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THE

LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS,

With Appendix

CONTAINING THE

PATENTS, DESIGNS AND TRADE MARKS ACT, 1883,

AND THE

PATENT, TRADE MARKS, DESIGNS

AND PRIVY COUNCIL

RULES.

BY

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PREFACE.



I AM aware that in the following pages I have ventured to express strongly my views as to the effect of some of the most important provisions of the new Patent Act, and that the conclusions I have come to are at variance with the opinions of some of the leading living authorities on patent law. I regret that on carefully reconsidering what I have written, I am unable to so alter the opinions which I have given as to place myself in accord with those to whose exposition of the law it is evident far greater weight should be given than to my own.

The principal section as to the effect of which this difference of opinion has arisen is section 5, and the question is, does that section abolish patents for communications from abroad? The history of the grant of letters patent for communicated inventions may be thus shortly stated. The Common Law consideration for the grant of letters patent was the *introduction of a new manufacture within this realm*. The consideration was certainly not the invention of a new manufacture, except in so far that a man who *invented* and put in practice an invention

might be said with justice to *introduce* the new manufacture. (See *In re Hastings' Patent*, *In re Malling's Patent*, and *Darcy v. Allen*.) The Statute of Monopolies defined the royal prerogative to grant patents, limiting it by section 6 to the grant for fourteen years or under "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 patent and grants shall not use, &c." This was intended to be nothing more or less than a declaration of the Common Law; and so it was held in *Edgeberry v. Stephens* and in a great number of cases which are hereinafter cited; and thus it was that after the Statute of Monopolies the introduction of a new manufacture was still the primary consideration for the grant. Afterwards came the Patent Law Amendment Act, 1852, which left the law as regards communicated inventions in precisely the same position that it was before, except that the applicant had to declare whether he claimed for an original invention or for a communicated invention. In the Act of 1852 it is not required that the inventor should declare that "he is the true and first inventor." In *Milligan v. Marsh*, Vice-Chancellor Wood, afterwards Lord Hatherley, held that a person declaring himself a true inventor, when, in truth, the invention was communicated to him from abroad, made a false suggestion, and that the patent was void; and this, indeed, is mere common sense. The

strict view with which this subject should be regarded may be gathered from the decision of Sir George Jessel in the Court of Appeal in *Marsden v. The Saville Street Co.* (L. R., 3 Ex. D. at p. 205.)

When the Act of 1883 was passed, some totally new provisions were adopted, and it was enacted by sect. 5, sub-sect. 2, that in every case the applicant must declare *that he is the first and true inventor of an invention.* This may have been an oversight, or it may have been intentional. I am rather inclined to think it was designed to abolish imported inventions; because we find only one form of declaration provided in the Act, which will clearly not do for an imported invention. Sect. 46 defines the word "invention" as meaning any manner of new manufacture within sect. 6 of the Statute of Monopolies. As soon as the Act was passed, a great deal of discussion arose as to whether or not communicated inventions were abolished by sect. 5. The opinion seemed to prevail that this form of patent could not thenceforth be granted, and that the definition of the word "invention" did not empower a man in possession of a communicated invention to make a declaration (equivalent to an affidavit) that he was the true and first inventor. Of course, patent agents, who were vitally interested, strongly objected to the change which was supposed to have been made in the law; and Mr. Chamberlain, I imagine, must have yielded to their representations, for

we find in the Board of Trade Rules, which were issued late in December, a form of declaration which is very remarkable. It runs as follows:—"I, ——, do solemnly and sincerely declare that I am in possession of an invention for ——, which invention has been communicated to me from abroad by ——, *that I claim to be the true and first inventor thereof, &c., &c.*" In other words, "I am not the inventor, but still, it being necessary under the Act to declare that I am the inventor, I make the necessary declaration." All must regret that Sir George Jessel is not now on the Bench to construe this document, and to give his judgment as to the power of the Board of Trade to institute any such form of declaration. I can only say that, in my opinion (worthy of very little consideration, no doubt), this form of declaration is nonsense, and that I believe the Courts will hold that it is altogether *ultra vires*. It bases its existence upon the construction given in the Act of the word "invention" and an endeavour to apply thereto the judicial decisions on the words "first and true inventor within this realm" in the Statute of Monopolies. If the definition had been, "the words 'first and true inventor' shall have the meaning which has been applied to the same words under the Statute of Monopolies," the matter might have been different; but even then it is difficult to see how, without overruling it, the decision in *Milligan v. Marsh* would have been got over. It is to be hoped that before long the point will have received judicial decision, as

otherwise a vast number of patents will be in some jeopardy of being at any moment held to be invalid. I trust that I shall be pardoned for having perhaps too boldly expressed myself. I respectfully submit these my opinions, and I admit that it is very probable that in many instances they are erroneous.

I have to thank my friend Mr. H. G. Watts, of 3, Harcourt Buildings, Temple, for many valuable suggestions in the preparation of this work, and especially for the Index to it.

THOMAS TERRELL.

NEW COURT, TEMPLE,

8th Jan. 1834.

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ERRATA.

Page 83, line 4, for "malâ fide," read "mala fides."
 ,, ad fin., for "bonâ fide," read "bona fides."

The Law and Practice

RELATING TO

LETTERS PATENT FOR INVENTIONS

INTRODUCTION.

LETTERS patent for inventions are granted by the crown by virtue of its common law prerogative. By the creation of monopolies to first and true inventors in the right of using their inventions, a species of property is created in favour of inventors, as a reward for the benefits which they have conferred on humanity, by the exercise of their thought, knowledge and industry. It is to the interests of the community that persons should be induced to devote their time, energies and resources in furtherance of the development of arts and manufactures, and this was recognized in England from the earliest periods which can pretend to be described as civilized.

It was to the advantage of the whole community that inventors should be rewarded, and no measure of reward can be conceived more just and equitable, and bearing a closer relation to the benefit conferred by the particular inventor than to grant him the sole right of making, using and vending his invention for a limited period of time. In the corrupt ages of the Stuarts, it is not to be wondered at, that the prerogative of the crown to grant monopoly rights to first and true inventors, should have been made a lever for assuming a prerogative to grant monopoly rights in trade generally.

In the reign of James the First, to such an extent had this abuse been carried, that it was deemed advisable by

the legislature that the rights of the crown in respect of letters patent should be declared by legislative enactment—this was the origin of the Statute of Monopolies.

It has been supposed that the prerogative of the crown to grant letters patent for inventions was created by this statute, but the most cursory perusal of its enactments and of the authorities which preceded it, shows clearly that, so far from the statute giving to the crown any right which it did not possess before it was passed, it has as its intention the limiting the right of the crown, and the declaring that, which had always been the common law upon the subject. In the first section of this Act, for instance, we find it recited “that all grants of monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty’s laws, which your Majesty’s declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm. . . . That all monopolies, and all commissions, grants, licenses, charters and letters patent heretofore made or granted or hereafter to be made or granted . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no-wise to be put in use or execution.”

Section 6 saved the granting of letters patent to inventors in the following words:—

“Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made 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 of 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 of 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, but that the same shall be of such force as they should be if this Act had never been made and of none other.”

It will thus be seen that the Statute of Monopolies creates no statutory right, but merely saves the common law right of the crown; and by sect. 116 of the Patents Designs and Trade Marks Act, 1883, it is enacted, “Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the crown in relation to the granting of any letters patent, or to the withholding of the grant thereof.” By sect. 46 of the same Act the word “invention” is defined as meaning “any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies and includes an alleged invention.”

So it is that in the present day, notwithstanding the various statutes which have been passed in relation to letters patent for inventions, these monopolies are still granted upon the mere motion of the sovereign, in the exercise of her royal prerogative, and that all that has been done, has been declaratory of the limits within which that prerogative should be exercised, and of the method of procedure to be adopted in obtaining letters patent for inventions.

For the purpose of supporting the validity of the letters patent it is necessary that the patentee should conform to certain requisites, and these requisites are indicated in the 6th section of the Statute of Monopolies. In the first place, he must be the true and first inventor of a new manufacture; the new manufacture must not be contrary to law, nor must it be mischievous to the State, by raising the prices of commodities at home; it must not be hurtful to trade, nor generally inconvenient. The

Act of 1883 has adopted this definition of an invention, and anything that does not conform with all these requisites is not entitled to be called an invention. The host of important decided cases as to the construction of the 6th section of the Statute of Monopolies, and the enormous expense, and labour and learning, which has been devoted to obtaining these decisions, no doubt induced the legislature to adopt a definition which had in some respects obtained a correct judicial meaning; but it is doubtful whether it was wise to re-enact it in a form which had, we may say, centuries ago, already become to some extent obsolete.

The protection of trade by means of Guilds, and of all those various protective schemes which were elaborated in the middle ages, have been found to be fallacious. Industries in this country are no longer protected by the artificial process of law, and therefore it is difficult to understand the correct meaning which would be given to the words in the 6th section of the Statute of Monopolies, which refer to an invention having a tendency to raising the prices of commodities at home, or to hamper trade, or to be generally inconvenient, terms exceedingly vague in themselves, and which the Courts have not had occasion to consider for a very great number of years.

These matters, and the construction which is to be placed upon the word "invention," will have to be dealt with hereafter, when we consider the cases which have been decided upon the matter.

CHAPTER I.

THE PATENTEE.

By sect. 46 of the Act of 1883, the word **patentee** is construed as meaning “the person for the time being entitled to the benefit of the patent;” consequently it may mean the original grantee, his executors and administrators, or the assignee of the original grantee. By sect. 4 of the same Act it is enacted:—

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

It will be observed, that there is no limitation whatever preventing a person under incapacity, either by reason of infancy or otherwise, from obtaining a patent.

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

By sect. 5, (1) “An application for a patent must be made in the form set forth in the Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office, in the prescribed manner.”

(2). “**An application** must contain a **declaration** to the effect that the applicant is in possession of an invention whereof he, or, in the case of a joint application, *one or more of the applicants* claims or claim to be the true and first inventor or inventors, and for which he or they desire or desires to obtain a patent, and must be accompanied by either a provisional or complete specification.”

Before this Act it was competent for an **alien** to obtain

a patent; Lord Cairns, in the matter of *In re Wirth's Patent* (a), went even further than this: "I am quite clear that letters patent may be granted to a foreigner who is resident abroad for an invention communicated to him by another resident also abroad."

There does not appear to have ever been a question as to whether an **infant** or a **married woman** might, under the old law, have become a grantee of letters patent. The new law, however, is perfectly clear, and sweeps away any doubt that might have been entertained on the subject.

By sect. 99 of the Patent Act of 1883, it is found that due provision is made for enabling infants and persons under incapacity to take the requisite steps for obtaining letters patent. The Act of 1883, however, appears to abolish by implication one large class of grantees, viz. those persons who claimed to have letters patent granted to them for communications from abroad. It will be observed that sect. 6 of the Statute of Monopolies deals with new manufactures *within this realm*, and the construction which has been placed upon that statute has been, that the consideration for the grant of the patent could be equally supported by the process of inventing a new manufacture, as by the process of importing from abroad a manufacture which up to the time of such importation had been unknown within this realm.

In the case of *Darcy v. Allin* (b), it was held, "Where any man by his own charge and industry, or by his own wit and invention, doth bring any 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, that in such cases the king may grant to him a monopoly patent for some reasonable time until the subjects may learn the same in con-

(a) L. R., 12 Ch. D. 303.

(b) 1 Web. P. C. 6.

sideration of the good that he doth bring by his invention to the commonwealth, otherwise not."

So in *The Clothworkers of Ipswich case* (c), it was laid down that "the bringing of a new invention into the kingdom equally with the discovery of anything was sufficient to support the king's grant." It is true that these cases were prior to the Statute of Monopolies, but the Statute of Monopolies merely affirmed the common law, hence these cases are applicable. *Edgebury v. Stephens* (d) was decided after the statute; there it was held that "a grant of a monopoly may be to the first inventor, and if the invention be new in England, a patent may be granted though the thing was practised beyond the sea before; for the statute speaks of a new manufacture *within this realm*, so that if it be new here it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing" (d).

The practice of granting letters patent to the first importers of manufactures new within this realm, has been uniformly sustained by our Courts of Law. It would appear, however, that the Act of 1883 is intended to abolish this class of patentee, for it will be seen, that after declaring that any person alien or otherwise may apply for a patent, it says that the application *must* contain a declaration to the effect that the applicant claims to be *the first and true inventor*. A form of this declaration is given in the first Schedule to the Act, and there is no provision whatever made for a declaration that the applicant is the first and true *importer*.

We have seen that the word "invention" is construed by the language of the 6th section of the Statute of Monopolies, that language has been held in *Edgebury v. Stephens* (d) and the succeeding authorities, to include an importer of an invention; but inasmuch as the Act

(c) Godbolt's R. 253.

(d) 1 Web. P. C. 35.

provides no machinery whereby an importer might apply for a patent, it may perhaps be taken as the intention of the legislature that henceforth that class of patentee shall be abolished, and that the patent should only be granted to the first and true inventor of the invention.

In *Milligan v. Marsh* (e) it was held by Vice-Chancellor Page-Wood that a person taking out a patent and making a declaration that he is a first inventor when in truth he is only an importer of a communicated invention, makes a false suggestion and the patent is void.

Only one of the applicants need make the declaration, so that a capitalist may join an inventor and obtain a valid joint patent.

Sect. 34 of the Act of 1883 makes provision for the granting of letters patent to the legal representative of a deceased inventor, provided application be made within six months from the decease of the inventor, the application must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

We have now to deal with the construction of the words "first and true inventor."

The reason that the common law has created a prerogative of the crown to grant letters patent to first and true inventors, is that the public benefit by the consideration which the inventor gives in return for the monopoly privilege which is granted to him. That consideration may be divided into three parts.

In the first place, the patentee must be the actual inventor, that is, the consideration must move from him.

Secondly. He must have invented a new and useful invention.

Thirdly. He must publish his invention.

(e) 2 Jur., N. S. 1083.

CHAPTER II.

THE CONSIDERATION—BEING THE ACTUAL INVENTOR.

An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The process of invention may be divided into two parts. The operation of the mind, and the carrying out of the results of that operation by the hands. It is true that when an invention is the result of pure accident, the physical production may precede the operation of the mind in perceiving its applicability, still, as a general rule, it will be observed that the operation of the mind must precede the physical production. The operation of the mind must in all cases be that of the mind of the inventor. The carrying out of the results of the operation of the mind may be done by the hands of the inventor, or by those of anyone else whom he may employ for that purpose.

In *Tennant's case (a)*, a material portion of the invention claimed was found to have been suggested by a chemist at Glasgow. Lord Ellenborough held, that the patent was bad because the plaintiff was not the inventor. It will be observed in this case, that although it is possible that the plaintiff was the first person to use the particular method for making a bleaching liquor, still, inasmuch as that method of producing this bleaching liquor was thought out by some one else and communicated to the plaintiff, he was held not to be an inventor. In considering this question we must not confuse the idea of **first manufacturer** with that of first inventor.

“A.” may have invented something, it may have pleased him to try a few experiments with his invention, and then to abandon it without publication. “B.” may

(a) 1 Web. P. C. 125.

subsequently have invented the same thing altogether independently of "A." If "B." applies for letters patent he is at law the first inventor; but should it be shown that the process of invention was not carried on in "B.'s" mind at all, but that "A." communicated his ideas to "B.," although with the full intention of abandoning them, "B." will not be the first inventor. Take, for instance, the case of *Dollond's Patent* (b), this was an improvement in the manufacture of object glasses for telescopes. Dr. H. had made and used identically similar object glasses for his own purposes, but he had in no way published his invention. Dollond, without any communication from Dr. H., had re-invented these object glasses; held that Dollond's patent was good.

In *R. v. Wheeler* (c), Abbott, C. J., delivering the judgment of the court, said: "If the patentee has not invented the matter or thing of which he represents himself to be inventor, the consideration of the royal grant fails." In *Barber v. Walduck* (d), it was proved that the invention was made by a workman in the workshop of the patentee, that he communicated it to his master: the patent was opposed on the ground that the patentee was not the inventor.

In *Bloxham v. Elsee* (e), the patentee had worked out the principle of his invention in his own mind, but he intrusted the mechanical details to Mr. D., an engineer. Mr. D. had suggested several parts of the machine to the patentee. An objection was taken that the patentee was not the inventor: the objection was overruled. It will be seen in this case, that the patentee's mind conceived the invention, and that Mr. D. was only, so to speak, the intellectual hands employed by the patentee to carry out that which he had previously conceived in his mind. The summing up of Mr. Baron

(b) 1 Web. P. C. 43.

(c) 2 B. & Ald. 345.

(d) 1 Carp. P. C. 438.

(e) 1 Web. P. C. 132, n.

Alderson, in the case of *Minter v. Wells* (*f*), is instructive upon this point:—"The patentee," said the learned judge, "claims under the patent, stating it in his petition to the crown, that he is the true inventor of the machine in question, and if it could be shown that he was not the true inventor, but that some one else had invented it, the crown is deceived in that suggestion, which was the foundation on which it granted the patent, and then the law is, that the patent obtained under such circumstances would be void, and no action could be maintained against the party for the infringement of the patent, If Sutton suggested the principle to Minter, then he, Sutton, would be the inventor; if, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter uses for the purpose of enabling him to carry his original conception into effect."

In *Lewis v. Marling* (*g*), Mr. Justice Bailey said: "If I discover a certain thing for myself, it is no objection to my claim to a patent that another also has made the discovery, provided I first introduce it into public use." The suggestion in that case having been that the patentee had acquired his invention by seeing a model of a similar machine which had been brought from America; it was disproved that he had seen the model, and consequently he was held to be the first and true inventor.

In *Cornish v. Keene* (*h*) Chief Justice Tindal said: "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 the

(*f*) 1 Web. P. C. 127.

(*h*) 1 Web. P. C. 507.

(*g*) 10 B. & C. 22.

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 although that was new with the party who got the patent, he was not the man whose ingenuity first discovered it, that he borrowed it from A. or B., or had 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 be an important question whether he was the first and original inventor of it.” There is no doubt that under the circumstances stated by the Chief Justice, the patentee would not be the original inventor.

Inasmuch as we have seen that the Act of 1883 probably abolishes *first importers*, and recognizes the right of all persons, whether British subjects or not, and whether resident in England or not, to become patentees, a serious question will arise for the consideration of the Courts as to whether the validity of a patent, and the claim to be a true and first inventor, must be supported upon an investigation of what has been published and become public property not only in England, but in any other part of the civilized world; and for the purpose of calling himself a first and true inventor, it will not only be, not sufficient for an inventor to say that he has not obtained the invention from a book printed or published in England, or from a communication made to him in England, but that he has not obtained the invention from a book published or printed in any part of the world, or from a communication made to him in any part of the world. In future the first and true inventor must in reality be an inventor, and the invention must be the result of the operation of his own mind.

It is probable that this change in the rights of first importers was not contemplated by the legislature, and that the omission of the words “within this realm,” in the 5th section of the Act of 1883, was accidental. If it

be accidental it is doubtful whether the Courts will venture so far as to correct such an omission by judicial decision; and the change in the law thus brought about will require a great deal of thought, and a great many decisions before its effect can be fully appreciated.

We do not propose to deal at length with the cases that succeed *Cornish v. Keene*. The principle laid down in cases we have cited has been invariably followed. In *Gibson v. Brand* (*i*), Chief Justice Tindal said: "A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor, he may have borrowed it from some other person, or book. The legislature never intended that a person, who had taken his knowledge from the art of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill." The same judge, in *Walton v. Potter* (*k*), said: "If the subject-matter of the patent has been published in a dictionary, for example, and, if a man merely adopts it, the merit is so small that his patent for it would be worth nothing."

It is evident that cases may arise where the operation of one man's mind may have assisted the operation of another's mind. In this case it will be a question for the jury which was, so to speak, the dominant mind and which the servient mind, the dominant mind will be entitled to the patent. In *Allen v. Rawson* (*l*), Chief Justice Tindal said: "I think it is too much that a suggestion of a workman employed in the course of experiments of something calculated more easily to carry into effect the conceptions of the inventor should render the whole patent void."

In dealing with this branch of the subject, and show-

(*i*) 1 Web. P. C. 628.

(*l*) 1 C. B. 574.

(*k*) 1 Web. P. C. 592.

ing that one of the essential portions of the consideration for the grant of letters patent is the labour of the mind of the inventor, we may cite the case of *Patterson v. Gas Light and Coke Company* (*m*). In that case certain referees had been appointed under the City of London Gas Act to inquire into the subject of the purification of gas. The plaintiff was one of those referees. The referees drew up a report on the 31st January, 1872. The report contained a description of the subject-matter of the plaintiff's patent. Subsequently to the making of the report, but before its delivery to the Board of Trade the plaintiff, who had really discovered the invention, obtained provisional protection. The action was brought against the Gas Light and Coke Company for infringing his patent. The company alleged that the invention was not new, and also denied the title of the plaintiff to take out a patent in respect of it, on the ground presumably, that he had no consideration to offer to the public in return for the grant of letters patent, he having already disposed to the public of his knowledge upon the subject for other considerations. In the judgment of the House of Lords, Lord Blackburn said: "It seems to me clear that the duty of the referees under the Act was to ascertain how far the gas could be practically purified by each company. If they found that gas containing not more than a certain limited amount of impurity could be practically produced by any means, they were to prescribe the maximum amount accordingly, and they were by obvious implication, though it is not expressly enacted, to make public how this degree of purity could practically be obtained. It was not material to them to inquire whether these were means previously known, which the companies had failed to make use of from parsimony, negligence or ignorance, or whether there was some new idea which

(*m*) L. R., 3 App. C. at p. 243.

had been developed during the course of their inquiries, which made these old means practicably valuable when before they were not. They were not at all required to distinguish new from old. In all these respects the report was quite different from a specification. But, as soon as they became aware that the gas could be practicably brought to this degree of purity, their duty was to fix the maximum accordingly, and to make known to the public the means by which this could practicably be done. The report of the 31st January, 1872, is drawn up as it ought to have been. It shows that, by some means there explained, purity to a great extent could practicably be obtained, it makes no attempt to show how much of this was previously known though neglected, and it nowhere states that any part of what was now disclosed was invented by one of their own body." In the Court of Appeal Lord Justice James had said (*n*): "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say we think it at the least very questionable whether it can be competent for a member of final commission or committee to take out a patent for the subject-matter of their official investigation, . . . it is to be borne in mind that the report then made belonged absolutely to the State. Every fact and figure in it had been obtained at the public expense, every hour of every referee and of the secretary employed in the production of it was public time . . . the consideration for every patent is the communication of useful information to the public. What consideration is there when the information was already the property of the State."

These judgments, although going to a point which was not absolutely necessary for the decision of the case (for the case was decided upon the ground of want of novelty in the invention), tend to show that it was in the minds

(*n*) L. R., 2 Ch. D. at p. 832.

of the judges that the mental labour of making the discovery being an essential element for the consideration of the grant, if that mental labour had already been paid for by the State, it failed as a consideration to support the patent.

By sect. 35 of the Act of 1883, "A patent granted to a true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection." This clause is only a re-enactment of that which had been decided to be the law previous to the Act. In *Ex parte Scott and Young (o)*, the servant had filed a provisional specification of an invention, after which the master filed a specification for a similar invention, and subsequently filed a complete specification, and obtained letters patent. It was held that, under the circumstances, the Great Seal might be affixed to the letters patent of the servant's invention, and that the patent might bear the date of his provisional specification.

In the case of *Ex parte Bates and Redgate (p)*, it was held, that leaving a provisional specification, and obtaining a provisional protection, does not prevent a second applicant from leaving a specification of a similar invention, and obtaining valid letters patent for the invention before six months have elapsed from the time when the first provisional specification was left, and in such a case letters patent will not be granted to the first applicant for any part of his invention, which is covered by the letters patent already obtained by the second applicant, but in this case there was no suggestion of fraud on the part of the second applicant. This decision has, however, been doubted in *Re Deering's Patent (q)*,

(o) L. R., 6 Ch. D. 264.

(q) 13 Ch. D. 393.

(p) L. R., 4 Ch. 577.

by Lord Cairns, who said: "I may, however, state my objections to that decision" (*Bates and Redgate*), "which I never could thoroughly understand; it has always seemed to me that if Parliament held out to inventors the advantage they could get from provisional protection, the inventor should have the enjoyment of that advantage for the six months granted to him. Parliament intended the six months to be for the completion of the invention, and for perfecting the specification, and never said that the applicant should be deprived of or lose that privilege for want of any due diligence on his part."

The difficult questions, however, which arise in these cases, seem to be set at rest by the 14th section of the Act of 1883: "Where the application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same. And such protection from the consequences of use and publication is in this Act referred to as provisional protection."

The general question of concurrent applicants, where there is no fraud, that is, where each applicant is in a position to offer the consideration of mental labour, will be considered in the next Chapter. It is only material here so far as concurrent application is brought about by reason of one man fraudulently appropriating the invention of another.

We have intimated that in all probability it will be held that the Act of 1883 has disqualified a true and first importer from becoming a patentee; but the provisions of the Act are not so clear as to warrant our omitting to give some account of the law which has hitherto been in force, and the more so since it is evident that on the 1st January, 1884 (the date when the Act of 1883 comes

into force), there will be in existence large numbers of patents granted to first importers, which will still have many years to run and which in all probability will at some time or other be the subject matter of litigation.

The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. We find that so far back as 1567 a patent had been granted to one Hastings^(r) for the making of frisadoes in consideration of his having imported the skill of manufacturing them from abroad. So in Mathey's case, "It was granted unto him the sole making of knives with bone hafts and plates of lattice, because, as the patent suggested, he brought the first use thereof from beyond the seas." This was in the reign of Elizabeth. In the clothworkers of Ipswich case we have this^(s) said, "The king granted unto B. that none besides himself should make ordnances for battery in the time of war: such grant was adjudged void. But if a man hath brought in a new invention and a new trade in the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything, in such cases the king, of his grace and favor in recompense of his costs and travail, may grant by charter unto him that he only shall use such a trade or trafique for a certain time; because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the king cannot make a new grant thereof." This was in 1615.

Then came the Statute of Monopolies, and we have seen that the 6th section of that Act carefully excepted "the sole working or making of any manner of new manufactures **within this realm**, to the true and first inventor or inventors of such manufactures, which others

(r) 1 Web. P. C. 6.

(s) 1 Web. P. C. 6; 1 Godb. 252, 254.

at the time of making such letters patents and grants shall not use.”

Afterwards came the decisions of *Darcy v. Allin* (*t*), and *Edgebury v. Stevens* (*u*), where it is said, “for the statute speaks of new manufactures **within this realm**, so that if it be new here it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing.” See the remarks of Eyre, C. J., in *Boulton v. Bull* (*x*).

In the early days of manufacturing enterprise, when true inventors were so exceedingly rare as scarcely ever to be heard of, the word inventor had not acquired the meaning which it has at present, and seems to have been used to designate a **first introducer** rather than a first inventor. In the early reports shortly succeeding the Statute of Monopolies we do not find the judges in any difficulty in dealing with the words “true and first inventor,” showing that the word **inventor** had not the precise meaning which it has since acquired.

In *Marsden v. Saville Street Co.* (*y*) in the Court of Appeal, Jessel, M. R., said, speaking of imported inventions, “It has been argued that before the Statute of James such patents were valid and were allowed by the judges, and that the statute merely restricts the duration of the patent and does not destroy the right as it previously existed. Even supposing that were so, the statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been followed ever since. It is difficult to say *à priori* on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor.

(*t*) 1 Web. P. C. 6.

(*x*) 2 H. Blac. 491.

(*u*) 1 Web. P. C. 35.

(*y*) L. R., 3 Ex. D. 203.

I have never been able to discover the principle; and although I have often made enquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, "It has been so decided and you are bound by the decisions." But it is an anomaly as far as I know, not depending on any principle whatever. It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is that I must look on it as a sort of anomalous decision which has acquired by time and recognition the force of law."

A patent granted to a British subject, in his own name, for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent be in truth taken out and held by the grantee in trust for such foreigner (*z*).

Sect. 23 of the Act of 1883, provides for the registration of owners of patents. Sect. 85 prohibits the registration of any trust. This does not abolish trusts, but merely prohibits the registration of trusts.

The importer of an invention need not be a meritorious importer, but may only be a mere agent, *Beard v. Egerton* (*a*).

The importer need not have acquired the information from a foreigner abroad, but may have done so from a British subject abroad (*b*).

But a communication made in **England** by one British subject to another, of an invention, does not make the person, to whom the communication is made, the first and true inventor within the meaning of the statute

(*z*) *Beard v. Egerton*, 3 C. B. 97.

(*b*) *Nickels v. Ross*, 8 C. B. at p. 710, per Earl, C. J.

(*a*) *Supra*, at p. 129.

21 Jac. 1, c. 3, so as to enable him to take out letters patent for the invention (*c*).

When a patent is taken out as for an original invention the subject of the patent being, in fact, a communication from abroad, the patent is void. *Milligan v. Marsh* (*d*).

This latter case very much strengthens our previously expressed opinion, that the Act of 1883 abolishes patents for imported inventions, since if the directions of the Act be followed, it is impossible to take out a patent for such an invention without making a false suggestion within the meaning of *Milligan v. Marsh*.

“The merit of an importer is less than of an inventor. . . . and it is an argument against the patent, that it was imported and not invented. I do not say it takes away the merit, but it makes it much smaller.”
Per Lord Brougham in *re Soame's Patent* (*e*).

We have now shown what is meant when it is said that the consideration for a patent must move from the patentee personally.

(*c*) *Marsden v. Saville Street Co.*, C. A.; L. R., 3 Ex. D. 203.

(*d*) 2 Jur. N. S. 1083.

(*e*) 1 Web. P. C. 733.

CHAPTER III.

THE CONSIDERATION (*continued*)—A NEW AND USEFUL INVENTION.

THE second branch of the consideration is that the inventor must have invented a **new and useful invention**. It is evident that a person may have invented a manufacture which, although new to him, may not be new so far as the world is concerned. He may have had all the work and labour of discovering for himself a process which, although not generally known, yet the previous knowledge of which may amount to prior user. In such a case, inasmuch as the public are considered at law to be in full possession of the invention, it is evident that the applicant for letters patent has no consideration to offer in return for the grant. The 6th section of the Statute of Monopolies defines a new invention as “any manner of new manufacture which others at the time of making such letters patent shall not use.”

We have seen that the Act of 1883 has adopted this definition of an invention. We have now to consider the legal meaning which has been placed upon the words “New Manufactures.”

A **new manufacture** does not mean, as it is erroneously sometimes supposed, only a **new article** of manufacture, but it also means a **new process** or method of manufacturing something new or old; it does not mean a new principle of manufacturing, but it means a new application of principles. No man can claim an invention in a **principle** (*a*), for that would be to invent the

(*a*) *Boulton v. Bull*, 2 H. Bl. 479; *Hornblower v. Boulton*, 8 T. R. 101; *Jupe v. Pratt*, 1 Web. P. C. 146; *Neilson v. Harford*, 1 Web. P. C. 342; *The Househill Co. v. Neilson*, 1 Web. P. C. 673; *Crossley v. Potter*, Mac. P. C. 240; *Patterson v. The Gas Light Co.*, L. R., 3 App. Cas. 246.

laws of nature, which have always existed. Man merely discovers the principle, and if, when he discovers a principle he can discover a method of utilizing the principle so as to make it applicable to the production of a new manufacture, he can obtain a patent for the method. In *Hornblower v. Boulton* (b), decided in 1799, the patent was granted for a method for lessening the consumption of steam and fuel in fire engines, by applying certain principles of combustion. It was held that the invention could be made the subject of a patent. The language of the learned judges does not seem very clearly to expound the doctrine upon which that judgment was based; but Mr. Justice Grose said, "I am inclined to think that the patent cannot be granted for the mere principle; but I think that, although in words the privilege granted is to exercise the method of making or doing anything, yet if that thing to be made or done be a manufacture, and the mode of making that manufacture is described, it thus becomes in effect (by whatever name it may be called) not a patent for the mere principle, but for the manufacture of the thing so made, and not merely for the principle upon which it is made." In *Boulton v. Bull* (c) the Lord Chief Justice Eyre said: "When the effect produced is some new substance or composition of things, it should seem that the privilege of sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating with or without old mechanism, by which the effect is produced." Mr. Justice

(b) 8 T. Rep. 95.

(c) 2 H. Bl. 463.

Heath speaking said, "What then falls within the scope of the proviso? such manufactures as are reducible to two classes: the first class includes machinery, the second, substances, such as medicines formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form; in the first class the machine, and in the second the substance produced, is the subject for the patent. I approve of the term 'manufacture' in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso—that it was introduced for the benefit of trade." With reference to this judgment, we may point out that a new chemical substance is not a new manufacture, as the words "new manufacture" are understood in modern times, but that in the case of manufacturing a new chemical substance, the process of making that substance is the subject of the patent, and not the substance when made.

Upon perusing the cases which we propose to quote, it will be seen that the more modern view of the construction of the words "new manufacture" has been the result of a great deal of development. At first the judges seemed to be inclined to limit the subject-matter of letters patent to new articles produced; but as the arts and manufactures of the country progressed and increased, it was seen that by far the most important inventions were inventions in the **process** of making old and well-known articles of commerce, and so it became evident that should the construction of the words "new manufactures" be entirely limited to the production of new articles, to the exclusion of the process of manufacturing old articles by cheaper, better and more improved methods, the inducement which the common law intended to give to inventors would be curtailed to the narrowest possible limits.

Hull v. Jarvis (*d*) was an action for the infringement of a patent for the improvement of the manufacture of lace by the use of the flame of gas for the purpose of singeing the fluffy ends of the surface of lace manufactured from cotton. For the defendants it was contended that the process was not new. Fire and flame had been applied for similar purposes before the plaintiff's invention. The mere doing that with the flame of gas could not be the subject matter of a patent. The patent, which was clearly only for a process, was supported. In *Jones v. Pearce* (*e*)—the patentee had used the principle of suspension to the manufacture of wheels; the patent was supported because, although the principle could not be patented, the method of applying that principle to the manufacture of wheels was properly the subject of a patent. In *Russell v. Cowley* (*f*) the patent which was for an improved process of manufacturing iron tubes was supported. Lord Lyndhurst, in giving judgment, said: "It is an invention to manufacture tubes for gas and other purposes by welding them without the use of any mandril or internal support, by which certain advantages are produced."

In *Walton v. Potter* (*g*), Chief Justice Tindal said: "Now there can be no doubt whatever, that although one man has obtained a patent for a given object, there are many modes open for a man 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

(*d*) 1 Web. P. C. 100. See also *Booth v. Kennard*, 1 Hurl. & N. 527; *Higgs v. Godwin*, 27 L. J., Q. B. 421; *Hills v. London Gas Light Co.*, 29 L. J., Ex. 409;

Young v. Fernie, 12 W. R. 903; *Newall v. Elliott*, 13 W. R. 11.

(*e*) 1 Web. P. C. 122.

(*f*) 1 Web. P. C. 459.

(*g*) 1 Web. P. C. at p. 590.

new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose." In this case, the learned judge by the word "object" must have meant the method of producing an article.

The same judge in *Gibson v. Brand* (*h*), said: "The patent is taken out 'for a new or improved process for the manufacture of silk, and silk in combination with certain other fibrous substances,' taken out therefore strictly for a process undoubtedly there is a very strong reason to suppose if the specification is carefully and properly prepared, so as to point out with great distinctness and minuteness what the process is, that such a patent may be good in law. Such certainly was the opinion of Chief Justice Eyre, in *Boulton v. Watt* (*i*), and such also appears to have been the opinion (carefully guarding against any abuse of that doctrine) of Lord Tenterden in the case of *The King v. Wheeler* (*k*), who says that, 'the subject-matter of letters patent, *i. e.* the word "manufacture," as used in the Statute of James, is generally understood to denote either a thing made, which is useful for its own sake, and vendible, or to mean an engine or instrument, or some part of an engine or instrument to be employed either in the making of some previously-known article, or in some other useful purpose or it may perhaps extend also to a new process to be carried out by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner or to a better or more useful account.'"

Since the date of these earlier decisions the law seems to have been considered as settled upon the subject. In *Bewley v. Hancock* (*l*), Lord Cranworth said: "A

(*h*) 1 Web. P. C. 633.

(*i*) 2 H. Bl. 468.

(*k*) 2 B. & A. 350.

(*l*) 6 De G., M. & G. 402.

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 might be more quickly and effectually accomplished, might be the foundation of another patent." In *Simpson v. Holiday* (*m*), the specification said, "I mix aniline with dry arsenic acid and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or nearly to, its boiling point until it assumes a rich purple colour." The patentee claimed "the manufacture or preparation of red or purple dyes by heating aniline dyes with arsenic acid as hereinbefore described." Lord Chelmsford, in giving judgment, said: "There is nothing on the face of the specification to show that the invention described is not, in every part of it, the subject of a patent." It is obvious that there may be many different processes of accomplishing the same object; if some of the processes are old, and that which is claimed is merely a new method, the subject of the invention will be confined to that method (*n*).

Hereafter, in considering the specification, we shall have to discuss the limitations within which the patent for a new process will be held valid, and the cases which have been decided upon the point.

Any addition to or subtraction from any known machine or process causing the old machine or process to accomplish an object in a more speedy, perfect or economical manner, is evidently the subject of a patent. In *Hornblower v. Boulton* (*o*) Mr. Justice Grose said: "A doubt is entertained whether there can be a patent for the addition of an old manufacture, this doubt rests altogether upon *Bircot's case* (*p*), if that were to be considered as law at

(*m*) L. R., 1 H. L. 315.

(*o*) 8 T. Rep. 104.

(*n*) *Bovill v. Pimm*, 11 Exch. 739.

(*p*) 3 Inst. 184.

this date (1799) it would set aside many patents for many ingenious inventions if indeed a patent could not be granted for the addition it would be depriving the public of one of the best benefits of the statute of James." In *Lister v. Leather* (*q*), Lord Campbell said: "The assertion that all patents for improvements of existing patents must be void, is obviously untenable." In *Fox v. Dellestable* (*r*), V. C. Malins said: "No doubt a man may make an **invention** which is partly covered by an **existing patent**, but he cannot use it without the license of the patentee. He may wait for the expiration of the patent and take out one himself. If his invention be novel, that patent will be valid."

An application of an old machine or an **old material for a new purpose**, may be the subject of a patent; for instance, *Muntz v. Foster* (*s*) was an action for an infringement of a patent for the manufacture of metal plates to be used for sheathing the bottoms of ships. The improvement consisted of using an alloy of zinc and copper in certain proportions for the manufacture of the plates, and for this purpose copper alone had hitherto been used. The alloy of zinc and copper was to produce an old and well-known material, still the application of that old material to sheathing of ships had not before been discovered, and upon its being shown that such an application was a great improvement on the old method of sheathing with copper, it was held that the patent could be sustained.

The mere application of a **known instrument or machine to a new purpose** will not support a patent unless the means or method of the application is also new (*t*).

In *Reg. v. Cutler* (*u*) Lord Denman said: "With

(*q*) 8 E. & B. at p. 1017.

(*r*) 15 W. R. at p. 195.

(*s*) 2 Web. P. C. 103.

(*t*) *Pow v. Taunton*, 9 Jur. 1056.

(*u*) 3 C. & K. 215.

regard to the third and fourth claims, in which the defendant claims the application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that would have been a new discovery, and a proper subject for a patent . . . I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article, or to the mode of applying it for attaining that result, forms no ground for a patent." Lord Denman's distinction between the mere application of an old instrument to a new purpose and a new combination, appears to have been followed, and to be a correct exposition of the law.

In the case of *Steiner v. Heald* (x), in the Exchequer Chamber, the head-note is inexplicable and erroneous. If the case itself is read, it will be found to be in accordance with the other decided cases on this subject: In the ordinary process of dyeing, by means of madder, the colouring matter was obtained from fresh madder by the application of hot-water; the refuse, after boiling, was called spent madder. It had long been known to dyers, that a portion of the colouring remained in the spent madder, but it was not known how to extract it, as it remained in combination with the plant; recently it was discovered that by means of acid and hot-water the pure colouring matter of madder, called garancine, could be obtained from fresh madder, and that this process extracted the colouring matter of the plant. The plaintiff obtained a patent for the new manufacture of garancine, by applying the same process of acid and hot-water to the spent madder; since his invention the spent madder, which was previously worthless, became valuable.

(x) 20 L. J. Exch. 410.

At the trial Chief Baron Pollock directed the jury to find a verdict for the defendant, upon the ground apparently that there was no subject for a patent; in reversing this decision Mr. Justice Pearson said: "Now spent madder might be a very different thing from fresh madder in its properties, or it might be in effect the same thing as fresh madder in its properties, chemical and otherwise, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical and otherwise, might or might not have been known to chemists and other scientific persons, so that they could find out whether fresh madder and spent madder were different or substantially the same things. The points appear to us to be questions of fact, and materially to affect the validity or invalidity of a patent." It will appear, therefore, that the Court were of opinion that it was a question of fact whether spent madder and fresh madder were the same thing in their chemical properties; if they were, no patent; if they were not, the validity of the patent would be sustained, but the fact must be decided by the jury.

In *Bush v. Fox* (*y*) Chief Baron Pollock graphically illustrated the point we are now discussing, he said: "I think if one man invents a new mode of looking at the moon, somebody else cannot take out a new patent for looking at the sun. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think anyone could say, 'I will take out another patent for another telescope to be used for taking observations on the sea.'" That case was ultimately confirmed in the House of Lords (*z*). In *Brook v. Aston*, Baron Martin said (*a*): "The application of a well-known tool to work previously untried materials, or to produce new forms, is not a subject of a patent."

(*y*) Macrorie's P. C. 164.

(*a*) 8 E. & B. 485.

(*z*) 5 H. L. C. 707.

It is evident to anyone considering these cases, that the border line is exceedingly fine. In *Penn v. Bibby* (b) Lord Chelmsford, L. C., recognized the difficulty of stating any definition which should be applicable to any case. He said: "It is very difficult to extract any principle from the various decisions on this subject which can be applied with certainty to every case, nor indeed is it easy to reconcile them to each other." He then proceeds to dissent from the definition given by Lord Campbell in *Brook v. Aston*, doubting the accuracy of the report, and proceeds to say: "Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or at least of a rule for judging in these cases, in *Harwood v. G. N. R.* (c), where he says, "although authorities established the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purpose, or to purposes so nearly cognate and similar as that the application of it in one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, whether the amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is so sufficiently meritorious as to be deserving of a patent.'" The case of *Harwood v. G. N. R.*, quoted above by the Lord Chancellor, was carried to the House of Lords, where Lord Chelmsford, then Lord Chancellor, said: "The question is, whether there can be any invention of the plaintiff in having taken that thing, which was a fish for the bridge, and having applied it as a fish for the railway, upon that I think the law is well and rightly settled viz., that you cannot have a patent for a well-known mechanical appliance, merely because

(b) L. R. 2 Ch. 127.

223; *Jordan v. Moore*, L. R., 1 C.(c) 29 L. J., Q. B. 193; also
Ralston v. Smith, 11 H. L. Cas.P. 624; *Parkes v. Stevens*, L. R.,
8 Eq. 367; L. R., 5 Ch. 36.

it is applied in a manner or to a purpose which is analogous to the manner or purpose in or by which it has hitherto been notoriously used(*d*).” It may be noticed that where the **object** of a patent is **old**, and the **means** to effect it only are **new**; the Court construes the invention strictly, as it looks jealously at the claims of inventors seeking to limit the right of the public to a well-known object(*e*).

A new combination is an invention consisting of the discovery that two or more known processes, materials, or implements when used together will become applicable to a new purpose, or will effect an old purpose in a better, cheaper or more expeditious manner than it had before been done.

In *Huddard v. Grimshaw* (*f*), Lord Ellenborough said: “I suppose it will not now be disputed that a new combination of old materials, so as to produce a new effect, may be the subject of a patent.” There may be a valid patent for new combination of materials previously in use for the same purpose (*g*).

In *Foxwell v. Bostock* (*h*), Lord Westbury said: “If a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented.”

Bovill’s patent consisted of a combination of a blast, with an exhaust of air to millstones, for the purpose of preventing the heat generated in grinding corn and

(*d*) 11 H. L. Cas. 654.

(*e*) *Curtis v. Platt*, 3 Ch. D. 135, n.; *Rushton v. Crawley*, L. R., 10 Eq. 522; *The Patent Bottle Envelope Co. v. Seymer*, 5 C. B., N. S. 164; *Horton v. Mabon*, 12 C. B.,

N. S. 437; *Ormson v. Clarke*, 14 C. B., N. S. 475.

(*f*) Daw. P. C. 267.

(*g*) Per Lord Eldon, *Hill v. Thompson*, 1 Web. P. C. 237.

(*h*) 12 W. R. 725.

saving the dust generated. It was proved that a blast and an exhaust had been used separately. But that the **combination was a substantial improvement.** The patent was held good (*i*).

In *Crane v. Price* (*k*), the patentee, in his specification, after specifically disclaiming the use of the hot blast or the use of anthracite coal, proceeded: "What I do claim as my invention is, the application of anthracite or stone coal or culm *combined* with the using of hot air blast in the smelting and manufacture of iron from ironstone, mine or ore as above described." The patent was held valid for the combination. This decision was afterwards questioned by Lord Justice James in *Murray v. Clayton* (*l*), but not on the ground that a combination could not form the subject of a patent. In *Murray v. Clayton*, the decision was followed and a patent of this description was upheld.

A patent was granted in 1870 for railway signalling apparatus; in 1871 another patent was granted for other improvements in railway signalling apparatus; in 1874 the plaintiffs obtained a patent for a combination which, in effect, was constituted of the improvements in the 1870 and 1871 patents; any person of ordinary knowledge of the subject would, by placing the two inventions of 1870 and 1871 side by side, be able to effect the desired combination without making any further experiment or gaining any further information. Field, J., held the 1874 patent void (*m*).

In *Cannington v. Nuttall* (*n*), it was held that the patent could be sustained, although **each principle or process in it was previously well known**, provided that the mode

(*i*) *Bovill v. Keyworth*, 7 E. & B. 725; *Brunton v. Hawkes*, 4 B. & Ald. 550; *Lewis v. Davis*, 1 Web. P. C. 488; *Carpenter v. Smith*, 1 Web. P. C. 538; *Allen v. Rawson*, 1 C. B. 551; *Lister v. Leather*, 27 L. J. Q. B. 295; *Dan-gerfield v. Jones*, 13 L. T. R., N. S. 142.
 (*k*) 1 Web. P. C. 393.
 (*l*) L. R., 7 Ch. 584.
 (*m*) *Saxby v. Gloucester Wagon Co.*, L. R., 7 Q. B. D. 305.
 (*n*) L. R., 5 H. L. 205.

of combining these processes was new and produced a beneficial result, and provided also that the specification claimed not the old processes or any other, but only the new combination. This case is very instructive, as clearly demonstrating what is meant by a "new combination."

Having now considered the interpretation which has been placed by the Courts upon the word "manufacture," we next examine what has been held to be a "**new manufacture**," that is to say, to what extent prior user is an answer to an action for the infringement of a patent. It is evident, that, if the alleged new manufacture can be shown to have been in the possession of the public before the application for the grant of letters patent, that there is no consideration for the grant. The patentee offers to the public, in return for the monopoly privilege, his information and knowledge respecting a new manufacture; if the public is already possessed of the information or knowledge the supposed inventor has nothing to give. We shall see hereafter, when we discuss the practice of the Courts in actions for the infringement of patents, that the **burden of proof** lies on the alleged infringer when he sets up a defence of **prior user**, *i. e.* of want of novelty in the alleged manufacture at the date of the patent; and it is as well to keep this in mind in reading the cases which have been decided as to what amounts to prior user.

We have seen that the Statute of Monopolies is a mere declaration of that which was the law before it was passed; it was always held by the Courts that the principle of a patent grant was not an arbitrary advantage granted by the Crown to one subject in detriment to the rest, but that it was an advantage granted by the Crown to persons who introduced a new manufacture, and that it was granted upon principle, not for the benefit of the patentee but for the benefit of the public: it being considered to the benefit of the public that

reasonable encouragement should be given to inventors to induce them to devote their time, energies and resources to the improvement of the arts and manufactures of the realm.

In the case of *Hasting's Patent* (*r*), decided in 1567, the patent was in consideration of the patentee having brought into the country the making of trisadoes as they were made in Haarlem, in Amsterdam, being not used in England. The infringers defended the patentees' bill in the Exchequer Chamber, on the ground that they had made baies very like to Mr. Hasting's frisadoes, prior to the date of Mr. Hasting's patent; they were therefore not restrained from making baies like his frisadoes. The monopoly patent granted to "one Humphrey, of the Tower, 'for the sole and only use of a sieve or instrument for melting of lead, supposing it was his own invention, and therefore prohibited all others to use the same for a time;' and because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber by English bill, in which Court the question was whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendip, in West country, which if it were there before used then the Court were of opinion that he should not have the sole use thereof (*s*)."

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex v. Arkwright* (*t*), decided in 1785, Mr. Justice Buller gave a definition of a novelty which now would be considered too wide. "Thus the case stands as to the several component parts of this machine, and if

(*r*) 1 Web. P. C. 6.

Liardet v. Johnson, 1 Web. P. C.

(*s*) 1 Web. P. C. 7; *Darcy v.* 52 and 53.

Allin, 1 Web. P. C. 6; *Mitchell*
v. Reynolds, 19 Mod. R. 130;

(*t*) 1 Web. P. C. 64.

upon them you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant upon either of these points, the prosecutor is entitled to your verdict.”

When we speak of an invention being new, we mean that it must be new so far as the public are concerned, that is, so far as the means of information of the public goes. If a man had invented a machine and made it and used it **secretly**, so that no one but himself had access to it, and the general public had no means of information upon it, there is no doubt that a subsequent inventor, re-inventing, so to speak, the same machine, and disclosing his knowledge to the public in his specification, would be entitled to a valid patent. A machine made by the person who kept it secret would not amount to such a public knowledge as would anticipate the invention of the patentee, but if the first-made machine had been used in such a manner that other persons had been enabled to acquire the knowledge of its use and application, there would be a prior user to void the subsequent patent. Lord Chief Justice Tindal said, in *Cornish v. Keene* (*u*): “If it was known at all to the world publicly, or practised openly so that any other person might have the means of acquiring a knowledge of it as well as the inventor, then the patent would be void.” In *Carpenter v. Smith* (*x*), Lord Abinger, C. B., analyzed the meaning of the words “**public use.**” “Public use does not mean a use or exercise by the public, but a use or exercise in a public manner.” Taking that as a definition of the meaning of the words “public use,” it will be apparent that the question of prior user is one of fact, and one which will have to be considered by

(*u*) 1 Web. P. C. 508.

(*x*) 1 Web. P. C. 534. See also
Lewis v. Marling, 10 B. & C. 26;
Minter v. Mower, 1 Web. P. C.

139; *Morgan v. Scaward*, 2 M. &
W. 544; *Betts v. Menzies*, 1 E. &
E. 1008; *Harwood v. G. N. R.*, 29
L. J., Q. B. 193.

a jury or a judge sitting as a jury upon the facts of each particular case.

The decided cases only offer illustrations of that which has been held to be public use or prior user in the different cases which have come before the Courts. In *Walton v. Bateman* (y), Crosswell, J., said, referring to the words in the statute, “which others at the time of making such letters patent and grants did not use,” said: “Now that has been held to mean a user, not by way of experiment, but a public user, in distinguishing which the knowledge of the parties as to the article in use will be material for your consideration. . . . Whether it is a *manufacture* within the meaning of this Act I apprehend to be a question of law.” The learned judge then proceeds to sum up to the jury upon the question of fact as to prior user. “First, was any article made before, answering the purposes or having the properties of that which the plaintiff has made and claimed as in the patent . . . then even supposing that article did embody the principles of the plaintiff’s, so as to present to persons using it the properties, qualities and advantages in principle of that article which the plaintiff makes, the question for you will be whether that user is not to be considered rather in the nature of an **experiment** than of any public use of the article, so as to deprive the plaintiff of the fruit of his discovery in respect of this manufacture.” The learned judge then proceeds to quote the words of Tindal, C. J., in *Cornish v. Keene* (z): “The question raised for the jury was this, whether various instances brought forward by the defendants amounted to proof, that before or 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 after-

(y) 1 Web. P. C. 615 to 619.

(z) 1 Web. P. C. 519.

wards abandoned.' ” It is very difficult to reconcile the meaning of Mr. Justice Cresswell when he says, that “the question of prior user is one for the jury,” with his remarks in the latter part of the judgment. “The third issue is much wider. The defendants say that the alleged invention was not, nor is, a new manufacture within the meaning of the statute concerning monopolies. Now that is put to him as a question of law . . . and I am confirmed now, on further consideration, in the opinion I previously expressed, that there is sufficient of a new manufacture in this case to justify and maintain the patent that has been granted. I think that there is a new principle developed, carried out and embodied in the mode of using that principle.” The learned judge must have had present in his mind that the point of law was as to whether the manufacture was a manufacture in the meaning of the statute or not, for the **novelty** of the manufacture is certainly a **question of fact**.

As further illustrating the distinction between “public use” and “secret use,” we may quote the words of Mr. Justice Williams in *Hancock v. Somervell*, which is quoted in “Newton’s London Journal,” Vol. XXXIX. p. 158. “The defendants say that the invention had been substantially published and was in use, not in secret use, but in public use in England before the date of the patent, and if that is so, it would entitle the defendants no doubt to a verdict upon this novelty issue. Upon that part of the case the view that it seems to me ought to be taken by you is this, you will first consider whether the material was before the public; it is not necessary that it should be used by the public if it is in public use, not in secret use. . . . I should here say that I do not think it necessary the use should be actually for sale; if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handed about the country for the purpose of attracting customers. If you should think

that the material being so in use, it was so palpable that you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it, that would be a public use.”

In *Stead v. Anderson* (z), Baron Parke placed some considerable limitation of the meaning of the words “public use” in saying, “if the mode of forming and laying blocks at Sir W. Worsley’s had been precisely similar to the plaintiff’s, that would have been sufficient user to destroy the plaintiff’s patent, though put in practice in a spot to which the public had not free access.”

It is difficult to draw the line precisely between public and secret use: we do not suppose that for the purpose of showing that some use was secret use, it would be necessary to show an intention of secrecy, but in all cases it will be a matter of fact whether the use was so private and so secret as to make it practically impossible that the public should become acquainted with the manufacture.

Mr. Justice Erle, in *Heath v. Smith* (a), cast a doubt even upon whether **secret use** would not amount to anticipation. He said, “If one party only had used the process and had brought out the article for profit and kept the method entirely secret, I am not prepared to say that then the patent would have been valid.” But this seems to be in direct contradiction to the decision in *Dolland’s Case* (b). In that case the objection to Dolland’s Patent was, that he was not the inventor of the method of making new object glasses, but that Dr. Hall had made the same discovery before him; but it was held, that inasmuch as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dolland was to be considered the inventor (c).

(z) 2 Web. P. C. 149. See also *Stead v. Williams*, 2 Web. P. C. 136.

(a) 3 E. & B. 256.

(b) 1 Web. P. C. 43.

(c) See also the remarks of Buller, J., in *Boulton v. Bull*, 2 H. Bl. 463 to 470, and Mr. Justice Dallas in *Hill v. Thompson*, 1 Web. P. C. 244.

In *Betts v. Neilson* (*d*) it is said, "There may be public use of a patented article, **without actual sale** of the goods manufactured."

There are some conflicting cases on the subject of **secret use**. It does not appear to be open to much doubt that purely secret use, without publication, even if accompanied with the sale of the article manufactured, provided the article itself, by its appearance or other qualities, does not disclose the invention, ought not to invalidate the letters patent granted to a subsequent inventor, since he is in the position to and does give to the public the full consideration required by the Statute of Monopolies and the common law, for the patent grant which he applies for. On the other hand, if the secret use has been by himself, and he only applies for letters patent when he has any fear of his invention being discovered, then, probably, the previous secret use of the inventor would be held to invalidate his patent; but that must be on the ground of want of *bona fides* on the part of the inventor, and not on the ground of prior user, and want of *bona fides* has always been held to invalidate letters patent (*e*). This question is discussed hereafter (p. 47).

In *Smith v. Davidson*, a Scotch case (*f*), the Lord President said, "In order to invalidate letters patent on the ground of previous use it is necessary not only that the use shall have been prior to the date of letters patent, but that it should be a public and not a secret use." The remarks of Lord Bramwell, in *Hills v. London Gaslight Co.* (*g*), on this subject were as follows: "If a person has invented anything which is the subject of a patent, and has kept it to himself or communicated it privately to one or two, in fact has not made it

(*d*) L. R., 3 Ch. 429.

(*f*) 19 C. S. 691.

(*e*) See *Tennant's case*, 1 Web. P. C. 125.

(*g*) 5 H. & N. 336.

public knowledge, if anyone else discovers that invention it is new, that is to say, new in the sense that the first invention has not been published.”

There is another description of anticipation which is capable of invalidating a patent besides that of public use, and that is **prior publication**. Prior publication means the printing, writing or publishing of some document to which the public have access, containing such a description of the invention as will enable a practical man to carry it out from the description given. Vague hints or descriptions of experiments, incomplete, or imperfect, are not sufficient to invalidate a subsequent patent. It is not necessary that that which is described in the book or publication should have been carried out in practice, it equally anticipates the patent (*h*). The question will always be one of fact, depending on the circumstances of each particular case, and the point which should be left to the consideration of the jury is, whether upon the whole evidence there has been such a publication as to make the description part of the public stock of information (*i*).

It is necessary that the description in the publication which is relied upon as evidence of prior publication, should be such as will when carried out produce the patented article; otherwise, however similar the description may be, if it will not produce the alleged invention it will not amount to anticipation (*j*).

Vice-Chancellor Wood, in *Betts v. Menzies* (*k*), said, “I think that if a man sits down and takes out a patent from his own conjectures without ever having tried the experiments set forth in it, that will not invalidate a subsequent patent taken out and practically

(*h*) See *The Househill Company v. Neilson* in the House of Lords, 1 Web. P. C. 718, n.

(*i*) *Stead v. Williams*, 2 Web.

P. C. 142.

(*j*) *Muntz v. Foster*, 2 Web. P. C. 94.

(*k*) 3 Jur. N. S. 358.

worked, especially when it turns out that the method prescribed by the earlier patent is practically useless." This remark of the learned Vice-Chancellor indicates how difficult a thing it is to lay down a general rule which shall bind every case, indeed no such general rule has ever been framed. It is evident that if a man were to describe an invention in a book or in a specification, and describe it so minutely and accurately that any practical person could from the description produce the invented matter, it would be immaterial whether the writer had tried experiments or had ascertained whether his invention would work in practice or not. If it should afterwards turn out to work in practice, and work as described, without any further inventive power and without any further invention being necessary, the description in the book or specification would be sufficient to invalidate any subsequent patent for the same invention.

In *Betts v. Menzies* (*ante*) the Vice-Chancellor had before him a case where the method described in the earlier publication was practically useless. In that event there is no doubt that the description would not invalidate a subsequent patent, because further invention would be necessary to bring the matter to a successful issue.

When *Betts v. Menzies* (*l*) came before the House of Lords, Lord Westbury said: "To defeat a new patent, it must be clear that the antecedent specification disclosed a practical mode of producing the result which was the object and effect of the subsequent discovery; a barren general description therefore, though containing some **suggestive information** or involving some **speculative theory**, could not be treated as avoiding for want of novelty a subsequent specification or invention, unless it was ascertained that the antecedent publication involved

(*l*) 10 H. L. C. 117. See also *Stoner v. Todd*, L. R., 4 Ch. D. 58.

the same amount of **useful information.**" In the same case the opinion of the judges having been taken by the House of Lords as to whether the Court could pronounce Betts' patent to be void simply on the comparison of two specifications without evidence to prove identity of invention, and also without evidence that Dobbs' specification disclosed a practical mode of producing the result, or some part of the result described in Betts' patent; Mr. Justice Blackburn, subsequently Lord Blackburn, gave it as his opinion, "that to avoid a patent on the ground of want of novelty, it is necessary to show that part of what the patentee claimed as a new invention was at the date of the patent already a publicly-known invention; this may be shown by proving that the invention was already disclosed in a publication accessible to the public it is not necessary to show that the invention thus made publicly known had already been put in actual use as soon as it has been ascertained that the description in the book makes known an invention, that is to say, that it adds to the public stock of knowledge what would without any further discovery enable a person to produce a result in the nature of a new manufacture. If Dobbs had made it part of the public knowledge how to produce a new material as a practical result, and Betts had afterwards claimed to have a patent for, amongst other things, producing that result, he would have claimed that which was not new, and if Dobbs had not made it part of the public knowledge how to produce the result, then Betts would not have claimed anything already known. The Court cannot tell without evidence whether what Dobbs disclosed would produce a result, and, therefore, as it seems to me, cannot pronounce the first patent void without evidence. I therefore answer your lordships' question in the negative" (*m*).

(*m*) See also *Betts v. Neilson* 429; *Neilson v. Betts*, L. R., 5 H. and *Betts v. de Vitre*, L. R., 3 Ch. L. 1.

The cases which have been decided have generally been upon the subject of antecedent publication by means of a **specification**, but it is evident that the publication of a **book** or **newspaper**, or in any other form which gives the public a means of information, is equally potent as an anticipation of a subsequent patent (*n*). *Hills v. London Gas Light Company* (*o*) illustrates very clearly the principle laid down by Lord Westbury in *Betts v. Menzies*. The plaintiff obtained a patent for the employment of hydrated oxide of iron in purifying coal gas. A specification was put in evidence as published some ten years prior to the plaintiff's patent by one Croll, in which he said that coal gas could be purified by using the oxide of manganese, the oxide of zinc, or the oxide of iron. Now there are two descriptions of oxide of iron, hydrated and anhydrous. Anhydrous oxides of iron will not purify coal gas. It was held, therefore, that inasmuch as further experiments were required to discover that the action of hydrated oxide of iron was different from that of anhydrous oxide of iron in the purification of coal gas, that the antecedent specification did not anticipate the plaintiff's specification.

In *Hills v. Evans* (*p*) Lord Westbury said: "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments."

It is not necessary that the book containing the description of the invention should be sold so as to constitute an anticipation. Mere exhibition in a book-

(*n*) *Young v. Fernie*, 12 W. R. 901; *Plimpton v. Spiller*, L. R., 6 Ch. D. 412; also *Patterson v. Gas Light and Coke Co.*, L. R., 3 App. Cas. 239, *United Telephone Co. v.*

Harrison, Cox, Walker & Co., L. R., 21 Ch. D. 720.

(*o*) 29 L. J., Ex. 409.

(*p*) 31 L. J., Ch. 463.

seller's window for sale is sufficient publication, or sending it to a bookseller's in this country to be published. "There is no difference between a foreign inventor and an English one if, when the inventor is a foreigner, he publishes the book in a foreign language and sends it over to the booksellers in this country for the purpose of being sold" (*q*). Prior publication in a foreign journal and in a foreign language will invalidate an English patent if it can be shown that a single copy was deposited in England in a public place, and was open to public inspection (*r*).

An inventor may invalidate his own invention by previous publication in a specification. For instance, if an inventor applies for letters patent and files a specification, and after the publication of the specification abandons it and begins again applying for letters patent for the same invention, the previous publication of the specification will invalidate a subsequent patent. Prior to the Act of 1883, it would have been otherwise if he made his application for a second patent prior to the expiration of the period of provisional protection for the first invention, and therefore before the first specification had been published, provided that he had not in the meantime published his own invention (*s*).

The secret manufacture and sale by the inventor himself of a subsequently-patented article prior to the date of the patent, would of itself constitute an anticipation of the invention. This branch of the subject is surrounded with considerable difficulty, for bearing in mind that the consideration which the inventor gives for the patent is the information which he is in a position to give to the world, it is difficult to under-

(*q*) Per M. R. in *Lang v. Gisborne*, 31 Bovan, 135. L. R., 21 Ch. D. 720.

(*s*) *Oxley v. Holden*, 30 L. J.,

(*r*) *United Telephone Co. v. Harrison, Cox, Walker & Co.*, C. P. 68.

stand upon what principle, if he keeps that information to himself and manufactures an article which of itself does not disclose his invention, he should not have a patent; since he is always in a position to give the information to the public, and to give a valid consideration for the grant. Unless indeed we regard the grant of letters patent, as not only the result of a contract between two parties, the state and the inventor, but also as somewhat after the nature of a reward for invention, which is only given for merit. There is, as we have pointed out before, no merit in publishing an invention which you find it difficult to keep any longer secret. Of course it would be otherwise where the article itself, by its appearance or by its properties, discloses the invention; the Courts, in their decisions, seem to have recognized the difficulty of this question. Baron Parke, in *Morgan v. Seaward* (t), said: "For if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a very much longer period than fourteen years." It does not seem to have been expressly decided that if an article sold did not disclose the invention, the use of the invention, if kept secret, would invalidate a subsequent patent by the inventor. Baron Parke seems to have thought that it would; on the other hand, if the original inventor manufactured articles, but kept the invention secret so that no one else could practise it, and someone else were to re-invent the same matter subsequently, can it be said that the secret use of the invention by the first inventor would invalidate the patent of the second inventor? and if not the patent of the second inventor, why, upon principle, should one person from whom the consideration would move personally be in a worse position than another? It may be said, perhaps, that the

(t) 2 M. & W. 544.

common law contemplated *bona fides* on the part of the inventor, and a *bonâ fide* discovery of the invention to the public within a reasonable time, and that the working of the invention in secret and subsequent application for the patent was strong evidence of *mala fides*, and consequently would avoid the patent on the ground of a constructive fraud upon the public (*u*).

Mere **experiments** with a view to discovery have been frequently held not to invalidate a subsequent patent; few inventions could be made without trial, and there are some things of such magnitude that the trials cannot practically be conducted in private: hence it has been held that the mere making of experiments, with a view to invention, does not invalidate a patent (*x*).

Not only must the invention be new, but **the whole of the invention** which is claimed in the specification **must be new** (*y*); and if any material part of it can be shown to have been anticipated, there would be a valid objection to the patent, and an action for infringement, even of the parts that are new, would not be maintainable.

We shall show hereafter that the claiming of too much in a specification, that is to say, the claiming of things which are not new, is not incurable, but that it operates in such a way as to prevent the inventor from

(*u*) As to publication by sale see *Wood v. Zimmer*, 1 Web. P. C. 44; *Losh v. Hague*, 1 Web. P. C. 205; *Gibson v. Brand*, 1 Web. P. C. 628; *Carpenter v. Smith*, 1 Web. P. C. 536; *Mullins v. Hart*, 5 Car. & K. 297; *Heath v. Smith*, 2 Web. P. C. 268; *Honiball v. Bloomer*, 2 Web. P. C. 200; *Oxley v. Holden*, 8 C. B. N. S. 666.

(*x*) *Newall v. Elliott*, 4 C. B., N. S. 269; *Hills v. London Gas*

Light Company, 29 L. J. Ex. 409. See also *Jones v. Pearce*, 1 Web. P. C. 122; *Bramah v. Hardcastle*, Holroyd, 81; *Cornish v. Keene*, 1 Web. P. C. 508; *Galloway v. Bleaden*, 1 Web. P. C. 525; *Stead v. Williams*, 2 Web. P. C. 135; *Househill Company v. Neilson*, 1 Web. P. C. 673.

(*y*) *Plimpton v. Spiller*, L. R. 6 Ch. D. 412, & per Jessel, M. R. in *Frearson v. Loe*, L. R. 9 Ch. D. 58.

successfully maintaining an action against an infringer until he has taken the proper steps to obtain a disclaimer of the tainted portion, so to speak, of his specification. In *Bramah v. Hurdcastle* (z) Kenyon, J., said: "Unlearned men look at the specification, and suppose everything new that is there; if the whole be not new, it is hanging terrors over them." In *Hill v. Thompson* (a), per Dallas, J., "If any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." In *Brunton v. Hawkes* (b) Abbott, C. J., said: "I feel myself compelled to say that I think so much of the plaintiff's invention, as respects the anchor, is not new, and that the whole patent is therefore void." A process incidental to the manufacture, which is not one of the substantial elements of the claim, will not invalidate a patent (c).

A description of two processes, one of which is old, and the other new, a claim of the combination of the two would be valid for the combination; but if the claim is not for the combination, but for the two processes, then the patent is void (d).

When a part of a described invention is old, the question will always arise as to whether the claim is for the several parts as described, or for the combination. We shall treat this subject at length when we deal with the specification.

We now come to the consideration of the question of **utility**, for not only must the invention be new, but it must be new and useful. The 6th section of the Statute of Monopolies does not refer to the necessity of utility in the invention, but saving, as it does, the common law

(z) 1 Carp. P. C. 168.

(a) 1 Web. P. C. 249.

(b) 4 B. & Ald. 541.

(c) *Muntz v. Foster*, 2 Web. P.

C. 112.

(d) *Templeton v. Macfarlane*, 1

H. L. C. 595; *McCormick v. Gray*,

5 H. & N. 25.

prerogative of the Crown in respect of inventions, it refers us back to what had previously been held to be the necessary elements of an invention. In *Darcy v. Allin (e)*, decided in 1602, it was held, the invention must tend to the furtherance of trade, and be for the good of the realm, and that the monopoly was granted in consideration of the good that the inventor doth bring by his invention to the commonwealth, otherwise not. Consequently an essential element of a valid grant is, that it should be for something which is for the good of the realm, that is, it must be useful (*f*).

In *Boulton v. Bull (g)*, Rooke, J., said: "The public have a right to receive a meritorious consideration in return for the protection granted." In the same case, Buller, J., said: "The invention professes to lessen the consumption of steam, and to make the patent good the method must be capable of lessening the consumption to such an extent as to make the invention useful." And in the case of *The King v. Arkwright (h)*, the same judge, in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for if it appears, as some of the witnesses say, to do as well without the stripes, and to answer the same purpose if you suppose the stripes never to have been used before, that is not such an invention as will support the patent."

It will always be a question for the consideration of the jury, whether the invention is useful, that is, whether that which is new is a sufficient advance or improvement upon what was already known by the public as to add to a material extent to the public stock of knowledge. It does not mean that there must necessarily be a great deal

(e) Noy, R. 182.

Web. P. C. 80.

(f) *Edgebury v. Stephens*, 1
Web. P. C. 35; *R. v. Arkwright*, 1
Web. P. C. 72; *Turner v. Winter*, 1

(g) 2 H. Bl. 478.

(h) 1 Web. P. C. 72.

of invention, or an extensive operation, to support the patent, but that the invention when carried out in some way materially improves the process of manufacture, either by cheapening the article produced, or by improving its quality, or by improving the method of producing, or the uses to which it can be put.

Each of the cases which have been decided upon the question of utility deal, and necessarily must deal, with an independent state of facts, and consequently, no case can be said to be an authority for another case; but they go to show the general principle that "utility" means a **substantial improvement**, and not necessarily an **extensive process**; for instance, a man might invent a large and complicated machine for the manufacture of boots, which, when completed, would do nothing which was not done before, and would not make them any quicker or any cheaper than they were made before. Such a machine would not form the subject of a patent. On the other hand, a man might discover a new needle for stitching boots, which would economise half-an-hour in the manufacture of each boot; such a needle would be the subject of a patent, although the whole improvement might consist of a bend.

In *Crane v. Price*, Tindal, C. J., said: "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 by some sudden or lucky thought, or mere accident of discovery" (i).

We have seen that the invention must be *new* in every part. It is not, however, necessary that it should be *useful* in every part. Provided always, that useless parts have not been added to the specification for the purpose of deception, or of misleading the public as to what the real nature of the invention is, and how it is

(i) *Crane v. Price*, 1 Web. P. C. at p. 411.

to be performed (*k*). The invention further need not be useful for every purpose to which it can be applied, provided it be useful for some purpose to which it can be applied (*l*).

In *Frearson v. Loc* (*m*), Sir George Jessel said: "It is not because a patentee has attempted to claim as an advantage something else to which he is not entitled that the improvement he has made is to be held not worthy of a patent. I am not to say that because even half the advantages said to arise from his invention may not be new he is not to be protected in respect of the other half." It will be observed that in this case the Master of the Rolls does not refer to the novelty of the invention claimed, but to the novelty of the advantages. A large number of patents which are applied for are intitled "improvements in the manufacture of ———," and sometimes it has been considered that when that which is claimed is really no substantial improvement at all, the patent is bad for a false suggestion" (*n*).

It is always a question for the jury whether the invention be useful or not (*o*).

In *Plimpton v. Malcolmson* (*p*), Sir George Jessel said: "The cases cited may be rather used as illustrations of what will amount to sufficient evidence than as deciding anything in principle beyond this, that it must be sufficiently known." This would apply to the utility issue as well as that of novelty. In such matters cases merely offer illustrations, and cannot be said to lay down any rigid principles of law.

(*k*) *Lewis v. Marling*, 1 Web. P. C. 496.

(*l*) *Haworth v. Hardcastle*, 1 Web. P. C. 483.

(*m*) L. R., 9 Ch. D. 64.

(*n*) In the case of *Losh v. Hague*,

1 Web. P. C. 202.

(*o*) *Hill v. Thompson*, 1 Web.

P. C. 237; *Bloxham v. Elsee*, 1 C.

&P. 565; *Cornish v. Keene*, 1 Web.

P. C. 506.

(*p*) L. R., 3 Ch. D. 557.

CHAPTER IV.

THE CONSIDERATION (*continued*)—THE SPECIFICATION.

THE third condition which supports a consideration for a valid patent, is that the patentee must publish his invention, that is to say, that in the specification which he files, and which forms the basis of the description of the subject-matter of his patent, he must give such an account of his invention, of the way of working it, and of what he particularly claims, as to enable an ordinary skilled person to carry out the invention without further assistance or discovery. By the 5th section of the Act of 1883, it is provided:—

“(1) The application for a patent must be made in the form set forth in the first schedule of this Act, or in such other form as may be from time to time prescribed, and must be left at or sent by post to the Patent Office in the prescribed manner.

“(2) An application must contain a declaration to the effect that the applicant is in possession of an invention whereof he, or in the case of a joint application, one or more of the applicants claims or claim, to be the true and first inventor or inventors, and for which he or they desires or desire, to obtain a patent; and must be accompanied by either a provisional or complete specification.

“(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings if required.

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

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

Sect. 6 of the same Act vests in an examiner the duty of reporting to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

Sect. 7 provides for the report of the examiner, and for an appeal from the decision of the comptroller should he refuse the application, to the law officer, who may affirm, reverse or vary the decision of the comptroller. By sect. 8 (1), “If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.” (2) “Unless the complete specification is left within that time, the application shall be deemed to be abandoned.” By sect. 9, “Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner, for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.” Sub-sect. 2 provides for the refusal of the complete specification by the comptroller upon an adverse report of the examiner; and sub-sect. 3 gives the machinery for appealing to the law

officer; by sect. 10, "On the acceptance of a complete specification, the comptroller shall advertise the acceptance, and the application and specification or specifications with the drawings (if any), and shall be open to public inspection." By sect. 18, sub-sect. 1, "An applicant or patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of such amendment, and his reasons for the same." Sub-sects. 2, 3, 4, 5, 5, 7, 8 and 9, deal with the practice to be observed upon amendment, to which we shall refer hereafter; and sub-sect. 10 enacts that "the foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending."

Such are the provisions of the new Act in respect of the requirements of the specification. It leaves the law respecting the necessary disclosures to be made in the specification very much as it was before; and the changes which are made are more changes of practice than anything else.

The specification is the means which is provided by the state, whereby a patentee publishes his invention, that is, dedicates it to the public. We have observed that two descriptions of specifications are provided for, one called "provisional," and the other "complete;" the applicant for letters patent may, if he so pleases, in the first instance, file a complete specification, or he may file a specification which, for want of a better word, has been described as provisional; subsequently, and within the prescribed time, filing a complete specification, which particularly describes and ascertains his invention. It is only necessary, however, that the provisional specification should describe the nature of the invention; and although it is not absolutely necessary that full details

should be given as to the method of working the invention, care should be taken to ascertain to what extent and in what direction the invention goes.

There are three things, in the specification, which must agree with each other—the title, the provisional specification, and the complete specification.

THE TITLE.

The title of the specification must disclose the object of the invention (*a*).

The title is a part of the specification, and should be read into it so that it may limit the patentee's claim, which otherwise would be too large (*b*).

In the case of *Rex v. Else* (*c*), the title of the patent was held to contain the claim, there being no other claim.

It has frequently been held that the **title must not go too far**; for instance, a man who had invented a new street lamp, and described his invention in the title as being "a method or methods of more completely lighting cities, towns and villages," was held to have vitiated his patent by going too far in his title. His claim should have been for a new or improved street lamp (*d*). So care must be taken that an improvement in buttons, for instance, is not described as an improvement in the manufacture of buttons; if the improvement is in the article, it must be so stated, and if in the process, likewise. In *Campion v. Benyon* (*e*), the title was a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, without any starch whatever; the title, therefore, described an invention, the novelty and utility of which

(*a*) *Househill Co. v. Neilson*,
1 Web. P. C. 678.

(*b*) *Newton v. Vaucher*, 21 L. J.,
Ex. 308.

(*c*) 1 Web. P. C. 76.

(*d*) *Cochrane v. Smethurst*,
Davy's P. C. 354.

(*e*) 6 B. Mo. 71.

was to omit the use of starch, but upon reading the specification we find that the real invention was an improved mode of twisting the threads to be applied to the making of unstarched cloth, the patent was held bad. In the case of *Bloxam v. Elsee* (*f*), the title for the invention was for a machine for 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. It was found that to vary the width of the paper it was necessary to have a different machine, and that consequently the title did not **correspond with the invention**, and the title was held bad. In *Felton v. Greaves* (*g*), the title was “a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments.” The machine would not sharpen scissors:—Held bad. These cases seem to have been decided upon the ground that an incorrect or too extensive title is evidence of fraud upon the Crown. For instance, in *Brunton v. Hawkes* (*h*), Best, J., said, “that the patent was taken out for more than the patentee was entitled to, that, in my opinion, avoids the patent *in toto*, for the king is deceived.” In *Cook v. Pearce* (*i*), however, Tindal, C. J., in the Exchequer Chamber, said: “This was an action on the case against the defendant for the infringement of a patent taken out by the plaintiff for improvements in carriages. The 6th plea, after setting out the specification, averred that ‘although the said alleged invention in the declaration of letters patent respectively mentioned is therein styled and described as improvements in carriages, yet the said invention in truth, and in fact, is not an invention of improvements of carriages generally, but certain alleged improvements in the fixing and adapting of German shutters in those carriages only in which German

(*f*) 6 B. & C. 169.

(*g*) 3 C. & P. 611.

(*h*) 4 B. & Ald. 552.

(*i*) 8 Q. B. 1054.

shutters are used, and that German shutters cannot be used in divers and very many carriages, to wit, coaches, &c.,' and so the defendants say that the title of the said invention is too large and general, and by reason thereof the said letters patent are void and of no force. It has been observed that the decision (in the Court below) does not proceed upon the ground that the title of this patent must be held of necessity to claim more than the invention as explained by the specification, as if the title had been 'an invention and improvement of *all* carriages,' and the specification had limited the invention to the improvement of one or more species of carriages only, or if the title had been for the invention of two things, and the specification had shown it to be an invention of one only out of the two; in such cases it may be readily admitted that the patent would be void, in the first, because there was no specification enrolled agreeing with the title, and in the second, upon the principle laid down by Mr. Justice Bayley, in his judgment in *Brunton v. Hawkes*: 'that the entire discovery of all the things for which the patent was taken out may be held to be the consideration upon the patent which was granted by the Crown;' but such an objection would not apply to the case now before us, for the words 'improvements in carriages' do not necessarily imply in all carriages, but in their ordinary use may well be held to be satisfied by an invention for improvements in some carriages only, but the ground of the decision is as before stated confined to the vagueness and generality of the title, and to that only. Now the mere vagueness of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground to avoid 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 payment with such title, the patent in those cases might undoubtedly be held void. We think it would be unsafe to lay down the rule in terms so large as it appears to have been adopted by the Court below, for that it would endanger the validity of very many patents which had hitherto been free from exception, if every patent must be held to be void simply on the ground that its title was conceived in such terms as to be capable of comprising some other invention besides that contained in the specification in the absence at the same time of any proof of an intention to commit any fraud upon the Crown, or of deceiving or misleading the public" (*k*). It will be seen, therefore, that although **variance** between the title and the specification is held to vitiate the patent as in *Felton v. Greaves*, that mere excess and generality in the title will not vitiate the patent in the absence of any evidence of fraud upon the Crown (*l*).

In *Neilson v. Harford* (*m*), Abinger, C. B., said, "If the specification is **consistent** with the title, that would be sufficient;" and Baron Parke said, "The title of the patent is for the improved application of air, though that is ambiguous. It is sufficiently explained by the specification, and is not at variance with it."

It is evident that the question of **variance** between the title and the specification is one upon which the decided cases can have no bearing. All that can be gleaned from previous decisions of the Courts is that variance is a fatal blemish; but in the immense variety of inventions it is evident that the same variance will never occur in any two cases, and it will be a question for the Court in each

(*k*) This decision was followed in *Crossley v. Potter* by Pollock, C. B. See Macr. P. C. 242.

(*l*) *Sturtz v. De la Rue*, 5 Russ.

322; *Morgun v. Seaward*, 1 Web. P. C. 196; *Stead v. Williams*, 2 Web. P. C. 137.

(*m*) 1 Web. P. C. 331.

individual case that comes before it to decide whether, in that case, the specification and the title vary or differ from each other; and although the decided authorities will be of assistance to the Court in showing to what extent variance has been held in prior cases to vitiate the patent, it is evident that no prior decision will be absolutely binding (*n*).

THE PROVISIONAL SPECIFICATION.

It was found that application for letters patent, being made merely upon the title of an invention, caused a great deal of inconvenience and uncertainty, therefore by the Patent Law Amendment Act, 1852, the provisional specification was created. Prior to the passing of that Act applicants for letters patent, when they made their application, merely deposited the title of their invention. By sect. 6 of that Act a provisional specification was required, which should give some more definite information as to the nature of the invention for which protection was sought than could be possibly given in a mere title.

It is very difficult to clearly define the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification.

Sect. 8 of the Act of 1852, to which we have referred, says that "the law officer must be satisfied that the provisional specification describes the nature of the invention," and we have seen that the exact words of that section are retained in sub-sect. 3 of sect. 5 of the Act of 1883; and probably the legislature had in view the desirability of retaining the effect of the numerous valuable decisions of the Courts of law upon the construction

(*n*) *Bainbridge v. Wigley*, Higgins' Digest, 155; *Hill v. Thompson*, 1 Web. P. C. 239; *Nickels v. Haslam*, 13 L. J., C. P. 146; *Croll v. Edge*, 9 C. B. 479; *Wright v. Hitchcock*, L. R. 5 Ex. 37.

which should be placed upon what is a sufficient description of the nature of an invention. It will be observed that the complete specification to which we shall refer at greater length hereafter must not only describe the nature of the invention, but must also *ascertain* the nature of the invention and in what manner it is to be performed; but both a provisional specification and a complete specification must commence with a title, and the complete specification must conclude with a distinct statement of the invention claimed.

The cases which we have quoted, and which were decided prior to the year 1852, as to the fatal nature of a variation between the title and the specification, will apply equally to the consideration of a variance between a provisional and a complete specification. It is evident, however, that the object of the legislature in creating a provisional specification, and founding upon it a period of provisional protection, was to enable the inventor in that interval to improve and perfect his invention, and to clearly ascertain what was new, and what was old, in that which he proposed to patent. That being so, it is obvious that it could not have been the intention of the legislature that, when framing a complete specification the inventor should be bound to follow implicitly every detail which he had given in his provisional specification, or that he should be prevented from adding to or subtracting from his invention: for, in that case, the object of the legislature would be defeated.

In *Newall v. Elliott* (*m*) Pollock, C. B., said: "The object of the statute which requires a provisional specification is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for a patent, to give some notion of what his invention is; that has been followed by Act of Parliament, requiring it to be done; but the object in both

(*m*) 10 Jur., N. S. 955.

cases is to ascertain the identity of the invention, and make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance I have no doubt that the object of the Act of Parliament was not to ascertain the **entirety** of the invention, but the **identity** of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." Mr. Baron Channell in the same case, at p. 960, describes a provisional specification as a "short note or minute of that which was ultimately disclosed in the full specification." It will be observed that in the cases to which we drew attention upon the subject of variance between title and specification, the point always was as to whether the title and the specification varied in the description of the **nature** of the invention; and the same principle holds good when considering the variation between the provisional and complete specification, the question always is, Do they differ in their description of the nature of the invention? In *Newall v. Elliott* (*n*) Mr. Justice Byles said: "The office of the provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out" (*o*).

Lord Chelmsford, in *Penn v. Bibby* (*p*), said: "The relation which the provisional specification bears to the complete specification is much the same as that which before the Patent Law Amendment Act a title bore to the specification the only objection then which is open upon the complete specification, is whether

(*n*) 4 C. B., N. S. 269.

R. 723.

(*o*) *Foxwell v. Bostock*, 12 W.

(*p*) L. R., 2 Ch. Ap. C. 127.

it is sufficient in itself, and whether it agrees with the provisional specification. Now, by agreement is not meant a perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional." The learned Lord Chancellor then proceeds to quote *Newall's case*, to which we have referred, and proceeds: "Nor is it at all necessary that the specification should extend to everything comprehended in the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now if he would be allowed to disclaim in such a case, which is a matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand. It is clear, therefore, that unless a complete specification in this case claims something *different* from the provisional specification, the objection to the patent under consideration cannot prevail."

In the absence of fraud, any part, whether in the description or the claim of the provisional specification, may be omitted in the complete specification without the necessity of any disclaimer (*r*). In *Stoner v. Todd (s)*, Jessel, M. R., said: "I must consider first the nature of a provisional specification, and the effect of a provisional specification on a final specification of

(*r*) *Thomas v. Welch*, L. R., 1 C. P. 192. See also the remarks of Lord Chelmsford in *Penn v. Bibby*, quoted above.
 (*s*) L. R., 4 Ch. D. 58.

the same invention. A provisional specification was never intended to be more than a mode of protecting an inventor; until the time of filing a final specification, it was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly no doubt, but in its rough state, until the inventor could perfect its details, the provisional specification as such is not and cannot be known to the public. It is never published unless with the final specification, when they become parts of the same document."

In the case of *Bailey v. Robertson*(*t*), decided in the House of Lords, the provisional specification stated the object of the invention to be the preserving of animal substances in the fresh state, and the patentees claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphite of lime, but in the complete specification they claimed as solution No. 1 a solution composed of bisulphite of lime alone, and gave no direction how this solution was to be used. Bisulphite of lime had been used by a prior patentee. In the action for infringement against the defendants who had used bisulphite of lime pure and simple, it was held that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than and different from that disclosed in the provisional specification. It will be observed that in this case the invention, which was described in the provisional specification, was the coating of animal substances with a film of a mixture of gelatine and bisulphite of lime; the complete specification claimed the dipping of the animal substance into a solution of bisulphite of lime in water; it is apparent, therefore, to anyone acquainted with the

(*t*) L. R., 3 Ap. C. 1055.

action of antiseptic substances upon animal decomposition, that the operation of a film of gelatine with bisulphite of lime is entirely different from the operation of a solution of bisulphite of lime; it is a totally different idea, and therefore a different invention; the complete specification, therefore, was not an extension, curtailment or modification of the provisional specification, but was a description of a totally different invention, and so it was held bad for variance.

Thus we see that the provisional specification is a mere extension of the title; but since variance between the title and the specification vitiated the patent before the inauguration of the provisional specification, variance between the provisional and complete specification also vitiates a patent; but it is quite open to a patentee to extend, improve or curtail the claim which he has made in his provisional specification when he comes to file his complete specification.

THE COMPLETE SPECIFICATION.

We now come to the more important subject of the requirements of a complete specification. The complete specification is, as we have seen, one of the essential considerations which the patentee gives for the grant which is made to him. **It is the disclosure of his invention**, and of the mode of performing it. It contains the information which he is bound to give to the public. That information must be *bonâ fide*, full, complete, and unambiguous; it must disclose the invention, the nature of it, the intention of it, the way of performing it, and an exact statement of what is claimed by the patentee.

These conditions are imposed by the common law; they were maintained intact by the Statute of Monopolies, by the Patent Law Amendment Act, 1852, and are now specifically re-enacted in the Act of 1883.

The specification must be **sufficient**—that is, it must

give a sufficient description of the invention to enable a person skilled in the art to which it refers to perform the invention from the description which it gives. It must be *bonâ fide*—there must be no reserve on the part of the inventor. He must disclose what he knows; he must conceal nothing, and thus he must give to the public the full benefit of his invention. In *Harmar v. Playne*(*u*), Lord Ellenborough said:—“The object of requiring the specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell from an inspection of the specification itself what the invention was for which the patent was granted, and how it was to be executed.” In *Morgan v. Seaward* (*x*), Mr. Baron Alderson said:—“The patentee ought to state in his specification the precise way of doing it (referring to the invention); if it cannot completely be done by following the specification, then a person will not infringe the patent by doing it. If this were an infringement it would be an infringement to do that perfectly, which, according to the specification, requires something else to be done to make it perfect. If that be correct, you would prevent a man from having a perfect engine. He says, practically speaking, the difference in the length of the rods would not be very material, the difference being small. But the whole question is small, therefore it ought to have been specified, and if it could not be ascertained fully it should have been so stated.” We quote this decision at length, because the exposition of the law which it contains is still absolutely correct. The subsequent cases to which we purpose to draw attention have implicitly followed the judgment of Mr. Baron Alderson (*y*).

The specification is a portion of the patent (*z*).

(*u*) Dav. P. C. 316.

(*z*) *Hornblower v. Boulton*, 8 T.

(*x*) 1 Web. P. C. at p. 182.

R. 95; *Crossley v. Beverley*, 9 B.

(*y*) *Neilson v. Thompson*, 1 & C. 62.

Web. R. 278.

In the case of *The King v. Arkwright* (a), Mr. Justice Buller said, "The public have a right to a fair, full, and true description of the invention in the specification."

It is incumbent on a patentee to give a specification of his invention in the fairest and most unequivocal terms of which the subject is capable (b). In the same case, Mr. Justice Buller said:—"Many cases upon patents have arisen within our memory, most of which have been decided against the patentees upon the ground of their not having made a full and fair discovery of their inventions. Whenever it appears that the patentee has made a fair disclosure I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him." In *Newbery v. James* (c), Lord Eldon said:—"In order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it was granted was at an end."

We have next to consider the bearing of the different decisions upon the question of what amounts to **sufficiency** in a specification. It is always a question of fact whether the specification is sufficient or not, taking care to distinguish between sufficiency of description and an attempt to cover too much—it is for the jury to say whether from the description given the invention could be carried out. It is for the Court to determine whether the inventor has claimed that which is not new among that which is new (d). The question of the sufficiency of the specification is a question for the jury (e).

(a) Dav. P. C. 61.

626.

(b) Per Mr. Justice Ashurst, in *Turner v. Winter*, Dav. P. C. 151.

(e) *Bickford v. Skewes*, 1 Q. B. 938; *Wallington v. Dale*, 7 Exch. 888; *Parkes v. Stephens*, L. R., 8

(c) 2 Mer. 451.

Eq. 358.

(d) *Hill v. Thompson*, 3 Mer.

The **intelligibility** of the specification is a question for the jury (*f*). The **construction** of the specification is in the same manner as the construction of all documents—a question of law. The duty of the judge at *Nisi Prius* is to **tell the jury** the specification says so-and-so, placing a meaning upon the different words used and the different sentences used in the specification. It is then for the jury to say it is intelligible or it is not, it is sufficient or it is not sufficient, but the Court will determine in all cases whether or not the patent is defective by reason of the patentee having endeavoured to describe or to claim too much (*g*).

We will deal with these different heads in their natural order, first, as to **construction**, next as to intelligibility, and then as to sufficiency. The object of the Courts is not to defeat patents. In *Hullett v. Hague* (*h*), Lord Tenterden said:—"I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat, and not to sustain, them." The patentee is to be presumed not to claim things which he must have known to be in use (*i*).

The leaning of the Courts is invariably in favour of the patentee, and specifications will **not** be construed **astutely** so as to overthrow a patent. Sir George Jessel, in the case of *Hinks v. The Safety Lighting Co.* (*j*), said: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on mere cavillings

(*f*) *Neilson v. Harford*, 1 Web. P. C. 295.

(*g*) *Hill v. Thompson*, 3 Mer. 626; *Beard v. Egerton*, 19 L. J., C. P. 38.

(*h*) 2 B. & Ad. 377.

(*i*) *Haworth v. Hardcastle*, 1 Web. P. C. 484.

(*j*) L. R., 4 Ch. D. 612.

with the language of their specifications, so as to deprive the inventor of the benefit of his invention; that is sometimes called a benevolent mode of construction, perhaps that is not the best term to use, but it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." And the same judge, in *Plimpton v. Spiller*(*k*), adopted the remark that "the judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it."

Lord Chelmsford, in *Harrison v. Anderston Foundry Co.*(*l*), said, "the language should be construed according to its ordinary meaning, the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention, and if the specification is thus sufficiently intelligible it performs all that is required of it." In *Clark v. Adie*(*m*) it was held that the words used in the specification must be construed like the words in any other instrument, in their natural sense, according to the general purpose of the instrument in which they are found.

The title of a specification and the specification itself is one document, and an ambiguity in the specification must be construed by the light which is thrown upon it by the title(*n*). In the case of *Unwin v. Heath*(*o*), in the course of an opinion given by the judges to the House of Lords, Mr. Justice Crompton said, "I think it will be a narrow and a dangerous construction to limit the

(*k*) L. R., 6 Ch. D. 422.

(*l*) L. R., 1 Ap. C. 581.

(*m*) L. R., 2 Ap. C. 423; *Dudgeon v. Thompson*, L. R., 3 App. Cas. 53; *Wegmann v. Corcoran*,

L. R., 13 Ch. D. 77.

(*n*) *Newton v. Vaucher*, 6 Exch. 864.

(*o*) 25 L. J., C. P. 8.

invention claimed in express words by the mode and process of working which the plaintiff sets forth as a means of carrying his invention into effect.”

The claims in specifications frequently claim the invention in a general manner with the words added “as herein described.” It has been held that the meaning of the words “as herein described” is not limited where the invention is for a mode of construction or manufacture, and not for a particular method of carrying out the principle which is described in the specification. In *Betts v. Menzies* (*p*) Mr. Justice Blackburn, giving his opinion to the House of Lords, said, “I agree with what was said by Mr. Justice Crompton in the Court below that, if a general claim for the use of an invention were cut down and limited to the use of the invention in the particular way pointed out by reason of the words ‘as herein described,’ it will be a narrow rule of construction, generally working to the detriment of patentees, and, what weighs more with me, generally giving an effect to specifications different from what the persons drawing them intended or those reading them understand.”

In the case of *Unwin v. Heath* (*supra*), Mr. Justice Williams said, “but if the invention described and claimed by the patentee in this case is not the particular process specified, but the employment of carburet of manganese in the process of the conversion of iron into steel, and if the description of the process in the specification, instead of being a description of the invention, is only one mode of carrying the invention into effect, an entirely different doctrine becomes applicable to the question, viz., that *if the patent is taken out for the application of a principle coupled with the mode of carrying the principle into effect the patentee is entitled to protection from all other modes of doing so, whether known or not known at the time of the specification.*”

(*p*) 10 H. L. C. 140.

There are numerous authorities which bear out the general rule of construction which has been laid down, viz., that a specification of an invention must be construed by the same rules and upon the same principles that are applied to other written documents, and if, on the one hand, minute cavilling at the words of a specification is not to be allowed as against a patentee, so, on the other hand, the interpretation must not be strained in favour of a patentee. Lord Westbury, in *Simpson v. Holliday* (*p*), said:—"It was contended before me, and the Vice-Chancellor is reported to have said, that it has been settled by authority that the most liberal construction is to be given to the patent that will sustain it. . . . I am not aware of any such authority."

A patent may be, as we have seen, for the application of a newly-discovered principle of manufacture or, for that of an old principle to a new object or, for a new method of carrying out an old principle applied to an old object. It frequently becomes a matter of construction upon the specification as to which of these branches of invention the specification is intended to apply, and there have been several cases upon the subject. It is evident that inasmuch as the patent will be valid provided a fair description of a new invention in either branch is given, that, in construing the specification of a patent a decided case upon some other specification will be of very little value. We do not propose, therefore, to discuss at length the constructions which have been placed upon specifications in particular cases. The words "improvements . . . in the manner hereinafter mentioned," followed by a claim concluding with the words "as above described," have been held to limit the claim to the particular machine described in the specification or to the particular method

of carrying out the process and not to include the principle of the process or any other method than that described of carrying it out (*q*).

We have seen, and we shall see more fully at length hereafter, that it is incumbent on a patentee in drawing the specification to distinguish that which is new in his invention from that which is old. In the case of *Holmes v. London and North Western Railway (r)*, A. obtained a patent for an improved turning-table for railway purposes, and in his specification gave a description of the machinery, of which no part was new except certain suspending rods; the combination, however, was both new and useful. In the specification the patentee claimed as his invention "An improved turning-table hereinbefore described, such my invention being, to the best of my knowledge and belief, entirely new." It was held, that no construction of the claim could be put upon it as including a combination of the various parts which were old, but that it must be construed as meaning that the patentee claimed the several parts of the invention as being new, and the combination being the only part which was new, the patent was held void. In the case of *Hills v. London Gaslight Company (s)*, it was held, that where the meaning of a document depends upon its terms and not on matters of fact, dehors the document, the question will be for the judge, even although the terms are technical or scientific; and where an ambiguity is raised by evidence, dehors the document, which is plain upon the face of it, the ambiguity being as to a term which imports one thing in a scientific sense, and another in a commercial sense. Query, whether it is for the judge or the jury. We should venture to say, that it would undoubtedly be for the jury. The question not being one at all as to the construction of the document,

(*q*) *Barker v. Grace*, 1 Ex. 339.

(*s*) 27 L. J., Exch. 60.

(*r*) 22 L. J., C. P. 57.

but being as a matter of fact, did the writer of the specification use the scientific term or the commercial term? A specification is to be construed with reference to the state of knowledge at the time it is published (*t*).

When drawings are attached to a specification, although the drawings may be used in construing the specification as explanatory of the text, they will not be allowed to be used in limiting the claim in a manner not provided for by the specification (*u*).

When two documents such as specifications are before the Court for comparison, the Court must interpret the meaning of the words, but the jury must say if they are identical (*x*). It is evident that, inasmuch as technical expressions are used in different trades and businesses, and that it is impossible for one person to be acquainted with every trade and every business, and every technical expression used in such trade and business, it is not necessary that the specification should be **intelligible** to any one, it is sufficient that it should be intelligible to a person reasonably skilled in the trade to which it particularly refers, and it must be intelligible to them without the necessity of their making new inventions of their own or additions to the specification or experiments (*y*).

In *Arkwright v. Nightingale* (*z*), Lord Loughborough, in charging the jury, said: "The clearness of the specification must be according to the subject-matter of it; it is addressed to the persons in the profession having skill in the subject, not to men of ignorance, and if it is under-

(*t*) *Heath v. Unwin*, 22 L. J., P. C. 105; *Tetley v. Easton*, Mac. C. P. 7. P. C. 68. But see *Bush v. Fox*,

(*u*) *Hinks v. Safety Lighting Co.*, L. R., 4 Ch. D. 607. See also *Clark v. Adie*, L. R., 2 Ap. Cas. 315. 5 H. L. C. 707; *Booth v. Kennard*, 2 H. & N. 84. Also *Hills v. Evans*, 31 L. J., Ch. 457.

(*y*) *Reg. v. Arkwright*, 1 Web.

(*x*) *Betts v. Menzies*, 10 H. L. C. P. C. 66. 117; *Muntz v. Foster*, 2 Web.

(*z*) 1 Web. P. C. 61.

stood by those whose business leads them to be conversant in such subjects, it is intelligible." And in *Hornblower v. Boulton* (a), to which we have previously referred, Mr. Justice Grose said: "If the specification be such as to enable artists to adopt the invention and to make the manufacture, it is sufficient."

In *Harmar v. Playne* (b), Lord Ellenborough graphically puts it: "No sort of specification would probably enable a ploughman utterly ignorant of the art to make a watch." But it is necessary that the specification should be in such terms as to enable persons of ordinary ability to understand it, and it will not be sufficient to show that one individual of extraordinary ability or of very exceptional technical knowledge is enabled to understand the specification (c). In *Neilson v. Harford* (d), Baron Parke puts it to the jury: "You are not to ask yourselves the question whether persons of great skill, a first-rate engineer, or a second-class engineer, as described by Mr. Farey, whether they would do it, because generally these persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification is supposed to be addressed: it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge, and the ordinary degree of capacity, to the subject."

In the process of the invention it is necessary to use some old or well-known apparatus; it is not necessary in the specification to describe the apparatus, save in such terms as it is generally known by in the particular business to which it belongs (e).

(a) 8 T. Rep. 104.

(b) Dav. P. C. 318.

(c) *Sturz v. De la Rue*, 5 Russ. 327.

(d) 1 Web. P. C. 314.

(e) *Crossley v. Beverley*, 3 C. & P. 513; *Househill Co. v. Neilson*, 1 Web. P. C. 676.

In *Heath v. Unwin* (*f*), Mr. Baron Alderson said: "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention; thus, if a particular mechanical process is specified, and there are for some parts of it, as specified, other well-known **mechanical equivalents**, the specification in those parts is in truth the specification of the well-known equivalent also, to those to whose general knowledge we refer: viz., mechanics and readers of specifications; and so it is with chemical equivalents also in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and chemists. These are not included in the specification but must be expressly stated there."

An error in a specification which may be said, in a sense, to be a technical error, will not vitiate a specification, although it be an error in description, provided it be such an error that an ordinary skilled workman would at once observe and be in a position to correct; provided it is not such an error as would require experiments to show that it was an error (*g*).

In *Plimpton v. Malcolmson* (*h*), Sir George Jessel said: "It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it; but there are various kinds of people who know something about it, if it is a mechanical invention, as this is; you have, first of all, scientific mechanicians of the first class, eminent engineers; then you have scientific mechanicians of the second class, managers of great manufactures, great employers of labour, persons who have studied

(*f*) 2 Web. P. C. 245.

per Lord Westbury, 13 W. R.

(*g*) See *Simpson v. Holliday*, 578.

(*h*) L. R., 3 Ch. D. 568.

mechanics, but not to the extent of the first class, and scientific engineers, but still to a great extent for the purpose of conducting the manufacture of complicated and unusual machines, and who therefore must have made the subject a matter of considerable study; and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even with slight hints and still more from imperfect description, and would be able to supplement so as to succeed even from a defective description, and, even more than that, would be able to correct an erroneous description—that is what I would say to be the two first classes, which I will call the scientific classes; the other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him, not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description. Now, as I understand it, to be a good specification it must be intelligible to the **third** class I have mentioned, and that is the result of the law.” This judgment very precisely lays down the law upon the subject of intelligibility generally.

The next question, as to what is a **sufficient** specification, is by far the most important branch of the subject.

We have seen that the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed; consequently for a specification to be sufficient it must particularly ascertain—(1) What the invention itself is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he has invented, and if in the course of the description of

his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, "This is old and I do not claim it as a part of my invention." There are two reasons why the inventor should be called upon to particularly state what he has invented; one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In *Macfarlane v. Price* (g), Lord Ellenborough said: "The patentee in his specification ought to inform the person who consults it what is new and what is old; he should say, 'my improvement consists in this' A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this." And the same judge, in *Harmar v. Playne* (h), maintained the same opinion.

The **degree of sufficiency** which is required by the law is very aptly and accurately put by Eyre, C. J., in *Boulton v. Bull* (i): "Suppose a newly-invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary that, in order to carry out this operation, the gold should be put into a crucible, and should be melted in that crucible, but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold in a state of fusion was to be performed. These are mere incidents, which every man acquainted with the subject is familiar." In taking this distinction as a guide, however, we must be

(g) 1 Web. P. C. 74.

(i) 2 H. Bl. 498.

(h) Dav. P. C. 311.

careful to remember that could it be shown that the chemical process would only be successful when the gold was melted in a particular kind of crucible, or at a particular temperature, that then, unless the description was given of the temperature and of the crucible, the specification would be insufficient.

It will be evident that, in any action for infringement, the statement of claim must relate to an infringement of something which is described and claimed in the specification, and consequently the invention, which must be proved, must be one of something which is found described in the specification. If that which is alleged to be an infringement is not described in the specification, then there can be no infringement of the patent. If anything cannot be completely done by following the specification then a person will not infringe the patent by doing it (*j*). The disclosure in the specification of the nature of the invention must be *bonâ fide*, but it need not go farther than the knowledge of the inventor at the time extends (*k*). If a patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad. So if he says that there are many modes of doing a thing, when, in fact, only one will do, this will also avoid the patent (*l*). The object of the patent is to benefit the world, and not to obstruct a subsequent invention; consequently, if the specification is worded in such a manner as to grasp at more than the patentee has actually invented, and to endeavour to cover, so to speak, wholesale problematic inventions, the patent will be void (*m*).

There is a head-note to the case of *Betts v. Neilson* (*n*) which is apt to mislead, the head-note is this: "Whether

(*j*) *Morgan v. Seaward*, 1 Web. P. C. 182. *Lewis v. Marling*, 1 Web. P. C. 496.

(*k*) *Lewis v. Marling*, 1 Web. P. C. 496. (*m*) *Crossley v. Potter*, Mac. P. C. 245.

(*l*) Per Mr. Justice Bailey, in (*n*) L. R., 3 Ch. Ap. 429.

a specification contains a sufficient description can only be ascertained by experiments, and in making an experiment knowledge and means may be employed which have been acquired since the date of the patent." It is evident that this head-note is incorrect, and if the case be read it will be found that the judgment of Lord Chelmsford was, not that the specification of the plaintiff could be held sufficient or insufficient upon experiments tried on the specification itself, with the assistance of subsequently-acquired knowledge, but that the specification, which was alleged to anticipate the plaintiff's patent, might be read for the purpose of determining whether there was anticipation or not, or whether there had been prior publication or not in the light of knowledge acquired by the general public since the date of the specification. This would be undoubtedly correct, because the question always is, in dealing with matters of prior publication, Was the supposed invention of the plaintiff's, at the time when he obtained his patent, already part of the public stock of knowledge or not? The public stock of knowledge consisted of the specification, which is put forth as anticipating the patent, together with all knowledge on the subject which can be proved to have been published or used prior to the date of the plaintiff's patent, and so in reading a specification with a view to ascertaining whether it anticipates a subsequent patent you must read into that specification all subsequently-acquired knowledge of the subject prior to the date of the patent; but in discussing the sufficiency of the specification which is actually in dispute, you cannot make use of information which has been acquired since the publication, for otherwise it would be held that the patent, which was void at first for insufficiency of specification, might become valid at some subsequent date by further discovery, which is obviously absurd.

The question of the sufficiency of a specification is one which must be dealt with on each particular case as it arises; a single word added to a specification may make that which was insufficient sufficient, and that which would be a sufficient description of one invention would be found to be an insufficient description of another, consequently there can be no absolutely fixed rules of construction in dealing with specifications.

In *Wegmann v. Corcoran* (o) it was held that the specification of a patent was bad if one of the materials to be used was described by a generic comprising a variety of species, the majority of which would be unsuitable. The specification of a patent is bad if a skilled mechanic would not, without performing a series of experiments, be able to construct the machine from the description.

The specification (p) of a machine for crushing meal, described the rollers as “to have a surface consisting of material containing so much silica as not to colour the meal or flour. I prefer to make them of iron, coated with china, and finally turned with diamond tools;” and the claim was, *inter alia*, for the use of material “of the hardness required.” It appeared that the rollers must be made of very hard china, such as had scarcely been made in Europe during this century, and specially tough, and must be fixed in a peculiar manner to an iron core or spindle, which carried them; and, according to the evidence, a miller or a skilled mechanic would not, without making a series of experiments, discover of what china the rollers must be made, or how they must be fixed to the spindle. Held by the Court of Appeal, confirming the judgment of Mr. Justice Fry, that the specification was insufficient and the patent invalid. Mr. Justice Fry had said: “Though the grantee of a patent for an invention communicated to him by a foreign resi-

(o) L. R., 13 Ch. 65.

(p) *Wegmann v. Corcoran*, supra.

dent abroad is only bound to tell the public what he himself knows, yet if the original inventor has not told him enough to enable him so to describe the invention as that it could be constructed by the aid only of the specification, the patent will be invalid. As we have seen, it is doubtful whether this does not only affect those patents which were obtained before the Act of 1883, known as "communications from abroad."

It will be seen that the last-mentioned case is distinguishable from the case of *Plimpton v. Malcolmson* (*p*). In *Wegmann v. Corcoran* the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, which he himself did not know, but which was within the knowledge of the person communicating from abroad; in that case it was properly held that he was not so bound, but it is obvious that he was bound to describe an invention in his specification which of itself was useful, and that he was bound to tell all that he himself knew.

We have seen that *bona fides* in the description of the invention is one of the essential elements of the consideration for the grant. The patentee must say not only that which is sufficient to carry out the invention, but he must say all he knows, and he must give every improvement which is within his knowledge at the time and which assists the process or manufacture. *Wood v. Zimmer* (*q*), decided so far back as 1815, gives a very clear idea of the law upon this branch of the subject. In this action to try the validity of Zinck's patent "for a method of making verdigris," it appeared that the method described in the specification was sufficient to make verdigris, but that Zinck had been accustomed, clandestinely, to put aquafortis into the boiler, whereby the metallic copper was dissolved more rapidly, but the verdigris produced was neither better nor cheaper

(*p*) L. R., 3 Ch. D. 531.

(*q*) 1 Web. P. C. 82.

than that made according to the specification. Gibbs, C. J., said: "It is said that the method described makes verdigris, and that the specification is therefore sufficient—the law is not so. A man who applies for a patent, and possesses a mode of carrying out that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without the aquafortis as with it, still, inasmuch as it would be made with more labour by the omission of aquafortis, it is **prejudicial concealment** and a breach of the terms which the patentee makes with the public."

In this case it must have been proved that the patentee, at the time when he obtained his letters patent and filed his specification, knew of the benefit to be derived by the use of aquafortis. It is evident that if he did not know it at the time, but discovered it subsequently during the currency of the patent, that then it would form an improvement upon his invention, and not one which he could possibly have disclosed at the time he filed his specification, and therefore there would be no *mala fides* on his part in not describing it.

The remarks of Gibbs, C. J., in *Bovill v. Moore* (q) go to the same extent; and in *Crossley v. Beverley* (r), Bailey, J., said: "It is the duty of the inventor if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable him better to effect the thing for which the patent was obtained,

(q) Dav. P. C. 400.

(r) 1 Web. P. C. 117.

not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he had obtained before the specification." In *Morgan v. Seaward* (s), Alderson, B., said: "If the patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect he ought to state it in his specification: that was laid down in a case before Lord Mansfield; there the question arose on a patent for steel trusses. It appeared that the patentee in some parts of his process used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of tallow. The Court held the specification to be bad, because they said: 'You ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so if that is the best mode of doing it, for you are bound to make a *bonâ fide*, full, and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet v. Johnson* (t).

In *Tetley v. Easton* (u), Pollock, C. B., said: "A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it;" and in *Heath v. Unwin* (v), Coleridge, C. J., said: "If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple

(s) 1 Web. P. C. 174.

(u) Mac. P. C. 76.

(t) 1 Web. P. C. 53; and Bull.

(v) 2 Web. P. C. 243.

N. P. 76.

and cheap one, it would be directly contrary to the good faith required from a patentee in his communication to the public.”

Upon the same ground of *malâ fide* it has been held, in a large number of cases, that if the patentee in his specification gives details which are not necessary to the invention, which of themselves do not constitute an invention, and which are merely put in for the purpose of misleading the public as to either what is the nature of the invention or how it is to be carried into effect, then the patent will be void. Bailey, C. J., in *Lewis v. Marling* (*w*), said: “If the party knew that it was unnecessary the patent would be bad, on the ground that this was deception; but if he thought it was proper, and only by a subsequent discovery finds out it is not necessary, I think that it forms no ground of objection.”

If the extraneous matter is put into the specification, *bonâ fide* thinking that it was necessary, the patent will not be held to be void; if it was put in *malâ fide*, with the intention of deceiving or knowing it was extraneous and useless, the patent would be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from successfully carrying out the invention, whether it is put in *malâ fide* or *bonâ fide*, the patent will be void. It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of *bonâ fide* on the part of the inventor (*x*).

We now come to that portion of the specification which is described as “the claim.” By sect. 5, sub-sect. 5, of the Act of 1883, it is provided that “a specification,

(*w*) 1 Web. P. C. 496.

Web. P. C. 83; *Bickford v.*

(*x*) *Simpson v. Holliday*, 20
Newton's London Journal, N. S.
108. *Crompton v. Ibbertson*, 1

Skewes, 1 Web. P. C. 218; *Neilson v. Harford*, 8 M. & W. 806.

whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed." This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of this Act, the necessity of the inventor making a distinct and unambiguous claim. He must not claim too much, and yet he must claim sufficient to show a useful manufacture, and he must distinguish in his claim what it is that is new in the process which he has described and what is old. So far as this goes, there is no doubt that the old law provided for similar declarations on the part of the inventor.

In *Bovill v. Moore* (*y*), Gibbs, C. J., said: "If the plaintiff has in this specification asserted to himself a larger extent of invention than belongs to him, if he states himself to have invented that which was well known before, then the specification will be bad, because that will affect to give him, through the means of this patent, a larger privilege than could be legally given to him." In the case of *Gibson v. Brand* (*z*), Tindall, C. J., said: "Looking at the specification in the case, it appears to me that this patent cannot be supported at law, because the plaintiffs have in the course of it claimed more than they are entitled to."

The Court must be taken to distinguish between **describing too much and claiming too much**. In the course of a well-drawn specification it is frequently necessary to describe something which is old, and if, provided the claim says that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent. But if two methods of doing a thing are

(*y*) Dav. P. C. 404.

(*z*) 1 Web. P. C. 634.

described, one of which will answer and the other will not, it will be interpreted, unless one of them is specifically disclaimed, that both parts are claimed as being new and useful, and one of them not being useful the patent will be invalidated, because it is said there is a false suggestion in the specification (*a*). In *Rushton v. Crawley* (*b*), Malins, V.-C., said: "The public must be told in very distinct language in every specification what are the articles they may use and what they may not use. Therefore, if a man makes a discovery, and instead of limiting himself in his specification to that which properly is a discovery (if it be one), makes his specification too extensive, and claims more than he is entitled to claim, that is calculated to embarrass the public; that is, I apprehend, a fatal objection to the patent."

In reading specifications, one frequently comes across a claim in these words: "I claim as my invention the appliances and combinations hereinbefore described." This claim is perfectly good (*c*), provided there is nothing described in the patent which is old. If there be anything old, the claim should proceed: "I do not claim so-and-so, and so-and-so, as part of my invention."

Under the new Act, it will be seen that for the validity of the patent to be supported, the specification *must* contain a claim; under the old law, if no claim was inserted the patentee was taken to claim everything that was described in the specification (*d*), it not being absolutely necessary that there should be a claim in the specification at all, provided nothing was described in the specification which could be shown to have been antici-

(*a*) *Simpson v. Holliday*, 13 W. R. 578; L. R., 1 H. L. 315, per Lord Westbury.

(*b*) L. R., 10 Eq. 527.

(*c*) *Seed v. Higgins*, 8 H. L. C. 550.

(*d*) *Tetley v. Easton*, 2 C. B., N. S. 706.

pated (*e*). For instance, if the invention be for an improvement upon an old process very great care should be taken that the improvement alone is made the subject of the claim; so if it be for a combination of old well-known parts, care must be taken that it be clearly shown that the patentee claims the combination, and not the parts. James, V.-C., in *Parke v. Stephens* (*f*), said: "It is obvious that a patentee does not comply as he ought to do with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy. And if a person desiring to find out what was claimed as new would have to get rid of a large portion of the specification, by eliminating from it all that was old and commonplace, all that was the subject of other patents, or of other improvements, bringing to the subject not only the knowledge of an ordinary skilled artizan, but of a patent lawyer or agent."

In *Harrison v. The Anderston Foundry Co.* (*g*), it was finally held by the House of Lords that if the combination and application of old machinery be new and beneficial the invention of this combination may be protected by a patent. The specification commenced: "The invention consists of a new or improved simple and most efficient mode of and arrangement of mechanism for connecting the set or sets of compound or multiple shuttle boxes of looms for weaving stripe, check or other ornamental or figured fabrics requiring two, three or more shuttle boxes in each set." The specification then described in detail and by reference to drawings the arrangement of mechanism in question, and then continued: "What we believe to be novel and original, and therefore claim as the invention secured to us by letters patent, is—(1) The construction and arrangement of the

(*e*) *Lister v. Leather*, 8 E. & B. 1004.

(*f*) L. R., 8 Eq. 365.

(*g*) L. R., 1 App. C. 578.

parts and portion of the mechanism, and (2) a shuttle-box moving and holding mechanism as herein distinguished generally for actuating the shuttle-boxes of power-looms, all substantially in the new or improved manner herein described and shown in the drawings or any mere modification thereof." A great number of the parts of the machine were admittedly old, and one of the questions in this case was, whether the first claim above set forth was a sufficient claim to a combination. Lord Cairns, in giving judgment, said: "It is as I read it a claim for a combination, that is to say, a combination of all the movements going to make up the whole mechanism described; it must, for the present at least, be assumed that this combination, as a combination, is novel, that it is, to use the words of the Lord President, a new combination of old parts to produce a new result or to produce a known result in a more useful and beneficial way; it is not doubted that a combination such as this is may be the subject of a patent, what, then, are the objections to the first claim viewed as a claim for the combination; the first is an objection said to be founded upon the case of *Foxwell v. Bostock* (h), decided by the late Lord Westbury. It is said to be determined in that case that where there is a patent for a combination there must be a discovery or explanation of the novelty, and the specification must show what is the novelty and what the merit of the invention. I cannot think that, as applied to a patent for a combination, this is or was meant to be the effect of the decision in *Foxwell v. Bostock*. If there is a patent for a combination the combination itself is *ex necessitate* the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In the same case Lord Hatherley said: "The judges extended, as it appears to me with great respect, the

(h) 4 Do G., J. & S. 298.

doctrine of *Foxwell v. Bostock* in their application of it in this case; it was there held, and that I think was all that was held, that it is not competent to a man to take a well-known existing machine, and, having made some small improvement, to place that before the public and say, 'I have made a better machine, there is this sewing machine invented by so-and-so, I have improved upon that. That is mine! it is a much better machine than his;' that will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by James, L. J., in another case, 'I think it will not do if you invented the gridiron pendulum to say, I have invented a better clock than anybody else, not telling the public what you have done to make it better than any other clock which is known.'"

In *Clark v. Adie* (i), Lord Hatherley said, speaking of *Foxwell v. Bostock*: "You must in some way or other inform those whom you are dealing with, by which I mean the general public, whom you wish to exclude for a certain limited number of years from using your invention, you must inform them in some mode or other whether you have sub-divided, if I may so term it, your machine into these separate parts and claim for each the merit of novelty, or whether you are simply making a combination of things *per se* old but which have never been used before in combination, and which make up, as you say, your machine, for which you claim protection, as a novel and useful machine."

These two judgments of the House of Lords show the extent to which the law went prior to the Act of 1883. We have seen that since the Act of 1883 the claim is an absolute essential, and the words of the statute are, "A distinct statement of the invention claimed." To what extent the words "a distinct state-

(i) L. R., 2 App. C. 328.

ment" will be construed it is at present difficult to say; but it will undoubtedly be advisable for inventors to be more careful that their claims are more accurately defined, it being very probable that the law as it at present stands will be held to be much more stringent in its requirements than it was before the Act of 1883.

CHAPTER V.

AMENDMENT OF SPECIFICATIONS.

THE Patents, &c. Act, 1883, provides for the amendment of specifications in two ways, **compulsorily** and **voluntarily**. We have seen that sect. 6 directs that the comptroller shall refer the specification to an examiner. Sect. 7 provides that (1), "If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application." Sub-sects. 2, 3, 4, provide for an appeal to the law officer; and sub-sects. 5 and 6 give directions as to what should be done when there are two applications for substantially the same invention.

Sect. 9, sub-sect. 1, requires that the examiner shall report to the comptroller as to "whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification." If the examiner reports that these conditions have not been complied with, the comptroller *may* refuse to accept the complete specification until it has been amended to his satisfaction, subject to appeal to the law officer.

Sub-sect. 3: The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if

any, the complete specification shall be accepted. By sub-sect. 4 the application is rendered void, except in the case of an appeal, unless a complete specification is "*accepted*" within twelve months from the date of application. Sect. 94 provides: "Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification without (if so required within the prescribed time by the applicant) giving the applicant the opportunity of being heard personally or by his agent."

These provisions of the law are entirely novel. It will be particularly observed that **compulsory amendment is strictly limited to matters of form.** The comptroller has no power to order an amendment on the ground that too much is claimed, or that there is want of novelty, or that the invention is not subject matter for a patent. It is very difficult to predicate what judicial decisions will be given to the words "that the nature of the invention is not fairly described." Is the examiner to be in the position of an expert witness, and to decide whether or not the description is sufficient to enable a skilled artizan to carry the invention into effect within the meaning of Jessel, M. R., in *Plimpton v. Malcolmson* (a)? or is he merely to see that the language is correct, and that, without going technically into the matter, the specification *appears* to fairly describe the invention? If the former is his province, it is difficult to see how it is to be carried into effect, since there is no machinery in the Act for the receiving of skilled evidence, such as would be necessary for the purpose of arriving at a satisfactory conclusion upon such a point. The applicant or his agent are alone to be heard. It is true that by sect. 38, when the applicant *appeals* he may call witnesses before the law officer, but surely the statute does

(a) L. R., 3 Ch. D. 568.

not contemplate that questions should be gone into which, it is evident, can only be decided on appeal, and even then not satisfactorily without the procedure and care of a regular formal trial.

Under such circumstances, it may fairly be presumed that the meaning of the section is, that the examiner shall report whether the specification, on the face of it, appears to fairly describe the invention.

In construing sect. 9, it will probably be held that a minute and scientific inspection of the specification is not within the contemplation of the statute.

Sect. 18 provides for the **amendment** of the specification by the applicant or patentee. There are several reported cases showing that at common law mere clerical errors in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (*b*). We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The **common law power** of amendment being found **insufficient** for the purposes of justice in such cases, the Act 5 & 6 Will. 4, c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, &c.,*" with the leave of the law officer, might **disclaim** any part of the "title of the invention or of the specification, stating the reason for such disclaimer"; or might, with such leave as aforesaid, "**enter a memorandum of any alteration in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c.**" The

(*b*) *In re Sharp's Patent*, 1 Web. P. C. 645.

case of *Spilsbury v. Clough* (c) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original patentee, or his assignees, or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any disclaimer or amendment made by the patentee was entirely at his own peril, and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The provisions of sect. 18 of the Act of 1883 are as follows:—

“(1) An applicant or a patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

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

“(3) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

“(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine

whether and subject to what conditions, if any, the amendment ought to be allowed.

“(5) When no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

“(6) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

“(7) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether and subject to what conditions, if any, the amendment ought to be allowed.

“(8) No amendment shall be allowed that would make the specification as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

“(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud, and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

“(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.”

Sect. 19. “In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs or otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.”

Sect. 20. “Where an amendment, by way of dis-

claimer, correction or explanation, has been allowed under this Act no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge."

Sect. 46 defines the word patentee, referred to in sect. 18, sub-sect. (1), as meaning "The person for the time being entitled to the benefit of a patent."

It will be observed that the amendments under the new Act are to be by disclaimer, correction or explanation, provided the amendment does not cause the specification to claim an invention substantially larger or different. The Act of Will. IV., after using the words "disclaimer" and "alteration," provided that no extension should take place in the "exclusive right" granted by the letters patent.

It was always a question of great difficulty whether or not a disclaimer or alteration extended the "exclusive right" of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. Mr. Justice Maule's view of the Act of Will. IV. was:—"Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer" (*d*).

(*d*) *R. v. Mill*, 20 L. J., C. P. at page 24.

Romilly, M. R., in the same case (*d*), at the Rolls, said, "It is proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in Macrory's Patent Cases at page 116, where Sir Richard Bethell, when Solicitor General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original clause being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said, "Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged (*e*)."

The case of *Ralston v. Smith* (*f*) shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle. Under the new Act it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different. It is presumed that the law officers will not find so much difficulty in dealing with these words as with the words of the old statute. Moreover, **an amendment once made cannot afterwards be objected to on any ground whatever, excepting that of fraud.**

(*d*) 14 Beavan, 315.

J. & S. 306.

(*e*) *Foxwell v. Bostock*, 4 De G.,

(*f*) 11 H. L. C. 223.

The amendment becomes part and parcel of the original specification in all courts and for all purposes.

Under the Statute of Will. IV. no disclaimer or amendment could be given in evidence in any action or suit (save and except in any proceedings by *scire facias*) pending at the time the disclaimer or amendment was enrolled. The object of this was obvious. It would have been unjust that a defendant should be held guilty of infringing a patent when at the time the action was brought against him the patent was void. The saving clause relating to *scire facias* was always exercised subject to just provision as to costs, and was inserted with a view to prevent a patent being repealed on account of some trifling error which might have been cured by disclaimer or alteration. The entry of a disclaimer under the old Act did not make a void patent valid *ab initio*, "so as to make any person a wrongdoer by relation," and in *Perry v. Skinner* (*g*) it was held, that the words "from thenceforth" must be read into the specification. Proceedings by *scire facias* are abolished by sect. 26 of the new Act, and a petition to the Court is substituted, the grounds for the petition being the same as heretofore in *scire facias*. Although we have seen that sub-s. 10 of sect. 18 prohibits any amendment *under that section* pending legal proceedings (including proceedings by way of revocation), sect. 19 provides machinery for saving a patent in the event of the Court or judge being of opinion that a disclaimer should be allowed upon such terms as may appear just (*h*). It will be observed that the Court or judge have no power to permit amendment by "correction or explanation" under this section.

In *Dudgeon v. Thompson* (*i*), an interdict granted prior

(*g*) Hindmarch, p. 207; 2 M. & W. 471.

(*h*) As to what are just terms, see *In re Smith's Patent*, Maer.

P. C. 232; and *In re Medlock's Patent*, Newton, London Journal, New Series, vol. 22, p. 69.

(*i*) L. R., 3 App. Cases, 34.

to the amendment was refused to be enforced after the amendment, on the ground that the amendment materially altered the patent, and that it was quite possible that there was no infringement of the patent as altered. In *Kynoch v. National Arms Company, Limited* (*k*), it was held that the law officer could not order an applicant for leave to disclaim to pay costs. Sect. 38 of the Act of 1883 cures this defect, giving the law officer full discretion as to costs, with provision that his order may be made a rule of Court.

Sect. 20 speaks for itself; may be it is intended to overrule *Perry v. Skinner* (*l*), quoted above. Under the Act of Will. IV., when a patentee sought to disclaim it was necessary that he should give his reasons for the proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment, whatever the form of the amendment may be. The reasons will, of course, vary with each case. Either that the patentee has discovered that parts of the invention claimed are not new, or are useless, or are not sufficiently described, or that they will not work. It will be observed that the reasons are not required to be advertised. The subject of opposition to the amendment proposed will be dealt with in the next chapter. It may be observed that there is nothing in the Act of 1883 to withdraw from the Master of the Rolls the common law power of amending clerical errors in specifications. See *In re Johnson's patent* (*m*).

(*k*) 37 L. J., Rep. N. S. 31.

(*m*) L. R., 5 Ch. D. 503.

(*l*) 2 M. & W. 471.

CHAPTER VI.

OPPOSITION.

SECTION 10 of the Act of 1883 provides that upon acceptance of the complete specification, but before sealing the patent, the comptroller shall advertise the acceptance, and that then the application and specifications, with the drawings, if any, shall be open to public inspection.

Section 11 is as follows:—(1) “Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification, give notice to the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground.”

Prior to the passing of this Act any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda* (a)), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent* (b)), but it was always considered necessary that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's*

(a) Hindmarch, at page 534.

(b) 6 De G., M. & G. 420.

Patent (c), and also *In re Vincent's Patent (d)*). If there was any doubt the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial. These two latter cases indicate the course the law officer should take, where the ground of opposition is an allegation that the applicant has obtained the invention from the opposing party. Such a question might very frequently raise questions of fact of great delicacy, and the question of the credibility of witnesses. Such questions should be left for trial in open court, more particularly as it will be observed that any such opposing party has an ample and unfettered remedy by petition to revoke the patent under sect. 26. The other two grounds of opposition are such as can readily be proved or disproved, hence the power of the law officer can be exercised with less prejudice to the interests of justice. It will make no difference in the exercise of the discretion of the law officer upon the report of the comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, that the validity, of the first patent is in dispute (*e*).

The second sub-section provides:—"Where such notice is given, the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

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

(4) "The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer may think fit to award."

(*c*) 14 W. R. 551.

(*d*) L. R., 2 Ch. 341.

(*e*) *In re Mancaux's Patent*,
L. R., 2 Ch. 272.

ration as the law officer with the consent of the treasury shall appoint.”

Sect. 38 of the Act gives power to the law officers to examine witnesses on oath, to make rules from time to time regulating references and appeals, together with the practice and procedure before them, and in any such proceedings they may make such orders as to costs as they may deem just, such orders to be enforceable as rules of Court.

In the absence of opposition, or in the event of any opposition being decided in favour of the patentee, the patent will be sealed. (Sect. 12.)

Provisions are made in sect. 18 for opposition to the amendment of any specification—opposition to an amendment may be made upon any ground—the only restriction being that the opposition must, in the opinion of the law officer, be by a person entitled to be heard. Any person who would be injuriously affected by a void patent becoming valid is a person entitled to be heard (*f*).

(*f*) See the conditions imposed in *Re Medlock's Patent*, reported in Newton's London Journal, New Series, vol. 22, p. 69, and also in *Re Smith's Patent*, Macr. P. C. 232, in which cases it appears that

great care was taken to protect the vested interests of persons who had acquired rights by reason of the imperfect condition of the original specification.

CHAPTER VII.

THE GRANT.

PRIOR to the Act of 1883 letters patent were issued under the great seal of England, and, consequently, by the Lord Chancellor, as keeper of the great seal. The process of sealing a patent was surrounded with all the formalities and expense which surrounds an important Act of State. Letters patent derived their authority from the fact that the great seal was attached to them, for "all the king's subjects are bound to take notice of the king's great seal" (*a*). Sect. 84 of the Act provides: "There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence;" and sect. 12: (1) "If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office. (2) A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom." Form D. in the first schedule to the Act gives the form in which in future letters patent are to be issued.

Letters patent consist of six material parts:—

- 1st. The address.
- 2nd. The recitals.
- 3rd. The grant.
- 4th. The prohibition.
- 5th. The conditions.
- 6th. The construction of the grant.

(*a*) *East India Co. v. Sandys*, Skin. 225.

THE ADDRESS.

The address is a public address from the sovereign to "all to whom these presents shall come." Mr. Hindmarch gives the reason for this as being, that it contains bargains made between the public and patentee (*b*).

THE RECITALS.

The recitals are four in number. The first recites the patentee's name and address, that he has made a declaration that he is in possession of an invention and is followed by the title of the invention. That he has declared that he is the true and first inventor of the invention, and that the same is not in use by any other person to the best of his knowledge and belief.

It will be remembered that previously to the Act of 1883, there were two forms in use; one when the inventor was the first and true inventor, and the other for a communicated invention; the latter running, "that in consequence of a communication from a foreigner residing abroad, he is in possession of an invention, &c." We have seen that communications from abroad have, in all probability, been abolished by the Act of 1883, and that if he would avoid making a false suggestion, and so destroy his patent, the inventor must himself become the patentee (*c*).

This recital contains the "suggestions" which have been made to the sovereign prior to the patent being granted and the representations upon which it has been granted. If either of these suggestions or representations be untrue the patent is void. We cannot do better to illustrate the exact meaning of a false suggestion than to quote the language of Parke, B., in *Morgan v. Seaward* (*d*). In that case the false suggestion complained of was in the title of the specification, which it was alleged

(*b*) Page 40.

(*d*) 2 M. & W. 544.

(*c*) Ante, pp. 7 & 21.

did not disclose the true nature of the invention. "This brings me to the question," said the learned judge, "whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so; and upon the authorities we feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person (*e*). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as in *Hill v. Thompson* (*f*); *Brunton v. Hawkes* (*g*); for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, 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, and no action maintainable upon it. We cannot help seeing on the face of this patent, as set out in the record, that an *improvement* in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis v. Marling* (*h*), this view of the case, that the patent was void for a false suggestion, does not appear by the report

(*e*) *Travell v. Carteret*, 3 Lev. 135; *Alcock v. Cooke*, 5 Bing. 340.

(*f*) 8 Taun. 375.

(*g*) 4 B. & Ald. 541.

(*h*) 10 B. & C. 22.

to have been pressed on the attention of the Court or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not vitiate the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself, as one of the subjects of it which may make a difference." It will be observed here that the learned judge draws a careful difference between an insufficient description in the specification and a false suggestion. In the cases cited below letters patent were held void for false suggestion (*i*). And the following cases are illustrations of the distinction drawn by Mr. Baron Parke:—*Lewis v. Marling* (*supra*) and *Haworth v. Hardcastle* (*k*). Also *Bainbridge v. Wigley* (*l*); *Hill v. Thompson* (*m*).

The **second recital** deals with the prayer of the application for the grant.

The **third recital** recites that a complete specification has been filed, particularly describing the nature of the invention. Here, again, a **false suggestion** will avoid the patent, so that if the complete specification is imperfect, the patent will be void upon two grounds, the one being the failure of consideration, and the other the false suggestion; and a false suggestion is equally fatal whether it is wilfully false or otherwise.

The **fourth recital** gives the common law motive for the grant, which is the encouragement of inventions for the public good. There will be something analogous to a false suggestion if the subject matter of the patent be immoral or illegal, and hence the patent will at common law be void. By sect. 86 of the Act the comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or

(*i*) *Jessop's Case*, 2 H. Bl. 489;
R. v. Wheeler, 2 B. & Ald. 345;
Felton v. Greaves, 3 C. & P. 61.

(*k*) 1 Bing. N. C. 189.
(*l*) 1 Carp. P. C. 270.
(*m*) 1 Web. P. C. 239.

morality. A serious oversight in the Act appears to be that there is no appeal from the comptroller when he exercises the power given by this section.

THE GRANT.

“Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c., give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise and vend the said invention . . . in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents.”

This language is intended to preserve intact the royal prerogative to grant or withhold a patent—which right was by the common law absolute and undoubted. We have seen that this prerogative is carefully preserved by sect. 116 of the Act.

It is the granting portion of the letters patent which creates the property in the invention. We have seen that this species of property is purely artificial in its nature; it is the most equitable and natural method which the state can devise for the reward and encouragement of inventors; it is merely a right yielding nothing until the invention is made practically useful to humanity. A trade mark is also an exclusive right, but it differs from a patent, insomuch that it has not merit and the benefit of mankind as its consideration. A trade mark is only a right to guarantee the genuine origin of an article. Anyone else may make the article, but they are only prevented from stamping it with the same

mark. A patent prevents the public from making the article or using the invention. There is no property which partakes of the nature of an exclusive right save that of a patent, copyright, or trade mark. There is no exclusive right in a secret. A man may only use a secret to his own profit so long as no one is in a position, by reason of knowing the secret, to use it. But the original possessor of a secret cannot, by any process of law, prevent a person from acquiring the knowledge of his secret, or, having acquired it, from making such use of it by publication or otherwise, as he may think proper (*p*). In *Newbery v. James* (*q*), although an agreement had been made to preserve a secret, the Court refused to grant an injunction on the ground that there was no means of enforcing it. Lord Eldon, L. C., said in *Williams v. Williams* (*r*), "So far as the injunction goes to restrain the defendant from communicating the secret upon general principles, I do not think that the Court ought to struggle to protect this sort of secrets in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public."

If the plaintiff's secret, however, be one which he intends to patent, and the defendant has acquired the information during the progress of experiments, or from the confidence of the plaintiff, he will not be allowed to make such use of the knowledge so acquired as to subsequently invalidate the plaintiff's patent, or to take out a patent for the invention himself, and if he do he will be liable in damages to the plaintiff (*s*). It will be observed that the word "patentee" is used in the grant; the old

(*p*) *Canham v. Jones*, 2 Ves. & B. 218.

(*q*) 2 Mer. 446.

(*r*) 3 Mer. 157.

(*s*) *Smith v. Dickenson*, 3 B. & P. 630.

form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 46th section, construed as being "the person for the time being entitled to the benefit of a patent;" we shall see presently that this includes assignees, executors and administrators, together with receivers and trustees in bankruptcy, but the subject of the devolution of patent rights is too extensive and important to be dealt with under this head.

THE PROHIBITION.

The prohibition in the patent commands "all our subjects, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

It is very difficult to understand the form of letters patent which is appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the "penalties" referred to in the prohibition are, and how are they to be put in force or recovered? The Act certainly does not mention penalties as a form of punishment for infringers.

THE CONDITIONS.

We find in the "conditions" that the grant is to be avoided "if it should appear to us, &c., or six or more of our Privy Council, that this our grant is contrary to law or prejudicial or inconvenient to our subjects generally, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the patentee is not the first and true inventor thereof within this realm as aforesaid." This proviso raises some questions of importance. The only proceedings mentioned in the Act for the repeal of letters patent are proceedings in the High Court of Justice. What is the proceeding before "six of our Privy Council"? It can scarcely be believed that reference is here made in a new codifying Act to the old prerogative claim of power to revoke, which has not been put in practice for two hundred and fifty years. If it be intended to have such a system of avoiding patents, surely it would be well to provide for it in a more certain manner than merely to mention it as one of the conditions in the patent itself. In the next place we find here, for the first time, an intimation that "**novelty**" means novelty within the kingdom; in the recitals of the patent it is recited as being novelty universally, and throughout the Act itself we find that "novelty" is not limited to novelty within the kingdom. Again, we find here for the first time the inventor described as "the first and true inventor **within this realm.**" In the Act and in the recitals of the patent he is described as the "first and true inventor." We have shown that the omission of the words "within this realm" makes an immense difference not only in the class of persons who may be grantees of letters patent, but also in the nature of the evidence of "prior user" which may be given in an action either for infringement or revocation. The ambiguity of the form of letters patent which is given, and the by no means

clear provisions of the Act upon these matters, will in all probability result in a plentiful crop of litigation (*t*).

The next proviso is one for the determination of the patent in the event of the prescribed fees not being paid, and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee upon reasonable terms and conditions. (*In re Daine's Patent*) (*u*).

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*x*). But should the Crown have employed a contractor, as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There being two methods of infringing; first, making and vending; and secondly, using. The contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (*y*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorize others who are not their officers, servants, or agents, to use a patented invention without a license from the patentee;" and Lord Selborne added, "I agree with the Court of Queen's Bench that this decision (*Feather v. R.*) is not to be extended by any reasoning from the convenience of the Crown, or of the public service, or from any idea that it practically comes to the

(*t*) See *Marsden v. The Saville Street, &c. Co. Limited*, L. R., 3 Ex. D. 203, and *Rolls v. Isaacs*, L. R., 19 Ch. D. 268.

(*u*) 4 A. & E. 949.

(*x*) *Feather v. R.*, 8 B. & S. 257.

(*y*) *Dixon v. The London Small Arms Co.*, L. R., 10 Q. B. 130; L. R., 1 App. Cas. 641.

same thing, whether the Crown manufactures itself or gives orders to other manufacturers.”

The right of the Crown to use a patented invention for the public service without being under any obligation to remunerate the inventor has been abolished by sect. 27 of the Act of 1883.

✧ (1) “A patent shall have to all intents the like effects as against her Majesty the Queen, her heirs and successors, as it has against a subject. L

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

Sect. 44 deals with the acquisition by the Secretary of State for War of any inventions dealing with instruments or munitions of war, and with the non-publication of specifications describing such inventions, and generally with the preservation for the public benefit of the secret of them.

THE CONSTRUCTION.

“And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.” These words are inserted in the patent for the purpose of preventing the common rule of construction of grants of the Crown when founded upon a petition being read most strongly against the grantee. This favourable construction will not, however, in any way save the validity of the patent if it can be shown to have been granted upon a false suggestion.

(z) *Dixon v. London Small Arms Co.*, supra.

CHAPTER VIII.

THE DEVOLUTION OF A PATENT.

WE have seen that a "patentee" is "the person for the time being entitled to the benefit of a patent." This includes the first inventor and any person or persons in whom the patent may have become vested by operation of law or by assignment.

The property of a patent passes, by operation of law, when the patentee dies or becomes a bankrupt. Upon the death of a patentee his interest in the property passes to his executors or administrators as the case may be in the like manner to the rest of his personal estate. Any step which in the Act is required to be taken by the patentee, may be taken by the executor or administrator, and sect. 34 of the Act provides that—" (1) If a person, possessed of an invention, dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative." This undoubtedly, seeing the terms of the grant itself, will mean his legal personal representative. Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male, such, for instance, as patents of nobility. The Act proceeds—" (2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention."

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee or assignee in

bankruptcy (*a*). It is doubtful whether the doctrine of apparent possession can be said to affect a patent right. The Lord Chancellor, in 1812, seems to have thought that it did (*b*). This, however, can hardly be quoted as an authority. The persons in whom the patent vests, by reason of bankruptcy, are placed in all respects in the position of the original patentee, and may sue in respect of infringements (*c*).

The second method of devolution is by assignment, *inter vivos*. This may be done either by absolute assignment of the whole of the patent, or by absolute assignment of the patent right for a limited area, or by assignment by way of mortgage, or by the grantees of licenses.

The right of the original inventor to assign the exclusive right which has been granted to him is recognised in the patent itself, which is granted to the said A. B., his executors, administrators or assigns. Without these words of limitation the property in the patent right would be merely personal, attaching to the person of the first inventor and becoming extinguished by his death.

The patent itself being a deed the assignment must be also by deed (*d*). So, also, licenses should be under seal, the prohibition in the grant itself being "without the consent, license or agreement of the said patentee in writing under his hand and seal."

A license granted by a patentee, but not under seal, is, however, not void in the sense that the licensee, having used the patent, is not bound to pay the royalties contracted for. In *Chanter v. Dewhurst* (*e*), it was held that the defendants having obtained the license they had

(*a*) *Hine v. Stevenson*, 3 B. & P. 565, also *Bloxam v. Elsee*, 9 D. & R. 215; *M'Alpine v. Mangnall*, 15 L. J., C. P. 298.

(*b*) See *Ex parte Granger*; Godson on Patents, 2nd ed. p. 225.

(*c*) *Bloxam v. Elsee*, *supra*.

(*d*) Co. Lit. 9 b, 172 a.

(*e*) 12 M. & W. 823.

bargained for, and kept it, were bound to pay for it; and secondly, that the license was not void as not being under seal. Baron Alderson said: "The defendants, in making the machine in question, are merely acting as agents for the patentee . . . in my opinion a license, for this purpose, need not be under seal."

Although the words of the grant are "under his hand and seal," the document is not a deed since it need not be delivered as a deed, nor need it be stamped as such (*f*).

By sect. 36 of the Act, "a patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only." Having assigned a patent, the original patentee cannot manufacture the patented article, and when an action is brought against him by his assignee he cannot set up that the patent was not valid; he is estopped by his deed (*g*). But where the plaintiff, fraudulently asserting that he had a right to a patent, induced the defendant to come to terms with him for a license to use that patent, the defendant, in an action upon that agreement, is not estopped from alleging the want of title in the plaintiff as a defence (*h*). But it would be otherwise in the absence of fraud and where both parties are innocent, in that case the assignee or licensee would not be allowed to set up as a defence the bad title of the assignor or licensor (*i*).

In *Bowman v. Taylor and others* (*k*), the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a license under seal for the use of the plaintiff's patent. The defendants defended on the grounds (1) that the invention was not a

(*f*) *Chanter v. Johnson*, 14 M. & W. 411.

(*g*) *Oldham v. Langmead*, cit. in *Hayne v. Maltby*, 3 T. R. 349.

(*h*) *Hayne v. Maltby*, 3 T. R. 438.

(*i*) See *Taylor v. Hare*, 1 Web.

P. C. 292, 293.

(*k*) 2 A. & E. 278.

new invention, (2) that the plaintiff was not the first and true inventor, (3) that the specification was not sufficient—pleas which in effect endeavoured to put in issue the validity of the plaintiff's title. Upon demurrer, Taunton, J., said, "The law of estoppel is not so unjust or absurd as it has been too much the custom to represent. The principle is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted. The question here is, whether there is a matter so asserted by the defendant under his hand and seal that he shall not be permitted to deny it in pleading. It is said that the allegation in the deed is made **by way of recital**, but I do not see that a statement such as this is the less positive because it is introduced by a 'whereas.' Then the defendant has pleaded that the supposed invention in the declaration and letters patent mentioned was not nor is a new invention. These words 'was not nor is a new invention' must be understood in the same sense as the words 'had invented' in the recital of the deed set out in the declaration, and must refer to the time of granting the patent, and if the invention could not then be termed a new invention, it could not, I think, have been truly said in the deed, that the plaintiff 'had invented' the improvements in the sense in which the deed uses the words. Then the plea directly negatives the deed, and comes within the rule that a party shall not deny what he has asserted by his solemn instrument under hand and seal." The learned judge then proceeds to distinguish *Hayne v. Maltby* (1), but for some reason does not refer to the element of fraud in that case, which certainly would take it out of the operation of the doctrine of estoppel.

Where, however, the license is not under seal there

(1) 3 T. R. 438.

will be **no estoppel**, and the defendant may show the invalidity of the plaintiff's patent by way of showing failure of consideration (*l*).

Besseman v. Wright (*m*) was decided on the ground of partial as against total failure of consideration, and has no reference to the doctrine of estoppel, although it seems sometimes to have been thought that it had.

In *Clark v. Adie* (*n*), James, L. J., said, "A licensee cannot under any pretence whatever bring his licensor into litigation as to the novelty of any part of the patent." This case was afterwards affirmed in the House of Lords (*o*). But it appears that if the license has been determined prior to the expiration of the term of the patent the ex-licensees may contest the validity of the patent, notwithstanding the covenants or recitals in the license (*p*). In giving judgment, Lord Cottenham said, "That is exactly coming to the point which I put, whether, at law, the party was estopped from disputing the patentee's right, after having once dealt with him as the proprietor of that right. And it appears from the authority of that case (*Hayne v. Maltby* (*q*)), and from the other cases, that from the time of the last payment (*i. e.* expiration of license), if the manufacturer can successfully resist the patent right of the party claiming the rent, that he may do so in answer to an action for the rent for the use of the patent during that year." The language is not clearly reported, but this appears to mean—to an action for the use and occupation, so to speak, of the patent after the expiration of the license.

The following cases have been decided uniformly, and show that parties to a deed of assignment or license are estopped from denying the validity of the patent, and

(*l*) *Chanter v. Leese*, 1 Web. P. C. 295.

(*m*) 6 W. R. 719.

(*n*) L. R., 3 Ch. D. 144.

(*o*) L. R., 2 App. Cas. 423.

(*p*) *Nelson v. Fothergill*, 1 Web. P. C. 287.

(*q*) 3 T. R. 438.

that there is no implied **warranty** on the part of the assignor or licensor. *Cutler v. Bower* (*q*), *Smith v. Scott* (*r*), *Walton v. Lavater* (*s*), *Norton v. Brooks* (*t*), *Crossley v. Dixon* (*u*).

Where the license is by parol and has been acted upon, and so long as the licensee has thought fit to claim the benefit of it, he is estopped from denying the validity of the patent, but no term being fixed for the duration of the verbal license he may determine it at any time (*x*). As to estoppel by judgment, see *Goucher v. Clayton*.

When the defendant has assigned his patent to the plaintiff, he cannot afterwards deny the validity of his own patent—*Walton v. Lavater, supra*. A licensee cannot take advantage of a judgment obtained by third parties against the patentee declaring the patent bad (*y*). But a licensee, in an action by the patentee, may claim to place the most **favourable construction** on the specifications, which will support the validity of the patent, if another construction would make it bad (*z*).

An assignment of patent rights in a **partnership** dissolution deed will estop the retiring partner from subsequently setting up the invalidity of the patent by way of defence to an action brought by his late partners (*a*). But where the plaintiff and defendant had been partners, and had worked as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, held that plaintiff was not estopped from denying the validity of the patent (*b*). And where partners are joined as defendants

(*q*) 11 Q. B. 973.

(*r*) 6 C. B., N. S. 771, and 28 L. J., C. P. 325.

(*s*) 3 L. T. R., N. S. 272.

(*t*) 7 H. & N. 499.

(*u*) 10 H. L. Cas. 293, and 11 Jur., N. S. 107.

(*x*) *Crossley v. Dixon*, 32 L. J. Ch. 617.

(*y*) *The Grover and Baker Sewing Machine Co. v. Millard*, 8 Jur., N. S. 714.

(*z*) *Trotman v. Wood*, 16 C. B., N. S. 479.

(*a*) *Chambers v. Crichley*, 33 Beav. 274.

(*b*) *Armann v. Lund*, 22 W. R. 789.

in an action for infringement, and one is assignor of the patent, the other is not debarred from setting up the pleas of invalidity (*c*).

Fraudulent agreements for the assignment of patents, such, for instance, as bubble patents, will be set aside (*d*). But in the absence of fraud the agreement will be enforced, and it is no defence to the action that the plaintiff has not invented the alleged invention (*e*).

Executors may assign a patent prior to registration of the probate (*f*).

Specific performance of an agreement to assign letters patent may be decreed (*g*). Even though the agreement be to assign patents for future inventions (*h*).

Licenses differ from assignments, in that the patentee granting a license does not part with his whole interest, but grants merely a right to use the patent for the whole term or any portion of the whole term. The license may be exclusive or otherwise.

Sect. 22 of the Act of 1883 provides for the granting of **compulsory licenses**.

“If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

“*(a)* The patent is not being worked in the United Kingdom; or

“*(b)* The reasonable requirements of the public with respect to the invention cannot be supplied; or

“*(c)* Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant

(c) *Heugh v. Chamberlain*, 25 W. R. 742.

(d) *Lovell v. Hicks*, 2 Y. & C. 46.

(e) *Smith v. Buckingham*, 18 W. R. 314.

(f) *Ellwood v. Christy*, 10 Jur., N. S. 1079.

(g) *Lewin v. Brown*, 14 W. R. 640.

(h) *Printing and Numerical Registering Co. v. Sampson*, 44 L. J., Ch. 705.

licenses on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus."

These provisions are entirely novel; "(a) and (b)" are capable of being reasonably construed, as to "(c)" it is difficult to understand how the Board of Trade will come to a decision as to whether "a person is prevented from working or using, to the best advantage, an invention of which he is possessed." The "invention" must be protected by letters patent (see the construction given in sect. 46).

The proceedings under sect. 22 will be regulated by rules to be made by the Board of Trade in pursuance of the power given by sect. 101, sub-sect. 1 (g), and sub-sects. 3, 4 and 5.

Money paid by a licensee for royalties cannot be recovered when it is ascertained that the patent was void *ab initio* (i). And if the licensees have kept the license and used it, the licensor can recover from them the agreed royalties, although the patent may have been void and the license not under seal (j). But if the consideration for the money paid is that an application for a patent should be made and a license to use the patent granted, no application being made for the patent there is a total failure of consideration, and the price paid may be recovered (k). But otherwise, if the licensor knew from the first that the patent was void (l), a license is not assignable (m). A license to a man and his assigns means a license with power to licensee to sub-license

(i) *Taylor v. Hare*, 1 B. & P. Rep., N. S. 70.
(N. R.) 260.

(l) *Chanter v. Leese*, 4 M. & W.

(j) *Chanter v. Dewhurst*, 12 M. & W. 823.

(m) Per Maule, J., in *Bowen v.*

(k) *Knowles v. Bovill*, 22 L. T. *Hodges*, 22 L. J., C. P. 198.

(*idem*). A licensee may covenant not to manufacture without applying the patented invention; such a covenant is not in restraint of trade (*n*). **A license may be created by parol**, but if no time is fixed for its duration it may be determined at will, and after the determination there will be no estoppel to the ex-licensee to dispute the validity of the patent (*o*). A patentee having granted a license cannot prevent anyone **vending the articles** which have been made in pursuance of the license (*p*). And an inventor selling the patented article abroad cannot restrain its importation and sale in this country. Although an assignee of the patent in this country might restrain the importation of an article made by the original inventor or his assignee abroad (*q*). A **latent ambiguity** in a license by deed may be explained by parol evidence in the same manner as other deeds (*r*). A licensor may in the license deed stipulate for a forfeiture in the event of royalties not being paid (*s*), but such forfeiture may be waived (*t*). The licensor may also agree that he will take all necessary steps to support the validity of the patent (*u*).

Sect. 23 of the Act provides:—“(1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be pre-

(*n*) *Jones v. Lees*, 1 H. & N. 189.

(*o*) *Crossley v. Dixon*, L. J., 32 Ch. 617, H. L.

(*p*) *Thomas v. Hunt*, 17 C. B., N. S. 183.

(*q*) *Betts v. Willmott*, L. R., 6 Ch. 239.

(*r*) *Roden v. The London Small Arms Co.*, 46 L. J., Q. B. 213.

(*s*) *Tielens v. Hooper*, 5 Ex. 850.

(*t*) *Warwick v. Hooper*, 3 M. & G. 60.

(*u*) *Henderson v. Mostyn Copper Co.*, L. R., 3 C. P. 202.

scribed; (2) the register of patents shall be *primâ facie* evidence of any matters by this Act directed or authorized to be inserted therein; (3) copies of deeds, licenses and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

X By sect. 85, "There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust, expressed, implied, or constructive." Sect. 87 provides for the entry in the register, at the request of the person becoming entitled, of any assignment or transmission of interest. The person registered shall have power to deal with such interest as he has registered, absolutely: "Provided that any equities in respect of such patent, &c., may be enforced in like manner, as in respect of any other personal property." Sect. 88 deals with the inspection of registers, and the obtaining of certified copies. By sect. 89 sealed copies are to be received in evidence.

Sect. 90 empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of persons aggrieved, and upon sufficient cause shown. The comptroller may himself correct errors in registers which are merely of a clerical nature, sect. 91.

Sect. 35 of the **Act of 1852**, after providing for the registration of proprietors, assignments, &c., of patents, proceeded: "Provided always, that, until such entries shall have been made, the grantee or grantees of letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all licenses and privileges thereby given or granted."

It will be observed that the Act of 1883, quoted above, **materially differs from this enactment.** Hence *Chollett*

v. *Hoffman* (*x*), and *Hassall v. Wright* (*y*), will not now apply.

Prior to the Act of 1883, the High Court of Justice exercised jurisdiction to alter and amend the register of patents (*z*).

The register should be amended whenever a fraudulent entry has been made. A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a license to work and use to A. B.'s assignment was first registered:—Held, that B. had **constructive notice** of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A., subsequently entered (*a*).

(*x*) 7 Ell. & B. 686.

(*y*) 40 L. J., Ch. 145.

(*z*) *In re Morgan's Patent*, 24
W. R. 245.

(*a*) *In re Morcy's Patent*, 25
Beav. 581, and Higgins' Digest,
339.

CHAPTER IX.

EXTENSION OF TERM OF PATENT.

SECT. 25 of the Act of 1883 provides :

“(1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a **petition to her Majesty in Council**, praying that his patent may be extended for a further time; but such petition must be presented at least six months before the time limited for the expiration of the patent.

“(2) Any person may **enter a caveat**, addressed to the Registrar of the Council at the Council Office, against the extension.

“(3) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

“(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

“(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term, not exceeding seven, or, in exceptional cases, fourteen years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions,

conditions, and provisions that the Judicial Committee may think fit.

“(6) It shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

“(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.”

These provisions have made **no substantial alteration in the law**. Prior to the Act 5 & 6 Will. IV. c. 83, there was no power in the Crown to extend the duration of letters patent, and should an inventor have desired to apply for an extension of the term of his grant, he could only do so by applying for and obtaining a **special Act of Parliament** in his favour. The Act of Will. IV., and the amending Act of 2 & 3 Vict. c. 67, introduced the method of petitioning and obtaining an extension to the Privy Council.

It had been found that the procedure to obtain an Act upon each occasion, when an extension was sought, was too costly and cumbrous, hence the modern course of procedure was devised.

This being shortly the history of jurisdiction of the Privy Council, at first an impression gained ground that the Privy Council were to put themselves in the position of Parliament, and not in that of a court of law, in considering the claims of applicants who appeared before them; that they were to weigh the claims of the **public interest** very heavily in the balance as against the inventor. In *Re Soame's Patent* (*y*) Lord Brougham

(*y*) 1 Web. P. C. 733.

said: "If this case were to be disposed of upon the ground which in arguing such cases have sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent; but that, moreover, the case is to be tried here as on a bill in parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no bill would ever have passed through the two houses of parliament."

The true construction is, however, not so severe as that, although still sufficiently severe. In *re Morgan's Patent* (z) Lord Brougham said: "It is by no means their (the Privy Council) course to put themselves precisely in the situation of the Legislature, and never to grant an extension where an Act of Parliament would not have been obtained. At the same time there are some limits to this. They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the Legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of parliament."

Such is the spirit in which the Privy Council will approach the subject of an extension, not benevolently to the applicant, but still with not so stern a regard to the interests of the public as parliament would entertain.

In considering their decision the Privy Council will consider:—

1. The nature and merits of the invention in relation to the public.
2. The adequacy or inadequacy of the profits made by the inventor as such.
3. The circumstances of the case.

In re Erard's Patent (a) Lord Lyndhurst said, "In cases

(z) 1 Web. P. C. 739.

(a) 1 Web. P. C. 559.

of this kind we expect a very strong case of hardship to be made out as well as a strong case upon the utility of the invention;" and the same privy councillor in *Soame's case* (b) said, "We consider the invention as very meritorious, the result of a great deal of labour, care, and science, and that it is extremely useful in its effects. We are satisfied by reasonable evidence that the party has sustained very considerable loss, and under these circumstances we think that the period ought to be extended."

It will be observed that the three considerations for the Privy Council laid down by the Act of 1883 are almost identical to the grounds of extension as given by Lord Brougham in *Re Derosne's Patent* (c): "The parties must show in the first place some invention, in the next place a benefit to the public, and in the third place that they have not had adequate remuneration."

It is immaterial whether or not the application is opposed. The Privy Council will require every necessary ground for extension to be strictly proved before they advise an extension (d), and this even though the Crown through the attorney-general consents (e).

"The merit of an importer is less than of an inventor. We are sitting judicially, and it is an argument against the patent that it is imported and not invented. I do not say it takes away the merit, but it makes it much smaller (f)."

Extension of the term will be granted to assignees, as they have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (g).

Merit here means the consideration which has been

(b) 1 Web. P. C. 560.	Moo. P. C. C. 490.
(c) 2 Web. P. C. 4.	(f) Per Lord Brougham <i>In re</i>
(d) <i>In re Perkins' Patent</i> , 2	<i>Soame's Patent</i> , 1 Web. P. C. 733.
Web. P. C. 18.	(g) See <i>In re Napier's Patent</i> ,
(e) <i>In re Cardwell's Patent</i> , 10	13 Moo. P. C. C. 543.

given to the state for the patent; it does not mean the merit of the inventor, but the **merit of the consideration** which he has given. An inventor may have diligently worked for years in a most deserving manner and yet have produced an improvement of the most trifling nature—the merit of the person in this case will not be considered. On the other hand, the invention, although a great one, may have been handed to him from abroad without thought or trouble on his part. This is what Lord Brougham contemplates when he says that the merit of an importer is less than that of an inventor. Again, the invention may have been a very simple one, produced by an inventor with a moment of thought, and yet of great importance to the world. This latter case would be one of merit—simplicity of an invention being an element of its value (*h*).

The Privy Council will not inquire into the **novelty or utility** of a patent, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention (*i*).

Non-user of the patent creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*k*). But the same objection being raised *In re Hughes' Patent* (*l*), the application was granted after strong and unanswered evidence of merit though the patent had not been used in England during the whole term (*m*).

In re Betts' Patent (*n*) Lord Chelmsford said, “Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead,

(*h*) *In re Muntz' Patent*, 2 Wob. P. C. 119.

(*i*) *In re Saxby's Patent*, L. R., 3 P. C. 292.

(*k*) See *In re Allan's Patent*, L. R., 1 P. C. 507, where an application was rejected on that

ground.

(*l*) L. R., 4 App. Cas. 174.

(*m*) See also *In re M'Dougal's Patent*, L. R., 2 P. C. 1, and *In re Herbert's Patent*, L. R., 1 P. C. 399.

(*n*) 1 Moo. P. C. C., N. S. 49.

and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the **real benefactor to the public**, and is entitled to claim that description of **merit** which constitutes one of the grounds for extending the term of a patent" (o).

Merit is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Privy Council must of necessity, therefore, be decided upon the facts of that particular case. It is otherwise with the other necessary condition for an extension, viz., the inadequacy of the remuneration of the inventor. Here figures can be dealt with, and a nearer approach to uniformity of decision obtained. It is possible, therefore, to gather from the various decisions a reasonably accurate set of rules for the guidance of the applicant for an extension on the ground of the inadequacy of the remuneration.

The **sufficiency of the remuneration** will be estimated with a view to the **importance of the invention** and the **benefit the public** have derived from it. That which would be ample remuneration for one patent would be considered inadequate for another. Refining sugar by filtering it through animal charcoal was an invention of great value and importance. The patent was extended for six years on the ground that although there had been a considerable profit, it bore no relation to the great merit of the invention (p). So *In re Newton's Patent* (q) the Privy Council granted an extension on the ground that there had not been sufficient remuneration considering the value of the invention.

An English patent may be renewed though a foreign one has been taken out and allowed to expire (r).

(o) Also see *In re Hills' Patent*,
1 Moo. P. C. C., N. S. 265.

(q) 14 Moo. P. C. C. 156.

(r) *In re Adair's Patent*, L. R.,

(p) *In re Derosne's Patent*, 2
Web. P. C. 1.

6 App. Cas. 176.

If the patentee is a manufacturer of the patented article, the privy council will not endeavour to distinguish accurately his profits as a patentee from his profits as a manufacturer, but will consider the gross amount of profits(s). In this case Lord Brougham said, "We cannot weigh in golden scales the proportions between manufacturers' profits and patentees, but we must take it in the gross, and apply our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing, nor in his favour straining. We must ascertain whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

The ground of this view of the case appears to be that the possession of the patent has placed the manufacturer in an advantageous position in obtaining orders(t).

In the accounts which the patentee must file upon an application for an extension, when he is a manufacturer of the patented article he should, so far as possible, distinguish profits as a manufacturer from profits as a patentee(u); and in cases where it can be shown that the reasoning in *Johnson's case* (supra) does not apply, he will be allowed to deduct his profits as a manufacturer before an estimate is taken of his profits as a patentee(w).

But where he ascribed two-thirds of the profits to the manufacturer, and only one-third to the patent, it was held to be unreasonable(x).

It will be observed that the cases quoted above appear to conflict with the principles laid down by Lord

(s) *In re Muntz's Patent*, 2 Web. P. C. 120.

(t) *In re Johnson's Patent*, 8 Moo. P. C. C., N. S. 291.

(u) *In re Betts' Patent*, 1 Moo. P. C. C., N. S. 49.

(w) *Ib.*

(x) *In re Hills' Patent*, 1 Moo. P. C. C., N. S. 258.

Brougham in *Muntz's case* (*y*). These words cannot be read as meaning that no regard whatever will be paid to the fact, that a great portion of the patentees' plant, expenditure, or time, is devoted to the business of an ordinary manufacture, from which some profits would be derived, even if no patent were in existence, but that no attempt will be made to go into minute details of figures. The profits will be treated in gross, and then their lordships will apply their general knowledge, as men of the world, in coming to a conclusion as to how much the patentee has received from the profits of his invention.

In estimating profits, a deduction will be allowed for the **expenses of experiments** in bringing the invention to perfection (*z*). And also in respect of the **costs of litigation** necessary to maintain the validity of the patent, and to restrain infringers (*a*). But not where actions have been compromised, improvidently, and costs abandoned without sufficient reason (*b*). The **expenses of taking out the patent** will be allowed as a deduction (*c*). So also will the **expenses incurred in bringing the invention in general public use** (*d*). And a deduction will be allowed in respect of the **personal expenses of the patentee**, and by way of salary for the exclusive devotion of his time in bringing the patent into practical operation and public notice (*e*). A patentee residing in America, for the purpose of getting the patented article into general use in England, employed **an agent**, and allowed him half profits. This half was allowed to be deducted (*f*).

But, on the other hand, the patentee must add to his

(*y*) 2 Web. P. C. 120.

(*z*) *In re Bates' Patent*, 1 Web. P. C. 739, and *In re Kay's Patent*, 1 Web. P. C. 572.

(*a*) *In re Galloway's Patent*, 1 Web. P. C. 729.

(*b*) *In re Hills' Patent*, 1 Moo. P. C. C., N. S. 258.

(*c*) *In re Roberts' Patent*, 1 Web. P. C. 575.

(*d*) *In re Galloway's Patent*, *supra*.

(*e*) *In re Carr's Patent*, L. R., 4 P. C. 539.

(*f*) *In re Poole's Patent*, 4 Moo. P. C. C., N. S. 452.

profits the profits arising out of the manufacture of the patented article, even though intended for exportation (*g*). So also he must add the profits which have been made by his licensees (*h*). And in *Re Johnson's* patent, Lord Justice James said: "Their lordships are of opinion, that where the question to be considered is, whether an invention has been sufficiently remunerated or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee or the person who claims the right of the patentee, *whether it be in one country or another.*"

We have seen by sub-section 6 of the section of the Act of 1883 now under consideration, the rules of the privy council, which have been heretofore in force, are to continue until amended or altered.

Rule 9 is as follows:—"A party applying for an extension of a patent . . . must lodge at the council office six printed copies of the specification, and also four copies of the **balance sheet of expenditure and receipts** relating to the patent in question, which accounts are to be proved on oath before the lords of the committee at the hearing." This must be done within one week of the hearing, rule 10.

The judicial committee will not enter into the accounts in a case for extension unless they have been filed in accordance with this rule (*i*).

But in exceptional cases, the filing of perfect accounts may be excused (*j*). Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of

(*g*) *In re Hardy's Patent*, 6 Moo. P. C. C. 441.

(*i*) *In re Johnson's and Atkinson's Patent*, L. R., 5 P. C. 87.

(*h*) *In re Trotman's Patent*, L. R. 1 P. C. 118; 3 Moo. P. C. C., N. S. 291.

(*j*) *In re Lowe's Patent*, 10 Jur. 363.

the patentee was examined to prove an allegation in the petition, to the effect that not only had there been no profits, but a considerable loss (*k*).

The **account** of profit and loss ought to be **clear and precise** (*l*). The application will be refused if the petitioner's accounts are unsatisfactory (*m*). The accounts furnished by the petitioner not containing sufficiently full and accurate information in respect of the patent, or the remuneration received by him, the judicial committee declined to recommend a prolongation of the term (*n*). In one case, the accounts being *primâ facie* unsatisfactory, the judicial committee directed the question of accounts to be taken before considering the merits of the invention (*o*). And where the accounts were *primâ facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (*p*). The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence (*q*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner.

Where a patentee, whether English or foreign, has obtained **foreign patents**, they **should be stated** in a petition for prolongation, and the fullest information afforded as to the profits thereof. A patentee should preserve the clearest evidence of everything which has been paid or received on account of the patent. Whether or not his remuneration has been adequate, his furnish-

(*k*) *In re Heath's Patent*, 8 Moo. P. C. C., N. S. 255.
P. C. C. 217.

(*l*) *In re Belts' Patent*, 1 Moo. P. C. C., N. S. 49.
4 P. C. 89.

(*m*) *In re Trotman's Patent*, 3 Moo. P. C. C., N. S. 488.
7 Moo. P. C. C., N. S. 309.

(*n*) *In re Clark's Patent*, 7 Moo. P. C. C. 364.
(*o*) *In re Wield's Patent*, L. R.,
(*p*) *In re Houghton's Patent*,
(*q*) *In re Hutchinson's Patent*,

ing a satisfactory account is a condition precedent to his obtaining an extension of his term (*r*).

The third head of subjects to be inquired into, upon an application for prolongation, consist of the various grounds of objections to an extension which have been allowed hitherto by the committee, and which are included in the general term used in sub-sect. 4, viz., “**All the circumstances of the case.**”

That the invention has not been brought into **public use** is a good ground of objection(*s*). So is **negligence** on the part of the patentee in **restraining infringement**(*t*). That the **invention was practically useless** as originally described in the specification, but was subsequently made practicable by subsequent improvements, introduced from abroad, is also a good ground for objection(*u*). But, otherwise, where the invention was useful and meritorious, in its original form, subsequent improvements form no ground in support of objection(*x*). When the non-profitable use of the patent has been caused by the fault of the patentee himself, objection will be allowed(*y*). So also where a patentee has **delayed, intentionally**, putting his invention into practice, unless he can show that shortness of funds, or other reasons, placed it out of his power to avoid the delay(*z*).

We have seen that the novelty or utility of a patent will not be inquired into, except so far as they bear upon the merit of the invention. Nor will the validity of the patent be inquired into, excepting in cases where it is **obvious the patent is invalid**. In *Re Hills'*

(*r*) *In re Adair's Patent*, L. R., 1 Web. P. C. 740.
6 App. Cas. 176.

(*s*) *In re Pucker's Patent*, 12 Web. P. C. 727.
Jur. 234.

(*t*) *In re Simister's Patent*, 1 Moo. P. C. C. 469.

(*u*) *In re Woodcroft's Patent*, supra. (z) *In re Norton's Patent*, 1 Moo. P. C. C., N. S. 339.

Patent (a), Sir J. T. Coleridge said: "Their lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent which is manifestly bad; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of **want of novelty** and **want of utility**, so far as they affect the validity of the patent. Indeed the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account; and in their lordship's judgment they are right in that contention. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it" (*b*).

An illustration of what is meant by the patent being clearly bad is given in *Re M'Innes' Patent (c)*. The patent was for a metallic soap to be used for the purpose of preserving metals from rust. The specification was very widely worded. Sir W. Earle said, "Their lordships taking into consideration with reference to the public interest that the individual substance for the application of which the patent is sought to be prolonged is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of

(a) 1 Moo. P. C. C., N. S. 262.

(c) 5 Moo. P. C. C., N. S. at

(b) Per Lord Langdale, M. R., p. 78.

In re Pucker's Patent, 12 Jur. 234.

the specification being as wide as it is. On the whole, therefore, their lordships are of opinion that they ought not to recommend her Majesty under such circumstances to grant a prolongation.”

In consequence of sect. 25 of the Patent Law Amendment Act, 1852, and of sect. 7 of 16 & 17 Vict. c. 115, which provided that letters patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent, and that any prolongation of letters patent should be made subject to that condition. **An inquiry into foreign patents** and their duration was always an essential element of the proceedings before the privy council (*d*).

These Acts are, however, specifically repealed, and by sect. 45, sub-sects. 2 and 3, of the Act of 1883 it is provided, “Every patent granted **before** the commencement of this Act, or on an application there pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses. In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.”

Thus it will be seen that after the commencement of the Act any prolongation of letters patent will be made regardless of foreign patents or their duration.

Prior to the Act of 1883 it had been held, in a series of cases, that **executors and administrators** of a grantee of

(*d*) *In re Bodmer's Patent*, 8 Moo. P. C. C. 282; *In re Aubé's Patent*, 9 Moo. P. C. C. 43; *In re Newton's Patent*, 15 Moo. P. C. C. 176; *In re Betts' Patent*, 1 Moo. P. C. C., N. S. 49; *In re Poole's Patent*, 4 Moo. P. C. C., N. S. 452; *In re Normand's Patent*, 6 Moo. P. C. C., N. S. 477; *In re Winan's Patent*, 8 Moo. P. C. C., N. S. 306; *In re Johnson's Patent*, 8 Moo. P. C. C., N. S. 287; *In re Blake's Patent*, L. R., 4 P. C. 535.

letters patent might petition for an extension (*e*). So might the assignee of a patent, even though a public company (*f*). So might the executor of an assignee (*g*).

The Act of 1883 gives a **patentee** the right to petition, and, bearing in mind that the **definition of the word patentee** is by sect. 46, "Any person for the time being entitled to the benefit of a patent," it will be observed that the greatest latitude is given as to persons who may petition. The committee will still regard different classes of petitioners in different lights.

In *Re Norton's Patent*, quoted above, Sir John Romilly, then Master of the Rolls, said, "Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

And in *Re Pitman's Patent* (*h*) Sir J. W. Colvile said: "There are no doubt cases in which their lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit as it may be said of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general

(*e*) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

(*g*) *In re Bodmer's Patent*, 1 Moo. P. C. C., N. S. 239.

(*f*) *In re Norton's Patent*.

(*h*) 8 Moo. P. C. C., N. S. 297.

rule which their lordships entertain in applications on the part of assignees is, as was stated by Lord Brougham in *Re Morgan's Patent (i)*, that by so doing 'they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent.' "

There is no case showing that an extension has ever been granted to licensees; but it may be suggested that at any rate *exclusive* licensees are "persons for the time being entitled to the benefit of a patent," although, of course, very exceptional circumstances indeed would have to be shown to warrant an extension to them.

It is difficult to estimate the effect of sect. 36 of the Act of 1883 upon this branch of the subject. Sect. 36 provides that: "A patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only."

Will the privy council, on the application of an assignee for a portion of the kingdom, extend the patent for that portion, or must all parties to the patent join in the petition?

It is evident that whilst one district assignee of an electric light patent, for example, may have been amply remunerated, another may not have been remunerated at all, owing to the action of local authorities or other matters entirely beyond the assignee's control. How could the committee in justice refuse the latter an extension? On the other hand, how could they grant it to the other?

(i) 1 Web. P. C. 737.

Then again, if a patent may be extended for one district and not for another we shall have the enormous practical difficulties and public inconveniences of an article being patented in one county and free in another, a state of affairs which, we venture to say, would be intolerable to the public.

Any person may enter a **caveat against the extension**, and may be heard at the bar in support of their opposition; and where unreasonable opposition is offered, they will be ordered to pay the petitioner's costs (*k*). But where the opposition is well founded and successful, costs will be allowed to the opposing party (*l*). If the petition be **abandoned, costs will be given to opposers**, and they need not give the petitioner notice of their intended application for the same (*m*). Where the petitioner had fairly and honestly stated his case, both the things against and the things for him in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration.

Where two or more parties have opposed the petition separately and successfully, the committee will sometimes order a **fixed sum** to be paid by the petitioner to the opponents, to be apportioned between them in lieu of saddling him with several separate sets of **taxed costs** (*n*). We thus see that, whilst on the one hand an unwarranted application for an extension may be very costly, unreasonable opposition may be equally so.

An extension of a patent having once been granted, the privy council have no jurisdiction to entertain a

(*k*) *In re Downton's Patent*, 1 C. C. 39.
Web. P. C. 567.

(*l*) *In re Westrupp and Gibbins' Patent*, 1 Web. P. C. 554. (*n*) *In re Jones' Patent*, 9 Moo. P. C. C. 41. Also *In re Hills' Patent*, 1 Moo. P. C. C., N. S.

(*m*) *In re Bridson's Patent*, 7 Moo. P. C. C. 499. See, however, 258, and *In re Wiold's Patent*, 8 Moo. P. C. C., N. S. 300.
In re Milner's Patent, 9 Moo. P.

petition for a **further prolongation**, their power being exhausted; and this objection may be taken by an opposing party, even though omitted from the objections filed by them (o).

The rules of practice to be observed upon application for extensions of letters patent will be found hereafter.

(o) *In re Goucher's Patent*, 2 Moo. P. C. C., N. S. 532.

CHAPTER X.

CONFIRMATION.

THE Statute 5 & 6 Will. IV. c. 83, provided a remedy for cases of hardship, such as, where an invention had been invented or used and subsequently abandoned before the date of the patent in a manner unknown to the patentee at the time of his application. There would be a sufficient prior user to invalidate the patent, and yet there would be great merit probably in the patentee, and a great benefit to the public. The patentee might petition the privy council to confirm the patent, that is, to declare it valid, notwithstanding such prior user. The proceedings on such a petition were similar to those upon a petition for extension.

The Act of 1883 repeals the statute 5 & 6 Will. IV. c. 83, and with it all proceedings for confirmation; and this method of clothing an invalid patent with validity is abolished. A perusal of sect. 45, sub-sect. 2 & 3, shows that this applies to patents existing at the commencement of the Act, as well as to those to be hereafter applied for and granted.

It is not strictly the purpose of a law work to criticise the enactments of the legislature, saving in their construction and application from an administrative point of view, otherwise a great deal might be said as to the evidence of abolishing that which was intended for and operated merely as a relief under very hard and exceptional circumstances.

CHAPTER XI.

REMEDIES OF THE PATENTEE AND OF THE PUBLIC—ACTION
FOR INFRINGEMENT.

AN action for infringement is the remedy which the patentee has, and the means which is given to him for enforcing his patent privileges.

The courts are bound to take notice of the patent, and are bound to give legal effect to it, provided it cannot be shown to have been granted contrary to law.

PARTIES TO THE ACTION.

The Act of 1883 gives no directions as to what persons may be **plaintiffs or defendants** in an action for infringement, and therefore leaves the question of the parties to the action as it was before the passing of the Act.

The **original grantee**, it is obvious, so long as he has not parted with the whole of his interest in the patent, may be a plaintiff. And so may the **assignees** of a patent (*a*), even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*).

The **assignee of a portion** of a patent may sue for an infringement of that part. Erle, C. J., in giving judgment in *Dunnicliff v. Mallett* (*c*), said: "The question is whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and

(*a*) *Electric Telegraph Co. v. Brett*, 10 C. B. 838.

(*b*) *Walton v. Lavater*, 8 C. B., N. S. 162.

(*c*) 7 C. B., N. S. 209.

severable. . . . Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action." The plaintiff in such an action would not be allowed to sever his part from the rest of the patent, and he would be liable to be defeated if it could be shown that the patent in any of its parts was void. But, on the other hand, he would have to show that his part alone would have been sufficient to support a patent, *i.e.*, that it contains a new and useful invention. Sect. 33, however, of the Act of 1883, provides, "Every patent . . . shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention."

By sect. 36, "A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only." The assignee for a district will be in a position to bring an action for infringement, but it is obvious that the infringement must be within his district, otherwise he will be unable to prove damage.

One of several joint owners of a patent may bring an action in his own name to restrain infringement, or for damages, without joining his other co-owners (*d*), and he may sue alone for an account of profits, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to.

Abinger, C. B., in *Derosne v. Fairie* (*e*), said that "a mere licensee could maintain no action against anyone else for the infringement of a patent." He might, how-

(*d*) *Sheehan v. Great Eastern Rail. Co.*, L. R., 16 Ch. D. 59; (*e*) 1 Web. P. C. 155.

ever, use the name of the grantor of the license for the purpose provided he were an **exclusive licensee** (*f*).

A mere licensee would have no exclusive right to use the invention; he is only a person who is permitted to use it. The grantor of such a license might grant a dozen other such licenses without prejudicing the rights of the licensee; but an exclusive licensee has a right of property in the monopoly, and stands very much in the same position as an assignee for a district. The term exclusive, as applied to a licensee, meaning exclusive within an area.

When the exclusive licensee finds it necessary to protect his rights by bringing an action in the name of the licensor he is liable to give the licensor security for the costs (*g*) which, in the event of defeat, the licensor would have to pay. The right, however, to assign for particular districts will make this branch of the subject unimportant, since exclusive licenses were only a scheme for the purpose of, in effect, assigning for districts.

The **assignees or trustees** in bankruptcy of a patentee may maintain action for infringement in their own name (*h*), and so may the **executors or administrators** of a patentee.

As defendants, a person physically using a patented invention is liable, such as a **contractor** (*i*). When a person in the position of a **servant** uses a patented invention, the master, in law, is the person who physically uses the invention as well as the servant, and the master may be sued. If a servant uses an invention in the course of his employment the master is liable, even though the master has told the servant to avoid infringing

(*f*) *Renard v. Levinstein*, 2 Hem. & M. 528.

(*g*) *Evans v. Rees*, 2 Q. B. 334; *Spicer v. Todd*, 1 D. P. C. 306.

(*h*) *Bloxam v. Elsee*, 6 B. & C. 169.

(*i*) *Denley v. Blore*, 38 Lond. Jour. 224.

the patent (*k*). The **directors of a company** whose servants infringe an invention are personally liable (*l*).

An architect specifying the use of a patented invention is not liable (*m*).

Aliens infringing a patent in this country by vending or otherwise are liable if they come within the jurisdiction of the courts (*n*). A person ordering goods to be made in England which are an infringement of a patent, although intended for exportation to him abroad, infringes the patent. "He that causes or procures to be made may be well said to have made himself." Per Tindal, C. J. (*o*).

(*k*) *Betts v. De Vitre*, L. R., 3 Ch. App. Cas. 441.

(*l*) *Ibid.*

(*m*) *Denley v. Blore*, 38 Lond. Jour. 224.

(*n*) *Caldwell v. Vanvlissengen*, 9 Hare, 415.

(*o*) *Gibson v. Brand*, 11 L. J., C. P. 186.

CHAPTER XII.

THE CAUSE OF ACTION—INFRINGEMENT.

THE infringement of a patent is the doing that which the patent prohibits from being done (*a*). The words of the Royal Command are as follows: "We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license or agreement of the said patentee in writing under his hand and seal, on pain, &c."

The **question of infringement** or no infringement is one of fact, and therefore **is for the jury** (*b*). But this refers to the mere infringement alone within the meaning of Tindal, C. J., in *Muntz v. Foster* (*c*), when he told the jury that "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff."

If the patent is invalid there can be no infringement in the sense that a patent which has no legal existence

(*a*) *Walton v. Bateman*, 1 Web. P. C. 586; *De la Rue v. Dickenson*, P. C. 616. 7 E. & B. 738.

(*b*) *Walton v. Potter*, 1 Web. (*c*) 2 Web. P. C. 99.

cannot be infringed. But assuming that it has a legal existence, the question is for the jury. This explains the apparently contradictory decision in *Curtis v. Platt* (*d*) in the House of Lords. The question of infringement was there taken as involving the validity of the patent.

It is equally an infringement whether the defendant acted in **ignorance** of the plaintiff's patent or not. In *Heath v. Unwin* (*e*) Parke, B., delivering the judgment of the Court, said: "There was therefore no intention to imitate the patentee's invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all." This judgment certainly gives an erroneous impression of the law, and Shadwell, V. C., when the same case came before him (*f*), said: "The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury) he is answerable for the consequences." In *Stevens v. Keating* (*g*) the Lord Chancellor disapproved of the case in the Court of Exchequer; "and I must decline to act upon the principle which it lays down."

Subsequently, when *Heath v. Unwin* came before the House of Lords, the opinion of the judges being taken, Parke, B. (*h*), acknowledged the error into which the Court had fallen, and approved of *Stevens v. Keating*.

In *Stead v. Anderson* (*i*) Wilde, C. J., graphically puts it: "The question of infringement depends not on what the defendant intends, but on what he does."

So it is **immaterial whether the defendant was aware** that the thing was patented or not, since in law every person in the realm is taken to have notice of a patent

(*d*) 35 L. J., Ch. 852.

(*e*) 14 L. J., Ex. at p. 156.

(*f*) 15 Sein. 553.

(*g*) 1 Mac. & G. 659.

(*h*) 25 L. J., C. P. at p. 19.

(*i*) 2 Web. P. C. 156.

in the same way that he is taken to be aware of the law (*k*).

And the converse is also sound—if a person intending to infringe a patent does not in fact do so, he will not be taken to have infringed (*l*).

In *M^cCormick v. Gray* (*m*) the specification, after describing several parts of reaping machines, including some cutting blades of peculiar construction, claimed: “The construction of reaping machines according to the improvements before described—that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels, respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed.”

The defendant made and sold cutting blades similar to those described by the plaintiff's patent, which were *capable of being used* in the plaintiff's reaping machine. Bramwell, B., in giving judgment, said:—“A man could not make the blade of a knife without infringing this person's patent, because you may intend to put it into a machine, or you may not. I think it is a very clear case, and I am satisfied there is no difference between making a thing with one intent and making it with another, because I always understood, that if a man may do a thing, he may do it with whatever intent he pleases.” It will be observed, that in this case, to make the knives was no infringement, and there was no evidence of the defendant having applied them to reaping machines (*n*).

(*k*) *Walton v. Lavater*, 29 L. J., C. P. 275; *Curtis v. Platt*, 11 L. T. R., N. S. 245.

(*l*) *Newall v. Elliott*, 10 Jur., N. S. 954.

(*m*) 31 L. J., Ex. 42.

(*n*) See, however, *Bancroft v. Warden*, Romilly's Notes of Cases, 103.

Thus we see that infringement, as taken apart from the question of validity, is a matter of fact, and that intention is not material to the conclusion.

To prove infringement, it must be shown that there is a **substantial resemblance** (*o*). The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification (*p*).

A patented article sold by a patentee carries with it the right of being used and sold anywhere (*q*).

It is impossible to surmise how the Courts will deal with sect. 36 of the Act of 1883, which enables a patentee to assign his patent for any place or part of the kingdom as effectually as if the patent were originally granted to extend to that place or part only.

Supposing a patentee to assign a patent for making brushes for London to A, and for Liverpool to B. Will the purchaser of brushes from A in London be infringing the rights of B by using the brushes in Liverpool, and will he be liable to an action? If he is not liable to be sued, of what use is the right of assignment for a part only, since the assignee, for one place, could make the brushes in that place, and sell them universally to the detriment of assignees for other places.

The amount of prior user which will be sufficient to invalidate a patent, differs considerably from the amount of user which will be held to infringe a patent: "these are different questions, depending on wholly different considerations, the one upon the extent of previous knowledge, the other upon the effect of the grant" (*r*). We have seen that by sect. 33 of the Act of 1883, a patent may still contain more than one claim, and in such a case,

(*o*) *Stead v. Anderson*, 2 Web. 6 Ch. App. Cas. 239.
P. C. 155.

(*p*) *Croll v. Edge*, M. Dig. 194. (*r*) Per Turner, V. C., in *Caldwell v. Vanrlessengen*, 9 Hare, 428; *Newton v. Grand Junction Rail.*

(*q*) *Betts v. Willmott*, L. R., 5 Ex. 334.

provided every claim which is made is valid, a patent may be infringed by infringing any one claim. In *Gillett v. Wilby* (s) Coltman, J., said:—"If they are all new (the parts claimed), and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." In *Newton v. The Grand Junction Rail. Co.* (t), Pollock, C. B., said:—"But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement," and in *Sellers v. Dickenson* (u), the same judge said:—"There may be an **infringement by using so much of a combination as is material** if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent."

"Where a patent is for a combination of two, three, or more old inventions, a user of any of them would not be an infringement of the patent; but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent" (v).

Speaking of this case in *Clark v. Adie* (w), James, L. J., said: "Upon the authority of *Smith v. L. & N. W.*

(s) 9 Carr. & P. 336.

(t) 5 Ex. 334.

(u) 5 Ex. 324.

(v) Per Campbell, C. J., in *Smith v. L. & N. W. Rail. Co.*,

2 E. & B. 76; *The Patent Bottle Envelope Co. v. Seymer*, 5 C. B., N. S. 172.

(w) L. R., 10 Ch. App. Cas. 674.

Railway Co., 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. If a patent for a combination of several parts is in reality a patent, and gives really a monopoly for every combination of any two or more of those parts, then it follows, from the very first principle of patent law, that if any conceivable combination of any two or more parts was old, the patent would be bad. On the other hand, if the patentees say, 'No, we do not claim to protect every combination of those parts, but only those subordinate combinations, or parts of the combination, which are new and useful,' then such a claim would be entirely inconsistent with the leading case of *Foxwell v. Bostock* (*x*), which, we may be permitted to say, is as good sense as it is sound and intelligible law I will state what we conceive to be the real principle which underlies the case of *Lister v. Leather* (*y*), and which reconciles it with the other cases, and with general principles, and common sense. A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact every, or almost every patent, is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or **substance of the invention** underlying the mere accident of form, and that invention, like every other invention, may be pirated by a theft in a disguised

(*x*) 12 W. R. 723.

(*y*) 8 E. & B. 1004.

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.”

Where, however, the **application** by the defendant of a portion of the invention of the plaintiff is for a **different object**, and with a view of carrying out a principle totally newly discovered by the defendant, and which was unknown to the plaintiff, there is no infringement, although at first sight there appears to be some similarity of process (*z*).

We have seen that sect. 5, sub-sect. 5, provides that a complete specification must conclude with a distinct statement of the invention claimed; so that, if the invention be a combination, it must be so stated; if for parts, they must be claimed. It is apprehended that there will in future be no **infringement** if the defendant cannot be shown to have infringed, directly or indirectly, a **part or parts of the claim**. In *Lister v. Leather* (*a*) it was held that a valid patent for an entire combination, or for a process, gives protection to every part that is new and material, for the purpose of effecting that particular combination or process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. In future, if any parts are desired to be protected, as well as the combination or process, the claim will have to be so drawn as to include those parts.

The jury will always have to consider whether the infringing machine process or combination is a **substantial imitation** (*b*). No fine lines can be drawn as to what amounts to a substantial imitation. In *Clarke v. Adie* (*c*), in the House of Lords, Lord Blackburn said, “I incline to

(*z*) *Newton v. Vaucher*, 6 Ex. 859. See also *Morewood v. Tupper*, 3 C. L. Rep. 718.

(*a*) 8 E. & B. 1004.

(*b*) *Thomas v. Foxwell*, 5 Jur. N. S. 39.

(*c*) L. R., 2 App. Cas. 335.

agree with what was said in the Exchequer Chamber in the case of *Lister v. Leather* (*d*), that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B, and C is or is not using part of that invention, nor can you decide in the abstract the other question, which was somewhat discussed in the case of the sewing machine (*Foxwell v. Bostock*) (*e*), whether or no the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister v. Leather*, before deciding it, to have before me the nature of the machine, in order that I may see what A, B, and C are, and what is their relation to each other.”

In *Parkes v. Stevens* (*f*), James, V.-C., said, “The authority of that case (*Lister v. Leather*) has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination the judgment if read well will be found to give no warrant whatever for such, I must call it, baseless notion. The law is summed up thus. The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material *for that process*, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man’s invention; and the question in every case is a question of fact—is it really and **substantially a part of the invention**” (*g*). This judgment was affirmed on appeal (*h*).

(*d*) 8 E. & B. 1004.

(*e*) 12 W. R. 723.

(*f*) L. R., 8 Eq. 358.

(*g*) See also *Wright v. Hitch-*

cock, L. R., 5 Ex. 37; on the other side *White v. Fenn*, 15 W. R. 348.

(*h*) 5 Ch. Ap. Cas. 36.

If a man in the course of producing an improved combination substantially uses a combination which already forms the subject of a patent he thereby infringes the patent, notwithstanding that the combination he is making has a different end in view than that which has been patented (*i*).

But, on the other hand, where a patent is for a combination a person who takes a new and material part of the combination, but **not for a similar or analogous purpose** to that to which it was applied in the patent, does not infringe the patent (*k*).

If the invention be for a combination or process whereby an already well-known object is produced, it will be no infringement to make **another combination, even of the same materials** (provided they be also old and well-known), for the purpose of attaining the same object, for the patent is for the *means* of attaining the object, and if other means are employed there is no infringement. The patent is also for the *method* of combining the old and well-known materials, and if **another method** is adopted there is no infringement (*l*).

When the defendant has set himself to work to **evade the plaintiff's patent** by fraudulently making a colourable imitation, or substituting a mechanical or chemical equivalent, the cases show that the Courts will look strictly at what he has done, and will take care that he does not overstep the line which he is endeavouring to keep within.

The question of fraudulent evasion is, as we have shown, one of fact. "A slight departure from the specification, for the purpose of evasion only, would, of course, be a fraud upon the patent; and therefore the question will be, whether the mode of working by the

(*i*) Per Lord Westbury in *Cannington v. Nuttall*, L. R., 5 H. L. at p. 230.

(*k*) *Lister v. Eastwood*, 9 L. T. R., N. S. 766.

(*l*) *Curtis v. Platt*, in the House of Lords, 35 L. J., Ch. 852.

defendant has, or has not, been essentially or substantially different (*m*).

In *Dudgeon v. Thompson* (*n*) Lord Cairns makes strong objection to the use of the term **colourable imitation**, in connection with the infringement of patents, and proceeds:—"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that the whole of it may be said, as is said in this injunction, Here is a machine, which is either the plaintiff's machine, or differs from it only colourably. But underlying all that there must be a taking of the invention of the plaintiff. There used to be a theory in this country, that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know there is by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. My lords, I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

Summing up the cases, therefore, we come to this. Strictly speaking, there is no such thing as a colourable imitation: either the defendant has infringed the thing

(*m*) Per Dallas, J., in *Hill v. Thompson*, 1 Web. P. C. 242.

(*n*) L. R., 3 App. Cas. at p. 43.

specified or he has not. At the same time there is an essence or substance to every invention underlying the mere accident of form or words. If the defendant has imitated and adopted the **essence of the invention** he will not be allowed to escape because he has not adopted the form or words in which the essence of the invention is clothed (*n*).

There is a description of imitation which is produced by the substitution of **chemical or mechanical equivalents**. To the unscientific eye there is a total dissimilarity between the infringing machine or process and the original; but, none the less, it is a mere imitation—it is a robbery of the ideas and intentions of the first inventor, but a robbery conducted in a scientific manner.

We have seen that a patent cannot be granted for the discovery of a mere principle (*o*), but that, if the principle when discovered is at the same time applied, a valid grant may be made for the application of the principle. The essence of the patent is the fact of applying the newly-discovered principle to a particular end. Now a mechanical or chemical **equivalent is another method** of producing the same result, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity of any inventive power whatever. Equivalents

(*n*) *Thorn v. The Worthing Skating Rink Co.*, L. R., 6 Ch. D. 417; *Flower v. Lloyd*, W. N. 1877, p. 132; *Barrett v. Vernon*, 45 L. T. R. (N. S.) 755; *Bailey v. Robertson*, L. R., 3 App. Cas. 1055. And the older cases, *Bovill v. Moore*, Dav. P. C. 405; *Forsyth v. Riviere*, 1 Web. P. C. 97; *R. v. Lister*, Web. P. L. 80; *Minter v. Wells*, 1 Web. P. C. 130; *Morgan v. Seaward*, per Alderson, B., 1 Web. P. C. 171; *Walton v. Potter*, 1

Web. P. C. 586; *Neilson v. Harford*, 1 Web. P. C. 310; *Walton v. Bateman*, per Cresswell, J., 1 Web. P. C. 616; *Muntz v. Foster*, per Tindal, C. J., 2 Web. P. C. 101; *Russell v. Ledsam*, 14 M. & W. 580; *Gamble v. Kurtz*, 3 C. B. 425; *Stead v. Anderson*, 2 Web. P. C. 156; *Unwin v. Heath*, 25 L. J., C. P. 9; *Curtis v. Platt*, 35 L. J., Ch. 852; *Murray v. Clayton*, L. R., 7 Ch. App. Ca. 585.

(*o*) *Anto*, p. 22.

may be substituted for parts as well as for the whole invention, so that it may happen that a patent is taken out which consists of three parts. An equivalent may be substituted for each part, so that in effect the whole invention may be changed and yet there may be a most flagrant infringement.

Take, for instance, the case of *Stevens v. Keating* (*p*). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime) by admixing it with pearlash (carbonate of potash) and sulphuric acid. Chemically, the effect was this: Sulphate of potash was produced; this, combined with the sulphate of lime, produced a double salt, which, when submitted to a high temperature and subsequently ground to a fine powder, constituted the cement. The principle of this discovery was that sulphate of lime combined with salts of potash or soda, and when so combined, produced a substance which set very hard. The defendant substituted for the pearlash and sulphuric acid a chemical equivalent, borate of soda (borax), and heated that with gypsum, producing in the same manner a double salt, and with the same resulting property of setting. This was properly held to be an infringement.

In *Russell v. Cowley* (*q*) the invention claimed was that of bringing to a welding heat a long piece of iron of the proper quality; after having turned up its edges and drawing it through a hole of the proper size of the intended tube, so as to compress together the edges and give it a complete circular form. The defendants turned up the skelp, and, after heating it in the furnace, passed it through two rollers with grooves:—Held, that the two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed under the patent (*r*).

(*p*) 2 Web. P. C. 181.

(*q*) 1 Web. P. C. 463.

(*r*) See also *Jups v. Prutt*, 1

Web. P. C. 146; *Heath v. Unwin*, per Parko, B., 2 Web. P. C. 227;

The Electric Telegraph Co. v. Brett,

There are three ways in which a patent may be infringed:—

1. By making the patented article or working the process.

2. By using.

3. By selling.

BY MAKING.

A person may infringe a patent by making the article himself, or by his agent, or by his servants. The agent and servants, it is true, will be considered as equally infringing the patent, and actions may be brought against them individually, but that in no way absolves the person who employs them for that purpose. In *Sykes v. Howarth* (s) a patent consisted of the application of cards or strips of leather covered with wire or rollers at “wide distances.” A person who contracted to clothe rollers and supplied to a “nailer” cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only and did not include the nailer’s work. In giving judgment, Fry, J., said: “I have come to the conclusion that the nailer must be deemed to have been the agent, for the purpose of nailing on, of the defendant there is a contract to clothe in the manner prescribed by the particulars given to the defendant, and that contract was carried into effect by a person paid by the defendant—the defendant himself receiving the total amount for which he contracted. The consequence is that in my judgment all the defences fail.”

10 C.B. 838; *Hancock v. Moulton*,
Johnson’s Patentees Annual, 3rd
ed. 208; *Bateman v. Gray*, Mac.
P. C. 102; *Simpson v. Holliday*,
20 Newton’s Lond. Journ. (N. S.)

111; *United Telephone Co. v.*
Harrison, Cox, Walker & Co.,
L. R., 21 Ch. D. 896.

(s) L. R., 12 Ch. D. 826.

We have seen that it is an infringement to colourably imitate an invention. It is no infringement to make, use, or vend the elements which afterwards enter into the combination. In *Townsend v. Haworth* (*t*), Jessel, M. R., said, "The chief of these chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser coming to him says, 'I want your compound because I want to preserve my cloth from mildew. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article can be sued as an infringer, because he knows that the purchaser intends to make use of it for that purpose."

The working and making must be by way of using the invention, as distinguished from experimenting with it, so as to operate as an infringement. In *Higgs v. Godwin* (*u*) the patent was for obtaining a commercially saleable manure by treating sewage with slaked lime. The defendant used the process by way of experiment to purify water—held no infringement. In *Frearson v. Loe* (*v*), Jessel, M. R., adverting to this branch of the subject, said, "The other point raised was a curious one and by no means free from difficulty, and what occurred with regard to that was this: that the defendant at

(*t*) L. R., 12 Ch. D. 831, note.

and *Muntz v. Foster*, 2 Web. P. C.

(*u*) E. B. & E. 529. See also

93 and 96.

Jones v. Pearce, 1 Web. P. C. 122,

(*v*) L. R., 9 Ch. D. 48.

various times made screw blanks, as he said, not in all more than 2 lbs., by various contrivances, by which no doubt screw blanks were made; according to the plaintiff's patent of 1870, as well as that of 1875, they seem to have been an infringement of both. He said he did this merely by way of experiment, and no doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment and not for a fraudulent purpose ought not to be considered within the meaning of the prohibition, and if it were, it is certainly not the subject for an injunction."

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions sometimes arose as to whether persons acting in the service of the Crown might manufacture a patented article or use a patented process.

When the persons using the invention were servants of the Crown, and acting in pursuance of their duty as servants, they were protected; but if they were contractors contracting with the Crown they were not protected, but stood in exactly the same position as other subjects (*x*).

Sect. 27 of the Act of 1883 provides that a patent should bind the Crown, but that the Crown may use the inven-

(*x*) *Dixon v. The London Small Arms Co.*, L. R., 10 Q. B. 130, and L. R., 1 App. Cas. 632, reversing decision of Court of Appeal, L. R., 1 Q. B. D. 384; also *Feather v. R.*, 6 B. & S. 257.

tion "by agents or *contractors*" on terms to be before or after the use agreed upon.

BY USING.

It frequently occurs that very fine questions arise as to what constitutes using a patented invention. The general rule may be thus stated: That if the defendant has put the invention to the purpose for which it was intended he has used it in this country. In the case of *Nielson v. Betts* (*y*), in the House of Lords, the facts were as follows: Betts, the plaintiff in the suit, was the patentee of an invention for the manufacture of capsules for the purpose of covering bottles of liquid (wine, beer, or otherwise), and protecting them from the action of the atmosphere. Betts' patent did not extend to Scotland. Nielson and his co-appellants, defendants in the suit, were persons who bottled beer in Glasgow for the Indian market. They bottled the beer and covered it with capsules, which were made in Germany in pursuance of Betts' specification. The beer was shipped by the appellants in vessels which called at Liverpool to complete their cargoes; on some occasions the beer was transhipped in England, but no cases of beer were opened, nor was any of the beer sold in this country. Held, by the House of Lords, that, inasmuch as the object of Betts' invention was to make a capsule that would preserve the beer, whilst the beer was in England it was being preserved by the use of Betts' invention, and consequently that there was an infringement of the patent. Lord Chelmsford, in giving judgment in the Court below, said: "It is the employment of the machine or article for the purpose for which it was designed which constitutes its active use, and whether the capsules were intended for ornament or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to

(*y*) L. R., 5 H. L. 1.

be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent to England, and had been afterwards sold here, there can be no doubt, I suppose, that this would have been an infringement, because it would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer."

The case of *Nobel's Explosive Co. v. Jones, Scott & Co.*, is instructive upon the question of user. The subject of the plaintiff's patent, dynamite, is a mechanical compound of nitro-glycerine and infusorial earth. The compounding of nitro-glycerine in this manner is done for and effects the purpose of rendering it less liable to explosion from concussion. The object of the patent was, therefore, to enable nitro-glycerine to be kept and handled with safety. Held, by Bacon, V.-C., that the mere storage of dynamite made abroad, and only landed in this country for the purpose of transshipment, amounted to an infringement of the plaintiff's patent. This decision was reversed in the Court of Appeal, but upon another point, to be mentioned presently, and without in any manner impugning the correctness of the Vice-Chancellor's decision on this question (*y*).

In the case of *Caldwell v. Vanvlissengen* (*z*), it was held by Turner, V.-C., that foreign ships coming into British ports, fitted with screw propellers, which were made in pursuance of the specification of an English patent, thereby infringed the patent. If the injunction which was granted be carefully read, it will be found to amount to a restraint from propelling the vessels with the propellers, not from having the ships merely fitted with them. Legally speaking, the user of propellers differs from that of capsules or dynamite in this important respect, that the

(*y*) L. R., 17 Ch. D. 721. See *Cambridge v. Richardson*, 6 Ves. 689.
also *The Universities of Oxford and*

(*z*) L. J. R., 21 Ch. 97.

one is in use only when in motion; the others are at use, the one when merely affixed to the bottles, and the other when merely in possession. Subject to the applicability of the arguments adduced in the case of dynamite, mere possession, unaccompanied with user, does not constitute an infringement of Letters Patent.

In the case of *Adair v. Young* (z), certain pumps, which were an infringement of the plaintiff's patent, were fitted on board a British ship. There was no evidence of their having been used. Held, by the Court of Appeal, that there had been no infringement, but as there was evidence of an intention to use the pumps, an injunction would be granted against the use of the pumps.

Sect. 43 of the Act of 1883 provides:—“(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man. (2) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges, for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.”

A patent is not infringed by being used on board an English vessel abroad (a).

In the case of *Nobel's Explosive Co. v. Jones & Scott* (b),

(z) L. R., 12 Ch. D. 13.

N. S. 954.

(a) *Newall v. Elliott*, 10 Jur.,

(b) 17 Ch. D. 721.

mentioned above, the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiff's patent, they having merely acted as Custom House agents for the transshipment of the dynamite, and their functions being confined to obtaining papers necessary for such transshipment, and that they never had any ownership in or exercised any control over the dynamite.

This decision shows that the Courts will not recognize that a person infringes a patent by aiding and abetting, so to speak, another to do so. There must be some actual infringement on the part of the defendant (*c*).

SELLING.

A person infringes letters patent who sells the patented article within this realm. It is a putting in practice of the invention within the terms of the grant.

The purchase of the patented article is not of itself an infringement of the patent, nor is the mere possession, since these do not come within the prohibition in the grant, which is against making use of, or putting in practice, the said invention (*d*).

This is always with exceptions such as in the case of dynamite, where the mere possession involves *ex necessitate* the use; and the importation of the patented article will not of itself amount to an infringement.

The possession of the patented article, combined with exposure for sale, if no sale is in fact effected, is no infringement (*e*).

But the making of the patented article, as we have seen, is an infringement, whether a sale was effected, or attempted or not (*f*).

(*c*) See also *Townsend v. Howarth*, L. R., 12 Ch. D. 831; *Sykes v. Howarth*, 12 Ch. D. 826.

(*d*) See *Minter v. Williams*, 1 Web. P. C. 135.

(*e*) *Ibid.*

(*f*) *Muntz v. Foster*, 2 Web. P. C. 101; *Oxley v. Holden*, 8 C. B. (N. S.) 666.

Where the patent is for a process the manufacture of an article by the process abroad and sale in this country is an infringement. In *Elmslie v. Boursier* (g) Sir W. M. James, V.-C., said: "It is said that tinfoil can be made by the plaintiff's process at less cost than by the old method; and it is conceded that nobody in England can use the plaintiff's process of making cast tinfoil as distinguished from rolled tinfoil without a license from the plaintiff. If that cannot be done in England it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted 'the whole profit, benefit, commodity, and advantage' arising from the patent. It would be a short mode of destroying 'every profit, benefit, commodity, and advantage' which a patentee could have from such a thing, if all that the man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee."

In *Walton v. Lavater* (h) Erle, C. J., said: "But it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented or of the infringement, it would

(g) L. R., 9 Eq. at p. 222.

(h) 29 L. J., C. P. 275.

be sufficient evidence of infringement that the defendant had imported and *sold*" (i).

Selling known chemical substances with knowledge of and a view to their being used for the purpose of infringing a patent is no offence, provided the vendor takes no actual personal part in the infringement (k).

A patentee selling the patented article sells with it the right of free disposition as to that article, and if he sells the article in France, the purchaser may import and sell it in England. Lord Hatherly in *Betts v. Willmott* (l), said: "Inasmuch as he has the right of vending the goods in France, or Belgium, or England, or in any other quarter of the globe, he transfers with the goods necessarily the license to use them wherever the purchaser pleases. 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 wherever he pleases *as against himself*."

But when the patentee has assigned his patent in France and kept it to himself in England, the French assignee may not, nor may a purchaser from him import and vend or use the goods made in France in England (m). In this case the sale of the article can only imply such license as the vendor himself has, and the vendor has no right to sell in England.

Conversely, if the patentee had assigned his patent rights in England he could not manufacture in France and sell in England, and the sale of an article in France

(i) See also *Wright v. Hitchcock*, 39 L. J., Ex. 97.

(k) *Townsend v. Haworth*, Higgins' Digest of Patent Cases, Pt. 2, p. 60; *Sykes v. Howarth*, L. R., 12 Ch. D. 826.

(l) L. R., 6 Ch. App. Cas. at p. 245.

(m) See the rule laid down in *Caldwell v. Vanclissengen*, 9 Hare, 415.

would carry with it no implied right to import into or sell in England. But if the rights under the patent are vested in one and the same person for both France and England, or if there are no monopoly rights in France but only in England, the patentee could make and sell in France and restrain the purchaser from selling or using the article in England, unless indeed there was a special agreement for that purpose; and then such agreement could not be held to attach to the article so as to prevent any person in whose hands it might come from importing it (*n*).

(*n*) *Betts v. Willmott*, 6 Ch. App. Cas. 239.

CHAPTER XIII.

THE REMEDY—INJUNCTION.

THE remedy sought or granted in an action for infringement may consist of an injunction, together with an account of sales and profits, or damages.

The judicature acts and the rules which have been made for the governing of the practice of the courts have introduced great changes in the method of procedure. The old practice of moving for an injunction by a suit in the Court of Chancery, and of trying the validity of the patent at common law, has disappeared; and in its place the patentee seeking to enforce his rights commences but **one action in which he claims, and if entitled to, obtains every remedy which was formerly granted to him by the dual process.**

Every patentee proceeding against an infringer must prove the validity of his patent and his title to an injunction; that being so, and the right to the injunction hanging so completely upon the question of validity, it is obvious that the new procedure and the new power of both divisions of the High Court of Justice to grant complete and sufficient remedies and to try every question is of great advantage to persons in possession of patent rights.

There are two forms of injunction, the interlocutory injunction and the perpetual injunction.

The interlocutory injunction stands very much upon the same footing, and will be granted for similar reasons and upon the same conditions that an injunction was formerly awarded by the Court of Chancery when an action was directed to be tried at common law.

The perpetual injunction is granted after trial, and binds the parties against whom it is granted during the continuation of the term of the patent.

An interlocutory injunction will be granted whenever there has been such **working, user and enjoyment** of the patent rights as will satisfy the Court that there are strong *primâ facie* reasons for acting on the supposition that the patent is valid.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge v. Richardson* (o), said: "It is then said in cases of this sort the universal rule is that if the title is not clear at law the Court will not grant or sustain an injunction until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent and puts his invention in execution and has proceeded to a sale, that may be called possession under it; however doubtful it may be whether the patent can be sustained, this Court has lately said **possession under a colour of title** is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only colour and not real title."

And in *Gardner v. Broadbent* (p) Sir J. Stuart, V.-C., said: "I wish it to be understood that the law of the Court is that laid down by Lord Eldon in the *Universities of Oxford and Cambridge v. Richardson*."

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be considered by the Court sufficient reason for granting an interlocutory injunction.

Where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory

(o) 6 Ves. 689.

(p) 2 Jur., N. S. 1041.

injunction will be granted. In *Dudgeon v. Thompson* (*q*) Jessel, M. R., said: "The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

So in *Betts v. Menzies* (*r*), Wood, V.-C., said, "The law of this Court is, that where the patentee has had long enjoyment, then he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful." On the other hand, we find Lord Westbury laying it down in *Hills v. Evans* (*s*), "It is the habit and the rule of the Court not to grant that injunction (to restrain infringement), at all events at the hearing, and not to make it perpetual unless the legal validity of the patent has been conclusively established."

Sometimes an application for an interim injunction is advisable where there has not been long user of the patent, or a decision in favour of the patentee. In such cases the plaintiff must be prepared to give *prima facie* satisfactory evidence of the validity of his patent (*t*).

These decisions certainly appear contradictory, but perhaps this principle may be gleaned from them—that the Court will consider the **balance of convenience** in each particular case. If it should appear that irremediable injury will be sustained by the defendant if an

(*q*) *Russell v. Cowley*, 2 Coop. C. C. 59 (n.); but see *Crosskill v. Ivory*, 10 L. T. R. 459.

(*r*) 3 Jur., N. S. at p. 358. See also *Davenport v. Goldberg*, 2 H. & M. 282; *Penn v. Bibby*, 3 L. J., Eq. 308; *Muntz v. Foster*, 2 Web.

P. C. 95.

(*s*) 4 De G., F. & J. at p. 289.

(*t*) *Gardner v. Broadhurst*, 2 Jur., N. S. 1041; *Davenport v. Jepson*, 1 N. R. 73; *Renard v. Levinstein*, 10 L. T., N. S. 177.

injunction goes which may afterwards appear unfounded, the Court will require a very strong case to be made out by the plaintiff before granting such an injunction (*u*), and the converse would equally appear.

In *Bickford v. Skewes* (*v*), Shadwell, V.-C., said, "I have nothing to do with any other case than the case before me."

The Court will not infrequently grant or refuse the injunction until the hearing upon terms; the terms on the plaintiff being that he shall be answerable in damages, or on the defendant that he shall keep an account of the material manufactured, or of the articles sold, in pursuance of the patent process. And in considering which course should be adopted the Court will be influenced chiefly by the balance of convenience and the probability of injury to either side (*w*).

In *Plimpton v. Spiller*, James, L. J., said, "The Court, not forming an opinion very strongly either one way or the other whether there is an infringement or not, but considering it as a fairly open question to be determined at the hearing, and not to be prejudiced by any observations in the first instance, reserves the question of infringement as one which will have to be tried at the hearing and which it will then have to consider. There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo*—for that is really what the Court has to do, to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, 'We will not stop a going trade. We will not adopt a course which will result in a very great difficulty in giving compensation on the one side or on the other. We have to deal with it as a practical question, in the best way we can.' I think, on

(*u*) *Neilson v. Forman*, 2 Coop. 61 (n.).

(*v*) 1 Web. P. C. 213.

(*w*) *Neilson v. Thompson*, 1 Web. P. C. 278; *Bridson v. M'Alpine*, 8 Beav. 229; L. R., 4 Ch. D. 289.

the whole, that the Master of the Rolls has made the right order, viz., by granting the injunction and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make if he should ultimately turn out to be in the wrong, and that it would not be right in this case merely to put the defendant upon the terms of keeping an account which, I conceive, might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right." In the same case the present Master of the Rolls, Sir W. B. Brett, said, "There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and an established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers."

Injunctions are now granted pursuant to the Judicature Act, 1873, sect. 25, sub-sect. 8:—"A mandamus or an injunction may be granted, or a receiver appointed, by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made, either unconditionally or upon such terms and conditions as the Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any cause or matter, to prevent any threatened or apprehended waste or trespass, such injunction may be granted, if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under

any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act sought to be restrained under any colour of title; and whether the estates claimed by both, or either of the parties, are legal or equitable.”

It will be observed that this section confers upon the Court very wide limits within which, in its discretion, it may grant injunctions. It sweeps away a great deal of the technical rules which had been from time to time laid down by the Court of Chancery for the granting of injunctions, and it practically substitutes for them the opinion of the judge trying each particular action as to the balance of convenience upon a consideration of the facts of the case.

The basis of an injunction is the threat actual or implied on the part of the defendant, that he is about to do an act which is in violation of the plaintiff's rights; so that not only must it be clear that the plaintiff has rights, but also that the defendant has done something which induces the Court to believe that he is about to infringe those rights.

The fact that he has been guilty of an infringement of the patent rights will, under circumstances, be evidence that he intends to continue his infringement, but whether he has actually infringed the patent or not, it will be sufficient if he has **threatened to infringe it**. Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.

In *Freearson v. Loe* (x), Jessel, M. R., said:—“ I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee, without infringement having been proved; but, in my opinion, on principle there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think for this reason:

(x) L. R., 9 Ch. D. at p. 65.

where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patentee is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury, where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury, as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed, and about to be carried into execution, to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course it must be plain that what is threatened to be done is an infringement.”

The actual infringement of the patent is taken by the Court to imply an intention to continue the infringement, notwithstanding any promises not to do so, and an injunction will be granted. Vice-Chancellor Shadwell, in *Losh v. Hague* (y), said:—“If a threat had been used, and the defendant **revokes the threat**, that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make not to do the same thing again.”

If the fact of actual infringement is relied upon, and not a mere threat, it will be necessary to show very clearly that what has been done amounts to an infringement. In *Hancock v. Moulton* (z), it was held that the

(y) 1 Web. P. C. 200.

(z) M. Dig. 506.

evidence must be so perfect, that if it were a motion to commit for the breach of an injunction, the Court would commit upon it. If the evidence of infringement is conflicting, either by reason that it is denied that the acts complained of were done, or that such acts as were done did not amount to an infringement of the patent, the Court should not grant an interim injunction before the hearing of the action (*a*).

If the evidence relied upon for the injunction is the sale by the defendant of the patented article, and not the manufacture, the plaintiff must show that such patented article was not made by himself or his licensees (*c*).

In the case of *Adair v. Young* (*b*), the defendant was the captain of a ship which was fitted with certain pumps which were an infringement of the plaintiff's patent. No act of using the pumps was proved; but it was shown that the ship was not supplied with other pumps. It was held that the possession of the pumps under such circumstances, although not of itself amounting to an infringement, was evidence upon which the Court would act that the defendant intended to use the pumps, should occasion require. And the Court, Brett and Cotton, L. JJ., James, L. J., dissenting, granted an injunction.

Lord Justice James, in giving his reasons for dissenting, said: "I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented. Now, a master who comes on board ought not to be answerable on the ground that, when he takes the command, there is on board a pump which infringes the patent. He does

(*a*) *The Electric Telegraph Co. v. Nott*, 2 Coop. 41.

(*b*) L. R., 12 Ch. D. 13.

(*c*) *Betts v. Willmott*, L. R., 6 Ch. App. Cas. 239.

not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of the ship; he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. An injunction, therefore, can only be granted on the principle of *quia timet*, and in applying that principle I think that it would be a right exercise of the discretion of the Court not to grant an injunction against a master who has done nothing wrong when there is no difficulty in finding and suing the owner of the ship.”

The Court, however, seem to have been of opinion that the ground upon which an injunction should be granted is not whether the defendant has done anything wrong or not, but whether there was evidence of an intention to use the patented invention. The Court held that the circumstances of the case showed an intention in the captain to use the invention.

No injunction will be granted where the patentee has not proceeded with reasonable speed to prosecute infringers (*d*). But in cases where there are several infringers he is not justified in commencing a vast multitude of actions and applying for injunctions in each (*e*). His proper course is to “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 will 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

(*d*) *Losh v. Hague*, 1 Web. P. Beav. 1.
 O. 201; *Bacon v. Jones*, 4 My. & Cr. 438; *Bridson v. Benecke*, 12
 (e) *Foxwell v. Webster*, 3 N. R. 103, at p. 180.