

**LETTERS PATENT FOR
INVENTIONS.**

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THE
LAW AND PRACTICE^{c#}
RELATING TO *angl 3*
LETTERS PATENT FOR
INVENTIONS.

WITH
EXAMPLES OF SPECIFICATIONS
AND A FEW PRECEDENTS
FOR THE TRANSFER OF INTERESTS IN LETTERS PATENT.

BY
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PREFACE.

IN this edition I have cut out a great deal of matter which was strictly speaking irrelevant to the subject of Patent Law, and I have brought the subject up to date by including recent decisions, and the Acts of 1885, 1886, and 1888. I have also added a few examples of specifications which have successfully passed the ordeal of litigation, and which may be useful in considering the cases in which they were contested, and in drafting. The Precedents for the Transfer of interests in letters patent are limited to the most elementary instances—the valuable work of Mr. Morris on Patent Conveyancing making it unnecessary to treat the subject at greater length.

The great increase in commercial importance which was given to Patents by the Act of 1883, has opened the eyes of the legislature to the magnitude of the interests which are entrusted to the profession of Patent Agents, and to the imperative necessity in the interests of the public of ensuring competence and integrity in that profession. It is difficult to conceive any human pursuit which requires greater qualifications than that of

a Patent Agent—his legal acquirements must be considerable, he must be an expert in mechanics, chemistry, and the whole range of applied science, and he must be capable of applying this varied knowledge to the preparation of clear and precise specifications. One day he is engaged on the details of a locomotive, the next on a complex chemical process, and the third on a specification for electrical transformers. It is not too much to say that the legislature has not stepped in one day too soon in requiring that the profession of a Patent Agent should be placed on a par with the other learned professions, and that the public should be to some extent assured of reasonable competence in the men that they employ. In future Patent Agents will be registered or enrolled much in the same way that Barristers or Solicitors are, and thus not only will an opportunity be given to the governing body of testing the knowledge of the members which they admit, but a control will be exercised so as to ensure the high tone which should prevail in the profession.

Since the issue of the first edition of this work, although some changes have been introduced in the Practice, but little alteration has been made in the law of Letters Patent. *Siddell v. Vickers* may be pointed to as one of the most important cases, weakening as it does greatly the importance which has always been attached to *conformity* between the provisional and complete specifications, and further, limiting the effect of

section 5 of the Act of 1883, requiring a claim to the complete specification.

The personnel of Patent lawyers has been somewhat changed, though fortunately no very familiar faces have been removed by death.

As Attorney-General, Sir Richard Webster has been in a position to use his great experience in Patent Law in settling upon a safe and reasonable basis the law and practice before the comptroller and the law officers. Mr. Fletcher Moulton has taken his place as a leader in that branch of law where the attainments of a senior wrangler are of pre-eminent value. Sir Frederick Bramwell, now raised to the dignity of a baronet, Mr. Imray and Dr. Hopkinson still delight us with the ingenious theories by which they show with perfect impartiality that either or both sides in a patent action may be absolutely right. The great Author of "The Correlation of Forces" has retired from the bench, regretted greatly by his compeers, and by those members of the junior bar who had the honour to appear before him, and who will long remember the kindly consideration which they always received at his hands.

THOMAS TERRELL.

NEW COURT, TEMPLE.

8th January, 1889.

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S. L.

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 or 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 rights 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 have been devoted to obtaining those 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 *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. 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 consideration 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

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

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

(c) Godbolt's R. 253.

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.

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.

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.

When the Act of 1883 was passed, doubts were expressed as to whether the effect of sect. 5, sub-sect. 2, was not to do away with the granting of patents for what is known as communications from abroad, these doubts were shared by the author particularly with reference to the case of *Milligan v. Marsh* (supra). The question has since been in a

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

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

manner touched upon in the case of *In re Avery's* patent (*f*), where although in no way deciding the point it appears to have been considered that such a patent might be granted. Stirling, J. (subsequently affirmed by the Court of Appeal) in giving judgment said, "The rules which have been framed by the Board of Trade under the power conferred upon them by sect. 101 of the statute contain provisions which the statute itself does not contain, in reference to an application for a grant for an invention which has been communicated from abroad. Rule 27 provides that the application for such a grant shall be in the form 'A' in the 2nd schedule, and that form is different from that which is prescribed by the statute and from the terms in which Lindsay made the application" (his Lordship read the form and continued) "that form has been framed so as to fit in with sect. 5, sub-sect. 2, of the statute which enacts that an application must contain a declaration . . . that the applicant is in possession of an invention, whereof, he . . . claims to be the true and first inventor. That form has not been followed in this case. There is no decision that a patent taken out as for an original invention, when in fact the invention patented was communicated from abroad, is void, though there is in the case of *Milligan v. Marsh* (*supra*) what appears to be a dictum of Vice-Chancellor Sir W. Page-Wood, to that effect, nor is there any decision that where an invention is partly original and partly communicated from abroad, the part communicated from abroad ought to be distinguished in the specification; but in the case of *Renard v. Levenstein* (*g*), the Lord Justice Knight Bruce expressed great doubt upon the point." And at p. 318: "That being so notwithstanding that the invention was founded on a communication received from abroad it appears to me that it well might be held that the statutory declaration made by the applicant was true in point of law."

(*f*) 36 Ch. D. 307.

(*g*) 10 L. T., N. S. 177.

Only one of the applicants need make the declaration, a capitalist or other person or persons may join an inventor and obtain a valid joint patent (*h*).

Where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without the consent of the others (*i*).

As to the rights of such joint grantees to the profits made by granting licenses, *quaere* (*ib*).

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.

(*h*) See express enactment, sect. 5 of Patents, &c., Act, 1885.

(*i*) *Mathers v. Green*, L. R., 1 Ch. 29.

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

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

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 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

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

(c) 2 B. & Ald. 345.

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

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

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 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:

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

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

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

“ 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 *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.

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.”

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

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

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 showing 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

(l) 1 C. B. 574.

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

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 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 that we think it at the very least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation, . . . It is to be borne in mind

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

that the report then made belonged absolutely to the State. Every fact and figure in it had been ascertained and 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 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 the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.*" 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

(o) L. R., 6 Ch. App. 274.

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

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 Dering's Patent* (q), 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 an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same. And such protection from the consequences of use and publication is in 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

(q) L. R., 13 Ch. D. 393.

here so far as concurrent application is brought about by reason of one man fraudulently appropriating the invention of another.

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

Afterwards came the decisions of *Darcy v. Allin* (*t*), and

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

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

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

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. 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

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

(x) 2 H. Bl. 491.

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

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 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

(z) *Beard v. Egerton*, 3 C. B. p. 710, per Earl, C. J.

97.

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

(b) *Nickels v. Ross*, 8 C. B. at

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

the subject of the patent being, in fact, a communication from abroad, the patent is void. *Milligan v. Marsh* (d).

“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.

(d) 2 Jur. N. S. 1083 ; but see remarks of Sterling, J., upon this case, *In re Avery's patent*, 36 Ch.

D. at p. 316. See, also, *Renard v. Levinstein*, 10 L. T. N. S. 177.

(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 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

(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; *Cross-*

ley v. Potter, Mac. P. C. 240; *Patterson v. The Gas Light Co.*, L. R., 3 App. Cas. 246.

(b) 8 T. Rep. 95.

(c) 2 H. Bl. 463.

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 Heath 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

(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.

one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose." 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 discovery

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

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

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

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

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

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

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

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

(*p*) 3 Inst. 184.

at 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 licence 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 regard

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

P. C. 115.

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

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

(*s*) 2 Web. P. C. 103; see also

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

Hayward v. Hamilton, Griffin,

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 *Jackson v. Needle* (x) North, J., said : "The plaintiff's first witness seemed to have an idea that because the parcels post was new, therefore a thing to be sent through the parcels post was new : there is no foundation for that."

In the case of *Steiner v. Heald* (y), 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

(x) Griffin, P. C., at p. 134.

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

the same process of acid and hot-water to the spent madder ; since his invention the spent madder, which was previously worthless, became valuable.

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* (z) 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 (a). In *Brook v. Aston*, Baron Martin said (b) : “ The application of a well-known tool

(z) Macrory's P. C. 164.

(a) 5 H. L. C. 707.

(b) 8 E. & B. 485.

to work previously untried materials, or to produce new forms, is not a subject of a patent."

In *Bamlett v. Picksley* (c), Blackburn, J., said: "There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Take this example. It was discovered that by taking flour and making it into tough dough by means of machinery you could spin it into a pipe known as macaroni pipe. An ingenious man knowing how to spin flour into a pipe, it occurred to him to take red-hot iron, and spin that into pipes by machinery in the same way as flour was spun into a pipe for macaroni. That was not an invention as it turned out, but had that been so, and had he been able to spin the iron in the same way as flour was spun into pipes for macaroni, few men I think would deny that there was an invention there, it being a product so completely new, and that it would be an invention for making a new manufacture which others did not make, because the result was so totally different, even although in fact the machinery which was used for the purpose, except that it was made stronger, would be indentially the same as the machinery originally used for the purpose of making the macaroni."

It is evident to anyone considering these cases, that the border line is exceedingly fine. In *Penn v. Bibby* (d), Lord Chelmsford, L. C., recognized the difficulty of stating any definition which should be applicable to every 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:

(c) Griffin, P. C., at p. 42. See Office Reports, 17.
also *Croysdale v. Fisher*, 1 Patent (d) L. R. 2 Ch. App. 127.

“ 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.* (e), 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 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 (f).” 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 (g).

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

(f) 11 H. L. Cas. 654.

(g) *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.

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 *Huddart v. Grimshaw* (*h*), 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 a new combination of materials previously in use for the same purpose (*i*).

In *Foxwell v. Bostock* (*k*), 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 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 (*l*).

In *Crane v. Price* (*m*), the patentee, in his specification, after specifically disclaiming the use of the hot blast or the

(*h*) Dav. P. C. 267.

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

(*k*) 12 W. R. 725. See also *Harrison v. The Anderston Foundry Co.*, *infra*, p. 98; *Hayward v. Hamilton*, Griffin, P. C. 115; and *Moore v. Barrett*, Griffin, P. C. 158.

(*l*) *Bovill v. Keyworth*, 7 E. &

T.

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; *Dangerfield v. Jones*, 13 L. T. R., N. S. 142.

(*m*) 1 Web. P. C. 393.

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* (n), 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 (o).

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

(n) L. R., 7 Ch. 584.

Co., L. R., 7 Q. B. D. 305.

(o) *Saxby v. Gloucester Wagon*

(p) L. R., 5 H. L. 205.

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* (q), decided in 1567, the patent was in consideration of the patentee having brought into the country the making of frisadoes as they were made in Haarlem, in Amsterdam, being not used in England. The infringers defended the patentees' bill in the Exchequer

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

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. A patent was 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 (r)."

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

(r) 1 Web. P. C. 7; *Darcy v. Liardet v. Johnson*, 1 Web. P. C. 52 and 53.
Allin, 1 Web. P. C. 6; *Mitchell v. Reynolds*, 19 Mod. R. 130; (s) 1 Web. P. C. 64.

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* (t): "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* (u), 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 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* (x), Cresswell, 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

(t) 1 Web. P. C. 508.

(u) 1 Web. P. C. 534. See also *Croysdale v. Fisher*, 1 Patent Office Reports, 17; *Lewis v. Marling*, 10 B. & C. 26; *Minter v. Mower*, 1

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

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

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* (y) : "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 afterwards 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

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

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

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

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 *Dollond's Case* (b). In that case the objection to Dollond'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, Dollond was to be considered the inventor (c).

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

(a) 3 E. & B. 256.

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

(c) See also the remarks of Buller, J., in *Boulton v. Bull*, 3 H.

Bl. 463 to 470; and Mr. Justice Dallas in *Hill v. Thompson*, 1 Web. P. C. 244.

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

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. 50).

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 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

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

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

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

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 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

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

P. C. 142.

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

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

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

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 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

(*l*) 10 H. L. C. 117. See also *and Barlow v. Baylis*, Griffin, *Stoner v. Todd*, L. R., 4 Ch. D. 58, P. C. 44.

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*).

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*

(*m*) See also *Betts v. Neilson* 6 Ch. D. 412; also *Patterson v. and Betts v. de Vitre*, L. R., 3 Ch. 429; *Neilson v. Betts*, L. R., 5 H. L. 1. *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.

(*n*) *Young v. Fernie*, 12 W. R. 901; *Plimpton v. Spiller*, L. R.,

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."

In *Philpott v. Hanbury* (q), however, Grove, J., said: "What I am going to say now is an expression of opinion that is rather obiter. . . . As a matter of fact my opinion is that there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there

(o) 29 L. J. Ch. 409.

143.

(p) 31 L. J. Ch. 463. See also
Lawrence v. Perry, Griffin, P. C.

(q) 2 P. O. R. 43.

is a distinction ; but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled—the higher class of skilled workmen), would enable them to understand it. If it be such it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent.”

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 bookseller'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” (*r*). 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 (*s*).

In *Otto v. Steel* (*t*), where a French treatise was placed in the British Museum Library in 1863, it was held by Pearson, J., that having regard to the arrangements of the library there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876. The library arrangements were as follows : There was no access to the public to any part of the library of the British Museum beyond the reading room. The public had

(*r*) Per M. R. in *Lang v. Gis* *Harrison, Cox, Walker & Co.*,
borne, 31 Bevan, 135. L. R., 21 Ch. D. 720.

(*s*) *United Telephone Co. v.* (*t*) 31 Ch. D. 241.

access to the general catalogue and to books of reference kept in the reading room. In the general catalogue of the British Museum the printed books were referred to under the names of their authors. The treatise in question was entered in the catalogue under the name of Beau de Rochas, and in no other place. It was itself kept in an inner room, and it could only be obtained by one of two means, either by some person knowing of the book and writing the name of the book on a piece of paper and requesting that the book might be furnished to him; or if a reader wanted to find something on a particular subject, and went to the superintendent and asked what books there were that he had better read. The superintendent, if not able to give the information, would direct one of the assistants to take him to that section of the library where such books were likely to be found, and would desire him to let the reader look over the titles of those books, and select what book he pleased out of that section of the library.

But in *Harris v. Rothwell* (u) it was held by the Court of Appeal that, *primâ facie*, a patentee is not the first inventor if before the date of his patent an intelligible description of his invention either in English or in any other language commonly known in this country, was known to exist in this country either in the patent office or in any other public library to which persons in search of information on the subject would naturally go for information. But if it be proved that the foreign publication, although in a public library, was not in fact known to be there, the existence of the publication in this country is not fatal to the patent. *Otto v. Steel* (*supra*) was distinguished on the ground that there the anticipating publication was proved not to be known to be in the public library.

An inventor may invalidate his own invention by previous

(u) 35 Ch. D. 416; 56 L. J. Ch. 459; 56 L. T. 552.

publication in a specification. For instance, if an inventor applies for letters patent and files a complete 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.

Under the Act of 1883 it is clear that if he only filed a provisional specification there would be no publication, since provisional specifications which are subsequently abandoned, are not published. In *Oxley v. Holden* (x) it appeared that on the 17th March, 1858, the plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages. On the 10th April, 1858, he obtained a second provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The first application was abandoned, and the second carried to completion—*there was no evidence that between the date of the first application and the second the invention had in any way been put in practice or published*: held, that the first application did not invalidate the patent. In *Lister v. Norton* (y) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J., held that the reasoning of *Oxley v. Holden* applied to this case, and said, “But reverting to the point of law, I think that this user in public is covered by the grounds on which the Court of Common Pleas decided *Oxley v. Holden*. The Court held that the protection of the first provisional specification extended down to the grant of the patent, and made this one of the grounds of their decision. A provisional specification was the creature of the Act of 1852. That Act, after providing for the filing of such a specification which is to describe the nature of the invention, and

(x) 8 C. B. N. S. 666.

(y) Griffin, P. C., at p. 151—154.

for the grant of the certificate, proceeds in the 8th sect. to enact that ‘Thereupon the invention therein referred to may during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same.’ The phrase ‘to be granted for the same’ obviously means in this section, and in the 9th section (which relates to the filing of a complete specification in the first instance) for the same invention, and cannot be construed as referring to the application or petition.” So far as the author can ascertain this judgment was not appealed from, nor does it appear to have been discussed in any subsequent cases. Should the decision be upheld the results will be curious.

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 understand 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* (z), 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 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 (α).

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

(z) 2 M. & W. 544.

(α) 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. 528; *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.

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 (b).

Neither does the manufacture and sending out of samples for the purpose of experimenting as to the satisfactory character of the invention (c).

Not only must the invention be new, but **the whole** of the **invention** which is claimed in the specification **must be new** (d); 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 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. Hardcastle* (e) 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* (f), 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* (g)

(b) *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. *Edison and Swan*

Electric Light Co. v. Woodhouse, Griffin, P. C. 90.

(c) *The Useful Patents Co. v. Rylands*, Griffin, P. C. 234.

(d) *Plimpton v. Spiller*, L. R. 6 Ch. D. 412, and per Jessel, M. R., in *Frearson v. Lee*, L. R. 9 Ch. D. 58.

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

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

(g) 4 B. & Ald. 541.

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 (*h*).

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 (*i*).

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 of 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 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* (*k*), 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 (*l*).

(*h*) *Muntz v. Foster*, 2 Web. P. C. 112. v. *Gray*, 7 H. & N. 25.

(*k*) *Noy*, R. 182.

(*i*) *Templeton v. Macfarlane*, 1 H. L. C. 595; see also *McCormick*

(*l*) *Edgebury v. Stephens*, 1 Web. P. C. 35; *R. v. Arkwright*, 1

In *Boulton v. Bull* (m), 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* (n), 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 of invention, or an extensive operation, to support the patent, but that the invention when carried out in some way materially improves the process or 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 improvement**; for instance, a man might invent a large and

Web. P. C. 72; *Turner v. Winter*,
1 Web. P. C. 80.

(m) 2 H. Bl. 478.

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

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 ” (o).

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 to be performed (p). 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 (q).

In *Frearson v. Loe* (r), 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

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

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

(q) *Haworth v. Harcastle*, 1 Web. P. C. 483.

(r) L. R., 9 Ch. D. 64.

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 (s).

In the case of a patent for a combination it appeared that in putting the invention into practice the inventor did not use everything described in the specification ; it was objected that the specification was bad on this account. The objection was overruled (t).

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

In *Plimpton v. Malcolmson* (x), 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.

(s) *Losh v. Hague*, 1 Web. P. C. 202. P. C. 237 ; *Bloxham v. Elsee*, 1 C. & P. 565 ; *Cornish v. Kecne*, 1 Web.

(t) *Ehrlich v. Ihlee*, W. N. 3rd March, 1888. P. C. 506.

(x) L. R., 3 Ch. D. 557.

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

CHAPTER IV.

THE CONSIDERATION (*continued*)—THE SPECIFICATION.

THE third condition which supports the 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 (a).*

(a) “Whereas sub-sect. 2 of s. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that

sub-sect. mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts; Be it there-

“(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 (b).*

“(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*

fore enacted that: The declaration mentioned in sub-sect. 2 of s. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act or not, as may be from time to time prescribed.” Patents, &c., Act, 1885, s. 2.

(b) By the Patents, &c., Act, 1886, s. 2, it is provided: “The requirement of sub-sect. 4 of s. 5 of the Patents, &c., Act, 1883, as to drawings shall not be deemed to

be insufficiently complied with by reason only that instead of being accompanied by drawings the Complete Specification refers to the drawings which accompanied the provisional specification, and no patent heretofore sealed shall be invalid by reason only that the Complete Specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.”

subsequent time within nine months from the date of application" (c). (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." Subsect. 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 the complete specification, the comptroller shall advertise the acceptance, and the application and specification or specifications with the drawings (if any), 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

(c) This has been varied by the Patents, &c., Act, 1885, by sect. 3 of which it is enacted: "Whereas under the principal Act, a complete specification is required (by s. 8) to be left within nine months and (by s. 9) to be accepted within twelve months, and a patent is required (by s. 12) to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times; Be it therefore enacted as follows: A complete specification may be left and ac-

cepted within such extended times not exceeding one month and three months respectively after the said nine and twelve months respectively, as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act."

disclaimer, correction or explanation, stating the nature of such amendment, and his reasons for the same." Sub-sects. 2, 3, 4, 5, 6, 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 disclosure 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 (*d*).

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 (*e*).

In the case of *Ree v. Else* (*f*), 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 (*g*). 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* (*h*), 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 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* (*i*), the title for the invention was for a machine

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

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

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

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

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

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

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* (*k*), 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* (*l*), 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* (*m*), 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 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

(*k*) 3 C. & P. 611.(*l*) 4 B. & Ald. 552.(*m*) 8 Q. B. 1054.

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 patent 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" (*n*). 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 (*o*).

In *Neilson v. Harford* (*p*), 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."

The question of **variance** between the title and the specification is one upon which the decided cases can have but little 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 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, no prior decision will be absolutely binding (*q*).

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

(*o*) *Sturtz v. De la Rue*, 5 Russ. 322; *Morgan v. Seaward*, 1 Web.

P. C. 196; *Stead v. Williams*, 2 Web. P. C. 137.

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

(*q*) *Bainbridge v. Wigley*, Higgins' Digest, 155; *Hill v. Thomp-*

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. In *Woodward v. Sansum* (r) the Court of Appeal held that all a patentee need do in his provisional specification is to describe his invention. He need not go on therein to describe any method of carrying out the invention, but, whether he do so or not, if a different or further mode of carrying out the invention is described in his complete specification that will not invalidate the patent so long as such new method of carrying out is fairly within the invention as described in the provisional specification. In *Moseley v. Victoria Rubber Co.* (s) Chitty, J., laid it down that the object of a provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details of the 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 in-

son, 1 Web. P. C. 239 ; *Nickels v. Hitchcock*, L. R. 5 Ex. 37.
Haslam, 13 L. J., C. P. 146 ; *Croll* (r) 56 L. T. 347.
v. Edge, 9 C. B. 479 ; *Wright v.* (s) 57 L. T. 142.

vention," 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 which should be placed upon what is a sufficient description of the nature of the 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 (t)*, Pollock, C. B., said: "The

(t) 10 Jur., N. S. 955.

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 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." 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* (*u*) 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" (*x*).

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

(*x*) *Foxwell v. Bostock*, 12 W. R. 723.

Lord Chelmsford, in *Penn v. Bibby* (*y*), 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 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

(*y*) L. R., 2 Ch. App. 127.

necessity of any disclaimer (z). In *Stoner v. Todd* (a), 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 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* (b), 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 coat-

(z) *Thomas v. Welch*, L. R., 1 C. P. 192. See also the remarks of Lord Chelmsford in *Penn v. Bibby*, quoted above.

(a) L. R., 4 Ch. D. 58.

(b) L. R., 3 App. C. 1055. See also *Lucas v. Miller*, Griffin P. C. 156.

ing 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 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. A patent is not rendered invalid by the fact that the complete specification describes something different from anything specifically referred to in the provisional specification, provided that what is so described comes within the nature of the invention described in general terms in the provisional specification (c).

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

(c) *Siddell v. Vickers*, 39 L. R., Ch. D. 92.

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 *bona 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 (*bb*).

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 *bona 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 *Edison and Swan Electric Light Co. v. Woodhouse* (*c*), a patent dated as to its provisional specification, November, 1879, and as to its final specification, 10th May, 1880, claimed an electric lamp with a carbon filament for its illuminating conductor. The patentee took out a subsequent patent, dated as to its provisional specification, December, 1879, for a method of making carbon filaments for electric lamps. Objection was taken that inasmuch as at the time of filing the complete specification of the first patent the patentee knew the subject-matter of the second, he should have included it in the first, and that therefore the first patent was bad by reason of concealment. This objection was overruled. In *Mozeley v. The Victoria Rubber Co.* (*d*), Chitty, J., held, that if the patentee, between the time of filing the provisional and the

(*bb*) As to required conformity between provisional and complete specification, see "The Provisional

Specification," *supra*.

(*c*) 32 Ch. D. 520.

(*d*) 57 L. T. 142.

complete specification, discovers any improvement in the manner in which the invention is to be performed, he is not merely at liberty, but is bound, to give the public the benefit of his discovery. In *Harmar v. Playne* (e), 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* (f), 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 have implicitly followed the judgment of Baron Alderson (g).

In *Coles v. Baylis* (h), the invention was for “Improvements relating to the preparation of lithographic printing surfaces.” It was alleged by the defendant that the plaintiff was acquainted with an improved method of using the lithographic printing surfaces after they had been prepared by the patented process, but that he had

(e) Dav. P. C. 316.

Web. R. 278.

(f) 1 Web. P. C. at p. 182.

(h) 3 Patent Office R. 178, Griffin

(g) See *Neilson v. Thompson*, 1 P. C. 57.

not disclosed the same in his specification, and that therefore the patent was bad. Bacon, V.-C., overruled the objection, and said :—“ It is to be said that the specification is bad because he knew a mode by which a stone prepared according to the specification may be more conveniently or more usefully worked than anybody but himself knew, that he was bound to put that into the specification. I know no authority for saying that.”

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

In the case of *The King v. Arkwright* (*k*), 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 (*l*). 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* (*m*), 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.”

In *Edison and Swan Electric Light Co. v. Woodhouse* (*n*), Lindley, L.J., said :—“ The next objection that requires notice is, that it is contended that the evidence shows that it is essential to success to increase the temperature gradually, and that the specification is **insufficient** because it does not point this out. Now the evidence certainly shows that

(*i*) *Hornblower v. Boulton*, 8 T. R. 95 ; *Crossley v. Beverley*, 9 B. & C. 63.

(*k*) 1 Web. P. C. 72 ; Dav. P. C. 61.

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

(*m*) 2 Mer. 451.

(*n*) Griffin, P. C. at p. 95.

the maintenance of a high temperature is that which distinguishes Cheesbrough's process from Despretz's experiment, and although Professor Dewar points out the importance of a gradually increasing current, neither he nor any other witness says that the temperature ought to be low to begin with, and be gradually raised. Their evidence only comes to this—that the temperature must be kept up and the electric current must be increased, or the temperature will fall. But the patentee himself tells you this. He says that the temperature must be as high as 7,000° F., and the sentence in the specification, 'as the carbon increases in size more current is required to maintain the temperature,' is shown by the evidence to be useless, and an obvious truism to those who understand the subject, unless the sentence is understood to be a direction to keep up the temperature; and when we find that in fact no difficulty is experienced by reason of defective instructions on this point, the Court cannot hold as a matter of law that the specification is not sufficiently explicit. If the defendants had shown that the directions as to temperature were not practically sufficient to enable a competent person to make the patented articles, the case would be very different; but they have not attempted to do this; they rely on the words used, and on the evidence as to temperature already alluded to. This, in our opinion, is not sufficient for our purpose. If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court and not for a workman to construe the specification; but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that as regards clearness of description the specification is in point of law sufficient."

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 (*o*). The question of the sufficiency of the specification is a question for the jury (*p*).

The **intelligibility** of the specification is a question for the jury (*q*). 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 (*r*).

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 *Hallett v. Hague* (*s*), 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 (*t*).

(*o*) *Hill v. Thompson*, 3 Mer. P. C. 295.
626.

(*p*) *Bickford v. Skewes*, 1 Q. B. 938; *Wallington v. Dale*, 7 Exch. 888; *Parkes v. Stephens*, L. R., 8 Eq. 358.

(*q*) *Neilson v. Harford*, 1 Web.

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

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

(*t*) *Haworth v. Hardcastle*, 1

Web. P. C. 484.

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.* (u), 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 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* (x), 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."

Per James, L.J., in *Binney v. Feldtman* (y), "giving that benignant interpretation which every instrument is entitled to have."

Per Cotton, L.J., in *Cropper v. Smith* (z), "It was said that one ought to interpret in favour of a good inventor, benignantly the construction of his specification. Now I am not satisfied to what cases that is to be applied. If it is to be applied to cases where the objection is that the specification is of such a character that it does not describe sufficiently the nature of the invention, that language may bear perhaps the not unreasonable interpretation, that you are to get all the knowledge you can with reference to the subject matter of the patent, and then you must in an intelligent frame of mind, and not in a frame of mind which shuts its

(u) L. R. 4 Ch. D. 612.

(x) L. R., 6 Ch. D. 422.

(y) Griffin, P. C. at p. 50.

(z) Griffin, P. C. at p. 62.

eyes to what is possibly not stated as clearly as it might be, consider what is the real meaning of the specification, not only of itself, but having regard to the knowledge existing at the time, and which would exist in the minds of those to whom the specification was addressed. Of course the judicial mind does not know, without evidence, all the facts which persons engaged in the trade would know, and it is merely saying, 'Now try and put yourself in the same position as regards knowledge as those to whom the specification was addressed, and then reasonably and intelligently construe it.'" See also the remarks of Bowen, L.J., which follow at p. 64.

In *Needham v. Johnson* (a), Lindley, L.J., said, "I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but of course if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid."

Lord Chelmsford, in *Harrison v. Anderston Foundry Co.* (b), 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* (c) 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 are one document, and an ambiguity in the specification must

(a) 1 P. O. R. at p. 58.

(b) L. R., 1 Ap. C. 581.

(c) L. R., 2 Ap. C. 423; *Dud-*

geon v. Thompson, L. R., 3 App.

Cas. 53; *Wegmann v. Corcoran*,

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

be construed by the light which is thrown upon it by the title (*d*). In the case of *Unwin v. Heath* (*e*), 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 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* (*f*) 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

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

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

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

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.*"

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* (g), 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

(g) 13 W. R. 578.

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 (*h*).

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* (*i*), 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* (*k*), 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

(*h*) *Barber v. Grace*, 1 Ex. 339.

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

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

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, 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 (*l*).

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 (*m*).

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

(*l*) *Heath v. Unwin*, 22 L. J., C. P. 7.

(*m*) *Hinks v. Safety Lighting Co.*, L. R., 4 Ch. D. 607. See also *Clark v. Adie*, L. R., 2 Ap. Cas. 315.

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

P. C. 105; *Tetley v. Easton*, Mac. P. C. 68. But see *Bush v. Fox*, 5 H. L. C. 707; *Booth v. Kennard*, 2 H. & N. 84. Also *Hills v. Evans*, 31 L. J., Ch. 457.

(*o*) *Reg. v. Arkwright*, 1 Web. P. C. 66.

In *Arkwright v. Nightingale* (*p*), 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 understood by those whose business leads them to be conversant in such subjects, it is intelligible." And in *Hornblower v. Boulton* (*q*), 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* (*r*), 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 (*s*). In *Neilson v. Harford* (*t*), 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 capacity, to the subject."

In the case of the *Badische Anilin Fabrick v. Levenstein* (*tt*), the patentee claimed, "First, the production of red

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

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

(*r*) Dav. P. C. 318.

T.

(*s*) *Sturtz v. De la Rue*, 5 Russ. 327

(*t*) 1 Web. P. C. 314.

(*tt*) L. R. 24 Ch. D. 156.

G

and brown colouring matters, which in chemical language may be termed the sulpho acids of oxyazo-naphthaline by the action of the diazo compounds, which may be prepared from naphthylamin or from the sulpho acids of naphthylamine upon any of the isomeric naphthols, or of mixtures of the same, or upon any of the sulpho acids which may be prepared from either alpha naphthol or from beta naphthol, or from mixtures of the same substantially by the process above described." It appeared that the patent was dated 1878 ; that there were two descriptions of naphthylamine, one called alpha naphthylamine and the other beta naphthylamine ; that the substance alpha naphthylamine had been known for a considerable period of time, but that beta naphthylamine had only been discovered in 1876 ; that at the date of the patent beta naphthylamine was very little known and very rare ; that up to the year 1880 it was only used in laboratory experiments and that it was very costly ; and that until beta naphthylamine was known, the alpha compound only was known and was called naphthylamine. Objection, that it was not stated what naphthylamine it was intended to be used. Pearson, J., said : (u) " I come to the conclusion that the word ' naphthylamine ' in the patent means that which was generally known in the year 1878 as naphthylamine, namely, what is now described as alpha naphthylamine although beta naphthylamine was invented in 1876 and would at once be called beta naphthylamine to distinguish it from the naphthylamine which had been known for at least 15 years before, it does not follow that that naphthylamine would all of a sudden acquire the name of alpha naphthylamine ; it would remain in all the books printed up to that time as naphthylamine only, and I am satisfied that at the date of the patent and subsequently to the date of the patent any person ordering naphthylamine simply, would have been supplied with the old naphthy-

(u) At p. 161.

lamine, and nobody would have thought of asking him whether he wanted 'beta naphthylamine.' Under these circumstances I think it would be improper to come to the conclusion that any naphthylamine was meant in this patent except that which was known simply as 'naphthylamine,' that is, that which is now properly described as 'alpha naphthylamine.'"

In the Court of Appeal (*v*), Baggalay, L.J., differing from Fry and Bowen, L.JJ., said: "If the language of the specification can be fairly construed, so as in the one case put, to support the validity of the patent, if challenged on the ground that the use of beta naphthylamine would lead to failure and in the other to protect the patentee against an infringement by the use of that substance, it would be fatal to the plaintiff's case in the present action whether the language had been adopted *per incuriam* or of set design. Though the term 'the literature' has been conveniently applied to the documentary evidence admitted in the present case, it is clear that publications of this nature must be regarded as of two classes—those addressed to the scientific world, and those addressed to working or practical men, a distinction which cannot, in my opinion, be more simply and clearly illustrated than it was by Dr. Odling, who being asked by Pearson, J., when the body, as alpha naphthylamine, but formerly known as naphthylamine without any prefix, first acquired its present name, replied as follows: 'My Lord, there are two distinct forms of literature upon the subject. There is the systematic scientific literature, and there is the technical literature, and in the technical literature it is called naphthylamine up to the present day, but in the more scientific literature you may find the distinction although it is very rare.' The distinction between the information given by scientific literature and that given by technical literature is one very im-

portant to be borne in mind when we are dealing with questions such as that now under consideration. Publications having reference to chemical science and intelligibly expressed will always be enquired after and studied in their laboratories by scientific chemists, ever on the alert to make themselves acquainted with the newest compounds with a view of putting them to some useful purpose ; but, speaking generally, it is not the fact that such publications are sought after and studied by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained."

In the House of Lords, Lord Herschell, upon the same point, said : (x) " I am satisfied that after 1875 and down to the time of the patent, alpha naphthylamine was still sometimes spoken of as ' naphthylamine,' and that if anyone had ordered ' naphthylamine ' of a manufacturer he would without hesitation have supplied alpha naphthylamine. Under these circumstances I entertain no doubt that any reader of the specification would understand by the word ' naphthylamine ' occurring in it, the known commercial article, which, until recently at all events, had always borne that name, and not beta naphthylamine, to which the term ' naphthylamine ' alone had never been applied. I am therefore of opinion that the specification is not in this respect open to the charge of ambiguity."

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 (y).

In *Heath v. Unwin* (z), Mr. Baron Alderson said : "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or

(x) L. R. 12 App. Ca. at p. 723.

1 Web. P. C. 676.

(y) *Crossley v. Beverley*, 3 C. & P. 513 ; *Househill Co. v. Neilson*,

(z) 2 Web. P. C. 245.

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 (a).

In *Plimpton v. Malcolmson* (b), 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 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

(a) Per Lord Westbury, *Simpson v. Holliday*, 13 W. R. 578.

(b) L. R. 3 Ch. D. 568.

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 would 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* (c), 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* (d), 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* (e): "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 in 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, with which every man acquainted with the subject is familiar." In taking this distinction as a guide, however, we must be 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

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

(d) Dav. P. C. 311.

(e) 2 H. Bl. 498.

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 (*f*). The disclosure in the specification of the nature of the invention must be *bond fide*, but it need not go farther than the knowledge of the inventor at the time extends (*g*). 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 (*h*). 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 (*i*).

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

(*f*) *Morgan v. Seaward*, 1 Web. P. C. 182.

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

(*h*) Per Mr. Justice Bailey, in

Lewis v. Marling, 1 Web. P. C. 496.

(*i*) *Crossley v. Potter*, Mac. P. C. 245.

(*k*) L. R., 3 Ch. Ap. 429.

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* (l) 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 (m) 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 resident 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."

(l) L. R., 13 Ch. D. 65.

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

It will be seen that the last-mentioned case is distinguishable from the case of *Plimpton v. Malcolmson* (n). There 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, and to give a sufficient description to work the invention.

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* (o), 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 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

(n) L. R., 3 Ch. D. 531. Judgment of Jessel, M.R., at p. 582.

(o) 1 Web. P. C. 82.

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* (*p*) go to the same extent; and in *Crossley v. Beverley* (*q*), 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, 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 specifica-

(*p*) Dav. P. C. 400.

(*q*) 1 Web. P. C. 117.

tion." In *Morgan v. Seaward* (r), 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 *bona fides* full, and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet v. Johnson* (s).

In *Tetley v. Easton* (t), 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* (u), 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 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 *mala fides* it has been held, in a large number of cases, that if the patentee in his

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

(t) Mac. P. C. 76.

(s) 1 Web. P. C. 53; and Bull
N. P. 78.

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

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* (v), 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, 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.

(v) 1 Web. P. C. 496.

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

Web. P. C. 83; *Bickford v. Skewes*, 1 Web. P. C. 218; *Neilson v. Harford*, 8 M. & W. 806.

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 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

(y) Dav. P. C. 404.

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

(a) *Simpson v. Holliday*, 13 W.

R. 578; L. R., 1 H. L. 315, per Lord Westbury.

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

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 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 anticipated (e). Since the Act of 1883 it has been held by the Court of Appeal that the enactment in sect. 5 that a complete specification must end with a distinct statement of the invention claimed, is **directory only**, and when letters patent have been granted, they will not be invalid because it has not been complied with (ee). 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

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

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

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

(ee) *Siddell v. Vickers*, 39 L. R., Ch. D. 92.

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 *Gandy v. Reddaway* (*g*), the claim was “ constructing belts or bands for driving machinery of cotton canvas or duck ‘ woven hard ’ and stitched and saturated or soaked with oil, such as linseed oil or any combination thereof, as herein described or set forth, or any modification thereof.” It was proved that cotton canvas woven hard was in the trade divided into classes numbered 1—10. Of these, only 2, 3, and 4, would practically answer to carry out the invention ; anyone attempting to use the other numbers would fail ; certain numbers would crack if used on small pulleys. Pearson, J., dismissed the action and was affirmed by the Court of Appeal on the ground that the claim was too large. And where a patent is taken out for a combination, it is not material to its validity that the specification should point out what parts are old and what are new, though, if an alleged infringement consists only in taking part of the combination, it is necessary that the patentee should in his specification have claimed the part so taken as new (*h*). If the whole combination constitutes the novelty of the invention the whole combination alone should be claimed, and subject to the substitution of equivalents and evasion, there will be no infringement

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

(*h*) *Proctor v. Bennis*, 36 Ch. D.

(*g*) 2 P. O. R. 49 ; *Griffin* P. C. 740.

unless the whole combination is taken; but if there is *merit and novelty* in *subordinate integers* or *subordinate combinations* they should be specially claimed, otherwise there will be no infringement in taking them. But in the case where there is *novelty in the result* of using the whole combination, and only the whole combination is claimed, then the Court will protect the patentee from infringement by taking the essence of the combination. *Proctor v. Bennis (supra)*.

In *Harrison v. The Anderston Foundry Co. (i)*, 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 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

(i) L. R., 1 App. Ca. 574.

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* (k), 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 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 improve-

(k) 4 De G., J. & S. 298.

ment. 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 *Moore v. Bennett* (l), Selborne, L.C., in giving judgment in the House of Lords, said: "Your lordships have not at all to consider whether in the case of *Foxwell v. Bostock* the decision arrived at was correct or not; nor have you to consider whether, when interpreted with reference to the facts of that case, the language used by the very eminent and able judge who decided it may not be susceptible of an interpretation which would make that language correct in point of law. But, my lords, I feel that your lordships cannot refuse to regard the decision in *Foxwell v. Bostock* in the light in which you have already explained, and interpreted, and commented upon it by your own decision in the case of *Harrison v. The Anderston Foundry Co.*, and so explained, it appears to me, to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but **you must condescend upon that which is improved.** The case of *Foxwell v. Bostock* was qualified or explained in *Harrison v. The Anderston Foundry Co.* It was treated as an authority in such a way as to make it impossible to apply it to the present case, where, looking at the specification and at the evidence, it is perfectly clear that no such general combination as this had been at any time used, and where the material and important parts of the two arrangements and

(l) Griffin P. C. 158.

combinations, which are described, are clearly, plainly and intelligibly described. It would, in my judgment, be in direct contradiction to the decision in *Harrison v. The Anderston Foundry Co.* to hold the specification bad."

In *Clark v. Adie (m)*, 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 three 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 statement" 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.

(m) L. R., 2 App. Ca. 328.

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, as amended by sect. 2 of the Patents, &c., Act, 1888, provides that (1), "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application, and in the latter case the application shall, if the comptroller so direct, bear date as from the time when the requirement is complied with.*" Sub-sects. 2, 3, 4, provide for an appeal to the law officer; and sub-sect. 5 gives 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 subsect. 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 were novel at the date of the Act of 1883. 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, where the applicant *appeals* he may call witnesses before the law officer, but surely the statute

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

does 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 (*cc*).

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*). *In re Gare's Patent* in 1884 (*c*), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patent, &c., Act, 1852, and said, "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c., Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, *or which is otherwise to be considered as a record under the authority of the Master of the Rolls*. So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

It would appear from the words printed in italics that

(*b*) *In re Sharp's Patent*, 1 Web. P. C. 645. *In re Nickel's Patent*, 1 Web. P. C. 649. *Re Johnson's Patent*, 5 Ch. D. 563.

(*c*) 26 Ch. D. 105.

(*cc*) *Brown's Patent*, 2 Griffin P. C. 1.

the jurisdiction of the M.R. is still intact with reference to amendments after sealing.

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 case of *Spilsbury v. Clough* (*d*) 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, as amended so far as sub-sect. 10 is concerned by sect. 5 of the Patents, &c., Act, 1886, 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*

(*d*) 2 Q. B. 466.

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."

"Disclaimer correction or explanation" does not include the amendment of a specification by the insertion of subsequently ascertained knowledge (e).

Under this section there is no power to amend the title, and when a complete specification is filed with a narrower title than the provisional, the proper course for the C. G. to adopt is to amend the title of the provisional under sect. 7, or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (f) (this latter course it appears to the author would be dangerous). Sect. 18 only applies to amendment after acceptance of the complete specification; all amendments before acceptance are under sects. 7 and 9 (g). The law officer will not in the absence of satisfactory explanation permit repeated applications to be made for the same proposed amendment (h).

Prohibition will not lie to the law officer in the exercise of his discretion under this section, *Ex parte Simon*, Times, Aug. 6, 1888, C.A.

"(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."*

(e) Per Sir R. Webster in *Beck v. Justice*, 2 Griffin P. C. 10.

(f) Per Sir R. Webster, *Dart's Patent*, Griffin P. C. 307.

(g) Per Sir R. Webster, *Jones' Patent*, Griffin P. C. 313.

(h) *Arnold's Patent*, 2 Griffin P. C. 5.

The comptroller exercises the power to impose conditions given in express terms to the law officer under sub-s. 4 (i). In *Codd's Patent* (j), he ordered as a condition of allowing an amendment (1), that no proceedings be taken against opponent A. in respect of infringements committed prior to the 1st January, 1884; (2), that the applicant pay to opponent A. 10 guineas as and for his costs of and incident to his opposition to the abortive application of 10th July, 1884. It is however clear that the C. G. has no power to give costs as a condition of amendment (k).

“(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.*”

In *Allen's Patent* (l) application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring any action or bring any proceedings whatever against them or any of their customers, &c., in respect of any pipes which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision. “I have carefully considered the question whether in allowing this amendment I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act, I find that they imposed as a condition

(i) *Hearson's Patent*, Griffin P. C. 309.

(j) *Codd's Patent*, Griffin P. C. at p. 307.

(k) *Pietschmann's Patent*, Griffin P. C. 314.

(l) 2 Griffin P. C. 3.

of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases as reported in Griffin's P. C., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act. No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification, by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition."

In *Cheeseborough's Patent* (n) the conditions were that no action should be brought with reference to any lamps *made* sold or used before the date of the amendment, and that any lamps so made might be used or sold after the date of the amendment without infringing. In the case of a second disclaimer the law officer will be disinclined to give costs to the patentee even if successful (o).

"(5) *When no notice of opposition is given, or the*

(n) Griffin P. C. 303. See also the terms imposed in *Westinghouse Patent*, Griffin P. C. 315.

(o) *Haddan's Patent*, 2 Griffin P. C. 12.

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.”

An amendment will not be allowed which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (p).

“(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 proceeding for revocation of a patent is pending.”

In *Cropper v. Smith* (q) the comptroller having declined leave to amend a specification by reason of the 10th sub-sect. of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was “an action for infringement or other legal proceeding.” Application was made to the Court under

(p) *Heath and Frost's Patent*, Griffin P. C. 311.

(q) L. R. 28 Ch. D. 148.

sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the comptroller from the power of amending the specification under sect. 18.

In *Codd v. Bratby* (r), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the comptroller.

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.*"

Where more than one action is pending, the leave of the Court must be obtained under this section in each action, otherwise the amendment will not be allowed, and each order must be filed under rule 55 (*infra*) (s).

In *Codd v. Bratby* (*supra*), in giving liberty to amend under this section, Chitty, J., said, "It is conceded for the applicant, first, that the amended specification is not to be put in evidence at the trial; secondly, that no evidence is to be given of any infringement prior to the amendment of the specification. Besides that, it is conceded that the applicant must pay the costs of this application and all the costs that have been thrown away in the action;" then as to the contention that a condition should be imposed on the plaintiff that he should not sue the defendants on the

(r) Griffin P. C. 56; 1 Patent Office Reports, 209.

(s) *Codd's Patent*, Griffin P. C. 305.

amended specification for future infringements, his Lordship said, "The result of my acceding to this part of the argument would be, that I should be giving to the defendants practically and substantially a license to infringe the plaintiff's patent when amended in the circumstances of this case, that would be going too far There may be cases in which it would be right to impose such a term. I am not satisfied in the case before me on the evidence, that the defendants are right in their attempt to impute knowledge to the plaintiff many years ago of the invalidity of his patent; if that point were made out, I think the case might stand on a different footing, because then I should have the case of a patentee with knowledge of a defect in his patent, lying by until a very few months of the expiration of his patent; and I should have on the other side the defendants saying that they were aware of the invalidity of the patent, that they were advised that the patent was invalid, and that they set up a trade and incurred great expenditure on the faith that the patent was invalid" See also as to terms imposed under this section, *Singer v. Stassen* (t), *Fuzee Vesta Co. v. Bryant & May* (tt), *Bray v. Gardner* (u), *Haslam Foundry Co. v. Goodfellow* (v), also *Gaulard v. Lindsey* (w).

Liberty to amend under this section will not be given after judgment (x).

Sect. 20. "Where an amendment, by way of disclaimer, 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 satisfac-

(t) 50 L. T. 326, Griffin P. C. 497; 56 L. T. 292.
207.

(v) 37 Ch. D. at p. 121.

(tt) 34 Ch. D. 458; 56 L. J.
Ch. 187; 56 L. T. 110.

(w) W. N. Feb. 4, 1888.

(x) *Lawrence v. Perry*, Griffin

(u) 34 Ch. D. 668; 56 L. J. Ch. P. C. at p. 148.

tion 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" (y).

Romilly, M.R., in the same case (z), 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

(y) *R. v. Mill*, 20 L. J., C. P. at 59.
page 24; 10 C. B. 379; 15 Jur.

(z) 14 Beavan, at page 315.

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" (a).

The case of *Ralston v. Smith* (b) 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 Act of 1883 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**.

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

(a) *Foxwell v. Bostock*, 4 De G. J. & S. at page 306; 12 W. R. 723; 10 L. T. N. S. 144. (b) 11 W. R. N. S. 28; 20 C. B. L. T. N. S. 1.

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* (c) 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 Act of 1883, 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 (d). 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* (e), an interdict granted prior 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*

(c) Hindmarch, p. 207 ; 2 M. & W. 471 ; 1 Web. P. C. 250 ; 6 L. J. Ex. 124.

(d) As to what are just terms, see *supra*, pp. 107 to 111, and *In*

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

(e) L. R., 3 App. Cases, 34.

v. *National Arms Company, Limited* (*f*), 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** (*ff*), 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* (*g*), 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* (*h*).

(*f*) 37 L. J. N. S. 31.

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

(*ff*) As to how this discretion has been exercised, see *infra*, "Practice."

(*h*) L. R., 5 Ch. D. 503; and *In re Gare's Patent*, 26 Ch. D. 105, *supra*, 104.

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, as amended by the Patents, &c., Act, 1888, 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 that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.”

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*

(a) Hindmarch, at page 534.

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 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. In *Edmunds' Patent (e)*, Sir R. Webster, A.-G., said :—“ I am clearly of opinion that under the circumstances the controller-general was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas if the patent is sealed the question can be raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings.” In this case the law officer held that, in the absence of breach of contract or duty, the words “ the applicant having obtained the invention from him ” in the 11th section did not apply to the obtaining the invention from a person abroad.

It frequently happens that the law officer is of opinion that **both** the applicant and the opponent **contributed materially to the invention**. In such case terms will be imposed giving both parties an interest in the

(b) 6 De G., M. & G. 420; 25
L. J. Ch. 456; 4 W. R. 473.

(c) 14 W. R. 551.

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

(e) Griffin P. C. at page 283.
See also *Firchter's Patent*, Griffin
P. C. 284.

patent (*ee*). In *David and Wodley (f)*, upon the question of **workman and master**, Sir H. Davey said :—“ I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them.”

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. In *Cummings' Patent (ff)*, Sir Henry James, although of opinion that the applicant's invention and that which formed the ground of opposition were very nearly the same, thought there was just sufficient difference (although a very slight difference) to justify him in affirming the comptroller-general's decision. He felt, too, that if he refused a patent his decision would be final. 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 (*g*).

“ **On the ground that the invention has been patented in this country** ” will not give a locus standi for opposition where only a provisional protection has been granted for the previous invention (*h*); but it is otherwise where the opponent has brought himself within the terms of sect. 15 (*i*). If the invention, the subject-matter of applicant's specification, is fully described in the specification relied on

(*ee*) *Russell's Patent*, Goodeve, P. C. 589; *Luke's Patent*, Griffin P. C. 294; *Evans & Otway's Patent*, Griffin P. C. 279; *Garthwaite's Patent*, Griffin P. C. 284.

(*f*) 2 Griffin P. C. 26.

(*ff*) Griffin P. C. 277; also *Jones's Patent*, 2 Griffin P. C. 33.

(*g*) *In re Manceaux's Patent*, L. R., 6 Ch. 272.

(*h*) *Bailey's Patent*, Griffin P. C. 269; *Dundon's Patent*, Griffin P. C. 278.

(*i*) *L'Oiseau and Pierrard*, 2 Griffin P. C. 36.

in opposition, the patent will not be allowed to go, notwithstanding that it is not made the subject of claim in the opposing specification (*k*). But when a patent is opposed on this ground, it is not open to the applicant to show that the invention, although described in the opponent's complete specification, is not contained in his provisional (*l*). The author ventures to hope this decision will be reconsidered, although it is one of Sir Richard Webster's. It is founded upon the fact that the applicant is not entitled to dispute the validity of the opponent's patent. But is this quite the point? Is it not a question of priority? The opponent's provisional was filed in March, 1885, and his complete in December, 1885. The applicant's provisional was filed in July, 1885, and his complete in April, 1886. Now if the invention contained in the applicant's provisional was not contained in the opponent's provisional, it is perfectly clear that the applicant was the first inventor. The decision in this case would lead to this hardship—that where people are racing after an invention, as is frequently the case, and A. has filed a provisional for no matter what, and afterwards hears that B. has made the desired discovery, A. can, by including B.'s invention in his complete, say to B., “I can oppose your grant. It is true my patent is invalid, but I can prevent you getting a patent by opposing, and you will not be permitted to enter into the question as to who was the real inventor, so you can get no patent, no matter how fraudulent my conduct may be, because fraud on the part of the opponent is not within the 11th section.” Since the above lines were in type the hardship indicated has been removed by sect. 4 of the Patents, &c., Act, 1888, amending sect. 11, sub-sect. 1, of the Act of 1853, quoted *supra*.

Under this section it will make no difference whether the patent upon which the opposition is founded has expired or not (*m*).

(*k*) *Von Buch's Application*, 2 286.
Griffin P. C. 40.

(*l*) *Green's Patent*, Griffin P. C. 293.
(*m*) Per Gorst, S.-G., *In Lancaster's Patent*, Griffin P. C. 293.

A question has arisen as to whether, when a patent is antedated, pursuant to the provisions of sect. 103 (*infra*), and when an application is made for letters patent for the same invention to another applicant, between the date to which such patent is antedated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17th, 1888, held in the matter of *Everitt's Patent* and *L'Oiseau and Pierrard's* opposition (*n*), that although the opponent's patent would override the applicant's by reason of the antedating, still that for the purpose of opposition the opponents had no locus standi. Sir R. Webster had, on December 7th, 1887, allowed L'Oiseau and Pierrard's patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent* (*o*).

In *Stubbs' Patent* (*p*), Sir R. Webster said:—"As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course I need not remind you that **stopping a patent is a very serious step**, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical. . . . I shall, as a rule, allow **costs to follow the event.**"

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.

(*n*) 2 Griffin P. C. 28.

(*o*) 2 Griffin P. C. 36.

(*p*) Griffin P. C. 298.

(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.”

In *Heath and Frost's Patent* (q), Sir E. Clarke said:—
“It appears to me that by sect. 11 it is quite clear that the only class of persons who **are entitled to be heard** in opposition before the law officer, are persons who are interested with a real and legitimate interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it.”

The law officer ought not to interfere with the decision of the comptroller unless it is clearly wrong (r), nor ought he to permit amendment in the opposition by substituting another opponent when it has been decided that the original opponent has no locus standi (s); but otherwise where the original opponent is dead (ss).

(4) “The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the treasury shall appoint.”

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 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.)

(q) Griffin P. C. at p. 290.

(r) Per Herschell, S.-G., *In Glossop's Patent*, Griffin P. C. 286.

(s) *In Heath and Frost's Patent*, Griffin P. C. 290.

(ss) *Lake*, 2 Griffin P. C. 35.

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 (t).**

For *practice* cases the reader is referred to those quoted under the head of “Practice—Opposition,” *infra*.

(t) 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.

By sect. 33, "*Every patent may be in the form in the first schedule to this Act, and 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.*"

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

The Comptroller may refuse to accept an application on the ground that the specification contains more than one invention. The question as to what in truth is one invention is consequently of importance. In *Jones's Patent* (b), Sir Farrer Herschell, S.-G., said : " It seems to me that the general object of the invention is the test by which the question of one invention must be decided. If you have a particular general object of an invention to make rails rest more securely, and you describe one or two or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention ; but if there is no common purpose so that you could say, ' I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them except that both are used in connection with rails, and it strikes me that would be two inventions."

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.

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 (c).

(b) Griffin P. C. 265 ; *Hearson's Robinson's Patent*, Griffin P. C. 267. *Patent*, Griffin P. C. 266 ; and (c) Page 40.

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 (*d*).

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* (*e*). In that case the false suggestion complained of was in the title of the specification, which it was alleged 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

(*d*) Ante, pp. 7 and 21.

(*e*) 2 M. & W. 544; 1 Web. P. C. 187; 6 L. J. Ex. 153.

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 (*f*). 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* (*g*); *Brunton v. Hawkes* (*h*); 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* (*i*), this view of the case, that the patent was void for a false suggestion, does not appear by the report 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

(*f*) *Travell v. Carteret*, 3 Levinz, 135; *Alcock v. Cooke*, 5 Bing. 340.
(*g*) 8 Taun. 375.

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

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