THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

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LETTERS PATENT FOR INVENTIONS.

WITH FULL

APPENDICES

OF

STATUTES, RULES, AND FORMS.

BY

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PRESIDENT

OF

THE BOARD OF TRADE

DURING THE

INTRODUCTION AND ENACTMENT

OF THIS

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PREFACE.

In offering this book to the legal profession the authors desire to acknowledge their indebtedness to Mr. J. C. Graham, of the Middle Temple, and to Messrs. Wilson, Bristows, and Carpmael, for kindly placing at their disposal Forms and Precedents which have been of much assistance to them in the preparation of the Fourth Appendix.

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Bearings with which Letters Patent for Inventions are now sealed.

Mr. W. Valentine Ball, of Lincoln's Inn and the North-Eastern Circuit, has assisted in the preparation of the Index and the correction of proofs.

R. W. W.
J. B. W.

THE TEMPLE,
July, 1900.

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THE LAW AND PRACTICE

OF

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

Historical and Introductory.

THE PREROGATIVE OF THE CROWN TO GRANT MONOPOLIES BY LETTERS PATENT AND THE LIMITATIONS IMPOSED THEREON BY THE STATUTE OF MONOPOLIES.

No Property in an Invention.—Neither at common law nor by statute is there any property in an invention. Hence no inventor, as such, is in law entitled to the sole use of his invention. He may exclude others from participation in its benefits, by keeping the product of his ingenuity secret; but if he adopts this course it will generally be at the price of himself abstaining from all profitable use of the invention. For if he once publishes his invention either by use in public or by description, so that others become cognizant of the manner of performing it, the public are free to use it as they please, and he cannot by virtue of any property in it peculiar to himself restrain them from so doing.

Hence an inventor who desires to secure to himself the full benefit of his ingenuity must not only invent but also acquire by a further step that right to the exclusive use of his invention which is not a legal incident of the successful exercise of the inventive faculty. In other words, he must obtain by grant, for such period as the law permits, the sole use of his invention. This is a monopoly and by English law can be granted only by the Sovereign, in whom

from time immemorial has been vested the right of thus bestowing upon an inventor the sole benefit of his invention.

The Granting of Monopolies a Prerogative of the Crown.—The right of the Crown to make such grants does not spring from, though it has been from time to time controlled by, parliamentary enactment. It is an inherent part of the royal prerogative; (*a*) one of those powers which the law recognizes as vested in the Sovereign for use for the public good; a power in its origin outside of and apart from the common law, and yet admeasured thereby, so that it shall not tend to the prejudice or hurt of any subject. (*b*) "The king's prerogative," says Sir Henry Finch, "stretcheth not to the doing of any wrong." (*c*) Thus the prerogative rights of the Crown enjoy legal sanction, not for the private advantage of the Sovereign, but for the general good of the community. (*d*)

The powers of the prerogative are of great antiquity; in fact, as ancient as the law itself. (*e*) Thus, from time immemorial the Crown has claimed and exercised the right of granting by charters and letters patent franchises and privileges to individuals and corporations. The subject-matters of such grants have been numerous and diverse; here, however, it is only material to consider the use of this power in respect of trade and the industrial development of the country.

Origin of the Royal Prerogative in relation to Trade.—At a very early period the king assumed in English history the position of arbiter and protector of commerce. (*f*) As the force in the Constitution responsible for the peace of the land and the orderly government of the community, he was the natural guardian and

(*a*) "By the word prerogative we usually understand that special pre-eminence which the king hath over and above all other persons, and out of the ordinary course of the common law, in right of his regal dignity" (Blackstone's *Com.*, vol. i. bk. 1, c. 7); "The king's prerogative is part of the law of England and comprehended within the same" (Coke, 2 *Inst.* 496).

(*b*) See *Willion* v. *Berkeley* (temp. 3 Eliz.), Plowden's Reps., edit. 1779, p. 236. Bracton says, "Ipse autem rex, non debet esse sub homine, sed sub deo et sub lege, quia lex facit regem" (*De Legibus Angliae*, lib. i. c. 8). "All prerogatives must be for the advantage and good of the people, otherwise they ought not to be allowed by law" (Bacon's *Abridgt.*, 7th edit. vol. vi. 385).

(*c*) *Description del Common Leys d' Angleterre* (pub. 1613), edit. 1759, p. 85.

(*d*) Per Lord Kenyon, C.J., in *Yorke* v. *Dayrell*, 4 T. R., p. 410.

(*e*) "The rights and prerogatives of the Crown are in most things as ancient as the law itself; for though the Statute 17 Ed. II. st. 1, commonly called *De prerogativa Regis*, seems to be introductive of something new, yet for the most part it is but a sum or collection of certain prerogatives that were known law long before" (Bacon's *Abridgt.*, 7th edit. vol. vi. p. 387).

(*f*) See Blackstone, *Com.*, bk. 1, c. 7, v.

fosterer of trade. When life and property were insecure, population sparse, and communication between the different parts of the realm difficult and hazardous, combination under the protection of the central executive authority was essential to the maintenance and development of trade. Hence merchants and craftsmen, for their mutual safety, formed themselves into guilds and societies under royal charters of privilege. The king's peace made trade possible; the king's charter regulated its exercise. Each craft or trade became a separate mystery, the practice of which was rigidly limited to members of the guild or society and those who obtained entrance thereto by serving a period of apprenticeship.

In addition to this regulation of internal trade, the Crown likewise played a leading part in promoting the introduction of new trades and manufactures from abroad, by issuing licenses or letters of protection to traders and craftsmen who were subjects of foreign states. (*g*)

From letters of protection the step was inevitable to letters of privilege, and thus the law early recognized that the Crown might, as an encouragement to introducers of new trades, grant to such persons advantages not enjoyed by subjects of the Crown at large. Hence, under the 40th year of Edward III. it is laid down in the Year-book that arts and sciences are greatly favoured in law, and the king, as chief guardian of the common weal, has power and authority by his prerogative to grant many privileges for the sake of the public good, although *primâ facie* they appear to be clearly against common right. (*h*) Such privileges were granted by letters patent, *i.e.* open letters addressed in the name of the sovereign to all to whom they may come, and attested by an impression of the great seal appended at the foot. (*i*)

Limitations Imposed on the Prerogative by Law.—Although the law thus recognized the royal right of intervention in matters of

(*g*) In 1331 Edward III. granted letters of protection to John Kempe, a native of Flanders, to enable him to set up the industry of cloth-making in England. Similar grants were made in 1336 to two weavers of Brabant, and in 1368 to three clockmakers of Delft. In 1440 Henry VI. made a similar grant to John Shiedame, the introducer of a new method of manufacturing salt; while again, in 1452, a grant was made to three Bohemian miners who possessed *meliorem scientiam in mineris*. See an article by Mr. E. W. Hulme in the *Law Quarterly Review* (1896), vol. xii. p. 141.

(*h*) 40 Ed. III., pt. iv. fol. 17, 18.

(*i*) Now, in the case of patents for inventions, the seal of the Patent Office. "The king's grants," says Blackstone, "are also of public record. These grants, whether of lands, honours, liberties, franchises, or ought besides, are contained in charters, or letters patent, that is, open letters, *literæ patentes*: so called because they are not sealed up, but exposed to open view, with the great seal pendant at the bottom; and are usually directed or addressed by the king to all his subjects at large" (*Com.*, vol. ii. bk. ii. c. 21, edit. 1809, p. 346).

trade, it vigilantly watched its exercise and protested against its abuse. For the freedom of trade was a principle dear to the common law; and just as private contracts in restraint of that freedom were repugnant to the law, so royal grants having the like effect could only be justified on exceptional grounds. Hence the law early denied the validity of grants which purported to place in a few hands a trade already known and used by others; for this was to abridge the vested rights of the subject. (*j*)

"The king's grant of a monopoly," says Bacon, "as of the sole buying, selling, working, making, or using of any commodity, is not only void by the common law, but the persons procuring such grants are said to be punishable by fine and imprisonment. And indeed the freedom of trade and labour is of such consequence that, as no man can by his own act totally debar himself of this privilege, much less can he be restrained by the king's letters patent." (*k*)

Monopolies of existing trades were objectionable on the double ground that they took away from a limited number of persons a lawful livelihood, and increased for all the price of the commodity covered by the grant. (*l*) Nevertheless, with the increase of the royal authority in the Tudor period, such grants became frequent. They afforded an easy means at once of rewarding favourites and increasing the royal revenues; and hence, though ever without law, were never without friends. (*m*)

The granting of these monopolies was carried by Elizabeth to an enormous height. (*n*) By the close of her reign, however, notwithstanding the high pretensions of the Crown, the principles of law applicable to such grants were clearly settled; and monopolies, though not invalid *per se*, were admitted to be unlawful, if so granted as to be injurious to the public interest. Thus a monopoly of a known trade found no favour with the law, but a monopoly of a trade new in the realm, granted for a limited time by way of encouragement to the first inventor or introducer thereof, was

(*j*) Parliament frequently interfered to vindicate freedom of trade against encroachment. See 9 Ed. III. st. 1, c. 1; 25 Ed. III. st. 4, c. 2; 31 Ed. III. c. 10; 2 R. II. st 1, c. 1; 12 H. VII. c. 6.

(*k*) *Abridgement*, 7th edit. vol. vi. p. 499.

(*l*) See Hawkins, *Pleas of the Crown*, bk. i. c. 79, s. 2; edit. 1716, p. 231.

(*m*) Coke, 3 *Inst.* c. 85, 182.

(*n*) Blackstone, *Comm.*, bk. iv. c. 12. Much interesting light is thrown upon Elizabeth's abuse of the prerogative in this respect by a debate in the parliament of 1601. Monopoly patents had been granted for all sorts of commodities, Secretary Cecil enumerates upwards of a score. See *Parl. Hist.*, vol. i. pp. 926, 927, 929; D'Ewe's *Journals of Parl.*, edit., 1682, pp. 645, 646, 652. The duration of these grants seems to have ranged from seven to twenty years. See Mr. E. W. Hulme's Article, *Law Quarterly Review*, vol. xii. p. 141.

regarded as a legitimate stimulus to trade enterprise and therefore beneficial to the whole community. A glance at the early authorities will illustrate this.

In the time of Edward III. one *John Pechey* obtained a license under the great seal that he only might sell sweet wines in London. For this monopoly he was arraigned at the bar in parliament, where the patent, after great advice and dispute, was adjudged void, and before his face, in open parliament, cancelled because he had exacted 3*s.* and 4*d.* for every tun of wine, he himself being adjudged to prison until he had made restitution of all he had ever received, and paid a fine of £500 to the king. (*o*)

A patent for the sole making and selling of frisadoes in England during a stated period was granted by Elizabeth, to one *Hastings*, in consideration of his having brought into the realm the skill of making frisadoes as they were made in Haarlem and Amsterdam beyond the seas. The patentee took proceedings upon this patent against certain clothiers of Coxall, for making frisadoes in breach of his monopoly; but failed upon the defendants shewing that they had done what he complained of before the making of his grant. (*p*)

In *Matthey's* case, a patent had been granted for the making of knives with bone hafts, a device which the patent alleged that *Matthey* had first introduced from abroad. But the Wardens of the Company of Cutlers proved that, except for a trifling difference, they had made similar knives before, and, therefore, the patentee "could never have the benefit of this patent, although he laboured very greatly therein." (*q*)

Again, in *Humphrey's* case, a patent had been granted for an instrument for melting lead, upon the supposition that the instrument was the patentee's own invention. But, doubt being cast upon this in a proceeding before the Exchequer Chamber, the Court held that if, as alleged, the invention had been used before within the realm, the patentee could not have that exclusive use thereof which his patent purported to give him. (*q*)

The Case of Monopolies.—Next in the well-known case of *Darcy* v. *Allin* (*r*) at the close of Elizabeth's reign, the validity of letters

(*o*) D'Ewe's *Journals*, edit. 1682, p. 645; *Parl. Hist.*, vol. i. p. 926; Coke 3, *Inst.* 181; Rot. Par., 50 Ed. III., nu. 33.

(*p*) Noy's Reps. 183.

(*q*) Ibid.; also a grant of Elizabeth.

(*r*) This case was argued between Trin. Term, 1602, and Easter Term, 1603, when judgment was given. It is reported in Moore's Rs., pp. 671 to 675; Noy's Rs., pp. 173 to 185; Coke's Rs., pt. xi. 84 b. The various reports are carefully collated and edited by Mr. J. W. Gordon in his recent book on *Monopolies by Patents*, pp. 193 to 234.

patent for trade monopolies was exhaustively debated before the Court of King's Bench. In this case the plaintiff, Edward Darcy, alleged that Queen Elizabeth had by letters patent granted to one Ralph Bowes for a period of twelve years and thereafter to the plaintiff for a further period of twenty-one years, the sole right of importing playing cards and of making, buying and selling them in England; that the defendant, a haberdasher of London, in breach of the plaintiff's monopoly, had made eighty gross of playing cards and imported one hundred gross more, and sold half a gross without the license of the Queen or consent of the plaintiff, and so defrauded the plaintiff of the benefit of his charter. The defendant contended that the patent was bad, on the ground that it created a monopoly of a known industry. After hearing repeated arguments, the Court of King's Bench held that the plaintiff's grant, being a monopoly, was utterly void, as contrary to the common law and against divers Acts of Parliament. (*s*).

This case is important, not only on account of the view it affords of the earlier authorities, but also as shewing through the arguments adduced on both sides the extent to which the common law by 1603 had established its right to limit the indiscriminate exercise of the royal prerogative in the granting of monopoly patents. Thus it is nowhere suggested by the counsel who argued for the patent that a Crown grant is above the law and *ipso facto* sufficient authority to support any monopoly. On the contrary, it is admitted that there is an onus upon the patentee to shew that his grant is for the public good. Sir E. Coke (Att.-Gen.) and Flemming (Sol.-Gen.), counsel for the plaintiff, both defended the grant in this case upon the ground that card playing was the cause of idleness and want, and a misemployment of time. From this they argued that the free and uncontrolled making or importing of cards was a national evil which the king's patent might in the public interest prohibit altogether and therefore certainly restrain. Further, they admitted by implication that the grant of a monopoly of an existing trade was void in law, by the attempt they made to save the patent in this case from the application of that principle by arguing that cards were not any merchandize or thing concerning trade of any necessary use, but things of vanity. Indeed, the whole course of the argument shews that it was common ground between the parties that royal letters patent are subject to review by the judges, who must determine whether they are good or bad according to the ancient allowance. Again, no

(*s*) See ante, p. 4, n. (*j*).

suggestion is found in the argument that trade monopolies are bad *per se* (*t*). It is assumed throughout that in a proper case the Court will enforce the grant.

What at common law were at this time considered to be the incidents of a valid monopoly patent was succinctly stated by Fuller, one of the counsel for the defendant, in a passage which has since been so frequently quoted as a correct exposition of the law, that it may be regarded as invested now almost with the authority of a judicial deliverance. That passage is as follows :—

"Now, therefore, I will shew you how the judges have heretofore allowed of monopoly patents, which is that where any man of his own charge and industry or by his own wit or 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 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."

Policy of the Crown under James I.—One of the results of this celebrated case was the publication, in 1610, of a book or declaration in the name of King James I., in which the royal pleasure in matters of bounty was set forth (*u*). In this book monopolies were expressed to be "things contrary to our laws," and suitors were commanded not to move the king in respect of them. From this command, however, were excepted "projects of new invention, so they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or otherwise inconvenient."

Some five years later, in 1615, trade monopolies again came under the notice of the Courts in the case of the *Clothworkers of Ipswich* (*v*). In that case the action was brought by the

(*t*) Sir E. Coke in his Commentary on the Statute of Monopolies seems, by limiting his definition of a monopoly to the objectionable type which the common law condemned, to suggest that all monopolies are bad in law. But this obviously is incorrect. For the sole right of using a new invention is clearly a monopoly, and this the common law never condemned. Sir E. Coke's definition is as follows:—"A monopoly is an institution or allowance by the king by his grant, commission or otherwise to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of anything, whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade" (3 Inst. c. 85).

(*u*) Coke says that this case was "the principal motive of the publishing of the King's Book" (3 Inst., 181). A copy of this curious book is reprinted by Mr. J. W. Gordon, in his *Monopolies by Patents*, pp. 160–193.

(*v*) Godbolt's Reps., p. 252; Coke's Reps. pt. xi. 53 a. This case was heard in the Court of King's Bench, Easter Term, 1615, Sir E. Coke then being Chief Justice.

Corporation of Ipswich Clothworkers against a defendant who had used the trade of a tailor in their town. The plaintiffs alleged that the king, by his charter, had incorporated them, and granted them the sole trade of clothworker or tailor in Ipswich. The Court of King's Bench, as appears by the following extract from Godbolt's Reports, held that this constitution, or ordinance, was unlawful.

"And it was agreed by the Court that the king might make corporations, and grant to them that they may make ordinances for the ordering and government of any trade; but thereby they cannot make a monopoly, for that is to take away free trade, which is the birthright of every subject."

But the judges also agreed that—

"If a man hath brought in a new invention and a new trade within the kingdom, in peril of his life and consumption of his estate or stock, 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 traffic 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. For when the trade has become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it."

Thus, at the commencement of the seventeenth century, two kinds of monopoly by patent were well known in England; both creatures of the royal prerogative; the one justified and supported by the law, the other regarded as a usurpation and an abuse; the first, a monopoly of a new trade or contrivance tending to the public advantage, granted for a reasonable time only, by way of reward and encouragement to the first inventor or introducer thereof; the second, a monopoly of a trade or contrivance already known and used by others, granted in deprivation of their rights to some suitor of the Crown who had conferred no benefit upon the public, and was therefore undeserving of such reward.

Examples of Illegal Patents.—Although the incidents of a good patent were thus clearly settled at common law, and the king in his book had announced his royal intention to grant no further monopolies except for projects of new inventions, the abuse of the prerogative in the issuing of illegal patents rapidly became under James I. an even greater source of oppression and discontent than it had been under Elizabeth.

Grants conferring monopolies of excessive duration, and interfering with existing trades, were obtained by many persons, and oppressively enforced before the Privy Council, under commissions and proclamations. A few of these grants may be briefly noticed.

In February, 1619, a patent was granted to Abraham Baker for the making of smalt, which gave the patentee a monopoly for the term of thirty-one years, although two previous patents (one declared prejudicial and void by the king, the other surrendered by the grantee) had been granted in respect of the same monopoly to the same patentee. (*w*) By the terms of this grant Baker undertook to make in the kingdom *smalt* as good and cheap as the like brought from beyond the seas within the seven years preceding the date of the first patent. The grant was expressed to be made by way of reward for Baker's great labours and expenses in attaining this mystery, and for his encouragement and that of others in the like endeavours. It prohibited the importation of smalt made abroad, and thus struck at a trade already existing when this monopoly was first granted.

With Baker's patent may be compared the patents granted by James I. for the making of *glass* with coal, on the pretext that it was necessary for the public good to stop the use of wood for this purpose; the making of glass with timber being alleged in the letters patent to be "the greatest and thiefest means to consume and destroy timber and wood." The glass patents created wide discontent, because, by prohibiting the importation of foreign-made glass, they at once raised the price and depreciated the quality of the glass formerly sold. (*x*)

Three other monopolies of an even more objectionable character, and most oppressively enforced, led to the intervention of the House of Commons. The first concerned inns, and in effect compelled every person who kept an inn to take out a license from certain private persons. (*y*) The second was of the same

(*w*) The first was granted to Baker jointly with two other persons. See these patents, 1 W. P. C. pp. 9 to 13.

(*x*) Three patents were granted for making glass; the first two being for the term of twenty-one years each. The third (to Sir Robert Mansel) was limited to a period of fifteen years. It was granted in 1624, and removed the restraint upon the importation of foreign glass. Further no rent or royalty was made payable under it to the Crown. In this way the enhancing of the price of glass was intended to be avoided. See 1 W. P. C. pp. 17 to 27.

(*y*) This grant was made (3rd March, 1617) apparently in the form of a Commission, Sir Giles Mompesson, Sir Giles Bridges, and James Thurburne being the grantees (Pat. Roll 14, Jac. I. c. 22). It authorized Sir Giles Mompesson, and at least one other Commissioner, to grant licenses for inns and charge fees for so doing, on the pretext that there were many unauthorized inns in the country. A second grant was made with reference

nature with respect to ale-houses. The third granted a monopoly of the making and selling of gold and silver thread. (*z*) Under this patent great quantities of counterfeit gold and silver thread were made from copper and other sophisticated materials, while persons who did an honest trade in the genuine articles were thrown into gaol, and fined severely as infringers of the patent. (*a*)

These monopolies led to a conference of the two Houses. Sir Giles Mompesson and Sir Francis Michell, who had been mainly instrumental in enforcing them, were, in the Session of 1601, impeached by the Commons, degraded from their knighthood, and otherwise severely punished by the Lords. (*b*) The king, finding how high the feeling ran, himself came down to the House and announced his intention to revoke the grants.

The Statute of Monopolies.—The continued misuse of the royal prerogative in the granting of these illegal patents resulted in 1624 in the passing of the Statute of Monopolies (21 Jac. I. c. 3) (*c*). This Act, "forcibly and vehemently penned for the suppression of all monopolies," did not introduce any new principle of law. Reciting in its preamble the King's Book of Bounty, the royal command therein contained that suitors should not presume to move the king for grants of monopolies, and the fact that, nevertheless, upon misinformations and untrue pretences of public good, many such grants had been unduly obtained and unlawfully put in execution, it enacted that all monopolies and all commissions, grants, licenses, charters, and letters patent

to the same matter sixteen days later, to Sir Giles Mompesson and his brother (19th March, 1617). See *Archæologia of Soc. of Antiquaries of London*, vol. xli. p. 235. The Commons reported to the Lords that proceedings had been taken against 4000 persons under this monopoly (see *Parl. Hist.*, vol. i. 1219).

(*z*) Sir Giles Mompesson was also charged as the principal offender under this patent. He was not, however, the patentee, but a Commissioner under a royal Commission issued to enforce the patent. The original patent was granted in 1611 to four patentees for a term of twenty years, on the assumption that they were introducing a new trade into England. It was surrendered, and a new patent granted in 1616 for twenty-one years. This patent granted to three patentees the sole making, working, beating, cutting, milning, and flatting of gold and silver thread. It also was surrendered, and a third patent granted to one Fowle, in 1618. Sir Giles Mompesson's name first appears in a Commission to enforce this last patent, dated 20th October, 1618. Two royal proclamations and two royal Commissions were issued in aid of these patents. See *Archæologia of Society of Antiquaries of London*, vol. xli. Paper by S. R. Gardiner on *Four Letters of Lord Bacon*, p. 217.

(*a*) See *Parl. Hist.*, vol. i. 122; also *Rapin*, vol. ii. bk. 18, pp. 203, 204.

(*b*) The estate of Mompesson (who had escaped abroad) was confiscated and the king added banishment to his punishment. Michell was fined £1000, ordered to be imprisoned for life, and carried on horseback with his face to the tail, through the public streets of London. Ibid.

(*c*) "This Act moved from the House of Commons." Coke, 3 *Inst.* 181.

heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate, whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, 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. (*d*)

To this sweeping condemnation of all monopolies, the Statute, however, like the King's book, allowed of one exception.

"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, of the sole working or making of any manner of new manufacture within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accomplished from the date of the first letters patent or grants 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." (*e*)

Thus, the limit of a reasonable time for which a patent monopoly might be granted was fixed so that it should not exceed fourteen years. Doubts, however, were entertained by some as to whether this period was not hurtful to the public on account of its excessive length, having regard to the circumstance that seven years was the legal term of apprenticeship. Hence the addition to the above section of its concluding words. Sir Ed. Coke, who took a principal part in pressing on the Bill, says with reference to this point—

"It was thought that the times limited by this Act were too long for the private, before the commonwealth should be partaker thereof and such as served such privileged persons by the space of seven years in making or working of the new manufacture (which is the time limited by law of apprenticehood) must be apprentices or servants still during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto as should be requisite for the commonwealth after the privilege ended. And this was the true cause wherefore, both for the time passed and for the time to come, they were left of such force as they were before the making of this Act." (*f*)

(*d*) 21 Jac. I. c. 3, s. 1.
(*e*) Ibid. s. 6.
(*f*) 3 *Inst.* 184. For an unsuccessful opposition by apprentices to the extension of a patent term, see *Baxter's Patent*, 13 Jur. 593.

Certain existing patents, including the glass and smalt patents above-noticed, were excepted from the operation of the Act, and left of such force as they would have been if the Act had not been made. (*g*) This appears to have been done upon the intervention of the Lords, the Commons consenting "not in love of these patents, but to the passage of the Bill." (*h*)

The Statute of Monopolies Affirmative of the Common Law.—Thus the Statute of Monopolies created no new patent right. It merely forbade the granting of those monopolies which the law had already declared to be *ultra vires* of the royal prerogative. All legal patent grants were left precisely where they stood before, except that in no future case could the term of a patent grant exceed fourteen years. "This Act," says Sir Ed. Coke, "maketh patents no better than they should have been if the Act had not been passed." (*i*)

The making of the grant still remained, as it does to-day, a matter of royal grace and favour. Neither this nor any subsequent Act requires the grant to be made in any given state of circumstances. It is still made *ex speciali gratia*, and remains what it has always been, an exercise of the prerogative. (*j*)

At one time it was supposed that a patent grant was in the nature of a bargain or contract between the inventor and the Crown, and many judicial dicta may be found supporting this view. In *Feather* v. *The Queen* (*k*), however, the Court of Queen's Bench, after full and elaborate argument at the bar, decisively rejected this contention. "It was contended," said Cockburn, C.J., "on the part of the patentee that the patent was based on a species of contract between the patentee and the Crown, in which the patentee, by communicating the secret of his invention to the public, gave a valuable consideration for the grant which he obtained; so that the grant being based on such a consideration, should receive the more liberal construction which it has been held that royal grants, when proceeding on a valuable consideration from the grantee, ought to receive. It appears to us that the assumption on which this presumption rests is altogether fallacious. The grant of the patent is, as has been explained, simply an exercise of the prerogative."

(*g*) 21 Jac. I. c. 3. See ss. 10, 11, 13, 14.

(*h*) *Journals of the House of Commons.* May 1, 1624. See note 1 W.P.C. 27.

(*i*) 3 *Inst.* 184.

(*j*) The prerogative right of the Crown to grant or withhold letters patent was expressly saved, so that it should not be in any way abridged, by the Patent Law Amendment Act, 1852; and a like provision has been inserted in the Patents Act, 1883. (See 15 & 16 Vict. c. 83, s. 16, and 46 & 47 Vict. c. 57, s. 113.)

(*k*) 35 L. J. Q. B., 205; 6 B. & S. 257.

No definition other than that in section 6 of the Statute of Monopolies has been attempted by the legislature of the subject-matter in respect of which that prerogative may lawfully be exercised; subsequent Acts merely referring to and incorporating this section. (*l*)

To sum up, then, the contents of this chapter; it may be said that the stream of English patent law still flows direct from the fountain of the royal prerogative; but along the defined course, and within the narrow channel which the ancient allowance of the common law determined centuries ago, and parliament subsequently ratified and affirmed by express enactment.

(*l*) 15 & 16 Vict. c. 83, s. 55; 46 & 47 Vict. c. 57, s. 46.

CHAPTER II.

THE GRANT: ITS TERMS AND EFFECT.

Form of the Grant.—As the grant to an inventor of the sole use of his invention is a mere exercise of the prerogative, the Crown is not restricted, in conferring the monopoly, to any special form of grant. By ancient custom, however, such grants are invariably made by open letters and not by charter. (*a*) A form of letters patent for an invention is provided by the Patents Act, 1883, but the use of that form is optional as the Statute only enacts, "Every patent may be in the form in the first schedule to this Act." (*b*) In practice, however, all patents for inventions now granted substantially follow the scheduled form; such variations as are used being introduced merely for the purpose of adapting that form to the differing circumstances of particular applicants. (*c*) It will be sufficient, therefore, in discussing the terms of the grant to examine the statutory form.

Address and Recitals.—Shorter and more concise than the ancient grants, the form now in use is nevertheless in all its essential features of great antiquity. It begins in the name of the Sovereign and is addressed at large.

"*Victoria by the grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith: to all to whom these presents shall come greeting.*"

Being an open grant, the contents of the patent are presumed in law to have come to the notice of, and be binding upon, all subjects of the Crown. (*d*)

(*a*) See ante, p. 3.

(*b*) Patents Act, 1883, s. 33, first sched. form D.

(*c*) The Board of Trade may vary the scheduled form (Patents Act, 1883, s. 101). Special forms are now in use intended to meet applications by the following: a single inventor; a joint inventor; an importer; joint applicants; legal representatives of a deceased applicant; legal representatives of a deceased inventor; a female inventor; and joint applicants where one of the original applicants is dead.

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

Next follow the recitals, the first setting forth the name of the grantee, the nature of his invention, and his representation to the Crown that the invention is lawful subject-matter for a patent grant—

Whereas, John Smith, of 29, *Perry Street, Birmingham, in the County of Warwick, Engineer, hath* (*e*) *represented unto us that he is in possession of an invention for "Improvements in Sewing Machines," and that he is the true and first inventor thereof and that the same is not in use by any other person to the best of his knowledge and belief.*

This recital alleges the applicant to have made certain representations to the Crown to induce the grant. These representations rebut the common law objections to the grant of a monopoly, for they allege the invention to be new and not already in use; thus suggesting to the Crown that the grant will not deprive any other subject of any right he already possesses. This recital also suggests that the grant is justified in the public interest as an encouragement to a deserving person, viz. a true and first inventor. By thus rebutting the common law objections to a monopoly (*f*) the applicant brings himself within the saving powers of Section 6 of the Statute of Monopolies. (*g*) This recital further states that the patentee is in possession of "an invention." Formerly there was nothing to prevent the Crown including more than one invention in the same grant. Now, however, it is enacted that "Every patent shall be granted for one invention only." (*h*)

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (*hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee*) *our Royal Letters Patent for the sole use and advantage of his said invention.*

Here, again, the grant is represented to have been made at the solicitation of the patentee. It includes not only the grantee himself, but also his executors, administrators, and assigns; so that the legal rights which the patent confers are not merely personal to the inventor, but may be transferred to others by assignment, (*i*) and pass, on his decease, to his legal representatives.

(*e*) The words "by his solemn declaration" are omitted here, as the declaration is not now made under the Statutory Declarations Act, 1835. See post, Patents Act, 1885, s. 2; also Patent Rules, 1890, rule 6.

(*f*) See ante, pp. 4, 8.

(*g*) 21 Jac. I. c. 3.

(*h*) Patents Act, 1883, s. 33. It is not, however, 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. Ibid.

(*i*) Unless the terms of the grant included assigns, the patent would not be assignable (*Duvergier* v. *Fellows*, 10 B. & C. p. 829). Now by s. 46 of the Patents Act, 1883, the word patentee in that Act

What the patentee solicits from the Crown is a monopoly: the sole use and advantage of his invention. Apart from the grant he could not have this privilege, for the law does not recognize any property in an invention such as the copyright in a book or a work of art.

And whereas the said inventor hath by, and in his complete specification, particularly described the nature of his invention.

The subject of the specifications will be dealt with hereafter; meanwhile it may be pointed out that, by an ancient rule of law, no royal grant can be supported which is not certain. The subjects of the king must know what the king grants, otherwise the letters patent are void. (*j*) This recital, by alleging that the subject-matter of the grant has been defined, suggests that this rule of law has been satisfied.

The filing of a complete specification is now a statutory requirement, and no patent is sealed until this has been done (*k*). Besides ascertaining and defining the subject-matter of the monopoly, this specification likewise gives to the public the knowledge of how the invention may be put in practice by them at the conclusion of the patent term. If the patentee were not compelled to give this information, the object of all patent law—the advancement of trade—would clearly be frustrated.

No mention of specifications is to be found in the Statute of Monopolies. At the passing of that Act, it was assumed that a new invention would, in effect, be a new trade, and put in use with the aid of apprentices who, as instructed persons, would be able to work the invention at the termination of the monopoly, and thus create a new industry. (*l*)

In the form of letters patent, authorized by the Patent Law Amendment Act, 1852, the recital as to the specification alleged that the patentee had therein also described the manner of performing the invention. (*m*) It is not apparent why this should have been omitted from the present form, seeing that the complete specification is still required to fulfil this function. (*n*)

And whereas we, being willing to encourage all inventions which

"means the person for the time being entitled to the benefit of a patent."

(*j*) *Lightfoot* v. *Lenet*, 3 Croke, 421; Comyn's *Digest*, Title Grant G. 6; Viner, Title, Prerogative F. C.; *Boulton* v. *Bull*, 2 H. Bl. 484; *Eastern Archipelago* v. *The Queen*, 2 E. & B. 892; 23 L. J. Q. B. 82.

(*k*) Patents Act, 1883, s. 5 (4).

(*l*) A condition that the patentee should employ apprentices was sometimes inserted in the grant.

(*m*) 15 & 16 Vict. c. 83, schd.

(*n*) Patents Act, 1883 (46 & 47 Vict. c. 57), s. 5 (4).

may be for the public good, are graciously pleased to condescend to his request.

This is a recital that in granting the monopoly the Crown is using its prerogative for the public benefit, and thus conforming to an established rule of law: For "the prerogative, as a general principle, affords the Sovereign the liberty of restraint only when the public good is the object in view." (*o*)

It is also a declaration of the intention of the Crown in making the grant. This is important, as the grant is void if it contradicts the intention. (*p*) Therefore if the invention be not new, or the patentee not the first or true inventor of it, the monopoly is not for the public good, and the letters patent cannot be supported.

The foregoing observations apply to the respective recitals. In addition, it may be noticed generally, that recitals in grants by the Crown are no estoppel upon the grantor. For, contrary to the rule applicable to private grants, such recitals are construed as mere suggestions emanating from the grantee, and binding only upon him. Hence, if any one of the recitals is false the grant is void, on the assumption that the Crown has been deceived by the false suggestion. (*q*) Moreover if the recited consideration is bad in part, (*e.g.* if any part of the invention claimed is not new), the grant is void, for the consideration is one and entire, and if it fails in part it fails in all. (*r*)

This rule has a far-reaching effect, for a royal grant possesses the distinguishing characteristic that it can be declared void, not merely in proceedings for its revocation between the Crown and the grantee, but also in any suit brought upon it by the grantee against a third party. (*s*) Letters patent can thus, notwithstanding the above recitals, be found invalid in an action of infringement, where the recited invention is proved not to be lawful subject-matter.

The Operative Part of the Grant.—*Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, do by these presents for us, our heirs and successors*

These words, which are common form of ancient standing in grants by letters patent, are manifestly inconsistent with the

(*o*) Chitty, *Prerogative of the Crown.* Preface.

(*p*) Coke, 1 Rep. 46 a.

(*q*) *Alton Wood's Case*, Coke, 1 Rep. 40 b; Comyn's *Digest*, Title Grant G. 8, 9. See, also, *Lord Chancellor's Case*, Hob. 214.

(*r*) *Morgan* v. *Seaward*, 2 M. & W. 544; 1 W. P. C. 187; 6 L. J. Ex. 153; *Brunton* v. *Hawkes*, 4 B. & Ald. pp. 552, 558. As to curing an invalid patent by disclaimer, see post, p. 257, chap. xiii.

(*s*) *Travell* v. *Carteret*, 3 Lev. 134; *Alcock* v. *Cooke*, 5 Bing. 340.

recitals already considered, and, it would seem, have now little meaning. Strictly construed, they import that the grant is a voluntary exercise of the prerogative made on the certain knowledge of the Crown, and without the solicitation of the grantee. The words "especial grace" shew that the grant is not a matter of right, but an act of bounty on the part of the Crown. (*t*) They negative the suggestion which has sometimes been made, that the patent is in the nature of a contract between the patentee and the public, (*u*) and indicate that the grant is in law a mere exercise of the prerogative. The words "certain knowledge" imply that the Sovereign has knowledge of the invention granted, and relies, in making the grant, upon that knowledge and not upon the suggestions of the patentee. (*v*) If these words, therefore, were strictly construed they would effectually cure any falsity in the recitals and prevent a patent being upset on that ground. They do not, however, have this effect, for the common law early placed the curious construction upon them that the king's knowledge is to be intended only of verity, which is the proper object of science, and not of falsity, which is a *non-ens* whereof the king cannot have knowledge. (*w*) Hence, notwithstanding these words, where the king was deceived in his grant it was held that the patentee could get no advantage by them.

The words "mere motion" are likewise now of little more than antiquarian interest. Strictly construed, they imply that the letters patent are granted at the instance of the Crown without any suit or request of the grantee. (*x*) They therefore directly contradict the recitals already discussed and are utterly at variance with the actual practice now in force: the grant always being made in pursuance of an application left at the Patent Office by the patentee. They are words of ancient use, however, in letters patent, and are said by Sir Edward Coke to have been introduced into royal grants to prevent such grants being avoided by the operation of the statute 4 Henry IV. c. 4, in which the king declared that he would abstain from granting any part of his revenues, lands, or wardships, unless to those who had deserved,

(*t*) See Viner, *Abridgement*, Title Prerogative, E. C. 3 (*c*), Coke, 10 Rep. 113 a.

(*u*) See *Brunton* v. *Hawkes*, 4 B. & Ald. 551; *Walton* v. *Potter*, 1 W. P. C. 595; *Gibson* v. *Brand*, 1 W. P. C. 629; *Feather* v. *The Queen*, 6 B. & S. 285.

(*v*) See Coke, 10 Rep. 112 b; Viner, *Abridgement*, Title Prerogative; Bacon, *Abridgement*, 7th edit. vol. vi. p. 515. The introduction of these words in royal grants was due to the statute, 1 H. IV. c. 6.

(*w*) Coke, 10 Rep. 112 b.

(*x*) Viner's *Abridgement*, Title Prerogative, E. C. 3 (1); Coke, 10 Rep. 113 a.

and that those who sued for any such thing should be punished, and not have the thing for which the suit was made. (*y*) It has also been said that the words "certain knowledge and mere motion" entitle the patentee, contrary to the rule in royal grants, to have the grant construed beneficially to himself; it seems doubtful, however, whether any actual benefit really accrues to the patentee from them. The words "our heirs and successors" are obviously intended to save the patent privilege being avoided by a demise of the Crown. But as such demise does not in law determine the grant, they are mere surplusage. (*z*)

Give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents or licensees and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents.

It is difficult to say what is the precise effect of the above words in letters patent; they have on first consideration the appearance of a granting clause, but they are not now followed by any habendum clause, as in the case of some of the older grants and the form used under the Patent Law Amendment Act, 1852. They would seem rather to be in the nature of a statement of that intention of the Crown in making the grant to which effect is given by the prohibitory clause which follows. The words "especial license, full power, sole privilege, and authority" are words of ancient use, and, like others already considered, have now an antiquarian rather than a practical interest. (*a*) They were introduced into letters patent at a time when trade was closely regulated and controlled by privileged companies and guilds, and were perhaps intended to prevent the patentee's use of his invention being held to be an interference with the privileges of some existing trade society or company. (*b*).

(*y*) Coke, 10 Rep. 113 a.

(*z*) Comyn's *Digest*. See Title Grant G. 3.

(*a*) In *Gilbert's Patent* (1618), Rymer. vol. xvii. p. 102, the corresponding words are "full and sole license, power, privilege, and authority;" while in some of the old grants this clause is rendered "full and free liberty, license, power, and authority:" see *Dudley's Patent*, 1 W. P. C. 14; *Mansell's Patent*, 1 W. P. C. 21.

(*b*) See Gordon's *Monopolies by Patents*, pp. 121, 122.

The words "make, use, exercise, and vend the said invention" differ somewhat from the corresponding words in the ensuing prohibitory clause. It may also be noticed that the word "vend" does not occur at all in the Statute of Monopolies, where the monopoly saved by Section 6 is the "sole working or making of any manner of new manufactures." (*c*)

It does not appear, however, that any real importance attaches to these variations; the intention of the grant, as subsequently expressed, being to give the patentee the whole profit and advantage of the invention, which he manifestly would not have unless the exclusive right of original sale were included. At the same time, once the patentee or his agent has sold the patented article the law implies a license to the purchaser, or any other person in whom the ownership of the article may subsequently become vested, to re-sell without interference by the patentee. (*d*)

The words "make, use, exercise and vend," are another instance of archaic language in the grant, and would seem to have reference to ancient trade distinctions, now of no practical importance.

The construction which the Courts have put upon the word "making" in the Statute, in fact renders the word "vend" in the letters patent redundant and unnecessary. "If a man buys and sells," said Jervis, C.J., in *Holmes* v. *London and North Western Railway Company*, (*e*) "he may be said to be making by the hands of another." And, notwithstanding the circumstance that the Statute only saves from illegality monopolies of "working" and "making," it has long been established that an unlicensed sale of a patented article is an infringement of the patent right. (*f*)

The area of the patent's operation is the United Kingdom and the Isle of Man. In the form of grant scheduled to the Patent Act, 1852, the Channel Islands were also included; (*g*) but they are now excluded by Section 16 of the Patents Act, 1883, which limits the effect of the letters patent to the above area. The position of the Channel Islands is peculiar, for the Act of 1852, which

(*c*) The words "sole buying and selling" are found in s. 1 of 21 Jac. I. c. 3, where any patent for sole buying and selling is declared to be void.

(*d*) *Thomas* v. *Hunt*, 17 C. B. (N. S.), 183; *Smith* v. *Buchanan*, 26 Sol. J. 347; *Heap* v. *Hartley*, 5 R. P. C. 503; 6 R. P. C. 496; but see post, p. 342.

(*e*) Macr. P. C. p. 23.

(*f*) *Minter* v. *Wells*, 4 A. & E. 251; *Gibson* v. *Brand*, 1 W. P. C. 630; *Walton* v. *Lavator*, 29 L. J. C. P. 279; *Oxley* v. *Holden*, 8 C. B. (N. S.), 666; 30 L. J. C. P. 68; *Elmslie* v. *Boursier*, 9 L. R. Eq. 217; 39 L. J. Ch. 328; *Von Heyden* v. *Neustadt*, 14 C. D. 230; *United Tel.* v. *Sharples*, 29 C. D. 164; *United Tel.* v. *Henry*, 2 R. P. C. 12.

(*g*) 15 & 16 Vict. c. 83, s. 18.

included them, is repealed, and the later Patent Acts do not apply to those islands. (*h*)

The term of the grant is fourteen years. This is in accordance with the Statute of Monopolies, by which royal grants of this description were limited to that number of years. (*i*) The theory of the common law, as already indicated, (*j*) was that the monopoly was only lawful when granted for a reasonable time; by the Statute, parliament fixed a reasonable time at fourteen years. A patentee may, however, in certain cases, obtain a prolongation of his monopoly, in the form of a further grant, if the Judicial Committee of the Privy Council so advise. The circumstances under which such a prolongation may be obtained will be considered hereafter; it is sufficient here to state that such a prolongation of the patent privilege is never granted unless it can be shewn that the object of all patent law, viz.—the encouragement of the inventor by the provision of a suitable reward for his ingenuity—has been defeated by circumstances beyond the patentee's control.

The term of the patent includes the day of its date. (*k*) The grant is dated as of the day of the application; (*l*) unless the grant is made under the international and colonial arrangements authorized by Section 103 of the Patents Act, 1883, when the patent is dated as of the day of application for the foreign patent. (*m*)

The Prohibitory Clause.—*And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, we do, by these presents, for us, our heirs, and successors, strictly command all our subjects whatsoever, within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly, make use of, or put in practice the said invention, or any part of the same, nor make, nor cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license, or agreement of the said patentee in writing, under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee, according to law, for his damages thereby occasioned.*

The above prohibitory clause is addressed to all subjects of the

(*h*) See Patents Act, 1883, ss. 112 and 117.

(*i*) 21 Jac. I. c. 3, s. 6. See, also, s. 17 (1) of the Patents Act, 1883.

(*j*) See ante, pp. 7, 8.

(*k*) *Russell* v. *Ledsam*, 14 L. J. Ex. 353; 14 M. & W. 574, 583.

(*l*) Patents Act, 1883, s. 13.

(*m*) See post, Patents Act, 1883, s. 103 as amended by Patents Act, 1885, s. 6.

Crown within the United Kingdom and the Isle of Man. This does not, however, mean that an infringement committed by an alien within the territorial limits of the letters patent is not a violation of the patent right. (*n*) The words of prohibition are very wide and cover all colourable imitations of the patented article or process. They cover also not only the whole invention, but any part thereof. That is, any part claimed by the patentee in his complete specification, for only what the patentee claims is protected. The terms of the prohibition do not apply, however, to persons acting under the license of the patentee. It would at first sight seem that such license is only effectual if given under seal. It has, however, been decided that a parol license is sufficient, and in certain cases the law will imply a license from the conduct of the parties. Where, however, it is intended to register the license, a license under seal is required.

The reference to the penalties, inflicted on offenders for contempt of the royal command, has now only an antiquarian interest. At one time, however, these penalties, stringently enforced by the Court of Star Chamber, were the most formidable weapon of the monopolist. The patentee's present remedy against an infringer of the patent right is an action of infringement, in which he can claim damages or an account of profits and an injunction. (*o*)

The Provisoes.—*Provided that these our letters patent are on this condition that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained.*

These words appear to provide a simple mode of revoking letters patent which are found not to fulfil the necessary

(*n*) *Caldwell* v. *Vanvlissengen*, 9 Hare, 426; 21 L. J. Ch. 97.

(*o*) The Statute of Monopolies, with the object of defeating the jurisdiction of the Star Chamber (which, as a committee of the King's Privy Council, was disposed to uphold all royal grants irrespective of their legality), enacted that all monopolies, and all such commissions, grants, licenses, charters, letters patent, proclamations, inhibitions, etc., should be examined, heard, tried, and determined by and according to the common laws of this realm and not otherwise. See 21 Jac. I. c. 3, s. 2.

conditions of a valid grant. The proviso is of great antiquity: a substantially identical clause being found in patent grants prior to the Statute of Monopolies. (*p*) In modern times, however, no recourse has been had to this mode of getting rid of an invalid patent. Nor is it likely that this remedy will again be resorted to, revocation by petition providing a sufficient means of avoiding a bad patent. Moreover, it is doubtful whether the proviso is now good in law, having regard to the terms of Section 2 of the Statute of Monopolies, which enacts that the validity of such grants shall be left to be determined according to the common law; for this would seem to exclude the interference of the Privy Council. These considerations suggest that the continued inclusion of this proviso in letters patent arises merely from a slavish following of the ancient forms, and that these words, like others in the grant, have now merely an historical interest.

Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in the manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void, notwithstanding anything hereinbefore contained.

Ancient grants by letters patent usually reserved a rent to the Crown. In the form of letters patent scheduled to the Patent Law Amendment Act, 1852, this rent took the form of stamp duty. Under the Patents Act, 1883, the payments of the patentee to the Crown are by way of fees, payable at stated intervals during the term of the patent. (*q*) The proviso for avoiding the patent privilege if the grantee makes default in these payments is now unnecessary, as Section 17 of the Patents Act, 1883, expressly enacts that "every patent shall, notwithstanding anything therein or in this Act, cease, if the patentee fails to make the prescribed payments within the prescribed times." Provision, however,

(*p*) See the Smalt Patent of July 17, 1606, 1 W. P. C. 10; also the patent to Lord Dudley of February 22, 1622, 1 W. P. C. 16.

(*q*) As to these payments, see post, Patent Rules, 1892 (second set).

exists for enlarging the time in cases of "accident, mistake, or inadvertence." (*r*)

The condition that the patentee shall provide the patented article for the public service if required has long been inserted in letters patent. The grant being a matter of grace and bounty, and not of right, the Crown has full power to impose such a condition; (*s*) but the provision that the price of such articles shall be settled "in manner for the time being by law provided" is new. The present provision as to this is contained in Section 27 of the Patents Act, 1883, which enacts as follows:—

(1) "A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject. (*t*) (2) But the officers or authorities administering any department of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on with the approval of the Treasury, between those officers or authorities and the patentee, or in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

In view of this express enactment it would seem that the proviso that the patentee shall, if required, supply the patented article for the public service is now of little importance; for as the public authorities may, by virtue of the Statute, themselves use the invention even before the patent is sealed, the occasion contemplated by the condition is hardly likely to arise. It may be noted, however, that if it does, and the patentee fails to observe the obligation created by this condition, the patent is void by the terms of the grant, although such a penalty does not attach by Statute.

Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: and lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness thereof we have caused these our letters to be made patent this one thousand eight hundred and and to be sealed as of the one thousand eight hundred and .

The granting of licenses by patentees will be considered

(*r*) Patents Act, 1883, s. 17 (3) (4).

(*s*) See Hindmarch, *Patent Law*, p. 431.

(*t*) Formerly the rule was otherwise; the Crown not being bound unless expressly named in the terms of the grant. As to this, see *Feather* v. *The Queen*, 35 L. J. Q. B. 200; 6 B. & S. 257.

hereafter. The above proviso saves the right of the patentee to grant licenses from being affected in any way by the special terms of the letters patent. (*u*)

The proviso that the grant shall be construed most beneficially to the patentee is inserted to except the letters patent from the ancient general rule of law that grants by the Crown shall be construed most strongly against the grantee.

The clause has now little importance. Questions of construction in regard to letters patent arise generally upon the terms of the specification, and notwithstanding dicta in many cases that that document ought to be construed benevolently, it is now settled law that specifications, like other written instruments, are to be construed according to the fair meaning of their terms without intending anything for or against the patent. (*v*)

The Authentication of the Grant.—The grant is made "patent," *i.e.* open, in order that all may be cognizant of its contents. It must be under seal. At common law all grants of privileges or franchises by the Crown require authentication by the great seal. (*w*) In the case of letters patent for inventions, however, the grant is now sealed with the seal of the Patent Office; all business arising from the exercise of the prerogative in the granting of letters patent for inventions being now transacted in that office. By statutory provision a patent so sealed has the same effect as if sealed with the great seal of the United Kingdom. (*x*)

If a patent is lost or destroyed or its non-production is accounted for to the satisfaction of the Comptroller-General of Patents, the Comptroller may at any time cause a duplicate thereof to be sealed. (*y*)

(*u*) See ante, pp. 20, 22.
(*v*) See post, p. 242, chap. xii.
(*w*) Comyn's *Digest*, Title Patent; A. & C. 2.
(*x*) Patents Act, 1883, s. 12.
(*y*) Ibid. s. 37.

CHAPTER III.

THE GRANTEE: TO WHAT PERSONS LETTERS PATENT FOR INVENTIONS MAY BE GRANTED.

The True and First Inventor.—The prerogative of the Crown to grant monopolies by letters patent and the form of such grants have already been considered. The limitations imposed by the law on that prerogative as to the persons in whose favour it may be exercised will form the subject of the present chapter.

By the operation of the Statute of Monopolies (*a*) this prerogative is now preserved only in the case of such persons as fall within Section 6 of that Act. That section, so far as at present material, is as follows:—

> "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 or inventors of such manufactures which others at the time of making such letters patent and grants shall not use."

Every patent must therefore be granted to the true and first inventor of a manufacture not already in use. Where, however, several applicants apply jointly for a grant of letters patent, it is now sufficient if one of such applicants is the true and first inventor. (*b*) So that an inventor who lacks the capital required to push his invention may now associate with himself as co-patentees persons in a more fortunate financial position.

The words true and first inventor have not been the subject of further statutory definition, but a long series of judicial decisions has placed upon them an interpretation now as binding upon the Courts as the Statute of James I. The general effect of these decisions was thus summarised by Sir George Jessel, M.R., in *Plimpton*

(*a*) 21 Jac. I. c. 3.

(*b*) Patents Act, 1885, s. 5.

v. *Malcolmson* (*c*): "As I understand, shortly after the passing of the Statute the question arose whether a man could be called a first and true inventor who, in the popular sense, had never invented anything, but who, having learned abroad that somebody else had invented something, quietly copied the invention and brought it to this country and then took out a patent. As I said before, in the popular sense he had invented nothing. But it was decided, and now, therefore, is the legal sense and meaning of the Statute, that he was a first and true inventor within the Statute, if the invention being in other respects novel and useful, was not previously known in this country—'known' being used in that particular sense as being part of what had been called the common or public knowledge of the country. That was the first thing. Then there was a second thing. Suppose there were two people, actual inventors, in this country, who invented the same thing simultaneously, could either be said to be the first and true inventor? It was decided that the man who first took out the patent was the first and true inventor. Then there was another point. If the man who took out the patent was not, in popular language, the first and true inventor, because somebody had invented it before, but had not taken out a patent for it, would he still, in law, be the first and true inventor? It was decided he would, provided the invention of the first inventor had been kept secret, had not been made known in such a way as to become a part of the common knowledge, or the public stock of information. Therefore in that case also there was a person who was legally the first and true inventor, although, in common language, he was not, because one or more people had invented it before him, but had not sufficiently disclosed it."

A true inventor (except in the case of an importer, to be considered hereafter) means a person who has in fact created a new invention by the exercise of inventive ingenuity: one who has himself found out by his own skill and application the discovery of which he seeks a monopoly. If, therefore, the person alleging himself to be an inventor has not found out the invention himself; if he has taken it from a book or from a prior patent, or borrowed it from another person, or learned it in a fiduciary capacity, he cannot in law be the recipient of a valid grant. (*d*)

(*c*) L. R. 3 C. D. 555; 45 L. J. Ch. 507.

(*d*) *R.* v. *Wheeler*, 2 B. & Ald. 349; *Minter* v. *Wells*, 1 W. P. C. 129; *Patterson* v. *Gas Light & Coke Co.* L. R. 2 C. D. 833; 3 App. Ca. 239; 45 L. J. Ch. 843; 47 L. J. Ch. 402.

Commenting on this in *Gibson* v. *Brand*, Tindal, C.J., said, "Now a man may publish to the world that which is perfectly new in all its use, and has not been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the legislature never intended that a person who had taken all his knowledge from the act 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." (*e*) In *Tennant's* case a patent for a bleaching preparation was held invalid when it appeared that a principal portion of the invention was due, not to the ingenuity of the patentee, but to the suggestion of a chemist who had assisted him. (*f*) So likewise where a workman in the employment of a master has made the discovery of an invention, the workman is the inventor, and not the master; (*g*) even though it be made in the employer's time, and with the use of his materials. (*h*)

How far an Inventor may be assisted by others.—This does not, however, preclude an inventor from obtaining help from others in perfecting and working out the details of his invention, and if a servant or professional assistant, working in such employment, makes a discovery subsidiary to the main invention, but of value in giving it practical shape and perfecting its use, such subsidiary discovery belongs to the master, and is considered in law to be his invention.

It may often be a question of some nicety, whether in such case the invention of the servant is, or is not, really subsidiary to, and therefore absorbed by, that of the master. As to this, Erle, J., directing the jury in *Allen* v. *Rawson*, said, "I take the law to be, that if a person has discovered an improved principle, and employs engineers or agents or other persons, to assist him in carrying out the principle, and they, in the course of the experiments arising from that employment, make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be

(*e*) 1 W. P. C. 627; 11 L. J. C. P. 177. See, also, *Walton* v. *Potter*, 1 W. P. C. 592; *Cornish* v. *Keene*, 1 W. P. C. 507–509; *Muntz* v. *Foster*, 2 W. P. C. 102; *Household* v. *Neilson*, 9 Cl. & F. 788.

(*f*) D. P. C. 429; 1 W. P. C. 125 n.

(*g*) *Barker* v. *Shaw*, Holroyd 60; *Bloxam* v. *Elsee*, 1 C. & P. 558; 1 W. P. C. 132 n.; *Barber* v. *Walduck* cited, 1 C. & P. 567.

(*h*) *Heald's Patent*, 8 R. P. C. 430; *Saxby* v. *Gloucester Waggon Co.*, Griff. A. P. C. 56.

embodied in his patent; and, if so embodied, the patent is not avoided by evidence that the agent or servant made the suggestions of that subordinate improvement of the primary and improved principle." (*j*)

In this case the patent was for improvements in the manufacture of felted fabrics. The invention related to the formation of the layer, or bat of wool, a preparatory step to the operation of felting. The patentee's method consisted of the employment of a roller mechanism, and in connection therewith he claimed, *i.a.* the use of a compound apron and longitudinal guides; both of these improvements had been suggested by workmen. On behalf of the defendant it was objected that the patent was bad because it included these claims.

The jury having found a verdict for the plaintiff, the Court of Common Pleas refused a new trial. Tindal, C.J., said, "The real question is, whether or not the improvements suggested by *Shaw* and *Milner* were of such a serious and important character as to preclude their adoption by *Williams* as part of his invention. It would be difficult to define how far the suggestions of a workman employed in the construction of a machine, are to be considered as distinct inventions by him, so as to avoid a patent incorporating them, taken out by his employer. Each case must depend upon its own merits But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." (*k*)

To put the test in another form, where the leading idea of the invention is the master's, and the workman's variations or additions are steps subsidiary and ancillary to that idea, there the master is in law permitted to include in his monopoly all such variations and additions as if he were in fact the true and first inventor of them.

In *Minter* v. *Wells*, where a similar question arose, Alderson, B., said, "If *Sutton* (the workman) suggested the principle to *Mr. Minter*, then he would be the inventor. If, on the other hand, *Mr. Minter* suggested the principle to *Sutton* and *Sutton* was assisting him, then *Mr. Minter* would be the first and true inventor, and *Sutton* would be a machine, so to speak, which

(*j*) 1 C. B. 551, at p. 567. See, also, Byles, J., in *Hatton* v. *Keane*, 7 C. B. (N. S.), 275.

(*k*) 1 C. B. p. 571.

Mr. Minter uses for the purpose of enabling him to carry his original conception into effect." (*l*)

"If a workman is employed by an inventor," said Davey, S.G., in *David* and *Woodley's* application "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." (*m*)

It may sometimes happen that the assistance which an employer receives from his servant assumes such importance that it is difficult to say, as between them, who in fact is the true inventor of the perfected invention. In such case the Patent Office authorities would now, if either opposed a grant to the other, refuse the letters patent, except in the form of a joint grant to them both. (*n*)

Inventor means, Inventor of all that is claimed.—The distinction between a subsidiary and an independent invention is of vital importance, because not only must the grantee be a true inventor, he must, further, be the inventor of everything which in his application to the Crown he represents himself to have discovered, (*o*) otherwise the grant will be void for false suggestion. (*p*)

This was clearly laid down in *Brunton* v. *Hawkes*. There Abbot, C.J., said: "But inasmuch as one of the things is not new, the question arises, whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The king could not in consideration of a new invention in one article grant a patent for that article and another. . . . The patent is granted upon the recital that he has made improvements in all three, and that they are all new, and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements the consideration fails in the whole, and the patentee is not entitled to the benefit of the other part of his invention." (*q*) In the same case, Best, J.,

(*l*) 1 Cr. M. & R. 505; 1 W. P. C. 133; 4 A. & E. 251.

(*m*) Griff. A. P. C. 26; *Homan's Patent*, 6 R. P. C. 104; *Kurtz* v. *Spence*, 5 R. P. C. 181.

(*n*) *Russell's Patents*, 2 De G. & J. 130; *Healey's Application*, Johnson, 165.

(*o*) See *Tennant's Case*, 1 W. P. C. 125 note; *Hill* v. *Thompson*, 1 W. P. C. 239.

(*p*) See ante, p. 17.

(*q*) 4 B. & Ald. 551.

said, "A patent taken out too large is not only void for the excess, but void altogether."

So also in *Losh* v. *Hague*: "If a man," said Lord Abinger, C.B., "claims by his patent a number of things, as being the inventor of them whether they consist of improvements or original inventions, and it turns out that some of them are not original and not improvements, his patent is void" (*r*).

"Upon the authorities," said Parke, B., in *Morgan* v. *Seaward* (*s*), "we feel bound to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in suit against a third party. It is on the same principle that a patent for two or more inventions where one is not new is void altogether, as was held in *Hill* v. *Thompson* (*t*) and *Brunton* v. *Hawkes* (*u*), 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 of 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 is maintainable upon it." (*v*)

A First Importer is an Inventor.—The first importer of a new manufacture from abroad is a true and first inventor within the meaning of the Statute.

This construction, which was first placed upon the Statute in the case of *Edgebury* v. *Stephens*, (*w*) was a mere reading into the words of the Act of the early practice at common law, (*x*) under which it had been held that any man who, by his own charge and industry, for the good of the realm, brought any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, might properly receive from the

(*r*) 1 W. P. C. 203, 204.

(*s*) 2 M. & W. 561; 1 W. P. C. 196.

(*t*) 2 B. Moo. 424; 8 Taunt. 375; 1 W. P. C. 237.

(*u*) 4 B. & Ald. 542. See, also, *Templeton* v. *Macfarlane*, 10 Court of Session Ca. 796; 1 H. of L. 595.

(*v*) Cf. *Roberts* v. *Heywood*, 27 W. R. 454; *Britain* v. *Hirsch*, 5 R. P. C. 74.

(*w*) 2 Salk. 447; 1 W. P. C. 35.

(*x*) See Tindal, C. J., in *Beard* v. *Egerton*, 3 C. B. 128.

king by patent the grant of a monopoly thereof, for some reasonable time, until the subjects might learn the same. (*y*)

"A grant to an importer is good," says Sir Edward Coke, "because such a person bringeth to and for the commonwealth a new manufacture, by his invention, cost, and charges, and therefore it is reason that he should have a privilege for his reward, and the encouragement of others." (*z*)

In the report of *Edgebury* v. *Stephens* it is stated to have been agreed by *Holt* and *Pollexfen* that, "If the invention be new in England a patent may be granted, though the thing was practised beyond sea before; for the Statute speaks of new manufactures within this realm; so that if they 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." (*a*)

In *Carpenter* v. *Smith*, (*b*) Lord Abinger, C.B., told the jury that a man has a right to a patent if he is the first person who brings into England an invention which is used abroad and not known in England, and that it was sufficient if the patentee was an "original importer."

In *Walton* v. *Bateman*, (*c*) Cresswell, J., stated the law thus: "The party obtaining the patent must be the true and first inventor in this country. If he imports from a foreign country that which others at the time of the making of such letters patent and grants did not use, it will suffice."

In *Beard* v. *Egerton*, (*d*) Tindal, C.J., said: "A person who has learned an invention abroad, and imported it into this country, where it was not used or known before, is the first and true inventor within the Statute."

In *Berry's Patent*, Lord Brougham, dealing with an application made to the Privy Council for the extension of a patent term, said: "The patent law is framed in a way to include two species of public benefactors; they are those who benefit the public by their ingenuity, industry, and science and invention and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the

(*y*) *Darcy* v. *Allin*, Noy's Rs. 178; 1, W. P. C. 6; *Clothworkers of Ipswich Case*, Godbolt, 252.

(*z*) 3 Inst. 184. See, also, Sheppard's *Abridgement*, Part III., Title Prerogative, p. 61.

(*a*) 2 Salk. 447, 1 W. P. C. 35. See, also, Eyre, C. J., in *Boulton* v. *Bull*.

(*b*) 1 W. P. C., pp. 535, 536.

(*c*) 1 W. P. C., p. 615.

(*d*) 15 L. J. C. P. 270; 3 C. B. 128, 129. See, also, *Stead* v. *Anderson*, 2 W. P. C. 149; *Stead* v. *Williams*, 2 W. P. C. 130; *Nickels* v. *Ross*, 8 C. B. 679.

results of foreign inventions. Now, the latter is a benefit to the public incontestably, and therefore they render themselves entitled to be put upon somewhat, if not entirely, the same footing as inventors." (*e*)

In *Marsden* v. *The Saville Foundry Company*, (*f*) Jessel, M.R., while recognizing the existence of the foregoing rule, strongly expressed the opinion that it was not possible to find any principle upon which to justify the putting of an inventor and an importer on the same footing. It is submitted, however, that the principle which has guided the Courts in this interpretation of the Statute is manifestly that suggested by Lord Brougham in *Berry's Patent*, as quoted above. For the merit in respect of which the law recognizes that an inventor deserves to be placed in the exceptional position of a monopolist is not the exercise by him of an unusual ingenuity *per se*, but the fact that he has made a contribution of value to the stock of industrial knowledge; and so far as the public are concerned, the value to them of that contribution is precisely the same whether the patentee has invented it by his personal ingenuity or imported it through his enterprise. In either case an addition is made to the stock of industrial knowledge, and hence in the eyes of the Crown, so far at least as the original grant is concerned, an inventor and an importer are properly held to be equally deserving of encouragement.

In *Beard* v. *Egerton*, (*g*) it was argued that the person who took out the patent as an importer must be a meritorious importer and not a mere clerk or servant; nor even an agent, acting for the purposes of the application only, upon a communication made by a foreign inventor. In rejecting this contention, Tindal, C.J., said: "No authority is cited for such distinction. So far as the public are concerned in interest, no such distinction is necessary. *Berry* (the patentee) is an Englishman, to whom the invention is communicated by a foreigner residing abroad; and *Berry* first brings the invention into England and makes it public there. So far, therefore, as relates to the interests of the public, *Berry* has all the merit of the first inventor." (*h*)

A foreign inventor may thus obtain a grant of an English patent, in the name of a person resident in England, who acts as a mere trustee for such foreigner. Formerly one foreigner could obtain a grant of letters patent as an importer upon a communication

(*e*) 7 Moo. p. 189. See, also, *Claridge's Patent*, 7 Moo. p. 396; *Soame's Patent*, 1 W. P. C. 733.

(*f*) L. R. 3 Ex. D. 203.

(*g*) 3 C. B. 128, 129.

(*h*) See, also, *Nickels* v. *Ross*, 8 C. B. 679; *Stead* v. *Williams*, 2 W. P. C. 130.

made abroad to him by another foreigner. (*i*) Now, however, the application, if made by an importer, must be made by an applicant resident in England. (*j*)

The Importer must be an Importer from Abroad.—The importer must, however, be a genuine importer. His invention, whether he learns it abroad or has it communicated to him from abroad, must come from beyond the limits of the Kingdom. At one time it was doubted whether or not Scotland was within the Kingdom for this purpose, but that question has long been answered in the affirmative. (*k*)

"It would be a monstrous thing," said Lord Lyndhurst, C., in *Brown* v. *Annandale*, "if an invention having full publicity in one part of the Kingdom could be made the subject of a patent in another part of it." Lord Campbell, in the same case, said, "If the Crown were made aware of that fact the grant would be refused." (*l*)

Colonies of the Empire which have statutory powers to grant letters patent in their own dominions are, for the purposes of the inventor, foreign countries, and persons first importing inventions from them are qualified to be grantees of letters patent. (*m*)

In *Marsden* v. *The Saville Foundry Company*, (*n*) the plaintiff in an action of infringement alleged in her statement of claim that letters patent had been granted to her for an invention communicated to her by her late husband which was not in use by any other person or persons in the United Kingdom, and of which, therefore, she was the first introducer. The defendant demurred to the statement of claim as bad in law, because on the facts stated, the plaintiff could not be the true and first inventor within the Statute, the communication not having been made from abroad. Pollock, B., upheld the demurrer. His decision was affirmed on appeal.

"This is a mere experiment," said Jessel, M.R. "From the time of the passing of the Statute (21 Jac. 1, c. 3) down to the present time, no one, as far as I know, has contended in a court of law, much less has any court of law allowed, the validity of such a contention as that a communication made in England by

(*i*) *Re Wirth's Patent*, L. R. 12 C. D. 303.

(*j*) See *Patent Office Journal*, May 9, 1884; and Form A 1, Appendix II., post. The applicant may be a corporation; *Societé Anonyme, &c., du Temple*, 13 R. P. C. 54.

(*k*) *Roebuck* v. *Stirling*, 1 W. P. C. 45.

(*l*) *Brown* v. *Annandale*, 8 Cl. & F. 437. Now, by the Patents Act, 1883, s. 16, every patent takes effect throughout the United Kingdom and the Isle of Man.

(*m*) *Rolls* v. *Isaacs*, 19 C. D. 268; 45 L. T. (N. S.), 704.

(*n*) L. R. 3 Ex. D. 203; 39 L. T. 92.

one British subject to another British subject can be patented by the receiver of the communication, so as to make the receiver the true and first inventor within the meaning of the patent laws. 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. What possible right have we to say that we can now extend that privilege beyond the importation of the invention from beyond the seas to the case of a man who dies before taking out a patent, and whose legal personal representative, finding the invention sufficiently described amongst his papers, thereupon obtains a patent as upon a communication from him. Whether or not there should be legislative provision for such a case it is not for me to say. But there is none. He is neither the first nor the true inventor within the ordinary or existing legal meaning of the term." This legislative provision to meet the case of a deceased inventor has, however, now been made, as will be shortly indicated. (*o*)

It was at one time doubtful whether the Patents Act, 1883, had not introduced a modification of the law by excluding the rights of importers to rank as inventors, and in *Edmund's* case this view of the Act was pressed upon the Law Officer. Sir R. Webster, A.G., in refusing to accede to it said: "Prior to the passing of the Act of 1883 the law was well settled that a person importing into the realm an invention was the true and first inventor within the meaning of the Statute of James, and it mattered not under what circumstances he had obtained the invention from abroad. In my judgment, the Act of 1883 has made no alteration of the law in this respect. In the case of an imported invention the merit of the invention is the importation—the communication to the public in the United Kingdom and the Isle of Man; and I think, therefore, the Comptroller has no jurisdiction to enquire as to the circumstances under which the invention was obtained by the importer. Of course there may be cases in which the relations between the parties are such that the person who has first imported the invention may be guilty of some breach of contract or breach of duty towards the person from whom he has obtained the invention abroad, and the importer may be liable

(*o*) See post, p. 38; also Patents Act, 1883, s. 34.

to proceedings in respect of the breach of such contract or duty; but in my opinion these are matters which the Comptroller General and Law Officer cannot enquire into, but must form the subject of independent proceedings between the parties either in this country or abroad as the case may be." (*p*)

An importer who applies for a patent for an invention communicated from abroad may supplement that invention by original improvements of his own, and does not thereby invalidate any patent granted upon the application. "It was suggested," said Lindley, L.J., in *Moser* v. *Marsden*, "that as the English patentee had himself improved *Grosselin's* invention, the specification ought to have shewn this on the face of it; and that as the whole invention was not communicated to the plaintiff by *Grosselin*, as stated by the plaintiff, his patent is bad. This point has been raised before, but as yet it has not found favour with any Court. Nor ought it. There is no substance in it. The patentee is the true and first inventor, within the meaning of the patent law, whether he invents himself, or whether he simply imports a foreign invention. I cannot see how he is anything but a true and first inventor if he does both; that is, if he both imports a foreign invention and improves it himself." (*q*)

Where two Persons simultaneously make the same Invention.—When two or more independent inventors simultaneously make the same invention the inventor who first discloses his invention to the public under the protection of letters patent is the true and first inventor. (*r*)

In *Cornish* v. *Keene*, (*s*) Tindal, C.J., said: "There may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent, and enjoy its benefits."

In *Henry's* Application (*t*) for letters patent, Lord Selborne, C., said: "I apprehend that it would be no answer to a *bonâ fide* applicant for a patent, assuming the absence of fraud or communication, to allege that experiments had been going on, or even

(*p*) Griffin, p. 283. See, also, *Higgin's Patent*, 9 R. P. C. 74, in which Sir R. Webster, A.G., said it mattered not even if the importer had stolen the invention abroad.

(*q*) 10 R. P. C. 359.

(*r*) *Forsyth* v. *Riviere*, 1 Carp. 401; 1 W. P. C. 97 *n.*

(*s*) 1 W. P. C. 508.

(*t*) L. R. 8 Ch. 237; 42 L. J. Ch. 356.

drawings made by another inventor. One person, being a *bonâ fide* inventor, comes first to ask for a patent for his invention, and such allegations are no answer to him. If a patent be granted to him, it would date from the date of his application. If he were the true inventor, the circumstance of something having taken place somewhere else, which was not disclosed to the world, and as to which no prior application was made, would be no answer to him, even if it were shewn that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time."

An Inventor means the First Discloser of an Invention.—The inventor who invents and first discloses his invention is the true and first inventor. Therefore an inventor who is not in strict language the first discoverer of an invention may still be a lawful recipient of a patent grant, if the earlier inventor who has anticipated him, has kept the invention secret.

Thus, in *Dollond's Patent* it was held that a patent for a new method of making object glasses was good, although the same discovery had been previously made by another, who had confined the invention to his closet and never disclosed it to the public. (*u*)

In *Hill* v. *Thompson*, Dallas, J., said that it was not enough to defeat the rights of a grantee to shew that there had been a prior discoverer of the invention, unless it was also shewn that that prior inventor had disclosed his discovery; (*v*) while in *Lewis* v. *Marling*, Bayley, J., said: "If I discover a thing for myself, it is no objection to my having a patent for it that another has also made the discovery, provided I first introduce it into public use." (*w*)

In *Carpenter* v. *Smith*, (*x*) Abinger, C.B., said: "That if an invention is new and useful, the inventor shall not be prejudiced by any other man having invented that before, and not made use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them." Hence "a man shall not, by his own private invention which

(*u*) 1 W. P. C. 43; Parl. R. 182; cited in 2 H. Bl. 470, 487. See, also, *Bramah* v. *Hardcastle*, 1 W. P. C. 44; Holroyd, 81.

(*v*) 8 Taunt. 395.

(*w*) 1 W. P. C. 126; 10 B. & C. 27.

(*x*) 1 W. P. C. p. 534.

he keeps locked up in his own breast or in his desk and never communicates it, take away the right that another man has to a patent for the same invention."

So likewise in *The Househill Iron Company* v. *Neilson*, Lord Lyndhurst said: "He is not called the inventor who has in his closet invented it, but who does not communicate it. . The first person who discloses that invention to the public is considered as the true inventor."

Aliens, Infants, Married Women, Lunatics, and Executors.—Provided the applicant for letters patent (or in the case of joint applicants, any one of them) satisfies the condition of being a true and first inventor, as above interpreted, it is not necessary that he should be a British subject. This had been decided prior to the Patents Act, 1883, (*y*) and is now expressly enacted by Section 4 of that Statute. (*z*)

So, too, letters patent may be granted to two or more inventors jointly, (*a*) and even to one inventor jointly with other applicants, who have not themselves that qualification. (*b*) In this way a corporation may join in an application for, and become a grantee of, letters patent. (*c*)

Infants, (*d*) married women, and lunatics may be grantees of letters patent. Section 99 of the Patents Act, 1883, provides the manner in which any declaration or act required by the Statute may be made or done on behalf of persons so incapacitated.

An important modification of the law was introduced by Section 34 of the same Act to meet the case of an inventor who died before he had obtained letters patent for his invention. (*e*)

That section provides, "If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative."

"Every such application must be made within six months of

(*y*) See Tindal, C.J., in *Beard* v. *Egerton*, 3 C. B. 128; *Chappel* v. *Purday*, 14 M. & W. 318. This is consistent with the early policy of the Crown in encouraging foreign subjects to bring new trades into England. See ante, p. 3.

(*z*) Whether the Crown would exercise its prerogative by granting a patent to an alien enemy is at least doubtful. See *Bloxam* v. *Elsee*, 6 B. & C. 169; 1 C. & P. 558; 1 W. P. C. 418 *n*.

(*a*) Patents Act, 1883, s. 4.

(*b*) Patents Act, 1885, s. 5.

(*c*) Patents Act, 1883, s. 117.

(*d*) See *Cheavin* v. *Walker*, L. R. 5 C. D. p. 858; 46 L. J. Ch. 265; 35 L. T. 757.

(*e*) See the case of *Marsden* v. *Saville Foundry*, L. R. 3 Ex. D. 203. See aute, p. 34.

the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention."

If an inventor dies after making application for a patent, but before it is sealed, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant. (*f*)

(*f*) Patents Act, 1883, s. 12 (3).

CHAPTER IV.

THE SUBJECT-MATTER OF THE GRANT.

Letters Patent Granted for Manufactures only.—The prerogative of the Crown to grant monopolies of inventions, and the limitations which the law imposes on that prerogative as to the persons in whose favour it may be exercised, have already been under review; the subject-matter of such grants must now be considered.

At the outset it is necessary to turn again to the Statute of Monopolies. By Section 6 of that Act the privilege of granting monopolies is preserved to the Crown only in respect of matters which can be brought under the following description. "*Any manner of new manufactures within this realm . . . which others at the time of the making of such letters patent and grants shall not use.*" Moreover, the Act further provides that such manufactures shall only be made the subject of grants by letters patent when "*not contrary to the law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient.*"

The inventor, therefore, who seeks a grant of letters patent must bring to the Crown a "manufacture." Further, such manufacture must be *new*. It must also be *useful*. The quality of utility is not specifically named in the Statute, but the words of the Act imply it. Prior to the passing of the Act the grant of a monopoly in a manufacture possessed of no utility was contrary to the common law, and at all times such a grant must necessarily be hurtful to the interests of the public, as calculated to obstruct and impede the discovery of really useful inventions. Lastly, a manufacture to be patentable, must be the fruit of ingenuity on the part of the inventor. In a word, it must imply *invention*. These qualities, which the law requires to be present in the subject-matter of all valid letters patent, will be considered in this and the five succeeding chapters.

Meaning of the Term Manufacture.—Recognizing that the primary object of all patent privileges is the advancement of trade and industry, the Courts have placed a very wide interpretation upon the term "manufactures." Alluding to this in *Boulton* v. *Bull*, Eyre, C.J., said: "I observe also that according to the letter of the Statute the words any manner of new manufacture in the saving fall very far short of the words 'anything' in the first section. But most certainly the exposition of the Statute, as far as reason will expound it, has gone very much beyond the letter. In the case in *Salkeld* (*a*) the words 'new devices' are substituted and used as synonymous with the words 'new manufacture.' It was admitted in the argument at the bar, that the word 'manufacture' in the Statute was of extensive signification; that it applied not only to things made, but to the practice of making, to principles carried into practice in a new manner, to new results of principles carried into practice." (*b*)

In *Ralston* v. *Smith*, Lord Westbury, C., said: "Your lordships are well aware that by the large interpretation given to the word 'manufacture' it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition to the thing produced, it will comprehend a new machine, or a new combination of machinery; it will comprehend a new process or an improvement of an old process." (*c*)

No comprehensive definition of all that the term "manufactures" may import has been attempted by the Courts. Nor, indeed, is such definition possible. (*d*) Judges have been content to define the term by stating illustratively what may be embraced under it.

A Thing Made.—It undoubtedly includes a thing made or produced.

In *R.* v. *Wheeler*, Abbott, C.J., said: "The word 'manufactures' has generally been understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, 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, as a stocking-frame, or a steam-engine for raising water from mines." (*e*)

'A thing made' does not, however, mean anything made; it

(*a*) *Edgeberry* v. *Stephens*, 2 Salk. 447.
(*b*) 2 H. Bl. 492, 493; Dav. P. C. 207.
(*c*) 11 H. of L. Ca. 246.
(*d*) *Per* Lopes, L.J., in *Blakey* v. *Latham*, 6 R. P. C. 189.
(*e*) 2 B. & Ald. 349.

must be a something industrial and vendible, for the Statute refers only to manufactures which are the subject of trade. (*f*)

"I approve of the term 'manufacture' in the Statute," said Heath, J., in *Boulton* v. *Bull*, "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." (*g*)

An Addition may be a Manufacture.—Owing to the immense progress of invention, it can hardly ever happen now (except in the case of chemical products) that the thing produced can be *in toto* a new manufacture. Yet it was at one time doubted whether an invention which merely added something to a known thing could be the subject of a patent. Thus in *Bircot's* case it was held by the Court of Exchequer Chamber that the addition to a manufacture cannot be the subject of a patent. For there it was said that that was to put a new button to an old coat, and it is much easier to add than to invent. (*h*) Lord Mansfield, however, refused to follow this case, and held in *Morris* v. *Bransom* (*i*) that an addition to an old stocking-frame was good subject-matter for a patent, saying, that if there could be no patent for an addition, that proposition of law would go far to repeal almost every patent that ever was granted. So, too, Eyre, C.J., in *Boulton* v. *Bull* (*j*) refused to follow *Bircot's* case; while in *Hornblower* v. *Boulton*, Grose, J., said that if *Bircot's* case were to be considered as law it would set aside many patents for many ingenious inventions, in cases where the additions to manufactures before existing were much more valuable than the original manufactures themselves. (*k*)

Nor is it any objection in law to the granting of a patent for an addition to shew that the manufacture to which the addition is made is the subject of a prior grant, provided the second patentee claims the addition only; for the second patent, after the expiration of the first, will be free from any objection, and even whilst the earlier grant subsists the second invention can lawfully be used by procuring a license, or purchasing the necessary apparatus, from the first patentee; and the probability of the refusal of a license to any one applying for it is so extremely remote that it cannot enter into consideration as a ground of legal objection. (*l*)

(*f*) See *Boulton* v. *Bull*, 2 H. Bl. 482; *Cornish* v. *Keene*, 1 W. P. C. p. 517.

(*g*) 2 H. Bl. 482.

(*h*) Coke, 3 *Inst.* 183; 1 W. P. C. 31 *n.*; temp. 15 Eliz.

(*i*) 1 W. P. C. 51; Bull N. P. 76 *c.*

(*j*) 2 H. Bl. 492; Dav. P. C. 205.

(*k*) 8 T. R. p. 104.

(*l*) *Per* Tindal, C.J., in *Crane* v. *Price*, 1 W. P. C. 413. As to the compulsory licenses

A New Process or Method of making an Old Article is a Manufacture.—In like manner it was at one time doubted whether the word "manufacture" could extend to the process or method of making as well as to the thing made. But in *Boulton* v. *Bull* (*m*) this meaning of the word was very clearly laid down by the Court of Common Pleas. In that case the patent was for a new method of using an old machine in a more beneficial manner than was before known. Eyre, C.J., said: "In the list of patents with which I have been furnished there are several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced are the saving of time and expense, and thereby lowering the price of the article and introducing it into more general use. Now, I think these methods may be said to be new manufactures, in one of the common acceptations of the word, as we speak of the manufacture of glass, or any other thing of that kind. The advantages to the public from improvements of this kind are beyond all calculation important to a commercial country, and the ingenuity of artists who turn their thoughts towards such improvements is in itself deserving of encouragement; and in my apprehension it is strictly agreeable to the spirit and meaning of the Statute Jac. 1 that it should be encouraged. . . . The patent cannot be for the effect produced, for it is either no substance at all, or, what is exactly the same thing as to the question upon a patent, no new substance, but an old one, produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed. It must then be for the method; and I would say, in the very significant words of Lord Mansfield in the great case of the copyright, (*n*) it must be for the method, detached from all physical existence whatever. . . . Probably I do not over-rate it when I state that two-thirds, I believe I might say three-fourths, of all patents granted since the Statute passed, are for methods of operating and of manufacturing, producing no new substances and employing no new machinery. . . . And shall it now be said, after we have been in the habit of seeing patents granted, in the immense number in which they have been granted, for methods of using old machinery to produce substances that were old, but in a more beneficial manner, and also for producing negative qualities by which benefits result to the public, by a narrow construction of the word 'manufacture' in this Statute, that there can be no

which may now be obtained under the Patents Act, 1883, s. 22, see post, p. 349.

(*m*) 2 H. Bl. 463 (1795).

(*n*) *Millar* v. *Taylor*, 4 Burr. 2397.

patent for methods producing this new and salutary effect, connected, and intimately connected as it is, with the trade and manufactures of the country? . . . It is not that the patentee has conceived an abstract notion that the consumption of steam in fire-engines may be lessened, but he has discovered a practical manner of doing it; and for that practical manner of doing it he has taken this patent. Surely this is a very different thing from taking a patent for a principle. It is not for a *principle*, but for a process." (*o*)

So, too, in *R.* v. *Wheeler*, Abbot, C.J., said: "The word 'manufacture' may perhaps also extend to a new process to be carried on 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 of a better or more useful kind." (*p*) Again, in *Morgan* v. *Seaward*, (*q*) Parke, B., said: "The word 'manufacture' in the Statute must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine."

In *Stevens* v. *Keating*, (*r*) where the patent was for improved processes of manufacturing stuccoes, plasters, and cements, a similar view was taken by the Court. Pollock, C.B., said: "The word 'manufacture' is introduced, and all patents must be for a manufacture. The real invention may not be so much for the thing when produced as for the mode in which it is produced; and its novelty may consist not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and, therefore, although the language of the Act has been said to apply only to manufactures, and not to processes, when you come to examine it, either literally, or even strictly, it appears to me the expression manufacture is free from objection, because though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture." In *Bush* v. *Fox*, (*s*) Coleridge, J., said: "In most of the cases cited the new method constitutes the manufacture. Manufacture includes both process and result." "One of the most useful of inventions," said James,

(*o*) 2 H. Bl. 494, 495, 496; Dav. P. C. 210-213.

(*p*) 2 B. & Ald. 350; followed by Tindal, C.J., in *Crane* v. *Price*, 1 W. P. C. 409; and *Gibson* v. *Brand*, 1 W. P. C. 633.

(*q*) 2 M. & W. 558; M. & H. 58; 1 W. P. C. 193.

(*r*) 2 W. P. C. 182.

(*s*) Macr. 176.

V.C., in *Elmslie* v. *Boursier*, (*t*) "is that of a process by which a common article may be made more economically than it was before."

It is no objection to a patent for a process to shew that a prior patent has been granted for another process aimed at the same end, provided the second process be new in itself, and distinct from the first.

In *Hullet* v. *Hague*, (*u*) the plaintiff claimed a specified method of hastening the evaporation of sugar. The plaintiff carried out his method by means of a large horizontal tube placed over the surface of the liquid. Into this tube were introduced a number of small perpendicular tubes, descending through the fluid to the bottom of the boiler, and having their lower ends exactly on a level, and parallel to the surface of the fluid. The air was forced by a blowing apparatus in at the open end of the large tube, and as the other end of that tube was closed, it descended through the smaller tubes to the bottom of the boiler, and thence bubbling up, facilitated evaporation. It was objected by the defendant that the plaintiff's patent had been anticipated by an earlier patent aimed at the same result. But the apparatus described in the earlier patent was a perforated coil of piping placed at the bottom of the vessel or boiler, and emitting the air through the perforations. The Court of King's Bench held that the plaintiff's patent was good as being for a different method and an apparatus perfectly distinct from that of the earlier invention.

A New Process means a Process distinct from any already known.—When the patent is for a new process it must, as above stated, be a process distinct from any other process already known. (*v*)

In *Curtis* v. *Platt*, (*w*) Lord Westbury, C., said: "If the idea started by one man be nothing in the world more than the discovery of a road to attain a particular end, it does not at all interfere with another man discovering another road to attain that end, any more than it would be reasonable to say that if one man has a road to go to Brighton by Croydon, another man shall not have a road to go to Brighton by Dorking. They are roads, and means of attaining the end, and unless you can prove that one is a colourable imitation of the other, or unless you can prove that one bodily incorporates the other with merely an addition, it is impossible to say that they shall not be co-existent subjects of contemporaneous patents."

(*t*) L. R. 9 Eq. 222.
(*u*) 2 B. & Ad. 370, p. 379.
(*v*) *Walton* v. *Potter*, 1 W. P. C. 590, 591.
(*w*) 11 L. T. (N. S.), 249.

In *Moore* v. *Thomson*, (*x*) Lord Halsbury, C., dealing with the rule that a new mode of attaining an old result is good subject-matter for a patent, said: "I will take the illustration which I think is that of Lord Westbury, in one of the cases relied on, in which he points out that the end and object (that is to say, the end in the Greek sense) of a ladder is to get down to the bottom of a pit, and that a man might have taken out a patent for a ladder which would include all sorts of instruments of that kind, but that if somebody invented a mode of lowering a man to the bottom of a pit with a rope, that could not be said to be an infringement of a patent for any sort of ladder, and yet the end and object of the invention would be the same, to get to the bottom of the pit."

When a patent is granted for a new method or process of attaining a known result, the protection it affords extends only to that particular method or process.

In *Bovill* v. *Pimm*, (*y*) Pollock, C.B., said: "It appears to us that where a subject is not new, as this certainly was not, viz. 'the cooling of substances undergoing the process of grinding' (which had been long known to be a desideratum in grinding, and to effect which various contrivances had been adopted, and several, if not many, patents taken out), any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase. In this case the common object was known, viz. cooling the grinding surfaces or the substances exposed to their action. The principle of obtaining a current of air by a rotating vane (if that can be called a principle) was already made known to the world by *Gordon's* patent. *Bovill's* method was an improvement on *Gordon's*. . . . *Rands'* is also probably a better method than *Gordon's*. . . . We think the patents as they appear before us are respectively independent original improvements; and that each is entitled to protection in respect of the method disclosed in it, but cannot claim beyond what is substantially the method actually described and given to the public."

A New Process may consist in the Omission of a Step in a Process already known.—A new process may consist in the omission of a step from some process previously pursued to the same end. If such an omission results in producing the same article in a cheaper

(*x*) 7 R. P. C. 333. (*y*) 11 Ex. 739.

or better form it is an improvement and may be made the subject of a patent. (*z*)

In *Wallington* v. *Dale*, (*a*) the patent was for improvements in the manufacture of gelatinous substances. Previous to the patent gelatine had been obtained by submitting large pieces of hide to the action of caustic alkali; or by reducing them to pulp in a paper machine and employing blood to purify the product. The patentee discovered that by cutting the hides into shavings, thin slices, or films, the use of blood for subsequent purification could be dispensed with, and this discovery was held to be good subject-matter for a patent. Again, in *Booth* v. *Kennard*, (*b*) the patentee claimed as his invention, making gas direct from seed, instead of making it from oil previously extracted. By this means the patentee got rid of one out of two processes. "Previous to this invention," said Cockburn, C.J., "the gas was obtained from oil previously expressed. The patentee says that instead of going through that first process of abstracting the oil, he makes it all at one process. I think that there can be no doubt it is a useful invention, and one for which a patent can be obtained, supposing it to be new."

A New Combination of Old Materials is a New Manufacture.—A new combination of old materials previously in use, if that new combination produces either a new result or an old result in a more useful and beneficial manner, is subject-matter for a patent.

In *Hill* v. *Thompson*, Lord Eldon, C., said, "There may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials." (*c*)

In *Cornish* v. *Keen*, (*d*) the patent was for improvements in the making of elastic goods or fabrics. In carrying out the invention strands of indiarubber were first covered by winding filaments tightly round them by an ordinary covering machine. They were then arranged as warp threads, and stretched to their utmost tension. Additional warp threads of cotton, flax, etc., were combined with the indiarubber strands. The cloth was then woven in the ordinary manner. Thereafter it was submitted to the action of

(*z*) *Russell* v. *Cowley*, 1 W. P. C. 467; 1 C. M. & R. 875.

(*a*) 7 Ex. 888; 23 L. J. Ex. 49.

(*b*) 26 L. J. Ex. 23 and 305.

(*c*) 1 W. P. C. 237; followed in *Crane* v. *Price*, 1 W. P. C. 409; *Murray* v. *Clayton*, L. R. 7 Ch. 584.

(*d*) 1 W. P. C. 508; 3 Bing. (N. C.) 570; 6 L. J. C. P. 225.

heat, which caused the indiarubber to contract and become elastic; the non-elastic threads, however, prevented the extension of the fabric exceeding a certain limit. In this way a new fabric of limited elasticity was produced. This new combination was held to be entitled to the protection of a patent, although the materials thus combined were before known and used. In delivering the judgment of the Court of Common Pleas, Tindal, C.J., said: "Does this invention come under the description 'any manner of new manufacture,' which are the terms employed in the Statute of James? That it is a manufacture can admit of no doubt; it is a vendible article produced by the art and hand of man; and of all the instances that would occur to the mind, when inquiring into the meaning of the terms employed in the Statute, perhaps the very readiest would be that of some fabric or texture of cloth. . . . That it comes within the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. The materials indeed are old, and have been used before; but the combination is alleged to be, and if the jury are right in their finding is, new, and the result or production is equally so. The use of elastic threads or strands of indiarubber, previously covered by filaments wound round them, was known before; but the placing them alternately side by side together as a warp, and combining them by means of a weft when in extreme tension and deprived of their elasticity, appears to be new; and the result, namely, a cloth in which the non-elastic threads form a limit up to which the threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken, appears a production altogether new. It is a manufacture at once ingenious and simple. It is a web combining the two qualities of great elasticity and of a limit thereto."

In *Crane* v. *Price*, (*e*) the question whether or not a combination could be good subject-matter for a patent was again considered by the same Court. In this case, Tindal, C.J., in the course of a "considered judgment," often since approved, said: "The question therefore becomes this, whether, admitting the use of the hot-air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite or stone coal, to have been known before in the manufacture of iron with cold blast, but that the two together were not known to be combined before in the manufacture of iron, whether such combination can be the

(*e*) 1 W. P. C. 377; 4 M. & G. 580; 12 L. J. C. P. 81.

subject of a patent; we are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, that such combination is an invention or manufacture intended by this Statute and may well become the subject of a patent. . . . There are numerous instances of patents which have been granted where the invention consisted in no more than the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public." (*f*)

In *Spencer* v. *Jack*, (*g*) Lord Westbury, C., said: "It is impossible to deny that, if there be a combination of several things previously well known, which combination is attended with results of such utility and advantage to the public that the combination itself is rightfully denominated a substantial improvement, it is, I say, impossible to deny that that is the subject of a patent."

In *Cannington* v. *Nuttall*, (*h*) the invention related to certain improvements in the manufacture of glass. The improvements consisted in a new combination of the materials previously used, by which the patentee obviated certain difficulties in the manufacture, and attained a result long desired by glass-makers. Under the former method of manufacturing glass it had been customary to put the raw materials into pots made of fireproof clay, which were stationed on "sieges" or benches, so that heat might be applied to them from below. A very high degree of heat was required, with the result that the pots often cracked, and the molten glass escaped through the fissures. To save the glass in such cases it was found necessary to remove the pots, so as to allow contact with the open air, when the glass congealed and stopped the fissures. As the pots were of very great weight, and could only be moved by means of a huge instrument acting like a pair of pincers, this was a troublesome thing to do. The patentee's combination was directed both to the prevention of cracking and to the healing of cracks when they occurred without the necessity of removing the vessels in use. To achieve this the inventor substituted a tank for the pots. To this tank heat was applied from the sides, so that the great heat occurred not below, as before,

(*f*) 1 W. P. C. pp. 408, 409. Cf. *Hall's Patent*, 1 W. P. C. 97; *Derosne's Patent*, 1 W. P. C. 152; *Hill's Patent*, 3 Meriv. 629; *Daniel's Patent* cited, Godson, 274.

(*g*) 3 De G. J. & S. 346; 11 L. T. (N. S.), 244.

(*h*) L. R. 5 H. of L. 205; 40 L. J. Ch. 739. Cf. *Saxby* v. *Clunes*, 43 L. J. 228.

but in the top part of the tank. Round the tank a channel was formed, so that the air might circulate freely. This kept the sides of the tank cooler than the interior, and so prevented cracking, or if a fissure did occur, it helped to heal the crack, as on contact with this atmospheric current the escaping glass became congealed. The House of Lords held that the invention was good subject-matter for a patent for a combination. Lord Hatherley, C., said: "I take it that the test of novelty is this: is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?"

In *Murray* v. *Clayton*, (*i*) the Court had before it an application for an injunction to restrain the infringement of a patented machine for the making of bricks. The machine was so contrived as to make the bricks by pushing a strip of clay (previously severed from the bulk by the action of a vertical wire) against a row of fixed vertical wires, so stationed as to divide the strip into separate pieces. There was also a contrivance for removing the bricks when made without handling them. In this way twelve bricks or more could be made by one operation of the machine. It was objected that the machine was formed by the mere arrangement of common elementary mechanical materials, producing results of the same nature as those previously accomplished by other mechanical arrangements. But the Court of Appeal (reversing Bacon, V.C.) held that the machine was good subject-matter as a combination of known parts which produced a new result, or, at least, an old result in a more economical and more perfect form, making better bricks and cheaper bricks than had ever been produced before.

In *Davis* v. *Feldtman*, (*j*) the patent was for improvements in umbrellas. Pollock, B., in a judgment which was subsequently affirmed by the Court of Appeal, said: "If taken as a patent for a combination the plaintiff's patent is good, and it is not, of course, the less good because it involves principles and actual construction, that have preceded it, which are common knowledge. A patent may be good for a combination, although when it is taken to pieces there is not one single part of the process, or of the machinery called into use to create that combination, which is new in itself."

(*i*) L. R. 7 Ch. 570; 21 W. R. 498.

(*j*) 1 R. P. C. 13, 193.

In *Reynolds* v. *Amos*, (*k*) the plaintiffs brought an action for infringement of a patent for improved appliances to be used in the manufacture of ensilage. The object aimed at by the patentee was the preservation of fodder in a fresh, wholesome state. For this purpose he had devised a combination of chains with levers for tightening them when required, so as to maintain the requisite amount of pressure. It was objected that this was not subject-matter for a patent. Bacon, V.C., held the patent good. The learned judge said: "Chains are not their invention; screw-jacks are not their invention; but using them in such a manner as will produce in the result a successful, new, cheap, useful manufacture of ensilage is the invention which they claim by their patent." (*l*)

So also in the more recent cases of *Thomson* v. *Batty* (*m*) and *Thomson* v. *Moore*, (*n*) it was held that a new and successful combination of old parts of an old machine, so devised as to attain a desired improvement, viz. the reduction to a minimum of the errors arising, from mechanical and magnetic causes, in the action of a mariner's compass, was good subject-matter for a patent.

In the *American Braided Wire Company* v. *Thomson*, (*o*) the question of subject-matter was much discussed. In that case the patent was for improvements in bustles or dress-improvers. The invention consisted in the ingenious adaptation of braided steel wire to the manufacture of bustles. It was proved that bustles were old, that the wire used was old, and that braiding wire upon a core was old; but the Court of Appeal, not without some doubt, held (reversing Kekewich, J.) that there was sufficient utility and novelty in the new application of tubular wire to the making of bustles in the manner described to support a patent. And in this decision they were affirmed by the House of Lords.

In *Vickers* v. *Siddell*, (*p*) the invention consisted of an apparatus composed of a wheel and endless chain for turning heavy forgings, the wheel being internally toothed, and having a ratchet working in it, by means of which the wheel was caused to rotate, and the forging which rested in the endless chain thus turned from time to time to the extent desired. It was admitted that the elements

(*k*) 3 R. P. C. 215.

(*l*) In *Herrburger* v. *Squire* (5 R. P. C. 592), Charles, J., said this case went a long way, but was reconcilable with the authorities, on the ground that Bacon, V.C., expressly found there was invention required to make this particular combination of well-known things. See, also, Bacon, V.C., in *Sharp* v. *Brauer*, 3 R. P. C. 193.

(*m*) 6 R. P. C. 84.

(*n*) 6 R. P. C. 426; 7 R. P. C. 325.

(*o*) 5 R. P. C. 119; 7 R. P. C. 47.

(*p*) See Lord Herschell's judgment, 7 R. P. C. p. 304.

were all old. Forgings had long rested in an endless chain, the idea of turning such forgings by turning the wheel over which the chain passed was not new, and a ratchet working in teeth was a well-known device for causing a wheel to rotate. But the result of the patentee's combination was a new apparatus of an extremely simple character, which possessed the advantage of being easily moved from place to place and applied wherever wanted, and the Court of Appeal and House of Lords held that this new and useful combination of old materials was good subject-matter for a patent.

An Improvement in a known Machine is a Manufacture.—An improvement in a known machine is a manufacture within the meaning of the Statute, and good subject-matter for a patent.

Where, however, the invention consists in such an improvement the patent must be limited to that improvement only, and must distinguish it from the rest of the machine. In *Foxwell* v. *Bostock*, (*q*) the patent was for improvements in sewing machines. The real invention was the use of a shaft with three cams upon it; but the patentee gave only a general description of the machine. Lord Westbury, C., held that this was not sufficient, and that the specification should have described the improvement and defined the novelty, otherwise than by a general description of the whole machine.

This rule, however, does not apply where the invention lies not in the introduction of a single improvement into an old machine, but in the new mode of arranging old parts. In such case the patent is for the combination as a whole, which is of itself, *ex necessitate*, the novelty, and to describe the combination is sufficient.

This was decided in *Harrison* v. *Anderston Foundry Company*, (*r*) where the subject of patents for combinations was fully considered by the House of Lords. In that case the patent was for a new combination, and the judges of the Court of Session, extending the principle of *Foxwell* v. *Bostock*, had held the patent bad on the ground that the specification did not distinguish the old and the new. On appeal to the House of Lords this decision was reversed. 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 to 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

(*q*) 10 L. T. (N. S.), 144. On this case, see Lord Penzance in *Harrison* v. *Anderston Foundry Co.*, L. R. 1 App. Ca. p. 592.

(*r*) L. R. 1 App. Ca. 574; see, also, *Kynoch & Co.* v. *Webb*, 17 R. P. C. 100.

improvement, to place that before the public, and say, 'I have made a better machine. There is the sewing machine invented by So-and-so; I have improved upon that. That is mine; it is a much better machine than his.' That will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by Lord Justice James in another case, (*s*) it will not do if you have 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. That principle was laid down in *Foxwell* v. *Bostock*, and I do not think that anything further was intended to be determined in that case. It could not have been meant in that case to say that where that happens which well may happen, that a person arranging his machinery in a totally different way from the way in which it has ever been before arranged, although every single particle of that machinery is a well-known implement, produces an improved effect by his new arrangement, that new arrangement cannot be the subject of a patent. It may be that the levers may be perfectly well known in their mode of action, and it may be that all the other separate portions of the machinery to which the patent relates may be perfectly well known; but if he says, 'I take all these well-known parts, and I adjust them in a manner totally different from that in which they have ever before been adjusted; I have found out just what it is that has made these parts, though they may have been used in machinery, fail to produce their proper effect, and it is this, that they have not been properly arranged; I have therefore reconsidered the whole matter, and put all these several parts together in a mode in which they never were before arranged, and have produced an improved effect by doing so.' I apprehend it is competent to that man so to do, and that it would be perfectly impossible for him to say what is new and what is old, because *ex concessis* it is all old, nobody ever before used it in the manner in which he has used it. That, my lords, I apprehend, is the principle of a patent for a combination." (*t*)

A Bare Principle apart from a mode of applying it is not a Manufacture.—Extensive as the meaning is which the Courts have given to the word "manufacture," they have always held that there can be no patent for a bare principle apart from a mode of applying it.

(*s*) *Parkes* v. *Stevens*, L. R. 8 Eq. 365. B. 966; Macr. P. C. 48.
(*t*) See, also, *Tetley* v. *Easton*, 2 E. &

But a patent for a mode of applying a new principle or for a new mode of applying an old principle is good subject-matter.

In *Boulton* v. *Bull*, (*u*) an objection was taken that the patent was one for a principle and therefore bad; and all the judges agreed that if that were the true construction of the specification the patent would be void. Buller, J., said: "The very statement of what a principle is proves it not to be the ground for a patent. It is the first ground and rule for arts and sciences, or in other words, the elements and rudiments of them. A patent must be for some new production from those elements themselves." (*v*) "Undoubtedly there can be no patent for a mere principle," said Eyre, C.J., in the same case, "but for a principle so far embodied and connected with corporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or in manual occupation I think there may be a patent." (*w*)

In *R.* v. *Wheeler*, Abbott, C.J., said: "No merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." (*x*)

In *Jupe* v. *Pratt*, (*y*) Alderson, B., said: "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all the other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

In *Neilson* v. *Harford*, (*z*) the inventor had discovered that the application of hot instead of cold air to the mixture of iron ore and fuel in the smelting of iron, produced a remarkable economy in the manufacture of the metal. He then devised a mode of

(*u*) 2 H. Bl. 463. See, also, *Hornblower* v. *Boulton*, 8 T. R. 101; *Forsyth* v. *Riviere*, 1 Carp. 401; 1 W. P. C. 97 *n.*

(*v*) 2 H. Bl. 485.

(*w*) Ibid. p. 496.

(*x*) 2 B. & Ald. 350.

(*y*) 1 W. P. C. 146. For other examples of patents granted for applied principles, see *R.* v. *Cutler*, 1 Starkie, 354; *Jones* v. *Pearce*, 1 W. P. C. 121; *Minter* v. *Wells*, 1 W. P. C. 127; *Walton* v. *Bateman*, 1 W. P. C. 620; *Newton* v. *Vaucher*, 21 L. J. Ex. 305; *Bovill* v. *Keyworth*, 7 E. & B. 725; *Hills* v. *London Gas Co.* 29 L. J. Ex. 409; 5 H. & N. 312; *Varey* v. *Walker*, 16 R. P. C. 596.

(*z*) 1 W. P. C. 295; 8 M & W. 806.

carrying out his idea, by which he heated the air in a closed vessel next the furnace, and applied it in the way required. A patent for that mode was held good subject-matter, and during its term he enjoyed a monopoly of the use of hot blast in the manufacture of iron. "I take the distinction," said Alderson, B., "between a patent for a principle and a patent which can be supported is, that you must have an embodiment of the principle in some practical mode described in the specification of carrying the principle into actual effect, and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect. In *Watt's* patent, which comes the nearest to the present of any you can suggest, the real invention of Watt was that he discovered that by condensing steam in a separate vessel a great saving of fuel would be effected by keeping the steam cylinder as hot as possible, and applying the cooling process to the separate vessel, and keeping it as cool as possible, whereas before, the steam was condensed in the same vessel; Mr. Watt carried that practically into effect, by describing a mode which would effect the object." (*a*)

In *Household* v. *Neilson*, (*b*) the same propositions of law were tersely laid down by Hope, L.J.C., in the Court of Session. "It is quite true that a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature, or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business and arts and utilities of life. The mere discovery of such a principle is not an invention within the patent-law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object, and without the application of it to human industry, or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a great, general, and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained."

In *Crossley* v. *Potter*, (*c*) the patent was for improvements in

(*a*) 1 W. P. C. 342. See Jessel, M.R., on this case in *Otto* v. *Linford* (46 L. T. (N. S.), 45), where he describes it as "one of the strongest illustrations" of a patent for an embodied principle.

(*b*) 1 W. P. C. p. 683.

(*c*) Macr. P. C. 240; 2 W. P. C. 245.

weaving figured fabrics. In his specification the patentee said, "My improvements in weaving figured fabrics apply to those particular kinds of fabrics which have a terry or raised looped surface, such as coach lace, Brussels carpeting, velvets, and other woven goods having terry or raised surfaces, either plain or figured, and consist in certain means of introducing and withdrawing the wires, etc." There was no evidence that any description of terried goods, except coach lace and one carpet, had ever been made under the patent. On the evidence, Pollock, C.B., doubted if the machine as described in the specification would make carpets or velvets. "The truth," said the learned Chief Baron, "appears to me to be this, that the patent is very much like what has been attempted, viz. to take out a patent for a principle, which the law will not allow. Any man who takes out a patent must take it for a manufacture. . . . Certainly the effect of all the evidence is, that, without additional parts, which are not described, the machine would certainly not be capable of making velvet goods, and I doubt whether it is capable of making carpet goods without a deal more than the specification contains; and the mention of carpets and velvets of all sorts in this specification appears to me to have had this for its object, to patent the principle. 'I have,' says the patentee, 'described that, in making coach lace, it is a beneficial thing to have two arms with wires attached to them, and going in succession, one after the other. I proclaim to the world that nobody shall apply that or anything like it, or any substitute whatever, in the making of either carpets, velvets, or any of the terry whatever.' A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the energy of mankind, and the introduction of other inventions adapted to the particular subject to which the invention may be applicable—a patent which has for its object to snatch and grasp at everything in all directions which may possibly come within the general language the patentee may choose to adopt in his specification—a patent, the object of which is not to benefit the world by its communication, but to obstruct, by the very general character of the claims made for conferring peculiar privileges on the patentee; such a patent as that, in my judgment, cannot be supported."

In *Hills* v. *London Gas Company*, (*d*) the question of the validity of a patent for an applied principle was again discussed. Bramwell, B., said: "It is next said that the mere application of the

(*d*) 29 L. J. Ex. 409, p. 424; 5 H. & N. 312, p. 369.

hydrated oxides to absorb the sulphuretted hydrogen from the gas is not the subject of a patent, the property of it being well known previously. With that we do not agree, the answer to that is that the question here is not properly stated, that the application of hydrated oxide is the principle. If a man were to say, I claim the use of hydrated oxide of iron for the purification of coal gas without saying I did it, it is possible the objection might be well founded; but he says here, I claim it in the manufacture of gas, in the way I have described, and he shews how it may be made practically useful: therefore this objection fails."

In *Cannington* v. *Nuttall*, (*e*) it appeared that the only thing which the patentee regarded as a new discovery (apart from his apparatus) was the application of external air to the sides of a tank. On this Lord Westbury, C., said: "It was a discovery, certainly, but it was a thing for which, independently of the other apparatus, probably no patent could have been obtained. I may construct an apparatus, and may, in point of fact, make the merit and the benefit of that apparatus depend upon the application of some natural force or property which is perfectly well known; but my invention consists in the construction of the apparatus in such a manner as to bring the natural agency or power to bear upon and effect the object which I desire to effect, and that I do by means of an apparatus constructed so as to bring into action that natural power. If, for example, I avail myself of the well-known expansive force of steam, in order to effect a new object as a more beneficial result, and I introduce that by means of an apparatus constructed for the purpose of bringing this well-known expansive power into utility for my particular purpose, I have no right of invention in the discovery of that expansive force. My invention consists in the arrangement of the apparatus in order to receive that ordinary and well-known dynamic agent, and make it a fit instrument for effecting a new result. Here the refrigerating effect of the air upon the sides of the tank was not a thing for which, *per se*, a patent could be claimed, but an apparatus so constructed as to bring into operation that particular property of the external atmospheric air, so as to produce a most useful effect, constitutes an invention to which the merit of novelty attaches, and for which a patent may be taken out."

In *Otto* v. *Linford*, (*f*) the patent was for improvements in gas-motor engines. Gas-motor engines and the possibility of producing

(*e*) L. R. 5 H. of L. 205; 40 L. J. Ch. 739. (*f*) 46 L. T. (N. S.), 35.

motion by a series of explosions in a cylinder containing mixed gas and air, were already well known. But the suddenness of the explosions, and the great heat generated by them, prevented these machines from coming into extensive use. It occurred to the plaintiff that these difficulties might be successfully obviated by the insertion of a cushion of air between the combustible material and the piston, and he invented an arrangement of the machinery which carried out this object. When thus reduced to practice the plaintiff's idea proved correct; the suddenness of the explosions was successfully moderated, and gas-motor engines in consequence became largely used.

In an action brought by the inventor for infringement the defendants objected (*i.a.*) that this discovery was not subject-matter for a patent, but was only a principle. The Court of Appeal, however, held that the plaintiff shewed a mode of carrying his idea into effect, and that the patent was good. Jessel, M.R., said: "The first objection is that this is not the subject-matter of a patent, because it is said that that which is claimed is the principle or, as it is sometimes termed, the 'idea,' of putting a cushion of air between the explosive mixture and the piston of the gas-motor engine, so as to regulate, detain, or make gradual, what would otherwise be a sudden explosion. Of course that could not be patented. I do not read the patent so; I read the patent as being to the effect that the patentee tells us that that is the idea that he wishes to carry out; and he claims to carry it out by substantially one or the other of these machines. That is the subject of a patent. If you have a new principle, or a new idea, as regards any art or manufacture, and then shew a mode of carrying that into practice, you may patent that; though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new."

So, too, in *Badische* v. *Levinstein*, (*g*) Fry, J., said: "A man cannot take out a patent for an idea, but he may take out a patent, if I may say so, for an idea coupled with a practical process of effectuating that idea." And in *Young* v. *Rosenthal*, (*h*) Grove, J., said: "It must be an invention of a manufacture, an invention of an idea or mathematical principle alone; mathematical formulæ or anything of that sort, could not be the subject of a patent. For instance, supposing a person discovered that three angles of a triangle are equal to two right angles,

(*g*) 24 C. D. 156; 2 R. P. C. 73. (*h*) 1 R. P. C. 30.

that is an abstract discovery and would not be the subject of a patent."

"You cannot," said Lord Halsbury, C., in *Pneumatic Tyre Company* v. *Tubeless Tyre, Ltd.*, "appropriate to yourself a mere principle; you can only appropriate the application of the principle." (*i*)

An Old Principle applied in a New Way is a Manufacture.—A patent for an applied principle being a patent rather for the application, or *modus operandi*, than the idea, it follows that even where the principle is old and well known a patent for a new and useful mode of applying it will be good. Thus, in *Hullett* v. *Hague*, (*j*) where the patent was for a mode of hastening the evaporation of sugar by driving cool air through the boiling liquid it was shewn that the idea was well known, and that a prior patent had been granted for a mode of carrying out the same principle. But the Court of King's Bench held that as the plaintiff's mode was distinct from that of the earlier patentee his patent was good, and he was entitled to a monopoly of the apparatus he described.

In *Cannington* v. *Nuttall*, (*k*) already noticed, where the patent was for a mode of utilizing the cooling properties of air in the manufacture of glass, Lord Hatherley, C., said: "It is quite apparent, my lords, that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every new invention—the skill and ingenuity of the inventor are shewn in the application of well-known principles. Few things come to be well known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a practical result not yet achieved."

In *Dangerfield* v. *Jones*, (*l*) the patentee claimed as his invention a new and improved mode of bending wood for the handles of walking-sticks, etc. The improvement consisted in a novel way of applying heat to the wood intended to be bent, so as to soften the fibres. It was objected that the application of heat to the bending of wood was old, and that the invention was not subject-matter. The Court, however, refused to adopt this contention. Wood, V.C., said: "When it is said, as one of the witnesses had stated, that because wood is bent by coachmakers and others

(*i*) 16 R. P. C. p. 79; 15 T. L. R. 105.
(*j*) 2 B. & Ad. 378.
(*k*) L. R. 5 H. of L. 216; 40 L. J. Ch. 739.
(*l*) 13 L. T. (N. S.), 143.

in a variety of ways by the application of heat to wood, you cannot have a patent for the application of heat to the making or bending of walking-sticks, that is the same sort of reasoning which was pressed ineffectually upon the Court with reference to an invention for an improvement in navigation. (The screw propeller case.) (*m*) It was said that the operation of a propelling power by presenting a screw surface to the action of the water was nothing new; that a screw propeller was an instrument for advancing a ship in the water by presenting a screw surface to the water, and that it was like the action of a windmill with reference to the wind. That reasoning, however, did not succeed. If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that that which has been invented is new, desirable, and for the public benefit."

In *Gadd* v. *The Mayor of Manchester*, (*n*) the patent was for the application to gasometers of a contrivance already known in connection with pontoons and floating docks. Alluding to the authors of those anticipations, Lindley, L.J., said: "They shewed the principle, but their attention was not turned to gasometers, and they did not shew how to apply the principle to them;" and the patent for this new application of the principle was held good by the Court of Appeal.

The Application of a known Machine to the Attainment of a New Result is a Manufacture.—In the *Adamant Stone and Paving Company* v. *Liverpool*, (*o*) one of the plaintiffs' patents was for improvements in the manufacture of slabs and blocks of cement. The invention consisted chiefly in the application of a filter press to expel the water; the result being a remarkable shortening of the time within which the artificial stone hardened and solidified. At the time the patent was taken out filter presses of various kinds were well known, and had been applied to a variety of purposes, but nobody had before applied a filter press to the production of stone or stone-like substance from cement. Moreover, considering the state of public knowledge at the date of the patent, invention was required to arrive at the plaintiffs' result. On these facts Romer, J., said: "As a matter of law I consider that in the case where various different machines of a certain general class or

(*m*) *Caldwell* v. *Vauvlissengen*, 21 L. J. Ch. 97; 9 Hare, 415; 16 Jur. 115.

(*n*) 9 R. P. C. 516; at p. 526.

(*o*) 14 R. P. C. 11.

character may be well known, if a person selects and applies one specially adapted for his purpose to effect a new object, and with the result of producing a new article, or an old article in a substantially more expeditious and economical way than it was produced before, then he may properly claim as subject-matter of a patent that machine, as applied to the new object, even though he could not have claimed the machine *per se*, that is to say, without limitation as to its application, and the case before me falls within that principle."

CHAPTER V.

NOVELTY OF THE INVENTION.

Why Novelty is Required.—An invention, to be valid subject-matter for a patent grant, must not only be a manufacture within the meaning of the Statute of James I., it must also be new. This condition, expressly enacted by the Statute of Monopolies, was also a condition imposed by the common law. (*a*) The principle underlying it is manifest. Every patent monopoly involves a temporary surrender of public right, which the Crown, as guardian of the public good, can only sanction where it is for the ultimate advantage of the community that the surrender should be made, *i.e.* where an adequate consideration is obtained in return. The law presumes that a new and useful invention is such a consideration. But, if the protected invention is not new, the patentee has nothing to bestow upon the public at the end of his patent term, and, therefore, the Crown, in such case, at the public expense, gives everything and receives nothing.

Hence a manufacture, the secret of which is already known to the public, either through the medium of description, exhibition,(*b*) or actual user, is not one in respect of which valid letters patent can be granted. Every inventor, therefore, who comes to the Crown for a grant of letters patent, comes representing that he is the discoverer of a new invention, and it is on the faith of such representation that he obtains his grant. If his invention in fact is old, the Crown has been deceived by a false representation; and, whether that representation has been made wilfully or not, the letters patent are void. "A petitioner for a patent," said Bacon, V.C., in *Murray* v. *Clayton*, "alleges to the Crown that he has made a new and useful discovery. As a just reward for such

(*a*) See *Hasting's Patent*, Noy, Rs. 182; *Matthey's Patent*, Noy, Rs. 178; *Humphrey's Patent*; Noy, Rs. 183; *Darcy* v. *Allin*, Noy, Rs. 182; *Clothworkers of Ipswich Case*, Godb. 254.

(*b*) As to publication at international and industrial exhibitions, see post, pp. 91, 92.

discovery, assuming the allegation to be true, the Crown grants him the exclusive use of his invention. If the allegation turns out to be untrue, the grant becomes void." (*c*)

The Novelty Required is the Novelty of all that is Claimed.—It is upon this ground of a fraud on the Crown that it has been held that the novelty must be the novelty of everything claimed by the patentee as his invention; so that if any essential part of what the grantee has represented to the Crown as being his invention is not new, the whole grant becomes void because of that false suggestion.

Thus, in *Huddart* v. *Grimshaw*, (*d*) Lord Ellenborough, C.J., said that if any part of that which was the substance of the invention had been communicated to the public, or was a known thing prior to the date of the patent, the patentee could not claim the benefit of his monopoly.

In *Hill* v. *Thompson*, (*e*) the letters patent were granted for an improved method or process of smelting and working iron. The improvement introduced by the plaintiff was obtaining iron from cinder and slag which formerly had been thrown away as refuse. This was apparently new. But the plaintiffs claimed, further, the merit of having discovered that the application of lime in certain stages of the process of iron manufacture, would cure a defect in the metal known as cold short, and that, too, whether the iron was made from slag or cinder, or from fresh ore. The application of lime to iron obtained from the cinder originally used in making the iron was, however, known and practised before.

The plaintiffs having obtained an injunction, Lord Eldon dissolved it; and, on motion to revive the injunction after a verdict obtained at the trial, Lord Eldon refused to make the order, pending the result of an application by the defendants for a new trial. The Lord Chancellor said: "Not only must the invention be novel and useful, and the specification intelligible, but also the specification must not attempt to cover more than that which, being both matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise

(*c*) L. R. 7 Ch. 574 *n*. See, also, *Hill* v. *Thompson*, 8 Taunt. p. 401; 1 W. P. C. p. 229; 3 Mer. 622; *Brunton* v. *Hawkes*, 4 B. & Ald. p. 555; *United Horse Nail Co.* v. *Stewart*, 2 R. P. C. p. 132.

(*d*) 1 Dav. P. C. 265; 1 W. P. C. 867.

(*e*) Supra.

fairly entitled. On the other hand, there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only; and not lay claim to the merit of original invention in the use of the materials. If there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might for the improvement merely, it is good for nothing altogether, on account of its attempting to cover too much."

When this case subsequently came before the Common Pleas, that Court non-suited the plaintiff. Dallas, J., said: "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; and to this point, which is so clear, it is unnecessary to cite cases." (*f*)

The decision in the above cases was followed in *Brunton* v. *Hawkes*, (*g*) decided by the Court of King's Bench in 1821. In that case the plaintiff's patent was for improvements in the construction of ships' anchors and windlasses, and chain cables or moorings. The part of the invention relating to the anchor having been proved to be old, the Court held the whole grant void. Abbott, C.J., said: "It seems to me, therefore, that there is no novelty in that part of the invention as affects the anchor; and, if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. Then, if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part, as to the mooring-chains? As at present advised, I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of these things is not new, the question arises, whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the grant. The king could not, in consideration of a new invention in one article grant a patent for that article and another. The question then is, whether, if a party applies for a patent, reciting that he has discovered improvements in three

(*f*) 1 W. P. C. 249.

(*g*) 4 B. & Ald. 550; 1 Carp. 405.

things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me, that the case of *Hill* v. *Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question. . . . The only difference between that case and this is, that here the plaintiff, instead of saying that he has made certain improvements, states the improvements; but still he claims the merit of having invented improvements in all the three. The patent is granted upon the recital that he has made improvements upon all the three, and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out that there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention. For these reasons I am of opinion that this patent cannot be supported."

In the later case of *Morgan* v. *Seaward*, the law was similarly laid down by Parke, B. "A patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson* and *Brunton* v. *Hawkes*; for although the Statute invalidates a patent for a 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 is maintainable upon it." (*h*)

Where, then, a patent is granted by the Crown on a representation by the grantee that he has discovered several distinct inventions or improvements relating to the same result, each invention claimed must be new, or the grant is bad for all.

In *Gibson* v. *Brand*, (*i*) the plaintiffs' patent had been taken out for "a new or improved process or manufacture of silk and silk in combination with certain other fibrous substances." In their claim the plaintiffs said, "We restrict our claims to the eight several heads of invention mentioned in the early part of this specification, all of which we believe to be new and of great public utility;" on this the Court of Common Pleas held that the

(*h*) 1 W. P. C. 196; 6 L. J. Ex. 158; 2 M. & W. 561. Cf. *Westrupp & Gibbin's Patents*, 1 W. P. C. 554.

(*i*) 1 W. P. C. 631; 11 L. J. C. P. 177.

plaintiffs could not sustain their patent unless they shewed that each one of the eight divisions of their process was new.

In *Gamble* v. *Kurtz*, (*j*) the patent was for "improvements in apparatus for the manufacture of sulphate of soda, muriatic acid, chlorine, and chlorides." The specification claimed (*i.a.*) "iron retorts worked in connection with each other as above described." This was construed by the Court to cover the peculiar form of retorts described (in this case two-chamber retorts with separate furnaces) as well as the mode of connecting them. The means of connection were new, but the retorts were old, and the patent was held bad.

In *Templeton* v. *Macfarlane*, (*k*) the same rule was applied by the Court of Session in Scotland. In that case the patent was taken out for "machinery for a new and improved mode of manufacturing silk, cotton, linen, and woollen fabrics." The specification claimed "the mode hereinbefore described of producing or preparing stripes of silk, cotton, woollen, or linen, or of a mixture of two or more of these materials, in such a manner that the weft or lateral fibres of both cut edges of each stripe are all brought up on one side, and into close contact with each other, and the re-weaving of such stripes with the whole fur or pile uppermost into the surfaces of carpets, etc." At the trial it was found that one of the processes in the mode claimed was old. The Lord Ordinary (Lord Robertson) ruled that this did not avoid the patent. On this ruling a bill of exceptions was presented to the Inner House by the defenders and allowed. The pursuer appealed to the House of Lords, but the House held that the Court of Session were right, and that want of novelty in one of the processes of the mode claimed avoided the patent. "The judge at the trial," said Lord Cottenham, "mistook the law in supposing it to be immaterial whether all the invention, or only part of it, was new." (*l*)

In *McCormick* v. *Gray*, the patent was for improvements in agricultural machines. The plaintiff claimed protection for three parts of his machine, viz. holding-fingers, cutting-blades, and gathering-reels. It was proved by a prior publication that the holding-fingers and cutting-blades were not new. The Court of Exchequer held the patent void. Pollock, C.B., said: "I agree that what the plaintiff claims is no novelty, since a portion of it was anticipated in the year 1845, and that the plaintiff should

(*j*) 3 C. B. 432.
(*k*) 1 H. of L. Ca. 595. See, also, *Dobbs* v. *Penn*, 3 Ex. 427.
(*l*) 1 H. of L. Ca. p. 604.

have restricted his claim to a combination of the three materials forming his machine, and not have claimed each of them." (*m*)

In *Roberts* v. *Heywood*, (*n*) the patent was for an "improved machine for painting laths for Venetian blinds and for other purposes." Besides claiming the general combination the patent claimed protection for eight several parts. The eighth claim was for a shallow sliding tray, arranged and used substantially in the manner and for the purpose described. This tray was not new, and it was objected that the patent was therefore void. Hall, V.C., said: "I think it impossible, having regard to the eighth claim, to say that this is a new invention; and, having tried in every way to construe it as subsidiary, and not a distinct claim, I cannot come to such a conclusion," and the patent was accordingly held void.

In *Haslam* v. *Hall*, (*o*) the plaintiff's patent was for "improvements in refrigerating processes and apparatus for preserving meat or other food or beverages." There were three claims. By his second claim the patentee claimed the combination together of a steam-engine, and of an air-compressing and air-expansion apparatus in the improved manner described. The first and third claims were new and useful, but the second claim had been anticipated by a prior machine, and the patent was therefore held void.

Want of Novelty in a Subsidiary Claim need not Defeat a Patent.—Upon the rule illustrated in the foregoing cases the Courts have, however, grafted an exception in favour of a claim which can be shewn to be subsidiary to the main invention, and to be claimed only in relation thereto. Want of novelty in such a claim need not avoid a patent.

Thus, in *Plimpton* v. *Spiller* (*p*) the patentee claimed: (1) "Applying rollers or runners to the stock or footstand of a skate as described, so that the said rollers or runners may be cramped or turned so as to cause the skate to run in a curved line either to the right or left by the turning, canting, or tilting of the stock or footstand; (2) The mode of securing the runners and making them reversible as above described."

It was proved that the second claim was not new, and the defendants contended that the patent was therefore void. But Jessel, M.R., refused to adopt this construction, and held the

(*m*) 7 H. & N. p. 35; 31 L. J. Ex. 42.
(*n*) 27 W. R. 454.
(*o*) 5 R. P. C. 1. See, also, *Murchland* v. *Nicholson*, 10 R. P. C. 417; *Pether* v. *Shaw*, 10 R. P. C. 297.
(*p*) L. R. 6 C. D. p. 428; 47 L. J. Ch. 211.

second claim to be a merely subsidiary claim covering something to be used only in connection with the principal invention. On appeal this decision was affirmed. (*q*) James, L.J., after stating the second claim, said: "It appears to me that in doing that he is claiming, not a distinct and substantial invention, but he is claiming it as one of the merits and advantages of the entire construction which he has before given, and he is not in any way pretending or claiming to enlarge his monopoly; because, of course, it was a novelty so far as Plimpton's skates were novel, and he is only applying an old thing to an entirely new thing. When the new thing ceases to be patented that old thing will cease to be patented too; so that there is no pretence really for saying that he is endeavouring to obtain under the colour of that second claim something other and beyond that which the invention itself purports to be, that is to say, an invention for making a rocking skate in the manner which he has described in the first part." Brett, L.J., while adopting the same construction of this claim as subsidiary, said: "At the same time, I think it cannot be denied that if a really independent claim of something which is not new, however inadvertently or carelessly it be made, is, in fact, made on the face of the patent, the Court is bound to hold that the patent is therefore objectionable, and that the plaintiff cannot succeed. If this second claim had been in a form which would have applied to the runner of any other skate than that which is patented here, I should have thought it would have been bad, and that therefore the whole patent would have been bad, and that this plaintiff could never recover." (*r*)

A similar construction was adopted by the House of Lords in the *British Dynamite Company* v. *Krebs*. (*s*) In that case the patentee claimed, not only the mode of manufacturing dynamite, but also "the modes of firing the same by special ignition" set forth in the specification. These, or some of them, were known at the date of the patent, and it was contended in consequence that the patent was bad. In rejecting this contention on the ground that the means of explosion were not claimed in *gross* but only as appendant to dynamite, Lord Cairns said: "It is to be observed that the mere manufacture of an explosive substance such as dynamite would not *per se* have constituted an invention, or, at all events, a useful and practical invention which could be protected by a patent. An explosive substance like dynamite

(*q*) L. R. 6 C. D. pp. 428, 433.
(*r*) See also *Dowler* v. *Keeling*, 14 T. L. R. 257; 15 R. P. C. 214.
(*s*) Goodeve, P. C. p. 93; 13 R. P. C. p. 193.

would be of little or no utility unless there were the means of bringing to bear upon it a method of detonating explosion which would be at once economical and easily applied. . . . I look upon the means of explosion, even assuming them to be known as applicable to other substances, to be part and parcel of the invention which the patentee was bound to give to the public as a complete invention, and I understand him to claim these means of explosion only as part and parcel of this invention."

Novelty in a Combination.—Where the patent is for a combination the novelty is the combination, and if that be new, it matters not that the component parts are old. In *Harrison* v. *The Anderston Foundry Company*, Lord Cairns, C., said: "If there is a patent for a combination the combination itself is, *ex necessitate*, the novelty." (*t*)

In *Newton* v. *Grand Junction Railway*, Pollock, C.B., said: "In order to ascertain the novelty you take the entire invention, and if in all its parts combined together it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent." (*u*)

In *Cannington* v. *Nuttall*, Lord Hatherley, C., thus laid down the test of novelty in a combination. "I take it the test of novelty is this; is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?" (*v*)

New, means New within the Realm.—"New," means new within the realm. Therefore prior user or prior publication abroad, *e.g.* in France, will not defeat a patent in England for an invention new within the Kingdom. It was at one time doubted whether or not this rule did not apply to user of a patent in Scotland as well as in foreign countries. But in *Brown* v. *Annandale*, (*w*) it was decided that a patent could not be taken out in England for an invention already known in Scotland. In *Roebuck* v. *Stirling*, (*x*) it had already been decided in the House of Lords that a Scottish patent for an invention known in England was bad.

It has been held, however, that "the realm" for the purposes of the Statute of Monopolies does not include such of her Majesty's

(*t*) 1 App. Ca. p. 578.
(*u*) 5 Ex. 334.
(*v*) L. R. 5 H. of L. 216; 40 L. J. Ch. 739.
(*w*) 1 W. P. C. 433; 8 Cl. & F. 437.
(*x*) 1 W. P. C. 45.

colonies as have statutory powers to grant patents within their own boundaries. Thus in the case of *Rolls* v. *Isaacs*, (*y*) Bacon, V.C., held that it was no defence to an action for infringement of an English patent to adduce evidence to shew that the invention prior to the date of the grant had been in use in the colony of Natal. Referring to the representation by the patentee that he was the true and first inventor, the learned Vice-Chancellor said that the Crown will not look whether that statement is strictly true. "That is not a matter to be enquired into. The only thing that the Crown desires to be informed of is, whether the invention has been used in this realm. Where an invention is communicated by a foreigner to an Englishman, if it should be proved that it has been used in all the other regions of the world, but never here before, the invention may be the subject of a valid patent, and there is no kind of objection to it." (*z*)

(*y*) L. R. 19 C. D. 268; 45 L. T. (N. S.), 704. (*z*) L. R. 19 C. D. p. 275.

CHAPTER VI.

ANTICIPATION BY PRIOR PUBLICATION.

Common Knowledge not necessary.—Novelty being essential, the publication of an invention anywhere within the United Kingdom will avoid letters patent subsequently granted in respect of that invention. Thus, no invention already described in a book, paper, specification or drawing to which the public have had access, or which has been publicly performed or exhibited, so that others have learned the secret of performing it, is lawful subject-matter for a patent grant. Such prior description or exhibition is *ipso facto* a dedication to the public and avoids that consideration for a subsequent patent which must be presumed in every valid grant. Nor is it material to shew that any person has in fact made the article in question from such description, or that the subsequent patentee borrowed his invention therefrom or even knew of its existence. Such publication is presumed to have acquainted the public with the secret of the invention, and no subsequent monopoly can lawfully deprive them of the right to put that knowledge into practice.

To establish prior publication it is not necessary to prove common knowledge; public knowledge is sufficient, whether the invention be known to many or few. "It is admitted," said Lindley, L.J., in *Savage* v. *Harris*, (*a*) "that his specification was published in this country and was matter of public knowledge and public property, although very likely not of common knowledge, the difference between the two being obvious. There may be a publication which is quite sufficient to invalidate a subsequent patent, and there may be very few people who know of that publication, so that you cannot say that the publication is a matter of common knowledge, however truly you may say that it is a matter of public knowledge."

(*a*) 13 R. P. C. 367.

In *Humpherson* v. *Syer*, Bowen, L.J., defined prior publication as follows: "That is, in other words, had this information been communicated to any member of the public who was free in law or equity to use it as he pleased?" (*b*) Whether there has been publication or not is a question of fact. "Each case must depend upon its own circumstances; and the effect, extent, and operation of the document by which the invention is supposed to be communicated to the public in this country so as to anticipate the invention of the person who first takes out letters patent for the invention, vary infinitely as the facts must vary." (*c*)

Publication in a Book or Specification.—In *Hill* v. *Thompson*, (*d*) the publication of the patentee's alleged invention in a dictionary in England nine years before the date of the patent was held fatal to the grant.

In *Westrupp and Gibbin's Patent*, (*e*) the Privy Council refused to recommend a confirmation of a patent when a material part of the invention had been published in a well-known book some years before, (*f*) and was likewise covered by two earlier specifications.

"If," said Lord Lyndhurst in *Household* v. *Neilson*, (*g*) "the machine is published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed books without reference to anything that has been done." "It negatives being the true and first inventor," said Lord Brougham, "which is as good as negativing the non-user. It must not be a foreign book, but published in England." (*h*)

The law was similarly laid down by Tindal, C.J., in *Stead* v. *Williams* (*i*): "If the invention has already been made public in England by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the Statute, whether he has himself borrowed his invention from

(*b*) 4 R. P. C. 407.

(*c*) *Per* Lord Halsbury, C., in *Pickard* v. *Prescott*, 9 R. P. C. p. 200. See, also, Tindal, C.J., in *Stead* v. *Williams*, 2 W. P. C. 143; 7 M. & G. 818; Lindley, L.J., in *Lyon* v. *Goddard*, 9 R. P. C. 527.

(*d*) 1 W. P. C. 229; 8 Taunt. 375; 3 Mer. 622; 2 B. Moo. 433.

(*e*) 1 W. P. C. 554.

(*f*) See, also, *Jablochkoff's Patent*, 8 R. P. C. 281.

(*g*) 1 W. P. C. 718.

(*h*) Cf. *Stocker* v. *Warner*, 1 C. B. 167.

(*i*) 2 W. P. C. 142. See, also, *Stead* v. *Anderson*, 2 W. P. C. 150; 16 L. J. C. P. 250.

such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time of the patent being granted."

It is not necessary to shew that the patentee learnt his invention from the prior publication, said Lindley, L.J., in *Harris* v. *Rothwell.* "It is sufficient to shew that the invention was so described in some book or document in this country as that some English people may have been fairly supposed to have known it." (*j*)

Where the publication alleged is contained in a prior specification, it is for the Court to construe such specification and say whether or not in fact it contains a prior disclosure of the invention.

In *Booth* v. *Kennard,* (*k*) where such publication was alleged against the patentee, Pollock, C.B., said: "We think it is a question as to the plain meaning of a written document, and we think it is for the Court to construe it." So, likewise, in *Bush* v. *Fox,* (*l*) it was held that when the want of novelty was apparent from matters contained in a document or written instrument, such as a prior patent and specification, it was for the Court to take notice of the identity of the two supposed inventions, and the want of novelty, therefore, in the second.

Publication in a Foreign Book.—Nor does it make any difference that the work or specification in which the prior description has appeared, has been published in a foreign country, (*m*) provided copies have been transmitted to England and sold, or otherwise put in circulation. It is not indeed necessary to prove that any copy has actually been sold. It is sufficient to avoid a subsequent patent for the invention so described, if the book has been publicly exposed for sale, or if the specification has been made public in this country.

In *Lang* v. *Gisborne,* (*n*) Lord Romilly, M.R., said: "A publication takes place when a person who is the inventor of any new discovery, either by himself or by his agents, makes a written description of that, prints it in a book, and sends it to a bookseller to be published in this country. It is not at all necessary to

(*j*) L. R. 35 C. D. 428; 56 L. J. Ch. 459; 4 R. P. C. 225.

(*k*) 1 H. & N. 527; 2 H. & N. 84; 26 L. J. Ex. 23, 305.

(*l*) 5 H. of L. 707; 25 L. J. Ex. 251.

(*m*) *Heurteloupe's Patent,* 1 W. P. C. 553; *McCormick* v. *Gray,* 7 H. & N. 28; 31 L. J. Ex. 42; *Pickard* v. *Prescott,* 7 R. P. C. 361; *British Tanning Co.* v. *Groth,* 8 R. P. C. 121; *United Telephone Co.* v. *Harrison,* 21 C. D. 720; 51 L. J. Ch. 705; *Harris* v. *Rothwell,* 35 C. D. 412.

(*n*) 31 L. J. Ch. 770; 31 Beav. 133.

establish the fact that one volume of that book has been sold; as soon as an inventor informs the public of what his invention is, and publishes that in a book, which he sends to a publisher to sell, the moment that book is exposed in the shop for the purpose of purchase, then that becomes a complete publication in point of law. That would be the effect if it were the publication of a book in England by an English inventor, and there is no difference when the inventor is a Frenchman, or any other foreigner, who publishes a book in his own language, but sends it over to a bookseller in this country for the purpose of being sold. As soon as the book comes to this country to be sold, and is offered for sale in the public shop of a bookseller, then that becomes a publication of the invention, assuming it to be a clear and accurate description of the invention in question. It would be impossible to arrive at any other result without producing the most inextricable difficulties in law. It would be difficult to ascertain how many persons had bought the book, though the purchase of the book would be nothing if they had not read the contents. It would be impossible to say to how many persons the purchaser had lent it, who had read it. In the present case it has been proved that a public library in one of the large universities in England had actually bought the book. It may be that a thousand persons had read it before this invention had taken place, but how can that by any possibility be proved? The Courts would be involved in inextricable difficulty if the burthen of proof were thrown on a person who had made public an invention as far as he was able to make it public, to shew that the public themselves had appreciated it by buying the book, or making it common to other persons."

In *Pickard* v. *Prescott*, (*o*) it was proved that a description of the invention—an improvement in the bridges of pince-nez, or double eye-glasses—had been published prior to the date of the patent, in a French monthly journal, copies of which were sold to two public institutions and three private individuals in the United Kingdom. The House of Lords, affirming the decision of the Inner House of the Court of Session, held this a sufficient publication to defeat the patent. In such case there is a strong presumption that the public journal in which the description is contained has reached its subscribers within a reasonable time after the date of publication; and, although no evidence may be obtainable that the contents of the journal have, in fact, been read by the recipients, the Court will assume this until the contrary is shewn.

(*o*) 7 R. P. C. 366.

"But then," said Lord Halsbury, C., in the above case, "it is said that *Dr. Berry* cannot tell us that he did read it. Of course he cannot. I would not believe him if he could. Nobody, unless it is a very exceptional man, can bring his memory back, after the lapse of years, sufficiently to be able to say: 'At that particular time I read such and such a thing.' The ordinary common sense of mankind naturally leads one to the conclusion, I should say, that, taking the fact that this is a monthly publication intended to give information on the subject in which its subscribers and readers are interested at the time when it is published, and, taking the fact that it is published, not merely once every year, but once every month, because it is intended to give people the current information upon the subject, *Dr. Berry* probably did read it within a reasonably short time after he received it." (*p*)

Publication in a Foreign Language.—Though a stronger inference of publication arises where the prior description is in the English language, (*q*) a prior description in any language known to persons in England is sufficient.

In *Lang* v. *Gisborne* and *Pickard* v. *Prescott*, the prior publication was in French; in the *United Telephone Company* v. *Harrison, Cox-Walker and Company* (*r*) and in *Harris* v. *Rothwell* (*s*) it was in German.

In the last-mentioned case the plaintiff's patent had been taken out in this country in April, 1880. It was proved that the same invention had been the subject of prior patents in Germany, and that specifications in the German language, with drawings attached, had been deposited in the public library of the Patent Office in December, 1878, and February, 1880, respectively, and that the journal then published periodically by the Patent Commissioners contained amongst the list of patents granted in Germany entries of these particular patents, with a note in each case that the specifications as well as the list of applications might be consulted in the free public library of the office. It was not actually proved that any one other than the librarian had seen the specifications. Commenting on this evidence, Lindley, L.J., said: "It is necessary next to consider the effect, if any, of these specifications being in German and not in English. The fact that German is understood by many people in this country, and that persons who can read and translate German can easily be found by those who want their

(*p*) [1892] A. C. 263; 9 R. P. C. 203.
(*q*) *Harris* v. *Rothwell*, 35 C. D. 412. See Lindley, L.J., p. 428.
(*r*) L. R. 21 C. D. 720; 51 L. J. Ch. 705.
(*s*) Supra.

assistance, must, we think, be treated as common knowledge, and be judicially noticed, although not stated in the special case. . . . The conclusion at which we have arrived, and which in our opinion is most in accordance with the authorities and with the principles that underlie them, may be thus expressed. *Primâ facie* a patentee is not the first inventor of his patented invention if it be proved that 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 library to which the public are admitted, and to which persons in search of information on the subject to which the patent relates would naturally go for information. But if, as in *Plimpton* v. *Malcolmson* and *Plimpton* v. *Spiller* and in *Otto* v. *Steel*, it be proved that the foreign publication, although in a public library, was not in fact known to be there, the unknown existence of the publication in this country is not fatal to the patent." (*t*)

No Publication where Book not Accessible to the Public.—It is apparent from the above case that although the Court will usually infer upon proof of publication in this country of even a single work containing a prior description of an invention, that such description has disclosed that invention to some member of the public, it is nevertheless open to any patentee to rebut that inference by shewing affirmatively that no member of the public has in fact had access to the work in question.

In *Plimpton* v. *Malcolmson*, (*u*) it was proved that a prior patent had been taken out in America for an invention similar to that claimed by the patentee. This patent was described in an American book, a copy of which had been sent to the Patent Office Museum in this country a month prior to the date of the plaintiff's patent. The assistant librarian had marked inside the book the date of its arrival; but it had neither been entered in the list of donation books nor in the catalogue. Not being a book of sufficient importance to have a place in the public room, it was placed in a small private apartment. There was no evidence that any one at the Patent Office knew the book was there. From these facts Jessel, M.R., drew the inference that the book had remained in the private room untouched, unread, and unlooked at for ten years. "It does appear to me, sitting as a jury," said his lordship, "that I should be wanting in common-sense if I came to the conclusion that the existence of this book on the shelf in a private room in the

(*t*) 35 C. D. pp. 429, 431.

(*u*) 3 C. D. 531.

Patent Library—private in the sense of not being accessible to the public, though public in the sense that if any one had actually known of it he could have sent for the book—would be such a publication as to deprive the man who first made it known to the world of that merit—the only merit so far as the importer is concerned—which consists in making known a useful invention to the public. Therefore, on the question of novelty, I should give a verdict for the plaintiff on this ground alone." (*v*)

The same patent again came before the Court in the subsequent case of *Plimpton* v. *Spiller*. Further evidence had been obtained, which shewed that the book in question had been placed on the top shelf of a corridor of the Patent Library through which the public passed. So placed, any member of the public might have taken it down and looked at it. But there was no evidence that any one had done so. The previous evidence as to the book not being entered in the catalogue or in the donation list was not varied. Jessel, M.R., again gave judgment for the plaintiff, and was affirmed by the Court of Appeal.

"It must be not only printed in a book," said Brett, L.J., "but that book must be placed in such a position and so used that you may fairly infer or assume that the contents of the book have become known to a sufficient number of persons. Therefore, when you prove that this book was put in the Patent Library, I care not into what part, I do not say that is no evidence of its having become known to the public, but I say that when you have other facts which shew that although it was put into the Patent Library the proper inference is that nobody ever did see it there or elsewhere, then, although it has been in one sense if you please published, or in one sense if you please dedicated to the public, all I can say is that the public have not been able to take advantage of the dedication or the publication, and therefore you do not shew that it was known to the public." (*w*)

In *Otto* v. *Steel*, an attempt was made to upset the plaintiff's patent, by proving that a description of the invention was contained in a French book, of which a single copy had been sent to this country, and placed in an inner room of the British Museum. To this room the public had not general free access, but persons desiring so to do were allowed on application to inspect the titles of the books it contained, and remove them, if wanted, to the reading-room for use. The book in question was entered in the general catalogue under the author's name only, and in a special

(*v*) L. R. 3 C. D. p. 566.

(*w*) L. R. 6 C. D. 412, p. 435.

French catalogue under author and subject. An English bookseller had ordered a large number of copies of this French catalogue, and sent them to his customers. But there was no evidence of any customer having ordered the book, and none of a reader in the British Museum having read it there. On these facts, Pearson, J., said: "I feel myself unable to accept this book. The question is whether or not this book has been published in this country in such a way as to become part of the public stock of knowledge in this country. It is not, to my mind, necessary for that purpose to shew that it has been read by a great number of people, or that any person in particular has got from it the exact information which it is said would have enabled *Dr. Otto* in this case to have made his machine. But, to my mind, it must be published in such a way as that there may be reasonable probability that any person, and amongst such persons, *Dr. Otto*, might have obtained that knowledge from it." (*x*)

Meeting the suggestion that proof that a book containing a description of the invention was in the library of the British Museum, must amount in law to publication, the learned judge said: "There is no decision, to my mind, that lays down such a proposition as that, and I cannot help thinking that I should be doing injustice probably to many persons if I were to say that inventions honestly made by them were to be held bad because they might have been anticipated by something to be found in a book in the library, for which nobody had ever called, and which nobody had ever read in this country. I cannot go so far as that." (*y*)

Limited Publication may be Sufficient.—With the foregoing cases may usefully be compared others in which the publication, though apparently slight, has been held to be sufficient to defeat a subsequent patent.

In the *United Telephone Company* v. *Harrison, Cox-Walker & Company*, (*z*) the plaintiffs were the assignees of two patents for the transmission and reproduction of sound by electricity. The defendants objected as to one of the patents that it was not new, on the ground that before it was taken out a similar invention had been described, with drawings, in a German scientific journal published at Berlin in 1862. Of this journal a copy had been in the Library of the Institute of Civil Engineers at Westminster for

(*x*) L. R. 31 C. D. p. 243; 3 R. P. C. p. 112.

(*y*) L. R. 31 C. D. p. 246.

(*z*) L. R. 21 C. D. p. 720; 51 L. J. Ch 705; W. N. 1882-84. Cf. *United Horseshoe Nail Co.* v. *Stewart*, 2 R. P. C. 122.

seventeen or eighteen years. The institute numbered from three to four thousand members. A copy of the journal had also been placed in the Patent Office library. A telegraphic engineer was called who gave evidence that he had seen, prior to the date of the plaintiff's patent, the copy of this journal which was in the Patent Office library; he could not read German, but he had been able to comprehend the invention by means of the drawings attached to the letterpress. On these facts, Fry, J. (though with some doubt), held that this amounted to publication and avoided the patent if the prior description covered the invention. (*a*)

Prior publication was also discussed in *Harris* v. *Rothwell*, (*b*) with special reference to the question of onus of proof. There the facts, as set out in a special case, were as follows. Prior to the date of the plaintiff's patent there existed in the library of the Patent Office two copies of two German specifications, each of which, with the drawings annexed to it, contained a description of the plaintiff's invention. Of these specifications one had been in the library more than a year, the other about six weeks. The presence of these German specifications in the library was known to the librarian, and attention had been called to the fact by the publication of English translations of their titles in the *Patent Commissioners' Journal;* moreover, the specifications themselves were in their proper places in the library, and anybody wanting to see them could have done so. Whether any person except the librarian had in fact ever seen them was not known. From these facts the Court of Appeal held that the proper inference was publication. Lindley, L.J., delivering the judgment of himself and Cotton, L.J., said: "It appears to us that on this evidence the burden of shewing that the English patentee was the first inventor in this country of his invention is again cast upon the plaintiffs, and that unless they can shew that the German specifications were not in fact seen by any one who could understand them the defendant is entitled to succeed. If the case were being tried by a jury . . . we are clearly of opinion that the judge ought at least to tell the jury to find for the defendant on the issue that the plaintiff was the true and first inventor, if they thought that the German specification had been so published in this country as to have become known to any one here, and to guide the jury on this point the judge ought to tell the jury that the invention

(*a*) But in this case the patent was upheld on the ground that the German invention was a different invention from that of the plaintiffs.

(*b*) L. R. 35 C. D. 416, at p. 427; 4 R. P. C. 225; 56 L. J. Ch. 459.

having been laid before the public in this country in the way and for the time mentioned in the special case, the invention ought to be presumed to have become known in this country in the absence of all proof to the contrary." (*c*)

What Degree of Knowledge is required in a Prior Publication.—Where a patent is attacked as wanting in novelty on account of a prior dedication to the public by means of a book, writing, or specification, it is open to the patentee, besides contending that the public have not, in fact, had access to such publication, to shew that even if they must be presumed to have had such access, the degree of knowledge thereby communicated is not such as to amount to a prior disclosure of his invention. It is, therefore, important to ascertain what amount of disclosure is necessary to invalidate a subsequent patent for the same invention. It is now well settled that the prior publication must be definite; "a vague notion floating in the air" will not do. (*d*)

"If a mere suggestion is made," said Lord Coleridge, C.J., in the *American Braided Wire Company* v. *Thomson*, "upon which the mind of an inventor has to work, and out of which the mind of the inventor produces something new which is different from, an improvement upon, and a distinct variation from the suggestion, I apprehend the fact that it has been suggested by the reading of a specification or by looking at the drawings of a specification, will not prevent his having a right to patent his invention. I suppose that all patents almost are suggested by something. It very seldom comes into the head of any man to do a thing without something or other suggesting the idea to him to do it—some physical fact, I mean, or some piece of observation. That, therefore, alone would not be sufficient." (*e*)

In *Thomson* v. *Batty*, (*f*) the plaintiff's patent was for improvements in the marine compass and the means of ascertaining and correcting its errors. It was urged for the defendants that the patent was bad for want of novelty, because the patentee two years before the date of his grant had pointed out, in a paper read to the British Association, and afterwards published in the *Philosophical Magazine*, the result he now obtained as a desideratum in science. But Kekewich, J., held that this did not amount to prior publication, on the ground that it is no anticipation of a

(*c*) In this case Lopes, L.J., was of opinion that the German specifications (in the circumstances) amounted to conclusive evidence of publication, L. R. 35 C. D. p. 431. Cf. *Humpherson* v. *Syer*, 4 R. P. C. 415.

(*d*) Per Bacon, V.C., in *Washburn* v. *Patterson*, 1 R. P. C. 157, p. 161.

(*e*) 5 R. P. C. 120.

(*f*) 6 R. P. C. 99.

patent for the patentee to intimate to the world at large before he takes out his letters patent that the attainment of a certain result is desirable, when he does not intimate at the same time the means of attaining that result.

Thus the outline sketch contained in a provisional specification has been held insufficient to establish publication. (*g*) For the description must be such a description as will work in practice without the exercise of further invention on the part of the person following the directions in the description, whether in a book or specification.

In *Betts* v. *Menzies*, (*h*) Wood, V.C., said: "I think that if a man sits down and takes out a patent from his own conjectures without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless. Take, for instance, the electric telegraph. Many ingenious persons had talked of the means of communicating between two places by electricity, and had discussed the mode of carrying out that idea before Messrs. *Wheatstone* and *Cooke* shewed a practically useful way of doing it." After referring to the Marquis of Worcester's book, "A Century of Inventions," and the many patents taken out from hints obtained from it, the learned Vice-Chancellor proceeded, "Such a publication as that will not suffice to invalidate a subsequent patent which is capable of being actually worked to a useful purpose."

Dealing with the amount of information which a paper anticipation must contain to invalidate a subsequent patent, Lord Westbury, in his well-known judgment in *Hills* v. *Evans*, (*i*) said: "Now, with regard to the specification of the prior patent it is not to be distinguished in principle from any other publication. The only peculiarity attending the specification of the prior patent is this, that the specification must be considered as a publication. There has been some doubt with regard to books and documents under particular circumstances, whether they can be considered as amounting to a publication. With regard to a specification there can be no doubt, because the specification is that which the patentee gives to the public, and makes matter *publici juris* in return for the privilege which he receives; but upon all principles

(*g*) *Stoner* v. *Todd*, 4 C. D. pp. 58–61. But see *Lawrence* v. *Perry*, 2 R. P. C., p. 187.

(*h*) 3 Jur. (N. S.), 358.

(*i*) 4 De G. F. & J. 289; 8 Jur. (N. S.), 528.

the specification is not to be distinguished from any prior publication contained in a book published in the ordinary manner. Now, the question is, What must be the nature of the antecedent statement? I apprehend the principle is correctly thus expressed: the antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained, which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent." And again, "There is not, I think, any other general answer that can be given to this question than this: that the information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. The invention must be shewn to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and a specific rule of practical application. The reason is manifest, because much further information, and therefore much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined pure metal which is extracted from it. Again, it is not, in my opinion, true in these cases to say that knowledge, and the means of obtaining knowledge, are the same. There is a great difference between them. To carry me to the place at which I wish to arrive is very different from merely putting me on the road that leads to it. There may be a latent truth in the words of a former writer, not known even to the writer himself; and it would be unreasonable to say that there is no merit in discovering and unfolding it to the world. Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be knowledge equal to that required to be given by a patent, namely, such knowledge as will enable the public to perceive the very discovery, and to carry the invention into practical use; and this appears to be consistent with the decided cases."

Applying the rules above laid down to the case before him,

his lordship proceeded: "There is here what I have denominated apparent generality, giving no specific knowledge, no practical rule of application, but furnishing suggestions which might give a direction to inquiry, from which inquiry a specific definite amount of practical information might possibly be elicited. That unquestionably, according to the rules which we have endeavoured to ascertain, is not such information as will vitiate a subsequent patent; for it is not such information as will be sufficient to support a patent. It adds nothing to the real stock of practical knowledge of mankind, and ought not to derogate from the validity and benefit of a subsequent invention." (*j*)

"We know what is necessary," said Cotton, L.J., in *Ehrlich* v. *Ihlee*, "if there is to be an anticipation, not by the existence of an actual thing, but by description either in a specification or otherwise; that the description must be of such a character as to enable any one competent to make the machine for which the protection is claimed from the description given." (*k*)

A prior publication to defeat a subsequent patent must, then, sufficiently impart the mode of carrying out the invention, to enable any one working upon the information conveyed from such previous specification, to reckon with confidence on the result. (*l*)

In *Betts* v. *Neilson*, (*m*) Lord Chelmsford said: "I entirely agree with the opinion of Williams, J., in the case of *Betts* v. *Menzies* in the Exchequer Chamber, that the publication of a notion that a certain useful art may be discovered without any information or knowledge of the means of the discovery, cannot preclude a subsequent first inventor of those means from taking out a patent for the entire art." And in *Patterson* v. *The Gaslight and Coke Company*, (*n*) Lord Blackburn, adopting the words of Lord Westbury, (*o*) said: "An antecedent specification ought not to be held an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery."

The law applicable to paper anticipations was again considered by the Court of Appeal in the *Cassell Gold Company* v. *Cyanide*

(*j*) This judgment was quoted with approval, and followed by Lord Chelmsford, C., in *Betts* v. *Neilson*, L. R. 3 Ch. 431; and by the Court of Appeal in *Savage* v. *Harris*, 13 R. P. C. 368.

(*k*) 5 R. P. C. 437. See, also, *Otto* v. *Linford*, 46 L. T. (N. S.), 39; *Shrewsbury* v. *Sterckx*, 13 R. P. C. 53.

(*l*) Per Lord Chelmsford in *Betts* v. *Neilson*, L. R. 3 Ch. p. 435.

(*m*) Ibid. p. 432.

(*n*) 3 App. Ca. 239, p. 245.

(*o*) *Betts* v. *Menzies*, 10 H. of L. C. p. 154.

Gold Syndicate. Smith, L.J., in that case said: "To constitute a paper anticipation the description in the prior specification must be such that a person skilled in the matter reading it would find in it the invention which is sought to be protected by the patent, and unless this can be found in the writing itself it is not an anticipation at all. In our judgment, the existence of a chemical patent, wherein the combined effect of two or more chemicals is claimed in order to bring about a desired result, does not by any means constitute an anticipation of a subsequent discovery that by the use of any one of the named chemicals the desired result can be attained, and, *à fortiori*, when the compound of the two or more has failed to do so, for, as stated by Professor Mills, there are any number of cases known in chemistry where two things when put together act very differently from what they do apart." (*p*)

In *Stoner* v. *Todd*, (*q*) Jessel, M.R., said that no prior publication was sufficient which did not enable a workman of ordinary skill in the subject-matter of the invention to perform it. Lord Westbury, in *Hills* v. *Evans*, took a similar view. This, however, cannot now be regarded as a correct exposition of the law, the House of Lords having laid down a different rule in the *Anglo-American Brush Electric Light Company* v. *King, Brown & Company*. (*r*) The question there was whether a specification of one *Varley* was an anticipation of the plaintiff's patent. Lord Watson said: "I do not think it necessary to deal with the conflict of testimony as to the sufficiency of *Varley's* specification for the guidance of a skilled workman. The Lord Ordinary was of opinion that the appellants had failed to prove that part of their case. But I agree with his lordship, and with the learned judges of First Division, in holding that the sufficiency or insufficiency of the specification for that purpose does not afford a crucial test of prior publication. Every patentee, as a condition of his exclusive privilege, is bound to describe his invention in such detail as to enable a workman of ordinary skill to practise it, and the penalty of non-compliance with that condition is forfeiture of his privilege. His patent right may be invalid by reason of non-compliance; but it certainly does not follow that his invention has not been published. His specification may, notwithstanding that defect, be sufficient to convey to men of science and employers of labour

(*p*) 12 R. P. C. 256.
(*q*) L. R. 4 C. D. pp. 58, 61.
(*r*) [1892] A. C. 378; 9 R. P. C. 313. See, also, Grove, J., in *Philpott* v. *Hanbury*, 2 R. P. C. 43; and Lindley, L.J., in *Savage* v. *Harris*, 13 R. P. C. 368, 369.

information which will enable them, without any exercise of inventive ingenuity, to understand his invention, and to give a workman the specific directions which he failed to communicate. In that case I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill."

When it is sought to Establish Publication by collating a Number of Documents.—The Court will not support a case of prior publication which can only be made out by piecing together a number of independent documents.

In *Von Heyden* v. *Neustadt*, (*s*) James, L.J., said: "It is contended that this invention is not novel. The burden of proving this is on the defendants, and it must be made out very clearly in order to destroy the patent of a man who at all events was the first person who, *de facto*, produced the thing to the public practically in a working state." Referring to the alleged prior publication, the learned judge proceeded: "What we have got in this case is not one clear statement by one writer, but a mass of paragraphs exhumed by the industry of the defendant's advisers from a number of publications. We are of opinion that if it requires this mosaic of extracts from annals and treatises spread over a series of years, to prove the defendant's contention, that contention stands thereby self-condemned. And even if it could be shewn that a patentee had made his discovery of a consecutive process by studying, collating, and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would do."

In *Moseley* v. *Victoria Rubber Company*, (*t*) Chitty, J., said: "The law in regard to prior publication by specification or otherwise is well settled: The antecedent statement must be such that a person of ordinary knowledge on the subject would be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. . . . It is unnecessary, and would be a mere waste of time, to go through these four specifications in detail. They cover a period of some fourteen or fifteen years, and the latest of them was published nearly a quarter of a century before the plaintiff's

(*s*) 50 L. J. Ch. 127.

(*t*) 4 R. P. C. 241.

patent. Yet no one did produce, or could, from reading these specifications, have produced such an article as that produced according to this plaintiff's patent."

Prior Publication must be construed in the Light of Subsequent Knowledge.—At the same time, in determining whether or not any particular prior specification or description has so disclosed an invention as to enable the public to perform it, such document must be construed in the light of any further information bearing on the same subject which has been added to the stock of public knowledge subsequent to such publication, but prior to the date of the patent it is alleged to anticipate.

Thus, a prior specification, insufficient in itself to support a patent, may, when construed at a later date by a person whose knowledge is supplemented by subsequent discoveries, be, in the light of those discoveries, sufficient to destroy a later patent; and a specification which may in itself be insufficient to support a patent may nevertheless afford a sufficient disclosure of the invention to amount to a dedication thereof to the public." (*u*)

So likewise a prior specification may anticipate a subsequent patent for an invention different from that which such specification claims. For a specification necessarily publishes to the world a certain amount of information, more or less new, and that becomes at once public knowledge, even although the public are not allowed to appropriate it in the way in which the patentee has appropriated it, because that is protected by the patent. But, from that time forward it is known, and it may be that that information is sufficient to exclude another patent, although the earlier one cannot be proved to be an anticipation of the later one. (*v*)

Publication to Confidential Agents and Workmen.—A difficult question sometimes arises as to whether there has been publication of an invention by reason of its disclosure to persons occupying a confidential or quasi-confidential relation to the inventor. The majority of inventions, whether mechanical or chemical, necessarily involve the labour and employment of more persons than the inventor. Thus questions often arise as to whether a patentee, in availing himself of the services and opinions of others, has exceeded the limits which the law imposes upon such publications.

The general rule which may be deduced from the decided cases

(*u*) See Lord Watson in *King, Brown & Co.* v. *The Anglo-American Brush Co.*, 9 R. P. C. p. 320 (quoted, supra, p. 84); also, Bowen, L.J., in *Vorwerk* v. *Evans*, 7 R. P. C. 274.

(*v*) *Per* Kekewich, J., in *Thomson* v. *Macdonald*, 8 R. P. C. p. 8.

appears to be that the communication of an invention to some other person, if made in confidence by an intending patentee, is no publication; such person being neither in law nor in equity entitled to make a personal use of the information against the person who gave it. (*w*) But should the person so informed, in breach of his duty to the confiding inventor, disclose the invention to some third party free to make use of it, then the publication will be complete, and the right of the inventor to letters patent destroyed. (*x*) For once any member of the public, under no restriction as to secrecy, has obtained a knowledge of the invention sufficient to enable him to perform it, no subsequent patent can debar such person fr. m putting in use the knowledge he has so acquired.

The most usual case of confidential communication occurs in the case of workmen, and a useful test, to ascertain whether or not that communication amounts to publication, has been said to be the intention with which it is made. (*y*) Thus a communication made by an inventor, who contemplates taking out a patent, to workmen in his employment, with the view of prosecuting the invention into a practicable form, is no publication. But a communication made carelessly, it may be, by an inventor who has no present intention of patenting what he has discovered, to persons employed by him, may amount to a public dedication of the invention.

It may sometimes happen that an inventor, instead of employing his own workmen to make his machine, may order it to be made for him by some independent employer. Whether in such case publication necessarily results was considered but not decided in *Humpherson* v. *Syer*. (*z*) Cotton, L.J., said: "I do not think that *Widmer* can be considered as having been a servant in any way of the defendant; he was a tradesman who received an order to make a machine in accordance with the directions and on the instructions of his customer, the defendant; but it may be that knowing it was to be an experimental machine—that the defendant was making experiments—and other circumstances that we have not fully before us, he might have received those instructions under such circumstances that he was not at liberty to communicate the knowledge he had obtained to the public, or to make use of it publicly, and that he was confined to the use of that knowledge

(*w*) Per Bowen, L.J., in *Humpherson* v. *Syer*, 4 R. P. C. p. 413.

(*x*) *Gadd* v. *Mayor of Manchester*, 9 R. P. C. p. 259.

(*y*) Ibid. p. 258.

(*z*) 4 R. P. C. 411.

which he obtained, and the instructions conveyed to him only for the purpose of the defendant, who was his customer."

In *Blank* v. *Footman*, (*a*) the question of publication was discussed in regard to a design. There the plaintiff, prior to registration, had disclosed his design to one *Hummel*, with whom he was in confidential business relations, as sole agent for the sale of the goods to which the design related. The disclosure was made confidentially with a view to advice from a person having expert knowledge, and Kekewich, J., held this to be clearly no publication. *Hummel*, however, had himself afterwards submitted the design (still prior to its registration) to various persons who he anticipated would be likely to purchase the goods when made to the pattern, and some of these had in fact given him orders. This the learned judge held to be a publication, which avoided the subsequent registration of the design.

In *Winfield* v. *Snow*, (*b*) (also the case of a design) Hawkins, J., held publication to be established where it was proved that prior to registration the design had been shewn confidentially to a customer, who had originally suggested the idea it embodied, but who on seeing it had given an order for a considerable quantity of the goods.

In *Gadd* v. *The Mayor of Manchester*, (*c*) a *Mr. Terrace*, who had made the same discovery as the plaintiffs, had communicated the invention confidentially to two persons in his employment (one a brother of his own), to another brother employed at similar works, and to three other persons interested in the subject-matter of the invention. One of the three latter persons was alleged to have repeated, as a matter of news, the information so received, to a foreman, a draughtsman, and a chemist in his employment. These communications, it was contended, amounted to publication. The Court of Appeal, however (affirming the judgment of Kekewich, J.), held that the last alleged publications were mere gossip, and that the others were confidential. "The public," said Lindley, L.J., "had no access to *Mr. Terrace's* description of his invention. No one had access to that who was not confidentially consulted respecting it." (*d*)

Publication to Fellow Workmen.—While the confidental relationship existing between employer and employed will negative

(*a*) 5 R. P. C. 653; 39 C. D. 678; 57 L. J. Ch. 909. See, also, *Hunt* v. *Stevens*, W. N. [1878], 79.

(*b*) 8 R. P. C. 15. Cf. *Heinriche* v. *Bastendorff*, 10 R. P. C. 160, where Day, J., held that publication was proved.

(*c*) 9 R. P. C. 249, 516.

(*d*) Ibid. p. 528.

publication where disclosures take place between them, disclosures by one workman to his fellow employés enjoy no such privilege.

In *Saxby* v. *The Gloucester Waggon Company*, (*e*) it was objected to the validity of the plaintiff's patent that the same invention had been discovered by one *Edwards*, a superintendent in the signalling department of the London and North-Western Railway Company, under whose directions working drawings had been openly prepared and shewn to the company's mechanical engineer and also to the locomotive committee. The plaintiffs contended that these facts did not establish prior publication, as the publication in question had only been made to *Edwards*' fellow servants and employés, and that as he had not taken out a patent they were entitled to do so.

Jessel, M.R., in a judgment affirmed by the House of Lords, said: "There is no question that the right of *Edwards* to the invention was his own personal right, the mere fact of his being the superintendent of the signalling department did not prevent him inventing and patenting a new signalling apparatus. If he obtained a patent, it would not belong to the company, but to himself, and if he chose to publish it to all the other ten thousand employés of the London and North-Western Railway Company, of course that would have been a complete publication. He did publish it, in fact, to twenty-two or twenty-three of them, and, in my opinion, there is no pretence for saying that the publication of a secret which was his own to his fellow servants was less than a publication to the same individuals if they had not been his fellow servants. The confidence of the servants is a confidence only as regards the secrets of the master, not as regards the secrets of the fellow servants. I should be of opinion that it was not only discussed, but sufficiently published by *Edwards* before the date of the patent."

Publication in a Report to Government.—The description of an invention in a report made to a Government department by a public official may be sufficient publication to defeat a subsequent patent for the same invention.

In *Patterson* v. *The Gaslight and Coke Company*, (*f*) the appellant had been appointed under the City of London Gas Act, 1868, to act as one of three referees who were to enquire into the subject of the purification of gas, and report to the Board of Trade the result of their enquiries. They drew up a report, one portion of which was alleged to have been confidentially communicated by

(*e*) Griff. P. C. 56.

(*f*) 3 App. Ca. 239.

the appellant to his co-referees. This report was fully prepared by the 31st of January, 1872, but it was not at that time presented to the Board of Trade. The appellant, a month later, applied for a patent for "Improvements in the purification of coal gas;" the alleged improvements in respect of which this patent was sought were the matters confidentially communicated by the appellant for the official report, and described therein, as above stated. The provisional specification was dated the 9th of March. The report was sent to the Board of Trade on the 27th of the same month and at once made public. The patent, founded on the specification of the 9th of March, was formally sealed on the 28th of May. On these facts the House of Lords held that there was no novelty in the invention, as it had already been dedicated to the public by the prior publication to the patentee's co-referees. Lord Blackburn, in his judgment, said: "I do not mean to throw any doubt on the doctrine in *Morgan* v. *Seaward* (*g*) that a disclosure to assistants or partners of an invention, whilst it is being perfected, under an obligation to keep it secret till the patent is taken out, is not a disclosure to the public, for such persons could not make the invention known without a breach of duty. But in the present case the disclosure was to paid public officers, who could not keep it secret without a breach of duty. They were bound to make it known, and even if they, in breach of their duty, kept it back, the invention was not the less the property of the public from the time the referees knew it, which was at least as early as the date of the report."

Drawings, Models, and Public Exhibitions.—The test of prior publication being, whether the public has in a practical sense already acquired the secret of the invention, it is obvious that publication may take place by means of drawings, models, or oral explanations, as well as by written descriptions and specifications.

In *Herrburger* v. *Squire*, Lord Esher, M.R., said: "If a person has drawn a machine, without describing it at all—has drawn a picture of it, but published that picture in a book, and that book was one which any machinist would understand, and could make a machine from that picture alone, then a person cannot take out a patent in respect of a machine made like that." (*h*)

In *Winby* v. *The Manchester Tramways Company*, (*i*) a patent for improvements in points and crossings of tramways was held anticipated by a model left open to the inspection of persons

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

(*h*) 6 R. P. C. 194. See, also, *Plimpton* v. *Malcolmson*, 3 C. D. 531; *Tetley* v. *Easton*, 26 L. J. C. P. 269; 2 C. B. (N. S.), 706; *Saxby* v. *Gloucester Waggon Co.*, Griff. P. C. 56.

(*i*) 8 R. P. C. 61 (p. 66).

entering the chairman's room in the offices of a company engaged in the construction of tramways. (*j*)

In *Humpherson* v. *Syer*, (*k*) Fry, L.J., held that publication was proved, on evidence, that a model of an invention similar to the plaintiff's had been made for the defendant and shewn openly in a shop, prior to the date of the patent, to a person under no obligation of secrecy.

In the *Lifeboat Company* v. *Chambers Brothers*, (*l*) the patent was for improvements in the construction of lifeboats. Two months before the patent had been taken out, announcements had appeared in newspapers describing the new boat, and a public exhibition of its qualities had been given at Glasgow, in the river Kelvin. This exhibition had been repeated before Board of Trade and Admiralty officials at the Royal Albert Dock in London. A third exhibition, also prior to the date of the patent, and followed by further newspaper notices, had been given at Portsmouth. On these facts the Court of Session held that, after such prior publication, no patent for the invention could be supported.

Protected Publication at Industrial Exhibitions.—Special provision has been made by the legislature to prevent the exhibition of inventions at industrial and international exhibitions operating as a publication which will defeat letters patent subsequently granted for such inventions.

Thus, Section 39 of the Patents Act, 1883, enacts—

"The exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or validity of any patent granted on the application, provided that both the following conditions are complied with; namely—

(*a*) "The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

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

(*j*) See, also, *Yates* v. *Armstrong*, 14 R. P. C. 747.

(*k*) 4 R. P. C. 407 at p. 415; but see *Ehrlich* v. *Ihlee*, 5 R. P. C. pp. 206, 207, 437.

(*l*) 8 R. P. C. 418.

By Section 3 of the Patents Act, 1886, these provisions were extended as follows to exhibitions held out of the United Kingdom:

"It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade-marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order, in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit." (*m*)

(*m*) The Order in Council applying sec. 39 of the Patents Act, 1883, to the Paris Exhibition of 1900 will be found in Appendix III., post.

CHAPTER VII.

ANTICIPATION BY PRIOR USER.

User means User in Public.—The novelty of an invention will be defeated if it is shewn that it was in public use within the United Kingdom at any time prior to the date of the letters patent granted in respect of it.

Public use does not mean general use by the public. It means practical use of the invention by any person in public. "The public use and exercise of an invention," said Lord Abinger, C.B., "means a use of the invention in public, not by the public." (*a*) "Public use," said Alderson, B., "means in use in public so as to come to the knowledge of others than the inventor as contra-distinguished from the use of it by himself in his chamber." (*b*)

At the same time, it is not necessary in proving prior user to shew that the user has been such as to disclose to others the knowledge of how to perform the invention. Anticipation by user is not a mere equivalent for anticipation by publication. Any practical use of an invention in public will be sufficient to defeat a subsequent grant of letters patent therefor, whether others have learnt the inventor's secret therefrom or not.

"It is obvious," said Pollock, B., in *Croysdale* v. *Fisher*, (*c*) "that in almost all cases of user it does not profess that there is a publication to the world as there is in the case of a specification, or in the case of a book that is largely disseminated, because the more perhaps as different modes of refinement and variations and improvements continue to multiply, the more does it happen that one portion of the manufacturing world does not know what is going on in, or what is being done by, another portion of the

(*a*) *Carpenter* v. *Smith*, 1 W. P. C. 543.

(*b*) Ibid.; quoted with approval by Lord Chelmsford, C., in *Betts* v. *Neilson*, L. R. 3 Ch. 436.

(*c*) 1 R. P. C. 17.

manufacturing world. Certainly still more does the public not know with very great nicety, unless concerned either as manufacturers or traders, what is going on in the laboratories or manufactories attached to any particular trade. When it is said that a process or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public, *i.e.* in such a way as contradistinguished from a mere experimental user with a view of patenting a thing which may or may not be existing."

A prior use of any material part of the invention claimed will invalidate a subsequent patent. In *Hill* v. *Thompson*, (*d*) proof that a material part of the invention had been in actual use in certain public works during a period of eight years anterior to the date of the patent was held fatal to its validity. So likewise in *Cornish* v. *Keene*, (*e*) Tindal, C.J., thus directed the jury: "The main question is whether this number three which is the principal subject of the patent, was or was not in use in England at the time of granting these letters patent. If this number three, calling it technically and compendiously by that title, was at the time these letters patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly, so that any other person might have the means of acquiring the knowledge of it, as well as this person who obtained the patent—then the letters patent are void. (*f*)

User by the Patentee Himself may be Public User.—Even prior user by the patentee himself will defeat a patent grant, if that user has been a public user. Thus, if an inventor before the date of his letters patent has used publicly or sold the product of his invention the grant is void. For by such use or sale he has given his invention to the public, and he cannot take it back under cover of letters patent. (*g*) In *Wood* v. *Zimmern*, (*h*) it was proved that the patentee had himself sold articles made according to his process four months before the date of his patent. This was held fatal to the patent. "To entitle a man to a patent," said Gibbs, C.J., "the invention must be new to the world. The public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void." This case was

(*d*) 1 W. P. C. 248, 249. See, also, *Losh* v. *Hague*, 1 W. P. C. 202; 8 L. J. Ex. 251.

(*e*) 1 W. P. C. 508.

(*f*) See, also, *Badham* v. *Bird*, 5 R.P.C. 238; *Hollins* v. *Capper*, 5 R. P. C. 289; *Podmore* v. *Wright*, 5 R. P. C. 380; *Hutchison* v. *Pattullo*, 5 R. P. C. 351.

(*g*) *Hoe* v. *Foster*, 16 R. P. C. 40.

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

followed in *Morgan* v. *Seaward*, (*i*) where the Court of Exchequer said: "It must be admitted that if the patentee himself had before his patent constructed machines for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly, that is, to any of the public who would buy, the invention would not be new at the date of the patent. This was laid down in *Wood* v. *Zimmern*, (*j*) and appears to be founded on reason; 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 much larger period than fourteen years. Nor are we prepared to say that if such a sale was only of articles that were fit for a foreign market, or to be used abroad, it would make any difference; nor that a single instance of such a sale as an article of commerce to any one who chose to buy might not be deemed the commencement of such a practice and the public use of the invention, so as to defeat the patent."

Thus, an inventor must elect whether he will use his invention under or without the protection of letters patent. He cannot do both. Where, however, a patentee had made one or two of his patented machines prior to the date of his patent, but had not attempted to sell them, or deal with them by way of profit, this user was held insufficient to avoid the grant. (*k*)

In the case of *Betts* v. *Menzies*, (*l*) the plaintiff applied in due course for letters patent, but owing to unforeseen delays did not obtain a grant within the usual time. Meanwhile he manufactured capsules (the subject of his invention) according to his new process, but only under the cognizance of his partners and workmen; imposing upon the latter an express injunction that none of the articles should be sold. None, in fact, were sold until the patent had been granted. Lord Campbell, C.J., held that this was not a public use which ought to invalidate the patent. "Now, others had not used this before the patent was granted," said the learned Chief Justice. "It was used only by the inventor, the patentee himself, and the use of it by the servants and mechanics whom he employed must be considered to have been his use, and therefore it was not used by others. But, still, if it could be shewn that the effect was really to extend the time of the monopoly that

(*i*) Per Parke, B.; 1 W. P. C. pp. 194, 195; 2 M. & W. 544; 6 L. J. Ex. 153. See, also, Tindal, C.J., in *Gibson* v. *Brand*, 1 W. P. C. 630.

(*j*) 1 W. P. C. 42; Holt, N. P. 58; 1 Carp. P. C. 290.

(*k*) *Bramah* v. *Hardcastle*, Holroyd, 81; 1 W. P. C. 44 n.

(*l*) 28 L. J. (Q. B.), 365.

would be fatal. But the defendant has entirely failed in shewing that."

Manufacturing for Profit, though in Secret, is User.—From what has been already stated it follows that prior user for profit by an inventor himself, even where he keeps his invention secret, will be fatal to a patent grant. Were the rule otherwise a patentee, as pointed out by Alderson, B., in *Morgan* v. *Seaward*, might indefinitely prolong his monopoly by making at first in secret, and taking out a patent when he thought his invention in danger of discovery. The benefit of the patent monopoly is intended for the inventor who gives his invention promptly to the public, not for him who seeks first to enjoy the use of it secretly as long as he can. So likewise prior user by another, even if a secret user, will avoid a patent.

In *Tennant's* (*m*) case the invention was an improvement in a bleaching process. Its great utility was proved, and also the general ignorance of bleachers as to this improvement until after the plaintiff's discovery. But evidence was given that one bleacher at Nottingham had used the same means of preparing his bleaching liquor during six years anterior to the date of the patent. This bleacher had kept the process a secret from the rest of the trade, only disclosing it to his two partners, and to workmen who carried out his instructions in performing it. It was argued that the secrecy thus observed prevented this user being a prior public user. But the Court refused to adopt this view, and held that such user defeated *Tennant's* claim to the exclusive benefit of his discovery; and in principle this decision was clearly right, for had *Tennant's* patent been upheld the Nottingham bleacher could have been prevented using a process formerly freely employed by him.

In *Heath* v. *Smith*, (*n*) Lord Campbell, C.J., pointed out this hardship upon the public if in such case the patent were maintained against a person who had enjoyed a prior use of the invention. The Chief Justice said: "Now, see what that comes to. If any man makes a discovery, and uses it without taking out a patent, and does not announce it by sound of trumpet or calling in the public as spectators, he must suspend the use of his discovery if another person subsequently makes the same discovery and takes out a patent for it."

So similarly in *Cornish* v. *Keene*, Tindal, C.J., said: "If the defendants have shewn that they practised it and produced the

(*m*) 1 W. P. C. 125 n.

(*n*) 3 E. & Bl. p. 273; 2 W. P. C. 268; 23 L. J. Q. B. 166.

same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done." (*o*)

Single Instance of Secret Use.—But a single instance of the manufacture of an article made by workmen under an injunction of secrecy for an inventor who is about to take out a patent, has been held not to avoid the subsequent grant.

In *Morgan* v. *Seaward*, (*p*) the evidence shewed that before the date of the patent, which was the 22nd of July, 1829, two pair of wheels had been made for *Morgan* by one *Curtis*, an engineer, at his own factory upon the principle mentioned in the patent. *Galloway*, the patentee, had given the instructions to *Curtis* under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at *Curtis's* factory, but not shewn or exposed to the view of those who might happen to come there. After remaining there a short time the wheels had been taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent out of England for the use of a foreign company of which *Morgan* was managing director, which carried on all its transactions abroad. Shareholders of this company were resident in England. *Curtis* deposed that the wheels "were sold to the company," without saying by whom, which might mean that they were sold by *Curtis* to *Morgan* for the company; and that *Morgan* paid *Curtis* for them. *Morgan* and *Galloway* employed an attorney, who entered a caveat against any patent on the 2nd of March, and afterwards solicited the patent in question, which was granted to *Galloway* and assigned to *Morgan*.

It was objected by the defendants that these facts amounted to proof of prior user, and that the patent was void. But the Court of Exchequer refused to adopt this view. In their judgment, delivered by Park, B., they said: "We do not think that the patent is vacated on the ground of the want of novelty, and the previous user or exercise of it, by a single instance of a transaction such as this between the parties connected as *Galloway* and the plaintiff are, which is not like the case of a sale to any individual of the public who might wish to buy; in which it does not appear that the patentee has sold the article, or is to derive any profit from the construction of his machine, nor that *Morgan* himself is, and in which the pecuniary paym[illegible] may be referred merely to an ordinary compensation for the labour and skill of the engineer

(*o*) 1 W. P. C. 511. (*p*) 1 W. P. C. 170; 6 L. J. Ex. 153; 2 M. & W. 544.

actually employed in constructing the machine; and the transaction might upon the evidence be no more in effect than that *Galloway's* own servants had made the wheels; that *Morgan* had paid them for the labour, and afterwards sent the wheels to be used by his own co-partners abroad. To hold this to be what is usually called a publication of the invention in England would be to defeat a patent by much slighter circumstances than have yet been permitted to have that effect." (*q*)

Operations of this kind are, however, extremely risky and ought to be avoided by an inventor. In a recent case the use of a printing-machine (already patented in America) in the printing of a provincial paper on various occasions was held to avoid a subsequent English patent: although the importer stated that such use was secret and had only been resorted to with a view to seeing that the machine would work properly before applying for the English patent. (*r*)

Mere Delay in Applying for a Patent is not Prior User.—Although the law assumes that an inventor will apply for letters patent promptly, a patent is not avoided by merely proving that the patentee has kept his invention on the shelf, as it were, for a considerable period before making his application, provided he has not meanwhile used the invention: for such delay is no extension of the period of his monopoly.

In *Bentley* v. *Fleming*, (*s*) it was objected that the plaintiff had delayed some considerable time after his machine had been in complete working order before he applied for a patent. But Cresswell, J., overruled the objection. The learned judge said: "A man cannot enjoy his monopoly by procuring a patent after having the benefit of the sale of his invention. But you cannot contend, that if a man were to keep his invention shut up in his room for twenty years, that circumstance merely would deprive him of his right to obtain a patent for it."

In *Young* v. *Rosenthal*, (*t*) Grove, J., said: "Mere private use in the closet, mere experimental working in a laboratory, without publishing the invention, keeping it a secret with a view of a patent being taken out, would not invalidate it; but if it is once publicly used or sold in a shop, or publicly used in a carriage or on the person, or in any such way, then the public have a right to it and the patent is bad."

(*q*) 1 W. P. C. p. 195. Cf. Kay, L.J., in *Westley* v. *Perkes*, 10 R. P. C. 192.
(*r*) *Hoe* v. *Foster*, 16 R. P. C. 33.
(*s*) 1 Car. & K. 587; 1 C. B. 479.
(*t*) 1 R. P. C. 32.

Prior User need not be Continuous User.—Prior user, provided it has been public, whether for a year, or a month, or a day, will equally defeat a subsequent patent. (*u*) Nor is it necessary that the use should have been continuous and actually going on at the date of the grant. Public user years before, if proved, is sufficient. But the circumstance that the user alleged has been abandoned affords, especially in the case of an invention of high utility, strong presumptive evidence that such user was not a user of the perfect and completed invention.

In *Household* v. *Neilson*, (*v*) the Court of Session held that prior user discontinued before the date of the grant did not invalidate the letters patent. But the House of Lords refused to adopt this view of the law. "Now, I am obliged to say, with all deference to the learned judge," said Lord Lyndhurst, C., "and with all respect to the learned judges of the Court of Session, that I think in that respect they are mistaken, and that if it is proved distinctly that a machine of the same kind was in existence, and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary it should come down to the time when the patent was granted. If it was discontinued, still that is sufficient evidence in support of the prior use, so as to invalidate the letters patent." (*w*)

In the same case Lord Brougham, after pointing out that the abandonment of the user of a prior invention might be a most material factor in determining whether or not such invention had in fact proceeded beyond experiment, said: "But suppose it was complete, and suppose it is admitted not to have been a trial; suppose it is allowed to have been an invention executed, if I may so speak, and not merely executory, or not merely in the progress of invention, but an invention completed, then it is one of the greatest errors that can be committed in point of law, to say that with respect to such an invention as that it signifies one rush whether it was completely abandoned, or whether it was continued to be used down to the very date of the patent, provided it was invented and publicly used at the time, twenty, or thirty, or as in this case, forty years ago, it is perfectly immaterial; not immaterial to the second question, arising upon the second condition, namely, whether it was used or not at the time of the granting of the patent, but totally immaterial to the other question, which is equally necessary to be ascertained in the inventor's favour, whether

(*u*) *Hoe* v. *Foster*, 16 R. P. C. 33 (per Chitty, L.J., p. 39).

(*v*) 1 W. P. C. 673; 9 Cl. & F. 788.

(*w*) Ibid. p. 709.

or not he was the first and true inventor; for he must be the first and true inventor, as well as the only person using it at the time; otherwise he is not entitled to the letters patent." (*x*)

In *Honiball* v. *Blumer*, (*y*) the plaintiff's patent was for improvements in the construction of anchors. At the trial it was proved that a firm in Liverpool twelve years prior to the date of the patent had made and sold a single anchor similar in construction to that of the patentee. On this Martin, B., said: "I think, Sir Frederick Thesiger, there is an end of your case, assuming the jury believe *Mr. Logan*, as to which I suppose there is no doubt. I think if that anchor of *Mr. Logan's* was sold in the ordinary way of business, although it turned out a failure, as possibly may have been, if it was sold in the regular way of trade or business, there is an end of your case, and this patent cannot be supported."

In the case of *Guilbert-Martin* v. *Kerr & Jubb*, (*z*) the plaintiff's patent was for improved gauge glasses communicated from abroad by a Frenchman. It was proved by the defendants that six years prior to the date of the patent, glasses of a similar description had been used by *Crossley & Sons*, placed against boilers in their works at Halifax; they were used there as long as they lasted, probably only a very short time. They were not renewed on being worn out, and were not in actual use at the date of the plaintiff's patent. Kekewich, J., held that the user was complete, and that on the evidence the fact that the glasses had not been renewed after being worn out pointed, not to a case of abandoned experiment, but to the discovery that those glasses were not the most useful for the purpose for which they were employed.

Actual Sales not Necessary.—As is already apparent from the preceding cases, it is never necessary to prove actual sales to establish prior user.

In *Mullins* v. *Hart*, (*a*) where the patent was for a new method of manufacturing brass penholders, the defendants proved that they had manufactured penholders on the principle contained in the plaintiff's specification, some months before the date of his patent; they had no shop in which to exhibit their goods, but these penholders had been deposited in their warehouse for sale. They could not, however, prove that any of them had actually been sold. Jervis, C.J., held that this was sufficient to defeat the novelty of the plaintiff's patent.

(*x*) 1 W. P. C. 713.
(*y*) 2 W. P. C. 199; 10 Ex. R. 538; 24 L. J. Ex. 11.
(*z*) 4 R. P. C. 18.
(*a*) 3 Car. & K. 297.

Nor is it necessary to prove that the anticipation alleged was an article manufactured with the intention of being sold.

In *Hancock* v. *Somervell*, (*b*) an invention was held to have been in public use which was brought under the notice of customers in various places, though no sale was actually effected.

Thus, an article used openly for a domestic purpose will defeat a subsequent patent for a similar invention.

In *Carpenter* v. *Smith*, (*c*) the plaintiff's patent was for an improved lock. Evidence was given which shewed that a lock similar to that which was the subject of the plaintiff's patent had before been used by a *Mr. Davies*, who had placed it on his gate adjoining a public way many years anterior to the date of the patent. Lord Abinger, C.B., held that this evidence, if the jury believed it, was fatal to the grant. The learned Chief Baron said: "Now, public use means this—that the use of it shall not be secret, but public; and in that sense I must say, that if you think the lock used by *Mr. Davies* is a lock which combines the same thing, I think that is a public use of it, and is within the meaning of this clause of the patent—'public use and exercise,' as used in opposition to private and secret use. Therefore, if a man invents a thing for his own use, whether he sells it or not, if he invents a lock and puts it on his own gate and has used it for a dozen years, that is a public use of it."

In the subsequent case of *Young* v. *Fernie*, (*d*) Stuart, V.C., doubted if the publication in *Carpenter* v. *Smith* was such as ought in more modern times to invalidate a subsequent patent. His Honour said: "It is not, I think, the habit of mankind to go about examining the construction of the locks on their neighbours' doors or gates. Even the few men endowed with an honest curiosity in examining mechanical inventions would probably not be anxious to be found taking models of their locks or prying into the exact construction of fastenings intended to protect private property against the whole body of the public."

But in the later case of *Betts* v. *Neilson*, (*e*) Lord Chelmsford quoted and followed *Carpenter* v. *Smith* without expressing any such doubt. In that case it was alleged that the patent had been anticipated by a prior manufacturer. No sale of the alleged anticipation was, however, proved, and Wood, V.C., considered the evidence insufficient. His Honour said: "I cannot say, in the

(*b*) 39 *New London Journal*, 158. Cf. Byles, J., in *Oxley* v. *Holden*, 8 C. B. (N. S.), 666; 30 L. J. C. P. 68.

(*c*) 1 W. P. C. 534; 11 L. J. Ex. 213; 9 M. & W. 300.

(*d*) 4 Giff. 577, p. 612.

(*e*) L. R. 3 Ch. 435; 18 L. T. (N. S.), 159.

absence of a single thing produced to me by any person who is said to have purchased it, that the manufacture was achieved. I want somebody who was an habitual purchaser." On appeal, Lord Chelmsford, C., dissenting from the doctrine that a sale must be shewn to prove anticipation, said: "An article which is capable of some useful application may from circumstances be unsaleable at a particular time, and yet if manufactured, not for experiment, but in the way of trade, may prevent another patent having a claim to novelty. Nor in order to establish a public use is it even necessary that the patented article should have been previously manufactured for sale." After citing the decision in *Carpenter* v. *Smith*, the Lord Chancellor proceeded: "If, therefore, the evidence which I am about to examine established the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that *Betts's* patent was invalidated."

Carpenter v. *Smith* and *Betts* v. *Neilson* were discussed in the more recent Scottish case of *Gill* v. *Coutts*. (*f*) In that case the invention was a gilding-paint compounded by a particular process. It was proved that a paint formed of similar ingredients had been used before, and on this it was contended that such use did not invalidate the patent, because the public had not been informed thereby of the way in which the paint was compounded. In rejecting this argument, Lord Traynor said: "Then as to the notion that the public must know what the article is composed of before it can anticipate a patent, I think the Sheriff-Substitute has fallen into error by misapprehending the statement often made, that there must be disclosure as well as use. But that disclosure does not mean that the public shall know as much about the article used as the maker of it knows. It means that the thing must be disclosed to the public, and not kept by the maker of it to himself. It is the use of the thing in public, as distinguished from the use in private, by the inventor. Public user involves disclosure. In the case of *Carpenter* v. *Smith*, a patented lock was held to have been anticipated by the fact that a similar lock had been used by 'an individual on a gate adjoining a public road.' There was no suggestion, in that case, that the lock on the gate had been examined by any member of the public so as to ascertain its peculiar construction, or that any such examination or knowledge

(*f*) 13 R. P. C. 125.