not to pierce and weaken the link.

3. *Windlasses*.—This improvement was unimportant.

At the trial, it appeared that the plaintiff's method of constructing anchors had been applied before the date of the patent to the construction of *adze* or *mushroom* anchors used in mooring stationary light-vessels, but was new as applied to the anchors of ships.

The alleged infringement related to the improvement in chain cables, which was of great value. ABBOTT, C.J. left it to the jury to say whether the inventions both as to the chain and anchor were new and useful, and the jury found in the affirmative. Verdict for plaintiff.

Rule nisi for a new trial, on the ground that the patent was void for want of novelty in one head of invention, made absolute by the Court of Queen's Bench. (Abbott, C.J., Bayley, Best, JJ.)

Per ABBOTT, C.J.—I think that so much of the plaintiff's invention as respects the anchor is not new, and that the whole patent is therefore void. The mode of joining the shank to the flukes of the anchor is precisely the mode by which the shank of the mushroom anchor is united to the top. It is, indeed, the mode by which the different parts of the common hammer, and the pickaxe also, are united together. Now, a patent for a machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good; because there is novelty in the combination. But here the case is perfectly different; formerly three pieces were united together; the plaintiff only unites two; and, if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent; but, unfortunately, the mode was well known, and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose. It seems to me, therefore, that there is no novelty in that part of the patent which affects the anchor; and, if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The consideration is the entirety of the improvement of the three.

things; and, if it turns out that there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention.

Per BEST, J.—The consideration to induce the King to grant the patent, was the statement made by the plaintiff in his petition, that there had been three inventions, when, in fact, there had been only two. The united consideration on which the whole grant was made is therefore void; and, consequently, the grant itself is void. I am therefore of opinion that there ought to be a new trial.

BUSH *against* FOX and OTHERS, A.D. 1852. 9 Ex. R. 651; }
 Macrory's Pat. Ca. 152; 5 H.L. Ca. 707. }

Novelty of Invention. Publication by prior Patent.

CASE for the infringement of a patent of 21st *Sept.* 1841, No. 9,094, to *W. Bush*, for 'improvements in the means of, and apparatus used for, building and working under water.' Plea 3. That the invention was not a new manufacture. Issue.

The patent related to the use of a hollow cylinder or caisson, divided horizontally into compartments, and employed for constructing foundations under water. The lowest chamber formed a diving-bell, from which water was excluded by air under pressure, and there were trunks or passages, provided with valves, for the purpose of affording access to the lowest chamber without much loss of compressed air. The specification described the caisson, with its air-pumps and valves, by reference to drawings, and explained the manner in which the materials excavated were raised from one compartment to another, as well as the filling up of the shell with concrete when sunk to a sufficient depth. *Claim*: The mode of constructing the interior of a caisson in such manner that the workpeople may be supplied with compressed air, and be able to raise the materials excavated, and to make or construct foundations and buildings as above described.'

At the trial, it appeared that the alleged infringement consisted in the use of hollow cylinders or piles, acting on the principle of excluding water by compressed air, and forming, when sunk and filled with brickwork and concrete, the foundations for the piers of *Rochester* Bridge. Each cylinder was closed by a cover at the top and was built up in lengths, so that one end rested on the bed of the river, and the other end remained above the surface of the water. This construction made it, in effect, a species of elongated diving-bell into which air was forced by pumps, so as entirely to exclude the water. Two small chambers, provided with valves, and called air-locks, were attached to the cylinder cover, whereof one was for the

passage of the workmen and the other for the raising of the materials excavated.

Defendants put in evidence the specification of a patent of 20th Oct. 1830, No. 6,018, to Lord *Cochrane* for a similar invention, consisting of a cylinder filled with compressed air and provided with an ante-chamber and valves for the entrance and exit of the workmen. The specification stated:—‘My invention consists in an apparatus for compressing air into, and retaining the air so compressed within, the interior capacity of subterranean excavations, sinkings, or mines, in order that the additional elasticity given to the included air may counteract, in part or wholly, the tendency of superincumbent water, or of such superincumbent earth as is rendered semi-fluid by admixture with water, to flow by gravitation into such excavations. And which apparatus, at the same time that it is adapted to retain the said included air in a state of compression in order to prevent or diminish the *influx of water* or of *semi-fluid earth*, is also adapted to allow workmen to carry on their ordinary operations of excavating, sinking, and mining, and to allow a ready passage to and fro from the said space.’

Plaintiff was called, and admitted that what defendants had done at *Rochester Bridge* was the same as Lord *Cochrane*’s invention, except that Lord *Cochrane*’s worked on land, and defendants’ worked in water. POLLOCK, C.B. said:—‘If that is the only difference, I am of opinion that the cause is at an end.’ Another witness having given evidence to the same effect, the learned judge directed the jury:—‘I think a man cannot, if he has applied an old invention, or part of an old invention, to a new purpose, obtain a patent for such an application. Now, if the construction of this caisson is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture. Both the plaintiff and the other witness emphatically say that the invention consists in the application, and not in the novelty of the thing itself; in other words, that the only novelty is in the application of the apparatus. I think that a patent cannot be taken out for such an application.’ Verdict for defendants on third issue; the jury discharged as to the other issues.

Error on bill of exceptions to the above direction.

In the course of the argument, MAULE, J. said:—‘Assuming that the machine itself is old, the learned judge held that the mere new application is not a new manufacture, and therefore not the subject of a patent, and my present opinion is, that on the evidence he was right in so directing the jury.’

Judgment affirmed by the Court of Exchequer Chamber. (Coleridge, Maule, Cresswell, Erle, Williams, Crompton, JJ.)

On appeal to the House of Lords, the judges were summoned, when Alderson, Martin, Bramwell, BB., Coleridge, Wightman, Erie, Cresswell, Williams, Crompton, and Crowder, JJ. attended. The question proposed for the learned judges was, whether, looking at the record, the direction given by the Lord Chief Baron was right in point of law. Answered in the affirmative, the judges being all of one opinion. Judgment for defendants in error, with costs.

Per LORD CRANWORTH, L.C.—From the time that I understood what the facts of this case were, I really have entertained no doubt whatever upon the question whether or not the direction of the Lord Chief Baron was right. I am not, indeed, clear that the Lord Chief Baron might not have gone much further, and that, even if there had not been any evidence at all, he might not have directed the jury to find for the defendants; because, I think, it was for the Court to compare the two specifications together, and, comparing the two together, it appears to me perfectly clear that the material part of the plaintiff's invention was involved in the invention of Lord *Cochrane*.

The evidence of the plaintiff himself and a witness having been given, the Lord Chief Baron said, that if the jury believed that evidence, the invention was not an invention of any manner of new manufacture; it was not new at least in the material part of it, the mode of putting up the caisson so as to supply the workmen with air. My Lords, I entirely concur in the opinion which the learned judges have, without any hesitation, given to your Lordships, that that direction was perfectly right, and, consequently, that there is no foundation for this proceeding in error.

CALDWELL *against* VANVLISSENGEN AND OTHERS, A.D. 1851. 9 Hare 415.

Practice in Patent Suits. Aliens restrained from Infringing an English Patent in England.

Motion for injunction to restrain defendants, who were subjects of the King of *Holland*, from using on board their ships, within the dominions of *England*, a screw propeller made according to an *English* patent assigned to plaintiff. Injunction granted.

Per TURNER, V.C.—It is part of the duty of this Court to protect property pending litigation; but when it is called upon to exercise that duty, the Court requires some proof of title in the party who calls for its interference. In the case of a new patent, this proof is wanting: the public, whose interests are affected by the patent, have had no opportunity of contesting the validity of the patentee's title, and the Court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoy-

ment under the patent (the enjoyment, of course, including use), the public have had the opportunity of contesting the patent; and the fact of their not having done so affords, at least *primâ facie*, evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law.

I take the rule to be universal, that foreigners are in all cases subject to the laws of the country in which they may happen to be. It is to be considered, then, what are the laws of this country with reference to the rights of patentees. According to our laws and constitution, the Crown, I apprehend, has at all times exercised a control over the trade of the country. The statute of James did not create, but controlled, the power of the Crown in the granting of patents. Patentees therefore have always derived and still derive their rights, not from the statute, but from the grant of the Crown. And, undoubtedly, this grant gives to the grantee a right of action against persons who infringe upon the sole and exclusive right purported to be granted by it. Foreigners coming into this country are, as I apprehend, subject to actions for injuries done by them, whilst here, to the subjects of the Crown. Why then are they not to be subject to actions for the injury done by their infringing upon the sole and exclusive right which I have shown to be granted in conformity with the laws and constitution of this country? And if they are subject to such actions, why is not the power of this Court, which is founded upon the insufficiency of the legal remedy, to be applied against them as well as against the subjects of the Crown? It was said that the prohibitory words of the patent were addressed only to the subjects of the Crown; but these prohibitory words are in aid of the grant and not in derogation of it; and they were probably introduced at a time when the prohibition of the Crown could be enforced personally against parties who ventured to disobey it. The language of this part of the patent does not, therefore, appear to me to alter the case.

CAMPION *against* BENYON, A.D. 1821. 6 B. Moo. 71; }
3 Brod. & Bing. 5. }

Title too large. Novelty of Invention. Obligation in Specifying.

CASE for the infringement of a patent of 13th April, 1813, No. 3,682, to *R. Champion*, for 'an improved method of making and manufacturing double canvas and sail-cloth, with hemp and flax, or either of them, *without any starch whatever.*' Plea: Not guilty. Issue.

The patent related to a manufacture of sail-cloth with double warp threads. Each warp thread was composed of two yarns, first

untwisted, and then twisted into a single thread of double size. No starch was used in the process. The specification stated:—‘I do hereby describe and ascertain the nature of my said invention and the manner in which the same is to be performed as follows; that is to say, my new and improved method of making double canvas and sail-cloth *without any starch whatever*, consists in,’ &c. Then followed a description of the process. There was no separate claim.

At the trial, it appeared that double sail-cloth had been made without starch before the patent. It was objected that the patent was void, by reason that plaintiff claimed to make sail-cloth without starch, which had been done before. DALLAS, C.J. left the case to the jury. Verdict for plaintiff.

Rule nisi to set aside the verdict and enter a nonsuit made absolute by the Court of Common Pleas. (Dallas, C.J., Park, Burrough, Richardson, JJ.)

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

CANNINGTON *against* NUTTALL, A.D. 1871. L.R. 5 H.L. 205.

Evidence of Infringement. Combination of Parts.

Suit to restrain from infringing a patent (in part disclaimed) of 7th May, 1866, No. 1,297, to *A. Pocheron*, for ‘improvements in the manufacture of glass.’ The cause was tried before the Master of the Rolls and a jury on the issues of novelty and infringement. Verdict for plaintiff. Application for a new trial refused. On appeal GIFFARD, L.J. ordered a new trial on the ground of misdirection. On further appeal to the House of Lords, order discharged and judgment of the Court below affirmed, with costs of the motion before the Lord Justice.

The patent related to a method of melting glass without the use of pots. Prior to this invention, a glass furnace or kiln consisted of a hollow truncated cone of large dimensions, having in its interior space a low covered chamber provided with a series of separate flues or chimneys placed around it. A fire-place occupied the centre of the inner chamber or *dome*, and *caves* or air passages extended throughout the subterranean area, and gave a supply of air to the furnace. A number of fire-clay pots, for holding the glass, were placed inside the dome; one pot standing in the space between two adjacent flues. The heated gases from the fire surrounded the pots, and passed through the flues into the main chimney formed by the external cone. The floor of the furnace was called a *siege* or *bank*. As the pots were quite close to the central fire, they were exposed to the danger of being cracked by currents of cooler air passing through the fire-bars; or they might yield from the too intense heat of the flame. The fracture of a pot caused the most serious difficulties. The provisional specification stated:—‘My invention consists in the suppression of the fire-clay pots or crucibles in general use, and placing the materials to be melted in the oven or kiln itself.’ The complete specification stated:—‘My improvements consist in the suppression of the fire-clay pots or crucibles hitherto in use, and in placing the materials to be fused or melted within the furnace itself, the usual inner form of the lower part of which is modified by doing away with the sieges or banks, and the general levelling of the bottom. The lateral sides are constructed of a hollow form, in such wise that a current of refrigerating or cooling air may be made to circulate around and prevent any excessive heating of the sides which are to retain or enclose the materials in fusion.’ The drawings showed (1) a basin or tank for holding the materials, (2) two gratings or fire-places situated on opposite sides of the tank, (3) air spaces or channels surrounding the tank on all sides and allowing the free circulation of air. There was no separate claim.

The patentee subsequently filed a disclaimer which stated:—‘Whereas I have been advised that the specification may be held to claim generally the suppression of the fire-clay pots and the placing the materials to be fused within the furnace itself, and, as I do not wish to make any such extended claim to invention, but desire to limit my claim to the forming the sides of the tank or chamber, containing the glass-making materials, hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or enclose the fused materials, I,

for this reason, wish to disclaim and do hereby disclaim all parts of the said specification which claim the suppression of the fire-clay pots, and placing the materials to be fused in the furnace itself.' The verbal alterations were then specified, viz., the substitution of '*have reference to,*' for '*consist in,*' also of '*to placing,*' for '*in placing,*' and after the words '*levelling of the bottom*' the introduction of the words '*to which separately I make no claim; but according to my invention,*' whereby the last passage read thus: '*but according to my invention the lateral sides are constructed,*' &c.

The alleged infringement consisted in the use of a furnace constructed according to a patent of 15th July, 1867, No. 2,075, to *F. D. Nuttall*, for improvements in the construction of glass furnaces wherein the patentee described the objects of his invention as being, (1) to economise fuel, (2) to obtain any desired temperature, (3) to render the most important parts of glass-makers' furnaces more durable. The specification showed, (1) a tank with a fire-place on either side thereof, (2) air tubes passing through the flame from each fire, and supplying heated air for the more perfect combustion of the gases, (3) narrow air passages, conveying air from the cave along either side of the tank, and at the back of the fire-bridge, for admixture with the current passing through the air tubes at points just above the bridge. It was apparent that the air passing along these passages would be heated, and also that it would *pro tanto* cool the sides of the tank.

In directing the jury, the MASTER OF THE ROLLS said:—'If a person takes well-known processes from a great number of sources, and a great many inventions, and adapts them all together to a perfectly new combination, for a perfectly new purpose, their previous use is not, in my opinion, an anticipation of the patent. Mr. *Bramwell* has pointed out that the most vulnerable part of the tank would be that which lies between the hot fused mass in the tank and the furnace which created the heat, and that the great object was to make some interval there by which the heat could not be communicated through to the tank, and by that means allow the glass, when in a state of fusion, to escape. That appears to have been the principal object of *Pocheron's* invention.' Then the learned judge described it, and said further:—'Every one of those things separately is anticipated by these patents, but that does not, in my mind, prevent the validity of a patent for their combination.'

In delivering the judgment of the House of Lords, LORD HATHERLEY, L.C. said:—'Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a

practical result not yet obtained. And I take it that the test of novelty is this: Is the product which is the result of an apparatus for which the inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?

‘What the respondent has done is this: he has not carried the hollow all round the tank, but he carries up, by means of what is technically called a split bridge, a space between the fire and the tank. Certainly there is not the same circular belt of air which there appears to be in *Pocheron's* invention; but, at the vulnerable points, the air is supplied and is running up, and it is performing the very purpose for which in *Pocheron's* patent air is introduced. Now, my Lords, I apprehend that in that point of view it is a plain infringement of *Pocheron's* patent. I apprehend the point is this, that if you find the air applied at the most vulnerable point, where it is most wanted for the purpose of cooling, the mere circumstance that it is not done in exactly the same way, or that it is not carried all round, does not touch the question of the infringement of the essence of the invention. If the same object is attained by the same process which is here introduced, and introduced for the purpose of attaining it, then I apprehend that the infringement has taken place.’

Per LORD WESTBURY.—The object of the patent was to secure an apparatus which should consist of three principal ingredients or parts. A tank first, instead of the pots; then the fire placed laterally to the tank instead of immediately beneath it. Then the third and principal part of the apparatus was this—the forming of a channel all around the tank, in order that the atmospheric air might circulate freely. These were the three principal objects which were to be united together, and the apparatus resulting from the union of the three was the improved apparatus to be used in the manufacture of glass.

Now, the only thing that appears to have been regarded by the patentee as a new discovery (apart from the apparatus) was the application of the external air to the sides of the tank. It was a discovery, certainly, but it was a thing for which independently of the other apparatus, probably no patent could have been obtained. The refrigerating effect of the air upon the sides of the tank was not a thing for which, *per se*, a patent could be claimed; but an apparatus so constructed as to bring into operation that particular property of the external atmospheric air, so as to produce a most useful effect, constitutes an invention to which the merit of novelty attaches, and

for which a patent may be taken out. The invention consisted in the things I have mentioned. All these things were embodied by Mr. *Pocheron* in his original specification, and they are well described in very few words in the provisional specification.

I come now to the original specification under the patent, and I must confess that I think it was a very unnecessary amount of nervous timidity with regard to this specification which led to the disclaimer. It is impossible to read the original specification, before the disclaimer, without observing that the object is to describe an apparatus or combination. It is the apparatus, the machine, the combination of the separate parts, which is the subject of the invention, and which constitutes the merit of the discovery. Originally Mr. *Pocheron* had said that his improvements consisted *in* the suppression of the fire-clay pots, and *in* placing the material to be fused or melted within the furnace itself. That preposition '*in*' appears to have led to some misapprehension, and accordingly it was the cause of the subsequent disclaimer.

Here I must pause for a moment, because, unfortunately, the Lord Justice did not observe where the disclaimer begins, and he has confounded the introductory part, or the reason for the disclaimer, with the disclaimer itself. What the Lord Justice did, was this: He read as part of the disclaimer, and as belonging to the disclaiming part of the amended specification, the following words: '*I desire to limit my claim to the forming of the sides of the tank or chamber, containing the glass-making materials, hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or enclose the fused materials.*' These words limiting the claim are, when rightly understood, no more than this: the patentee says, 'In the introductory part of my specification there are two things which, I think, are erroneously represented as part of the invention, but the remaining third thing is correctly represented as a discovery, and is part of the invention.' Then, if the Lord Justice had observed what that discovery was, namely, *the introduction of the atmospheric air*, he would at once have been conducted in his mind to the mechanical arrangement made for the purpose of effecting that object, and he would have found that mechanical arrangement to be a part of the entire combination, a part of the whole furnace or kiln, which is described in both the original and amended specifications as the improved furnace or kiln, which is the subject of the patent, and is, in point of fact, the discovery of the patentee. If the matter had originally been carefully examined, it would have been seen from the very nature of the thing itself that the merit of the invention must

lie in the improved kiln or furnace, constituted mainly of the three integral parts that I have described, and which are all brought into correlative action for the purpose of getting a better manufacture of glass. In the three taken together, and not in any one of the three taken separately, lies the utility, and lies the novelty of the invention.

I have now only to advert for a moment to the question of infringement. Say the counsel for the respondent, 'You are greatly mistaken in supposing that we have the same object as you have. Your combination has for its object the keeping cool the material portion of the furnace or kiln, the combined machine, which would be liable to be destroyed by heat. Our combination, on the contrary, is intended to intensify the heat. These channels which you describe as an imitation of your channels have nothing at all to do with refrigeration. They conduct the atmospheric air in a heated state to the top of the furnace, and then they inject oxygen by means of the heated atmospheric air into the products of combustion. That has the effect of greatly augmenting the intense heat of the furnace below, and usefully consumes the smoke and vapour of the furnaces.'

I do not mean to deny that that may possibly be an improvement upon the appellant's combination. But we all very well know that if you are obliged to adopt a combination of machinery which originally is directed to one purpose, before you can make it minister to another and additional purpose, the user of it for this additional purpose is an infringement of the patent which first introduced that combination, and we find this sort of infringement to be substantially admitted in the argument.

Mr. *Webster* says, 'In conducting the air through my channels in order to make it arrive at the top of the furnace, and then projecting it into the mass of vapour and flame that I find there, I cannot deny but that in that process I do *pro tanto* cool the sides of the furnace.' But then we find that the sides are cooled just where the cooling process is required. If there had been no intention to pirate the invention these channels for the air might have been conducted behind the furnace, or they might have been brought in at an elevation above the sides of the tank, but instead of that we find that the channels are placed exactly where refrigeration is required. There can be no doubt that there is refrigeration; and there can be no doubt that if there be any merit in the respondent's discovery, it is a thing added to the process of the appellant. It embodies the appellant's apparatus, and therefore becomes in law a piracy of his invention.

CARPENTER *against* SMITH, A.D. 1841-2. 1 Webs. Pat. Ca. 530; }
 } 9 M. & W. 300. }

Public Use of an Invention.

CASE for the infringement of a patent (in part disclaimed) of 18th June, 1830, No. 5,880, to *J. Carpenter* and *J. Young*, for 'improvements in locks.' Plea 3: That the invention was not new as to the public use thereof in *England* at the time of the grant. Issue.

At the trial, it appeared that several years before the date of the patent, a model of a lock, similar to plaintiff's, was brought from *America*, and that seven and a half dozens of locks were then made from this model by a manufacturer in *Birmingham*, presumably for export to *America*. Also that a lock, similar to plaintiff's, had been in use for sixteen years on a gate belonging to one *Davies*, and adjoining a public road. LORD ABINGER, C.B. directed the jury:— It is required as a condition of every patent that a patentee shall set forth in his specification a true account and description of his patent or invention, and it is necessary in that specification that he should state what his invention is, what he claims to be new, and what he admits to be old; for if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole as new, why then his patent must be taken to be a patent for the whole and for each particular part, and his patent will be void if any particular part turns out to be old, or the combinati itself not new.

I think what is meant by '*public use and exercise*' is this: A man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any man having invented that before, and not made any use of it, because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them. Now '*public use*' means this—that the use of it shall not be secret, but public. Therefore, if a man invents a thing for his own use, whether he sells it or not—if he invents a lock and puts it on his own gate, and has used it for a dozen years, that is a public use of it. Now we come to the second case. Here you have an article, manufactured by an *English* manufacturer and sold; and in my opinion if it was sold even for the assumed purpose (of which there is no legal evidence) of being sent to *America*, I cannot but think that would be a de-

struction of the novelty of the plaintiff's invention. Where a model is sent to a workman who sells seven and a half dozen, and sells them at a certain price, I must say I think the invention was used and publicly exercised. Verdict for defendant.

Rule for a new trial, on the ground of misdirection, refused by the Court of Exchequer. (Lord Abinger, C.B., Alderson, Gurney, BB.)

During the argument counsel quoted the summing-up of Patteson, J. in *Jones v. Pearce* (1 Webs. Pat. Ca. 124), to the effect that, 'if the wheel was used openly in public, so that everybody might see it, and the use had continued *up to the time of taking out the patent*, undoubtedly that would be a ground to say that the invention was not new.' Whereupon ALDERSON, B. said:—'That is the very same principle of law as was laid down by my Lord in the present case; the only restriction I should put upon it would be, that it need not appear that the machine was used up to the time of taking out the patent.'

Lewis v. Marling (10 B. & C. 22) was also quoted by counsel.

Per ALDERSON, B.—I have not the least doubt that that is the right construction of the law which my Lord has put upon it. Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber. If the plaintiff's doctrine is correct, it would follow that, if Mr. *Davies* were to change his lock to another gate, he would be liable to an action for the infringement of the plaintiff's patent. The case of *Lewis v. Marling* went to the very extreme point of the law.

Per LORD ABINGER, C.B.—I was counsel in *Lewis v. Marling* and in *Jones v. Pearce*, and I recollect that those cases proceeded on the ground of the former machines being, in truth, mere experiments, which altogether failed. The public use and exercise of an invention means a use and exercise in public, not by the public. I have always entertained the same opinion on the subject.

CARTWRIGHT *against* EAMER, A.D. 1800. Cited 14 Ves. 131, 136.

Test of Sufficiency of Specification.

Per LORD ELDON.—The question is, whether the specification be such that a mechanist can make the machine from the description there given. The patent is to be considered as a bargain with the public, and the specification therefore is to be construed on the same principle of good faith as that which regulates all other contracts. If therefore the disclosure be such that the invention can be communicated to the public, the statute is satisfied.

CHAMBERS *against* CRICHLEY, A.D. 1864. 33 Beav. 374.

Estoppel.

Suit to restrain from infringing a patent. It appeared that, in 1862, defendant assigned all his share in the patent to plaintiff. He now insisted that the patent was invalid. Injunction granted.

Per ROMILLY, M.R.—I do not intend to express my opinion as to the validity of the patent. I will assume, for the purpose of my judgment, that it is worth nothing at all. But it is certain that the defendant sold and assigned that patent to the plaintiff as a valid one, and having done so, he cannot derogate from his own grant.

CHANTER *against* LEESE and OTHERS, A.D. 1838-9. 1 Webs. Pat. }
Ca. 295 ; 4 M. & W. 295 ; 5 M. & W. 698 (In Ex. Ch.) }

Consideration for a Licence.

ASSUMPSIT. The declaration stated that by an agreement which recited that plaintiff was possessed of certain patents, plaintiff licensed defendants to use the same on payment of an annuity of 400*l.* Pleas: 2. That the invention of an improvement in furnaces was not new, whereby the patent became void. 3. That the said improvement was not invented by plaintiff, whereby the patent became void, as plaintiff well knew. Demurrer to 2nd and 3rd pleas, and joinder. Judgment for defendants by the Court of Exchequer.

Per LORD ABINGER, C.B.—The declaration is founded on the contract, and nothing but the contract. In the present case it does not appear to the Court that the defendants ever accepted or enjoyed any part of the patents which were the consideration of their agreeing to pay 400*l.* a year to the plaintiff, nor that the sum they so agreed to pay can in any manner be apportioned among the different patents which they might have had, the possession of all and each being an entire consideration. The plea therefore impeaching that consideration, is a good plea to avoid the whole contract as it appears on the record.

Error brought in the Court of Exchequer Chamber. Judgment affirmed.

Per TINDAL, C.J.—Here it is plain that the enjoyment of all the six patents is the consideration for every part of the defendants' promise, and that the annuity to be paid is neither apportioned by the contract nor capable of being apportioned by a jury. We see that the consideration is entire, and the payment to be made by the defendants is entire; we see also a failure of the consideration, which, being entire, by failing partially, fails entirely; and it follows that no action can be maintained for the money.

CHANTER *against* DEWHURST and ANOTHER, A.D. 1844. 12 M. & W. 823.

Licence valid without Seal.

ASSUMPSIT to recover a sum of money due under a licence not under seal, granted by plaintiff to defendants for the use of a patented furnace. Plea: *Non assumpserunt*. Issue.

At the trial, defendants put in evidence the letters patent granted to plaintiff, wherein all persons were strictly commanded not to 'make use or put in practice the said invention, without the license, consent, or agreement of the said *J. Chanter* (the patentee) his executors, administrators or assigns, in writing, under his or their hands and seals,' &c.; and it was objected that the licence, not being under seal, was void. ALDERSON, B. refused to nonsuit. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit discharged by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Rolfe, BB.) During the argument ALDERSON, B. said:—'To grant a licence not under seal may be a contempt of the Crown, but does not exempt the man to whom it is granted, and who derives a benefit from it, from paying the price of it.'

Per PARKE, B.—The doubt in this case arises, not because it can be considered necessary to have a licence under seal to use every patent article that may be sold in a shop, but because we have to consider whether the plaintiff could give the power to use the article in question without complying with the terms of the letters patent as to the mode of granting it. It is difficult to give effect to all the words of the patent.

Per ALDERSON, B.—The plaintiff permits the defendants to make the machine for themselves, and to use it for themselves, and in my opinion a licence for this purpose need not be under seal.

CHANTER *against* JOHNSON and ANOTHER, A.D. 1845. 14 M. & W. 408.

Written Licence, addition of Seal to. Evidence. Stamp.

ASSUMPSIT. The declaration stated that defendants were indebted to plaintiff in 33*l.* for the licence to use a furnace made according to certain patents, whereof plaintiff was owner. Plea: *Non assumpserunt*. Issue.

At the trial, plaintiff tendered in evidence a document, purporting to be a licence from plaintiff to defendants, for the use of the patented furnace, in consideration of the payment of 33*l.* The document was under seal, but not stamped, and was given as in pursuance of defendants' application for a licence *in writing*. WIGHTMAN, J. was of opinion that this document was a deed, and was inadmissible without a stamp; he, however, refused to nonsuit, but reserved leave to defendants to move to enter a nonsuit; and proof

having been given of the supply of the furnace to and its use by defendants, plaintiff had a verdict, damages 33*l*.

Rule nisi to enter a nonsuit, or for a new trial on the ground of misdirection. It was contended that, the document in question having been rejected, plaintiff had proved no written licence, and defendants were entitled to a new trial. Rule made absolute for a new trial by the Court of Exchequer.

Per PARKE, B.—The contract of the defendants was to pay the plaintiff a certain sum for a licence in writing, and I do not see any evidence of that contract having been waived or altered, and another substituted for it. But then the licence was rejected at the trial for want of a stamp, and the question therefore arises whether any stamp was necessary. The defendants say the instrument is a deed and ought to be stamped as such: but that is not so; it does not purport to be sealed and delivered as a deed; it rather resembles an award, or a warrant of a magistrate, which, though under seal, are not deeds.

CHOLLET *against* HOFFMAN, A.D. 1857. 7 E. & B. 686.

Validity of Assignment without Registration. Notice of Objections.

CASE for the infringement of a patent of 12th Nov. 1850, No. 13,338, to *E. Masson*. The declaration alleged that the patent was duly assigned to the plaintiff. Plea 6: That the patent was not assigned as alleged. Issue.

At the trial, it appeared that the assignment had not been registered pursuant to stat. 15 & 16 Vict. cap. 83, sect. 35. The notice of objections raised no question as to the validity of the assignment. LORD CAMPBELL, C.J. directed a verdict for defendant on the 6th issue.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—The stat. 15 & 16 Vict. cap. 83, sect. 35, provides that, till the entry of assignment has been made in the register of proprietors, the grantee of the letters patent 'shall be deemed and taken to be the sole and exclusive proprietor thereof.' Therefore, if *Masson* had sued for the alleged infringement, he must have been deemed and taken to be the sole person who had a right to sue; and an issue upon any plea denying his title must have been found in his favour. But the defendant could not be liable to be sued at the same time for the same infringement by the grantee and by the assignee of the letters patent. We, at present, give no opinion upon the question whether and how far the entry of the

assignment, when made, will refer back; but supposing that it might refer back to the execution of the indenture, till the entry is made no legal interest passed by the indenture, and nothing beyond a right to have the title completed.

The only other point made by the plaintiff was that the defendant was precluded from insisting on the want of registration of the assignment, because it was not specifically mentioned in his notice of objections. The requirements of the late statute, as to notices by the defendant, are clearly confined to notices affecting the validity of the patent.

CLARK *against* FERGUSSON, A.D. 1859. 1 Giff. 184.

Practice in Patent Suits. Recent Patent.

Suit to restrain from infringing a patent of 12th April, 1859, No. 910, to *W. Clark*, for 'an improved safety block, to be used in lowering ships' boats.'

It appeared that plaintiff, before specifying, agreed with defendants that they should manufacture the patent block. An improvement was then suggested by one *Nash*, a foreman of defendants', and plaintiff was requested to insert the same in his specification, as well as to share the profits of the patent with defendants. Plaintiff declined the proposal, whereupon *Nash* applied for and obtained a patent for his improvement. The alleged infringement consisted in working under *Nash's* patent.

Injunction granted until further order.

Per STUART, V.C.—This is not a case in which the plaintiff's title is disputed. The litigation has been occasioned by the plaintiff's refusal to embody his plan with the alleged improvement made by the defendants' servant. It is not a mere matter of course, because a patent is recent, to call on the patentee to establish his rights at law before he can obtain relief in this Court. It is in the discretion of the Court to require a plaintiff to assert his rights at law or otherwise, according to the nature of the case.

CLARK *against* ADIE, A.D. 1873. 21 W. R. 456, 764.

Injunction. Rights of a Licensee.

Motion to restrain defendant from issuing circulars interfering with plaintiff's right, as licensee, to the free sale of certain horse-clippers. It appeared that defendant was patentee of an improved form of horse-clipper, and that he agreed by letter to license plaintiff to work under his patent. Pending the settlement of certain disputes as to collateral matters, defendant issued circulars to customers of plaintiff, threatening legal proceedings if they pur-

chased horse-clippers without certain distinguishing marks thereon. Injunction granted. On appeal, motion dismissed by the Lords Justices, with costs.

Per JAMES, L.J.—The trade of a licensee of a patent is not to be stopped pending the settlement of disputes as to certain collateral matters.

CLARK *against* ADIE, A.D. 1873–5. L.R. 10 Ch. 667.

Evidence of Infringement. Sub-combination of parts.

Suit to restrain from infringing a patent of 22nd Oct. 1869, No. 3,076, to *J. R. Grayson*, for ‘improvements in apparatus for clipping or shearing horses.’

The specification described the instrument or clipper by reference to drawings, and showed a flat 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 under surface. A thin plate of steel, with V-shaped cutters, traversed to and fro over the comb, being guided by stems 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 of the clipper 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 cutter was connected with the block by two short pins. Each guiding stem was fixed to the comb at one end, and was screwed at the other end, so that the adjustment between 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. *Claim*: ‘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 manner that the apparatus may be adjusted to numerous angles or positions to suit the varying surface of the animal, 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 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, and 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. BACON, V.C. granted an injunction. On appeal to the Lords Justices, the bill was dismissed, with costs.

Per JAMES, L.J.—The claim of *Grayson* is in the most general terms, and it has obviously been so framed in order to escape the danger which might be lurking in some existing machine or patent, if any thing or any part or parts more definite or more limited had been claimed. [His Lordship then read the above claim, and said it was obvious that *Clark's* instrument did not answer that description.] Nor is it so pretended; but it is alleged that, although the general arrangement, construction, and combination of parts have not been copied, there is a subordinate combination—part of the entire combination—which has been transferred from *Grayson* to *Clark*, and that under the supposed doctrine of *Lister v. Leather* (8 E. & B. 1,004) the plaintiff is entitled to treat as an infringement the use of that subordinate combination.

It has been strongly contended before us, that whenever there is a patent for a combination, that patent gives protection, not indeed to every distinct thing that enters into the combination, but to every combination, arrangement, and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification.

This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority short of the House of Lords in applying such a doctrine.

A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form; and that invention 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. The

principle is really very plain, as it seems to us. A combination or accumulation of three improvements is a totally distinct thing from a combination or accumulation of two of them—as distinct as a partnership of A, B, and C is from a partnership of A and B. If a man really wants to patent not only the whole but something less than the whole of what he calls ‘a new arrangement, construction, and combination of parts,’ he must clearly show that he claims that something less—of course perilling his patent if that something less is not a novelty.

But it appears to us that even if *Lister v. Leather* were the true exposition of the law, and had the full meaning and extent for which the plaintiff’s counsel has contended, it would be impossible to apply that case to the case before us. Combination and subordinate or partial combination, are terms really not applicable to such improvements in such an apparatus as that now before the Court. The ‘general arrangement, construction, and combination’ is not a combination in any sense except that in which every one of the several improvements may be said to combine with every other in making the machine a better one. *Parva componere magnis*: take a screw steamship in which the whole locomotive apparatus is one which by means of fuel set on fire under a boiler full of water at one end sets in motion a screw at the other end. Improvements may be made in every part of that apparatus, but it would be absurd to talk of a combination of an improved steam generator, of an improved arrangement for economising the steam, and of an improved method of attaching and moving the screw.

So here it appears absurd to talk of a combination of the means of adjusting the handle of the cutter with the other parts. As to the supposed subordinate combinations, there is, no doubt, in *Grayson’s* patent a combination of the teeth of the comb made parallel and cut like a musical-box comb, with the angular cutter made like that of a reaper, because they are combined to effect a clean sharp cut. But there is no combination between them and the arched or convex cutter-bar, or between them or the latter and the parallel motion on the strong fixed stems. They are all improvements, but they are distinct improvements for distinct purposes, as much as those in the case supposed of a marine steam engine.

To examine particularly the things which are supposed to be taken from *Grayson* by *Clark*, the convex or arched cutter-bar is really not to be found anywhere in the written specification, and, although it may be found in the drawings, it was clearly no part of the invention which was present to the mind of the inventor; or, if it was, he has wilfully omitted to describe a material part of his in-

vention. Again, the strong fixed stems cannot be brought into any conceivable sub-combination of parts. They have their own independent function of making the whole machine stronger and less likely to get out of order. As jurymen, giving our verdict on that which is, after all, a question of fact, we find that *Adie's* clipper is not a piratical appropriation of *Grayson's* invention, and consequently we hold that the plaintiff's bill ought to have been dismissed with costs.

COCHRANE *against* SMETHURST, A.D. 1816. 2 Coop. Ch. Ca. 57; }
1 Stark. R. 205. }

Title of Patent too large. Practice in Patent Suits.

Suit to restrain from infringing a patent of 3rd *March*, 1813, No. 3,657, to *Sir T. Cochrane*, for 'an invented method of more completely lighting cities, towns, and villages.'

The patent related to a glazed street lamp, having an eduction chimney for the escape of vitiated air, together with pipes or apertures for conducting a supply of air directly to the flame. The principle was that of *Argand's* lamp. The specification stated:— That the object of the invention would be more clearly understood by contrasting the construction of the present street lamps with lamps proposed to be formed according to the principles and adaptation of the improvements.

Injunction refused by LORD ELDON, L.C., who directed an action at law, and said that the rule of the Court was that an injunction should not be granted, unless the Court entertained no doubt respecting the validity of the patent. His mind here was far from satisfied. It rather inclined against the plaintiff. If it inclined as much in his favour, he, nevertheless, would not say that the injunction ought to go. He had considerable difficulty about the specification. He would grant no injunction until the result of the action was seen.

Action at law. Plea: Not guilty. Issue.

At the trial, LE BLANC, J. directed the jury:—The patent cannot be sustained. The plaintiff has obtained his patent, not for an improved street lamp, but for an improved method of lighting cities, towns, and villages; but from the specification it appears that the invention consists in the improvement of an old street lamp by a new combination of parts known before. The patent therefore is too general in its terms; it should have been obtained for an improved street lamp, and not for an improved mode of lighting cities, towns, and villages.

Plaintiff nonsuited.

COLLARD *against* ALLISON, A.D. 1839-40. 4 Myl. & Cr. 487.

Practice in Patent Suits where possession of Patent has been disturbed.

Suit to restrain from infringing a patent for an improvement in the manufacture of pianofortes. The patent had been in existence for twelve years. Defendant disputed the validity of the patent, and stated facts to show that the possession under it had not been undisturbed. LORD LANGDALE, M.R. refused to grant an injunction, and directed an action at law. On appeal, order affirmed.

Per LORD COTTENHAM, L.C.—For the purpose of protecting the right until the trial should have been had, I ought to have very satisfactory evidence of exclusive possession. The result is that this case, in my opinion, wants that evidence of exclusive possession upon which Lord Eldon acted in *Hill v. Thompson* (3 Meriv. 622), and that there is so much doubt as to the novelty of what is claimed, and as to the validity of a patent for such a manufacture, that I do not feel that I ought to interfere. It is obvious, however, that the question should be immediately tried.

COOK *against* PEARCE, A.D. 1843-4. 8 Q.B. 1,044, 1,054.

Title of Patent.

CASE for the infringement of a patent of 22nd Feb. 1840, No. 8,392, to *W. Cook*, for 'improvements in carriages.' Plea 6. Setting out the specification, and averring that the title was too large, whereby the patent became void. Issue.

The patent related to a method of fixing folding shutters in carriages, and was applicable to the fitting of a certain class of shutters, having three hinged folds, which closed up and were known in the trade as *German* shutters. As to the 6th issue, the jury found:—That the invention was not an invention of improvements in carriages generally, but of certain improvements in adapting *German* shutters to those carriages only in which *German* shutters were used, and whether or not, &c. Verdict for plaintiff on remaining issues. The special verdict was argued in the Court of Queen's Bench. (Denman, C.J., Williams, Coleridge, Wightman, JJ.) Judgment for defendant.

Per LORD DENMAN, C.J.—We are unable to distinguish *Cochrane v. Smethurst* (1 Stark. R. 205) from the present case, or to discover any reason why, if the patent in that case were vitiated by being too general in its terms, this patent can be sustained.

Error brought in the Exchequer Chamber. (Tindal, C.J., Coltman, Erskine, Maule, JJ., Parke, Alderson, Gurney, Rolfe, BB.) Judgment for plaintiff *non obstante veredicto*.

Per TINDAL, C.J.—The words ‘improvements in carriages’ do not necessarily import ‘in all carriages,’ but may be held to be satisfied by an invention of improvements in some carriages only. The mere vagueness of the title appears to us to be an objection which may well be taken on the part of the Crown before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, in those cases the patent might undoubtedly be held to be void.

In *Cochrane v. Smethurst*, the extreme generality of the title far exceeds that now under consideration ; but that case was never moved in the Court of Queen’s Bench, and its authority cannot be rated higher than that of the opinion of the learned judge who tried the cause. We think therefore that, as in the present case, no more is objected than mere vagueness and generality in the title of the patent ; without any evidence leading to the inference of fraud upon the Crown, or prejudice to the public, enough has not been shown to avoid the patent.

COPELAND *against* WEBB, A.D. 1862. 11 W. R. 134.

Practice in Patent Suits. Two Patents for the same Invention.

Suit to restrain from infringing a patent. It appeared that both plaintiff and defendant had severally obtained patents for the same invention, and defendant claimed to be working under his own patent. Injunction refused. Account ordered.

Per KINDERSLEY, V.C.—This is a case which I should certainly have sent to be tried by a Court of law if the recent statute (25 & 26 Vict. cap. 42. sect. 1) had not prevented my doing so. It appears that both plaintiff and defendant have obtained patents for doing precisely the same thing. If the defendant’s patent cannot stand with the plaintiff’s, then the plaintiff ought to take steps to set it aside, which he might do by *scire facias*.

CORNISH and SIEVIER *against* KEENE and ANOTHER, A.D. 1835–6.]
1 Webs. Pat. Ca. 501 ; 3 Bing. N.C. 570.]

*Subject-matter of a Patent. Novelty of Invention. Evidence of prior Publication.
Evidence of sufficiency of Specification. Prior Experiments.*

CASE for the infringement of a patent of 17th Jan. 1833, No. 6,366, to *R. W. Sievier* for ‘improvements in the manufacturing of elastic fabrics, applicable to various purposes.’ Pleas: 3. That the invention was not new. 4. That it was not an improvement in manu-

facturing elastic fabrics applicable to useful purposes. 5. That the specification was insufficient. Issue.

The patent related to the manufacture of elastic cloths, by interweaving strands of ordinary indiarubber. The specification stated:— That the invention comprised three objects, the *third* being to produce cloth of cotton, flax, &c., in which should be interwoven elastic strands of indiarubber. These strands were first covered by winding filaments tightly round them by an ordinary covering machine, and were then arranged as warp threads and stretched to their utmost tension. Additional warp threads of cotton, flax, &c. were combined with the indiarubber strands. The cloth was then woven in the ordinary manner. It was next subjected to the action of heat, whereby the indiarubber contracted and became elastic, the non-elastic threads forming a limit beyond which extension was impossible, and the relative admixture of materials determining the degree of elastic pressure. There was no separate claim.

TINDAL, C.J. directed the jury:—I think, upon the specification, very little question arises, because not only persons of skill and science read it, and say that it was intelligible to them to make the manufacture from, but also two or three witnesses were called who actually made it without any instruction but the specification. No person was called who stated that he could not understand it, or had been misled by it, or incurred expense in endeavouring to copy or imitate it, or stated that he was unable to understand what was meant by it.

It is a circumstance in the case that the cloth is found useful for surgical purposes. The patent, however, is not taken out for that purpose, and it would not be sufficient, in order to maintain the patent on the ground of its being an improvement, to show that it was an improvement in surgical cases for bandages only, because the patent is not confined to that; but they must prove also that it is generally an improvement with respect to the general uses of that fabric or manufacture which was intended.

We are now approaching the real question in contest; that is, whether it is a new discovery of which the patentee was the first inventor, or whether it was known and practised in *England* before, and at the time of obtaining the patent in question. Sometimes it is a material question to determine, whether the party who got the patent was the real and original inventor or not; because these patents are granted as a reward, not only for the benefit that is conferred upon the public by the discovery, but also to the ingenuity of the first inventor; and although it is proved that it is a new discovery so far as the world is concerned, yet if anybody is able to show

that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A or B, or taken it from a book that was printed in *England*, and which was open to all the world, then, although the public had the benefit of it, it would become an important question whether he was the first and original inventor. It will be a question for you to say, whether, upon the evidence that you have heard, you are satisfied that the invention was or was not in public use and operation at the time the letters patent were granted. A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person, who has made the same experiments, or has gone a little further, may take out a patent, and it will be no answer to him to say that another person before him made the same experiments, and therefore that he was not the first discoverer of it: because there may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first who comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and to enjoy its benefits. On the part of the plaintiffs the evidence is, as it necessarily must be, of a negative character. You cannot prove a negative strictly—you can only do so by exhausting the affirmative instances of it, by calling persons who have never heard of it or seen it; and the more those persons are in the way of hearing of it or seeing it, if it had existed, the stronger is that exhausting evidence, if I may so call it, in its effect and value with the jury.

Undoubtedly if you could show under the hand of the plaintiffs or anybody's hand that the secret had been publicly communicated to the world, which was intended to be covered by the subsequent patent, there is an end of that patent.

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

Verdict for plaintiffs.

Rule nisi to enter a nonsuit on the ground that the invention was not the subject of a patent, and for a new trial on the grounds that the verdict was against the evidence, and that since the trial

defendants had found a patent of 14th Nov. 1832, No. 6,334, to *J. V. Desgrande* for a like invention, discharged by the Court of Common Pleas. (Tindal, C.J. Gaselee, Vaughan, Bosanquet, JJ.)

Per TINDAL, C.J.—The first objection is that the invention is not the subject-matter of a patent. The question therefore as to this point is, does it come under the description of ‘any manner of new manufacture’ which are the terms employed in the statute of James. That it is a manufacture can admit of no doubt; it is a vendible article produced by the hand of man, and of all the instances that would occur to the mind when inquiring into the meaning of the terms employed in the statute perhaps the very readiest would be that of some fabric or texture of cloth. The use of elastic threads or strands of indiarubber, previously covered by filaments wound round them, was known before; the use of cotton or other non-elastic material was also known before; but the placing them alternately side by side together as a warp, and combining them by means of a weft, when in extreme tension and deprived of their elasticity, appears to be new; and the result—viz., a cloth, in which the non-elastic threads form a limit up to which the elastic threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken—appears a production altogether new. It is a manufacture at once ingenious and simple. It is a web combining the two qualities of great elasticity and a limit thereto.

The second objection to the verdict is, that it is against the evidence. The question raised for the jury was this: whether the various instances brought forward by the defendants amounted to proof that, at the time of taking out the patent, the manufacture was in public use in *England*; or whether it fell short of that point, and proved only that experiments had been made in various quarters, and had been afterwards abandoned. This question is, from its nature, one of considerable delicacy; a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury. We see no reason to be dissatisfied with the conclusion at which they arrived.

With respect to the third ground upon which the rule was obtained, without entering into the question whether the invention for which the patent in dispute was taken out was or was not described in the specification of *Desgrande*, we think it sufficient to observe, that this specification was not enrolled till *May*, 1833, whereas the article made under the plaintiffs’ patent was publicly made and sold upon the London market, to a very large extent, in *March* and *April* of the same year. And although the specification

of *Sievier's* patent was not enrolled till *July*, 1833, we think the mere fact of the enrolment of *Desgrande's* specification after the plaintiffs' patent was sealed, and his discovery known upon the market, does not of itself, alone, afford any proof whatever of the want of novelty in the manufacture made under the plaintiffs' patent.

CRANE *against* PRICE and OTHERS, A.D. 1840-2. 4 M. & G. 580; }
 1 Webs. Pat. Ca. 377. }

Subject-matter of a Patent. Novelty of Invention.

CASE for the infringement of a patent of 28th *Sept.* 1836, No. 7,195, to *G. Crane*, for 'an improvement in the manufacture of iron.' Pleas: 3. Setting out the specification, and averring that the said improvement was not a new manufacture within the statute. 5. Stating the grant of an existing patent to *J. B. Neilson*, and averring that the user of the hot blast as described was a user of *Neilson's* invention, whereby the patent was void. Issue.

The patent related to the use of anthracite or stone coal, in conjunction with a hot-air blast, for the smelting of iron. The specification stated that the preferable temperature for the blast was 600° Fahr. *Claim*: 'The application of anthracite or stone coal, combined with the using of hot-air blast in the smelting and manufacture of iron.'

TINDAL, C.J. was of opinion that there was nothing to leave to the jury, and directed a verdict for plaintiff, subject to a special case. After argument, the Court of Common Pleas directed a verdict for plaintiff on all issues, except the 5th; on that for defendants; and notwithstanding such verdict gave judgment for plaintiff. (Tindal, C.J., Erskine, Coltman, Maule, JJ.)

Per TINDAL, C.J.—The question becomes this, whether—admitting the using of the hot-air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite or stone coal to have been known before in the manufacture of iron with the cold blast, but that the combination of the two together (the hot-air blast and the anthracite) was not known before in the manufacture of iron—such combination can be the subject of a patent.

We are of opinion, that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent. There are numerous instances of patents which have been granted where the invention

consisted in no more than the use of things already known, the acting with them in a manner already known, the producing those effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public. It will be sufficient to refer to a few instances, in some of which the patents have failed on other grounds, but in none on the objection that the invention itself was not the subject of a patent. The learned judge then referred to *Hall's patent* (1 Webs. Pat. Ca. 97), *Derosne's patent* (1 Webs. Pat. Ca. 152), *Hill's patent* (3 Meriv. 629), *Daniell's patent* (Godson. Pat. 274), and continued:—

It was objected, in the course of the argument, that the quantity or degree of invention was so small, that it could not become the subject of a patent; that the person who had procured a licence to use the hot-air blast under *Neilson's* patent had a full right to subject to that blast coal of any nature whatever, whether bituminous or stone coal. If the invention be new and useful to the public it is not material whether it be the result of long experiments and profound research, or whether of some sudden and lucky thought, or of mere accidental discovery.

The Case of Monopolies (*Darcy v. Allin*, Noy. R. 173) states the law to be, 'that where any man by his own charge or industry, or by his own wit or invention, doth bring a new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm, in such cases the king may grant to him a monopoly-patent for some reasonable time.' If the combination now under consideration be, as we think it is, a manufacture within the statute of James, there was abundant evidence in the cause that it had been a great object and desideratum, before the granting of the patent, to smelt ironstone by means of anthracite coal, and that it had not been done before; indeed, no evidence was called on the part of the defendants to meet that which the plaintiff brought forward.

With respect to the issue raised by the 5th plea, it is impossible to find any substantial or real distinction between the hot-air blast and the machinery and apparatus described in *Neilson's* specification, and that described and referred to in the plaintiff's. On the 5th issue, therefore, we think the verdict should be entered for the defendants.

Then arises the question whether the plaintiff is or is not entitled to judgment notwithstanding the verdict upon the 5th issue. Undoubtedly, if the second patent claims, as part of the invention described in it, that which was the subject-matter of a patent then in force, it would be void. But in this case there is an express dis-