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(PATENTS AND DESIGNS ACTS, 1907-8)

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THE  
LAW AND PRACTICE

RELATING TO

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(PATENTS AND DESIGNS ACTS, 1907-8)

BY

DAVID FULTON

OF THE MIDDLE TEMPLE AND NORTHERN CIRCUIT

BARRISTER-AT-LAW

*(Assoc. Mem. Inst. Civil Engineers)*

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## PREFACE.

**T**HE publication of the present Fourth Edition of this book has been intentionally delayed in order that the practical working of the new provisions of the Patents and Designs Act of 1907 might have time to be judicially ascertained and settled. Thus, instead of mere speculative comments upon these novel sections, the Author has been able to record actual practice and cite reported rulings.

The enlarged jurisdiction and increased powers of the Comptroller have added considerably to the importance of his office and the responsibility of his administration, and some interesting developments in practice will be found noted in the body of the work. The Courts also have, since the advent of the altered conditions, not only discussed and interpreted the new portions of the present Statute, but have in some instances taken occasion to modify or explain the effect of certain of the older decisions. The results, as regards both administrations, are that much of the matter in existing text-books is no longer reliable.

The true interpretation of Section 27, governing the Revocation of Patents upon the ground of manufacture

mainly or exclusively abroad, has been authoritatively set forth by Mr. Justice PARKER in *Hatschek's Patents*, and the influence of his decision upon the Comptroller's practice may be traced from a study of the cases quoted in the pages which follow and comment upon that decision.

The new Order LIIIA of the Rules of the Supreme Court regulates, *inter alia*, the preparation and scope of particulars, and minimises the danger of a Patent being unexpectedly upset upon the plea of alleged prior user.

The main justification of the new Act is that the disadvantages of a scattered series of Statutes of different dates, not always reconcilable in their provisions, have been done away with, and for the first time there may be said to exist a Code of Patent Law comprising the effective sections of the Statute of Monopolies, the Act of 1907, the Patents Rules of 1908, Order LIIIA, and the International Convention.

Following the scheme adopted in the first, second, and third editions, the entire field covered by the new Patents and Designs Act has been discussed in this work. Such a course is convenient, as there are many

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Sections which are common to both subjects, and it is useful to have in one compact volume the whole material of the Statute. So far, this is the only treatise extant which fulfils these conditions.

Owing to the exclusion of Trade Marks from the new Act, these are not now included in this work. Consequently, the additional matter on Patents and Designs has not increased the bulk of the volume comparatively with the last edition. The whole of the older matter has been carefully revised, and in great measure re-written. Over a hundred new cases, many of them of material importance, have been cited, and the Indexes of both the Patents and Designs portions have been re-arranged and enlarged.

DAVID FULTON.

1 GARDEN COURT, TEMPLE,

*June, 1910.*

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## KEY TO ABBREVIATED REFERENCES TO REPORTS.

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App. Cas. (or A. C.)	...	Law Reports (New Series), Appeal Cases.
Atk.	...	Atkyn's Reports.
B. & Ald.	...	Barnewall & Alderson's Reports.
Barb.	...	Barbour's American Reports.
Beav.	...	Beavan's Reports.
B. & Cr.	...	Barnewall & Cresswell's Reports.
Bos. & P.	...	Bosanquet & Puller's Reports.
B. & S.	...	Best & Smith's Reports.
C. & P. (or Car. & P.)	...	Carrington & Payne's Reports.
Car. & K.	...	Carrington & Kirwan's Reports.
Cart. T. M. C. A.	...	Cartmell's Trade Mark Cases (1876 to 1892).
C. A.	...	Court of Appeal.
C. B. N. S.	...	Common Bench Reports (New Series).
Ch.	...	Chancery (Appeal).
Ch. Ca.	...	Cases in Chancery.
Ch. D.	...	Law Reports (New Series), Chancery Division.
Cl. & F.	...	Clark & Finnelly's Reports.
C. M. & R.	...	Crompton, Meeson & Roscoe's Reports.
Coop. Ch. Ca.	...	Cooper's Chancery Cases.
Dav. Pat. Cas.	...	Davies's Patent Cases.
De G. J. & S. (or D. J. & S.)	...	De Gex, Jones & Smith's Reports.
De G. & J.	...	De Gex & Jones's Reports.
De G. M. & G.	...	De Gex, Macnaghten & Gordon's Reports.
De G. & Sm.	...	De Gex & Smale's Reports.
E. & B.	...	Ellis & Blackburn's Reports.
E. & E.	...	Ellis & Ellis's Reports.
Good. O. C.	...	} Goodeve's Patent Practice before the Comptroller and Law Officer, with Appendix to end of 1892. (1893.)
"    "    (1st Appx.)	...	
Good. P. C.	...	Goodeve's Patent Cases, Vol. I. (Reports to end of 1883).
Griff. A. P. C.	...	Griffin's Additional Cases— for 1887.
Griff. P. C.	...	Griffin's Patent Cases (1884 to 1886).
Hare	...	Hare's Reports.
H. Bl.	...	H. Blackstone's Reports.
H. & M.	...	Hemming & Miller's Reports.
H. & N.	...	Hurlstone & Norman's Reports.
H. of L. C.	...	House of Lords Cases.
How. Pr.	...	Howard's Practice (U.S.).
Hyde	...	Hyde's Indian Reports.
Ir. Eq.	...	Irish Equity Reports.
Ind. L. R. (Calc.)	...	Indian Law Reports, Calcutta.
Johns.	...	Johnson's Reports.
Jur. N. S.	...	Jurist (New Series).

K. & J. ...	...	...	Kay & Johnson's Reports.
L. J. Ch. ...	...	...	Law Journal Reports (New Series), Chancery.
L. J. C. P. ...	...	...	" " " Common Pleas.
L. J. Ex. ...	...	...	" " " Exchequer.
L. J. Q. B. or K. B. ...	...	...	" " " { Queen's Bench. } or King's Bench.
L. R. App. Cas. ...	...	...	Law Reports, Appeal Cases.
L. R. Q. B. D. ...	...	...	" " Queen's Bench Division.
L. R. Ex. ...	...	...	" " Exchequer.
L. R. Ch. D. ...	...	...	" " Chancery Division.
L. R. Ch. ...	...	...	" " Chancery Appeals.
L. R. Eq. ...	...	...	" " Equity Cases.
L. R. C. P. ...	...	...	" " Common Pleas.
L. R. P. C. ...	...	...	" " Privy Council Cases.
L. R. H. L. ...	...	...	" " House of Lords.
L. T. ...	...	...	Law Times
L. T. N. S. ...	...	...	Law Times Reports (New Series).
Law. Pat. ...	...	...	Lawson on Patents, &c., 3rd Edition.
M. & Cr. ...	...	...	Mylne & Craig's Reports.
M. & G. ...	...	...	Manning & Grainger's Reports.
M. & W. ...	...	...	Meeson & Webster's Reports.
Mer. ...	...	...	Merivale's Reports.
New. L. Jou. ...	...	...	Newton's London Journal.
O. G. ...	...	...	Official Gazette of United States Patent Office.
Popham ...	...	...	Popham's Reports.
Q. B. ...	...	...	Queen's Bench.
R. P. C. ...	...	...	Reports of Patents, Design, and Trade Mark Cases.
Seton ...	...	...	Seton's Reports.
Sol. J. ...	...	...	Solicitors' Journal.
Stark. ...	...	...	Starkie's Reports.
Taunt. ...	...	...	Taunton's Reports.
T. L. R. ...	...	...	Times Law Reports.
T. R. ...	...	...	Term Reports (Durnford & East).
U. S. Pat. Gaz. ...	...	...	United States Patent Gazette.
Ves. ...	...	...	Vesey's Reports.
Web. P. Cas. ...	...	...	Webster's Reports of Patent Cases.
W. N. ...	...	...	Weekly Notes.
W. R. ...	...	...	Weekly Reporter.

The correct citations of the Law Reports, from and including 1891, are as follows:—

Date, A. C. ...	...	...	Appeal Cases.
Date, 1 or 2 Ch. ...	...	...	Chancery Division, 1st or 2nd Vol.
Date, 1 or 2 Q. B. (or K. B.) ...	...	...	Queen's Bench (or King's Bench), 1st or 2nd Vol.

# INTRODUCTION.

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**P**ATENTS for Inventions are now granted and regulated under and by virtue of the provisions of The Patents and Designs Act, 1907, which came into force on the 1st of January, 1908. Trade Marks are no longer included, these being governed by an independent Statute: viz., The Trade Marks Act of 1905.

So far as Patents are concerned, the new Act introduces many important and valuable changes and additions. Some use has been made of the experience gained from the working of the Patent Laws of Foreign Countries, but nothing revolutionary has been attempted, and the changes are on the whole the fruit of careful and mature consideration. The section which has appealed most to the popular imagination is that which provides for the revocation of Patents that are worked wholly or mainly abroad. The results of this provision have been entirely satisfactory. Factories have been built and industries established in this country which, but for the Act, would have remained abroad. Statistics have been published which show that during the year 1909 considerably over a half-a-million of money has been expended in England by foreign firms holding British Patents, on the acquisition of land, premises and plant; and to this must be added the expenditure incurred by British firms in extending their workshops for the purpose of manufacturing under royalties or on behalf of foreign patentees. Nevertheless, as will be seen when the section comes to be discussed, so far from this beneficial provision being new, it is simply a reversion to the spirit and meaning

of Section 6 of the old Statute of Monopolies, the main object of which was the establishment of new manufactures within the realm.

Practically, the New Act is the result of the amendment and consolidation of the respective Patents Acts extending from 1883 to 1902, with certain new features, the most important of which are shortly as follows:—

- (1) The Comptroller is armed with extended powers. Thus the ambit of the official search among the specifications of the last preceding fifty years is extended to include prior specifications which were unpublished at the date of the application. In cases of clear anticipation he may refuse outright the grant of a Patent. Within a certain time limit he may deal with applications for revocation upon the same grounds upon which the grant might at an earlier stage have been opposed. Again, it is the Comptroller who, in the first instance, hears applications for revocation of Patents which have been exclusively or mainly operated outside of the United Kingdom. Lastly, he is empowered to order the payment of costs by parties in proceedings before him.
- (2) Supplementary applications may be made during the period of provisional protection and the whole incorporated in one Complete Specification.
- (3) Unauthorised publication of an Invention, without the knowledge and consent of the Inventor, will not invalidate a Patent for the same, afterwards obtained by him.
- (4) Patents of Addition may be obtained, depending upon and expiring with the mother Patent.

- (5) The grounds of opposition to the grant of a Patent may now include an objection to the sufficiency and fairness of the description.
- (6) Petitions for Prolongation of the term of patent right are now to be presented to the Court, instead of to the Privy Council as formerly.
- (7) A Patent which has unintentionally been allowed to lapse by non-payment of the renewal fee may, at any time afterwards, on sufficient explanation of the circumstances, be restored.
- (8) A Patentee may at any time surrender his Patent by notifying the Comptroller to that effect.
- (9) In an Action for Infringement, a Defendant may apply by way of counterclaim for revocation of the Plaintiff's Patent, instead of having to lodge a separate Petition as formerly.
- (10) In an Action for Infringement, the Defendant may escape the payment of damages by proving that he was not aware of the existence of the Patent.
- (11) Where a Patent has been granted to two or more persons jointly, and one of the Patentees dies, his beneficial interest in the Patent devolves on his personal representatives, instead of passing to the surviving co-Patentee as formerly.
- (12) Section 92 signalises a step towards the creation of a special court for dealing with Patent matters. It provides for the selection of a special Judge of the High Court by the Lord Chancellor to hear appeals from such decisions of the Comptroller as are appealable

to the Court, and to adjudicate upon Petitions referred or presented to such Judge. By virtue of this section, Mr. Justice Parker was appointed by an Order of May, 1908. It is further provided that the decision of such Judge in these matters is *to be final*, except where the appeal is from the decision of the Comptroller revoking a Patent on any ground upon which the grant might have been opposed under Section 26.

By an oversight it was not noticed in passing the Act that, owing to the repeal of the Act of 1883, the phrase "Petition referred or *presented* to such Judge" included Petitions for Revocation presented directly to the Court under Section 25. This would have done away with the right of appeal to a higher Court in ordinary Petitions for Revocation, which was never contemplated by the Legislature. To correct the error a short Act was passed, cited as the "Patents and Designs Act, 1908," to explain Section 92 of the Act of 1907. The Act shortly provides that, in the case of a Petition for Revocation presented under Section 25 of the Act of 1907, the decision of the Judge of first instance is *not* to be final.

As the various provisions for appeals under the Act might give rise to some confusion, it may be as well to summarise them as follows:—

- (1) *The Law Officer's decision is final.*—(a) On appeals from the Comptroller's decision upon matters within Section 7, viz., amendments and alterations in a specification as the result of the official search; or the imposition of specific references; or the refusal of a Patent; (b) On appeals from the Comptroller's decision in oppositions to grant under Section 11; (c) On appeal from the Comptroller's decision in amendments of specifications under Section 21.

(2) *The decision of the Special Judge is final.*—

(a) On appeal from the decision of the Comptroller *refusing* revocation of a Patent under Section 26, viz., on the grounds of Opposition to Grant set forth in Section 11; (b) On reference to the Court by the Board of Trade of petitions for compulsory licence with alternative of revocation under Section 24; (c) On appeal from the decision of the Comptroller, granting or refusing revocation of a Patent, on the ground of being worked outside the United Kingdom, under Section 27; (d) On a Petition for Prolongation of a Patent under Section 18; (e) On appeal from the refusal of the Comptroller to restore a lapsed Patent under Section 20.

(3) *Appeals may be carried to the Court of Appeal and House of Lords.*—

(a) On any appeal from a decision of the Comptroller *revoking* a Patent under Section 26, viz., on the grounds of opposition set forth in Section 11; (b) From any decision by the Court revoking or upholding a Patent on Petition under Section 25 (see Patents and Designs Act, 1908); (c) In all actions for Infringement, Restraint of Threats, &c. Of course, these latter need not of necessity come before the specially appointed Judge, but may fall into the list of any Judge of the High Court in the Division in which they are entered.

Each of these new features will be more fully discussed in its proper place in the body of the work.

No far as the essential elements of Patent Law are concerned, the new Act has made hardly any change. In weighing the questions of invention, patentability, subject-matter, infringement, construction,



and validity, the old Rules and the effects of accepted decisions remain, generally speaking, undisturbed. Like its predecessors, the present Patent Act makes no attempt to define what is a patentable invention. The sole requisite is that it should be within the exceptions contained in the sixth Section of the ancient Statute of Monopolies.

With this short introductory reference to the main new points in the present Act, the writer will now proceed to sketch very briefly the origin and history of Patent Law generally, and will then deal with the subject more in detail from the modern standpoint, noting specially the new provisions of the Statute where these have modified the hitherto existing methods and conditions which governed the obtaining and upholding of Letters Patent for Inventions.

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# PART I.—PATENTS.

## CHAPTER I.

THE ORIGIN AND HISTORY OF PATENT LAW.—  
THE PATENT LAW AMENDMENT ACT, 1852.—  
THE PATENTS, DESIGNS, AND TRADE MARKS  
ACTS, 1883 TO 1902.—THE PATENTS AND  
DESIGNS ACT, 1907.

FROM very early times up to the date of the famous Statute of Monopolies passed in the reign of James I., the Sovereign was at liberty to exercise unchecked the prerogative of making special grants to favoured subjects, and even to foreigners.

Origin of  
Letters  
Patent for  
Inventions.

Letters Patent for Inventions are the survival of these ancient Royal Grants.

When a monopoly was granted, it was made known by the issue of "Open Letters," or *Litteræ Patentes*, addressed to all subjects of the realm, so that the privileges granted should not be questioned from want of knowledge. It followed, therefore, that any infringement of the monopoly rendered the infringer liable, no matter how ignorant he might have been of the existence of the grant, or how innocent of any intention to trench upon the rights of the monopolist. The present Patent Act for the first time challenges this privileged position of the patentee and provides, in Section 33, that in an action for infringement the defendant may escape the payment of damages by proving that he was not aware of the existence of the patent.

Crown  
Grants.

It is evident that from the first, although existing manufactures and the supply of certain products and goods, both natural and artificial, were the chief objects of the

Early  
patents  
for new  
inventions.

older grants of monopoly, new inventions, new manufactures, and advances in arts and sciences were considered favourable subjects for protection by Royal Grants.

Alleged  
early  
Patent for  
discovery.

Setting aside the somewhat apocryphal account of a Patent having been issued by King Edward III. in respect of an alleged discovery of the Philosopher's Stone, it is a matter of record that the same Monarch granted a Patent to one John Kempe in respect of the introduction of a new manufacture or industry of cloth-making, and also issued similar grants for clock-making to three men of Delft. These industries may have been, and probably were, of the nature of new inventions as far as this country was concerned, and to this day valid grants for the mere importation of new inventions or manufactures still exist. But in the bulk of cases the ancient trade monopolies, such, for instance, as in the manufacture of salt, and in respect of mining operations and the like, were mere oppressive grants, fettering rather than encouraging national industry and enterprise.

New manu-  
factures.

Early trade  
monopolies  
and their  
abuse.

With lapse of time the perverted custom of granting monopolies in the exercise of trades and in the sale of goods grew to such an outrageous extent that in the reign of Elizabeth a vast number of commodities, representing in some cases the merest necessaries of life, were in the hands of patentees or monopolists, who used their powers in the harshest and most arbitrary manner to enforce their rights. The supplies of coal, salt, vinegar, iron, steel, bottles, glass, lead, oil, tin, sulphur, pots, brushes, currants, and numbers of other products, natural and artificial, home and foreign, were governed by monopolists, who stood so little on conscience that in certain places that prime necessary of life, salt, rose from sixteen pence to fifteen shillings a bushel. According to the historian Hume, a list of these things, read in the House of Commons, brought to his feet an indignant member, who declared that if things were allowed to go on at this rate "bread itself would be reduced to a monopoly."

Statute of  
Monopolies  
(21 Jac. I.  
c. 30), 1624.  
Monopolies  
abolished.

But the foregoing represents the high-water mark of monopolies, and in the succeeding reign of James I. the whole vicious system was done away with by the famous *Statute of Monopolies*. At one stroke of the pen the bulk of these unjust and restrictive privileges was declared

“utterly void and of none effect, and in no wise to be put in use or execution.”

One of the exceptions to the general extinction of monopolies was made by Sections 5 and 6 of the Statute of Monopolies, in favour of patents for inventions then in force and thereafter to be granted, and this is still the basis upon which patent rights stand at the present day. For example, by Section 6 of that Statute, the term of a patent was limited to fourteen years, and the subject-matter is shortly defined as “any manner of new manufactures which others at the time of making such letters patent and grants shall not use.” The patent must be granted to the true and first inventor; the invention must be novel; the privilege must not be contrary to law nor mischievous to the State, nor hurtful to trade, nor generally inconvenient. The term of fourteen years seems to have been fixed by doubling the usual period of apprenticeship—*i.e.* seven years.

Sections 5 and 6 reserve patents for inventions and become the basis of modern patent rights.

Subject-matter and conditions of patents defined.

Probably the draftsman of the section reasoned that if the inventor of a new manufacture trained an apprentice in the art for seven years, it was but just that he should have the services of the skilled workman, at skilled workman's wages, for another seven years, before the pupil should be at liberty to exercise the art for his own personal advantage. Indeed, under the earliest practice it was customary to insert a proviso in the grant, requiring the inventor to take apprentices during the last seven years of the term, if he had not done so before.

Reasons for fixing duration of patents.

The privilege of Letters Patent for inventions having been thus saved from the general wreck of monopolies brought about by the Statute of James I., thereafter passed through a long period of comparative obscurity, to endeavour to trace which would only weary without instructing the reader.

After-history of Patent Law.

England, Scotland, and Ireland had each its separate patent, the fees for protection in all three amounting to about £300. With the addition of attorneys' and other charges the entire cost to the patentee of a patent covering the United Kingdom could not in those days have been less than from £500 to £700. In *re Kay's Patent* (1 Web. P. C. 568) the accounts showed the patent to have cost £500. Up to the reign of Queen

Separate patents for England, Scotland, and Ireland.

Enrolment  
of specifica-  
tions.

Anne no specification seems to have been required, but about the year 1730 the enrolment of a specification became compulsory.

Disuse of  
provisions  
for working  
patent.

As a consequence of this enforced deposit of an exact description of the invention, the conditions in the grant requiring the establishment of the new industry and the instruction of others in its mysteries—in other words, the commercial working of the invention within the realm—appear to have fallen into abeyance during the latter half of the eighteenth century. Apparently, the presence on record of the exact description contained in the specification was held as a warrant that on the expiry of the patentee's monopoly, whether he worked it or not, others would be able to put the invention in practice. From this it followed that the question of construction and sufficiency of the specification as a guide to the workman became then, as now, one of the tests by which it was ascertained whether this part of the consideration for the grant had been fulfilled by the patentee.

Sufficiency  
of speci-  
fication.

Conse-  
quences  
of filing  
specifica-  
tion.

It may be interesting to point out that the consequence of this departure from the spirit of the Statute of Monopolies, which, as is clear from the wording of Sections 5 and 6, was intended to further “the *working or making* of any manner of new manufacture within the realm,” was at the root of the modern complaint, that foreigners could obtain patents in this country with no intention of working them here, but merely for the purpose of preventing competition by tying the hands of British manufacturers and enabling the patentees to manufacture abroad and import to England at prices which were often exorbitant. It is indisputable that, under the Statute of Monopolies patents were not granted to inventors as a reward for being ingenious, but for the purpose of introducing new manufactures into the country and to create increased employment for the working classes. It is equally indisputable that, under the conditions existing before the coming into force of the present Act, many a patent granted to a foreigner, so far from being an encouragement to native industry, was a positive fetter upon the wrists of those who would otherwise have found profitable employment had working in this country been made compulsory. The most important commercial

Abuses  
arising  
from non-  
working.

combinations in England, strongly supported by the working classes, lost no opportunity of pressing upon the Government the advantages of reverting to the original purposes of the Statute of Monopolies, viz., that, so far at least as concerned patents granted to foreigners, working in this realm should be made compulsory. At first these proposals did not find acceptance, and the only result was a compromise represented by the Compulsory Licence Clauses of the Patents Act of 1902, which however remained practically a dead letter.

Compulsory  
licences.

To-day, Section 27 of the new Act provides that, at any time not less than four years after the date of the Patent, and not less than one year after the passing of the Act, any person may apply to the Comptroller for the revocation of any Patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. Thus the original intention of the Statute of Monopolies has at last been restored.

To return from this digression: As time went on, and as the volume of patent business increased, the attention of legislators was directed more and more to projected improvements in the Patent Law. Slight changes in the procedure were made, and the power of entering a disclaimer of any part of his specification was granted to the patentee by 5 & 6 Will. IV. c. 38, the same Act providing for a seven years' period of extension. By 7 & 8 Vict. c. 69 the possible period of extension was increased to fourteen years. Following these Acts there came—

Disclaimer  
allowed  
(5 & 6  
Will. IV.  
c. 38).

Further  
extension  
allowed  
(7 & 8 Vict.  
c. 69).

### THE PATENT LAW AMENDMENT ACT, 1852.

Patent Act,  
1852.

The changes effected by this Act were important.

One patent covered Great Britain and Ireland, the Channel Islands, and the Isle of Man. The whole business of the Commissioners of Patents was conducted in one office under a responsible head. The stages of procedure were reduced to—(1) The Application, with Provisional or Complete Specification; (2) The Giving Notice of Intention to proceed with the Application; (3) The Applying for the Warrant and Seal (which latter step was practically revived under the Patents Act of 1902); and (4), if it had not been done at the time of application,

One patent  
for United  
Kingdom.

Steps in  
obtaining  
a patent.

First introduction of Provisional Specification.

The Filing of the Complete Specification. This option of filing a provisional description of the invention at the time of application, and following it up within six months afterwards with a Complete Specification, was a new element in patent procedure which has proved extremely satisfactory in practice.

Fees under Act of 1852.

Under the Act of 1852 the mere stamp duties payable on obtaining a patent amounted to £25, and the sums payable at the end of the third and seventh years respectively were £50 and £100, so that the total amount payable in stamps alone, on a patent obtained and kept in force for the full term of fourteen years, was £175.

Agitation for alteration in Patent Law.

During the operation of the Act of 1852 considerable agitation was carried on among Patent Law reformers, whose chief objects were the reduction of the fees and the introduction of some system of examination. The former result was to some extent obtained under the Act of 1883, but the Examination of Applications only dates from the 1st of January, 1905, and is the result of the coming into operation of The Patents Act of 1902.

Examination of Applications.

### THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1852 TO 1902.

Act of 1852 not an originating Act.

If the reader has followed the foregoing historical *résumé*, he will doubtless have noticed that the Act of 1852 made no real change in the principles of Patent Law. It was merely an amending Act by which the procedure was simplified, the cost decreased, the United Kingdom placed under the scope of one patent, the principle of the Provisional Specification adopted, and sundry regulations promulgated relating to the conduct of litigation.

No change was effected in fundamental principles, and no attempt made to define afresh the subject-matter of patents. For a definition of the expression "invention" the reader of the Act was referred to the old Statute of Monopolies.

Patents, Designs, and Trade Marks Act, 1883.

As in the case of The Patent Law Amendment Act of 1852, so it was with The Patents, Designs, and Trade Marks Act of 1883. By this Act the procedure was still further

simplified. The fees and stamps on the obtaining of a patent were reduced from £25 to £4 (under the Act of 1902 increased to £5), while the fees for maintaining the patent in force during the full term of fourteen years were reduced from £150 to £95. This sum, added to the £5 payable as fees on the obtaining of the patent, made exactly £100 as the cost in Government fees of obtaining and keeping in force a patent for fourteen years.

Procedure simplified and fees reduced.

The foregoing, and sundry additional provisions having reference to the regulation of legal proceedings, restriction to one invention only, the amendment of specifications, oppositions, &c., represented the bulk of the changes made by the Acts of 1883 to 1902.

One invention.

The Patents Act of 1901 (1 Edw. VII. c. 18), which came into operation on the 1st January, 1902, related solely to international arrangements. It constituted an amendment of Section 103 of the Act of 1883, and extended from seven months to *twelve months* the time within which persons who had applied for protection of an invention in a country other than the United Kingdom, and being subjects, citizens, or domiciled inhabitants of or in a State which had adhered to the International Convention or with which reciprocal arrangements had been made by the British Government, were entitled to apply for a similar privilege in the United Kingdom. Sub-section 2 of Section 1 provided that any such application, when made in this country, must be accompanied by a Complete Specification, with drawings (if any); and provided, further, that the said Complete Specification, "if it be not accepted within the period of twelve months," shall be open to public inspection at the expiration of that period.

Patents Act of 1901.

Extension of period of priority under Convention.

Convention application to be accompanied by Complete Specification.

The Patents Act of 1902 dealt with three important amendments, which were as follows:—

Patents Act, 1902.

(1) Applications were made subject to an examination as to novelty, the investigations dealing only with British Complete Specifications published and dated within fifty years prior to the date of the application.

Examination.

(2) When a patent had been granted under the Act of 1902: that is to say—on any application

Restriction on anticipation.



made after the 1st January, 1905—no British Specification older than fifty years back from the date of the patent, and no published Provisional Specification whatsoever, was to be deemed an anticipation of the patent so granted.

Compulsory  
Licences.

- (3) The hearing of Petitions for the Grant of Compulsory Licences, which had been formerly in the hands of the Board of Trade, was transferred to the Judicial Committee of the Privy Council.

Patents and  
Designs  
Act, 1907.

The whole of the foregoing Acts, extending from 1883 to 1902, were, with certain trifling exceptions, repealed by the new Patents and Designs Act, 1907. But these, though repealed, have not lost their significance, and in the consideration of questions raised under the new Act must frequently be referred to, were it only that the changes introduced by the new Act should be better understood and appreciated.

The next chapter will be devoted to a more detailed consideration of these new features of the present Statute, which have already been briefly indicated in the Introduction.

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## CHAPTER II.

## THE PATENTS AND DESIGNS ACT, 1907.

THE Patents and Designs Act of 1907 is practically an amending and consolidating Act by which the piecemeal legislation extending from 1883 up to 1907 has been gathered together, unified, and extended. Taken in conjunction with the Statute of Monopolies, the Rules framed by the Board of Trade and Order 53A of the Rules of the Supreme Court, together with the effective Clauses of the International Convention, we may be said to possess for the first time a Code of Patent Statute Law.

Effect of  
the Patents  
and Designs  
Act, 1907.

It must be remembered that the new Act is mainly a re-enactment of the provisions of the previous and now repealed Statutes. For that reason it is not proposed in the present chapter to do more than draw attention to the salient novel features, leaving to succeeding chapters a more complete consideration of the whole law and procedure.

The question as to who may be a patentee is left untouched, but the procedure in dealing with an application is slightly modified, and the powers of the Comptroller are considerably enlarged. In the first place the limits of the official search as to novelty are extended. Under the Act of 1902 the Examiner's researches were confined to specifications *published* before the date of the application, and deposited in pursuance of applications made within fifty years preceding. The new Act has the same provisions, but, in addition, the Examiner may now include in his search specifications published *after* the filing of the application, but of prior date thereto. If in the specifications published *before* the date of the application, it should be found that the applicant's invention has been already wholly and specifically claimed, then the Comptroller may absolutely refuse the grant of a patent (see Section 7). This is a new power given specifically to the Comptroller to refuse a grant on his own motion, and as the result of the official and statutory search.

Extension  
of official  
search.

Comp-  
troller's  
power to  
refuse.

Hitherto the Comptroller has had statutory power to refuse a grant only in cases of opposition, where he found that the subject-matter of the opposed application had already been patented in this country.

No power of refusal under Section 8.

Apparently, however, this right of refusal can only be exercised by the Comptroller under Section 7. Where an anticipation of the applicant's invention has been found in a specification of prior date which has been published *after* the date of application, the Comptroller's power is limited to requiring references in the applicant's specification. From the wording of Section 8 it would seem that these references can be required whether or not the applicant's specification has been accepted or a patent granted to him.

The difference in the consequences arising from the search under Sections 7 and 8 respectively is founded on the following considerations. A specification which has been published before the date of the application, and was at that date open to all the world, constitutes prior publication; whereas, if published only after the date of application, it would constitute, not prior publication, but prior grant, the effect of which might, in the eye of the Court, be materially different.

Chemical samples.

In chemical inventions, typical samples may be required by the Comptroller before acceptance of the Complete Specification (Section 2, Sub-section 5).

Supplementary applications.

A novel system of supplementary applications is inaugurated by the new Act (Section 16). An applicant who has lodged a Provisional Specification, and who during the six months of provisional protection devises additional improvements therein, as to which he may be doubtful whether they can be included in the Complete Specification, may file one or more additional provisionals containing these improvements. If, when the Complete Specification falls due, the Comptroller is of opinion that these supplementary improvements may properly be incorporated therewith, then, one Complete Specification will cover all, and the patent will date from the earliest of the several applications. Apparently the respective claims, when founded on the subject-matter of these supplementary applications, will bear dates to correspond (Section 16 and Sub-section 2), and these sub-dates will be taken into

Dated claims.

consideration apart from the main date of the patent, in ascertaining the novelty and validity of the respective claims.

It seems convenient at this point to draw attention to a further new feature in the Act, viz., the facility now given under Section 19 for obtaining Patents of Addition to an existing patent. These are only granted for improvements in or modifications of the original invention. Patents of Addition are free from the payment of annual taxes and expire with the mother patent.

Patents of  
Addition.

Another extension of the powers of the Comptroller is created by Section 26 of the Act. It is the power of revoking a patent at any time within two years from its date, on the application of any person who would have been entitled to oppose the grant, or is the successor in interest of a person so entitled. This application to revoke is in fact no more than a belated opposition, and the grounds urged to procure revocation must be identical with the grounds of opposition enumerated in Section 11. In lieu of revoking the patent, the Comptroller may make an order to amend the specification by disclaimer, correction, or explanation; or he may dismiss the application to revoke.

Comp-  
troller's  
power to  
revoke.

Section 27 contains the provision which has attracted the largest share of popular attention to the Act. This section provides that any person may at any time, not less than four years from the date of the patent, apply to the Comptroller for its revocation, upon the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. This section is aimed at all patentees alike, whether British or foreign, but in effect it is directed against the holding of restrictive monopolies in this country by foreigners who manufactured wholly abroad, and used their British patents merely as a means of stifling competition in this country, without themselves employing British labour or stimulating British industries. There is no doubt that such a practice had, in respect of certain foreign made goods, almost reached the proportions of a scandal. It was wholly adverse to the meaning and intention of the sixth Section of the Statute of Monopolies, which had for its object the establishing "of new manufactures within this realm." However, the abuse is gone.

Revocation  
for working  
mainly  
abroad.

Construction of Section 27.

At first the section was administered in a most drastic fashion by the Comptroller; but in the cases of *Hatschek's Patents*, (1909, 26 R. P. C. 228), and *Bremer's Patent*, (1909, 26 R. P. C. 449), which were appeals from the Comptroller's decisions to revoke the patents, Mr. Justice Parker outlined the methods which the Court intended to adopt in giving effect to the section. The terms of the learned Judge's decision will be more closely scanned in the chapter on Revocation. Briefly, he held that in considering Sub-section 1 of Section 27, the comparison instituted by the sub-section is not to be a bare comparison between what is done in this country and abroad respectively by the patentee, his licensees and agents, but the comparison is between the extent to which the subject-matter of the patent is manufactured or carried on in this country and the extent to which it is manufactured or carried on abroad, whether the articles so manufactured are or are not imported into this country. The learned Judge was further of opinion that the policy of Section 27 is directed to secure fair play between foreign industries and the industries of this country, and not to secure to home industries, during the period of the patent, a protection which they would not enjoy if no patent had been granted.

Policy of Section 27.

In other words, it is not the intention of the Act to substitute one abuse for another, or to cause forfeiture of a patent by insisting upon unreasonable conditions, or to penalise want of success where *bona fide* attempts have been made to establish the industry in this country.

New ground of opposition.

The grounds of opposition to the grant of a patent remain practically unchanged, but a fresh ground has been introduced, viz., that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the Complete Specification (Section 11).

Comptroller may award costs.

In all proceedings before the Comptroller, where an interested party appears in opposition to the grant or amendment of a patent, or as an applicant for revocation, the Comptroller has now discretion to award costs (Section 39), and in the case of an opponent domiciled outside of the jurisdiction, he may order the giving of security for costs.

Where an invention, not yet protected, has been made public without the knowledge and consent of the inventor, a patent afterwards obtained by the inventor will not be held invalid on that account, if he proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that, if he became aware of the publication before the date of his application for a patent, he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication (Section 41, Sub-section 2). In the absence of any decision upon this sub-section, it would be unsafe to generalise upon how far the inventor would be protected by its operation. An inventor has always been protected against the results of the use made of confidential disclosures, where advantage was taken of such disclosures directly by the confidential agent, but not where the information had been transmitted to third parties under no such confidential obligation. This latter hardship is cured by the sub-section. Whether it would hold good in the case of an inventor publishing abroad, for example, with the result that a description filters through to this country, may be doubted. Knowledge and consent might be implied where reasonable care was not taken by the inventor, or where publication would be the natural result of incautious disclosure.

Premature disclosure of invention.

Petitions for the extension of Letters Patent are now to be presented to the Court, instead of to the Judicial Committee of the Privy Council as formerly (Section 18). One result of this change of tribunal will probably be that petitions are less likely to be refused upon merely technical grounds, such as insufficiency of accounts and the like. The Judicial Committee were unable to cure defects of this sort, not having any machinery for referring accounts to enquiry. The High Court labours under no such disadvantage, and incomplete or mistakenly prepared accounts can easily be referred to Chambers for correction or amplification, without prejudice to the real merits of the Petition.

Petitions for extension.

A patent upon which the renewal fee has not been paid lapses. But by the new Act (as under the repealed Statute) if the fee is paid within three months after it fell due, together with a graduated fine, the Comptroller

Failure to pay renewal fee.

shall restore the patent, apparently without requiring any statement of the circumstances which brought about the omission to pay the fee when due (Section 17, Sub-section 1). This is a relaxation of the terms of the corresponding Section 17 of the repealed Act, which required that the Comptroller should be satisfied that the non-payment of the fee arose from accident, mistake, or inadvertence.

Revival of  
lapsed  
patent.

But the new Act goes further in the direction of saving lapsed patents, and provides in Section 20 that even where a patent has lapsed from non-payment of fees, and the three months' grace has expired, the patent may yet be revived on application being made to the Comptroller, with a full statement of the circumstances that led to the failure to pay the renewal fee. If it appears that the failure was unintentional, and that no undue delay has occurred in making the application, the patent may be replaced on the Register. The restoration is made subject to conditions for the protection of those persons who may have used the patent after it has been advertised in the *Patent Journal* as void.

Surrender  
of patent.

Another new provision is found in Section 26, Sub-section 3, by virtue of which a patentee may at any time surrender his patent by giving formal notice to the Comptroller to that effect. A patentee is thus enabled to rid himself of his patent in an inexpensive manner, should he be threatened with a petition for revocation to which he has no effective answer.

Counter-  
claim for  
revocation.

In an action for infringement, any defendant who is entitled to petition for the revocation of the plaintiff's patent, may now, under Section 32 of the new Act, apply for revocation by way of counterclaim in the action. Formerly this was not possible, and a separate petition for revocation had to be presented.

Defendant's  
ignorance  
of patent.

Under Section 33 a patentee suing for infringement of a patent granted after the commencement of the Act is not entitled to recover damages from a defendant who proves that, at the date of the infringement, he was not aware or had no reasonable means of making himself aware of the existence of the patent. Even if the articles made and sold under the patent are marked "patented" this shall not of itself be held to constitute notice of the

existence of the patent, unless the intimation is accompanied by the number and date of the patent. The section expressly leaves the defendant subject to an injunction. As "damages" alone are mentioned, some commentators on the new Act thought it possible that the section left the defendant liable to be called on for an account of profits, although it is obvious that this would only be damages under another name. But in the trade mark case of *Slazenger v. Spalding* (1909, 27 R. F. C. 20), Neville, J., held that where the Statute or practice barred "damages," there was only a right to an injunction and none to compensation (*Edelsten v. Edelsten*, 1 De G. J. & S. 185 followed).

The rights of co-patentees are dealt with in Section 37 of the new Act. Therein it is provided that where, after the commencement of the Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein, as joint tenants; but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent; and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

Rights of  
co-  
patentees.

The inclusion of Section 37 in the Act was probably prompted by a desire to mitigate the harsh effects of the known rule at law that, where there has been no severance of the joint interest, the share of a deceased joint owner passes to the survivor. The doubt that has hitherto existed, as to whether a co-patentee could grant a licence on his own responsibility, is now set at rest by the terms of the section. He cannot do so without the consent of his co-owners.

Right of co-  
patentee to  
grant  
licences.

Up till the coming into force of the present Act, a fruitful cause of disaster to a patentee who sought to assert his rights, lay in the danger of disconformity between the Provisional Specification and the Complete: that is to say, where the claims attached to the Complete endeavoured to secure something not indicated in the Provisional. This possible hardship has been remedied by Section 42 of the

Discon-  
formity.



new Act. The section provides that a patent shall not be held to be invalid on the ground that the Complete Specification claims a further or different invention to that contained in the Provisional, if the invention therein claimed, so far as it is not contained in the Provisional, was novel at the date when the Complete Specification was put in, and that the applicant was the true and first inventor thereof. Of course, if the disconforming matter claimed was old, or had been published at the date of the Complete, or had been protected in the interim by another inventor, the patent would still be bad. The section should be read in conjunction with Section 16, providing for supplementary applications during the period of provisional protection. One result of this section should be the exercise of caution in publishing, during the period of provisional protection, developments of the invention which the inventor might wrongly assume to be covered by his original application.

Unlawful  
conditions  
as to sale.

Section 38 is directed chiefly against a practice not unknown among the owners of patent rights—of imposing restrictive conditions upon their licensees and agents, as to the use and purchase, in conjunction with the patented article, of goods which are not patented. For example, compelling the licensees of a patented gas mantle to purchase or use therewith a burner which is not patented. The Act is retrospective in giving the power to cancel existing agreements of such a nature, on three months' notice, under certain conditions of compensation which, failing agreement between the parties, may be awarded by an arbitrator appointed by the Board of Trade.

The foregoing comprise the bulk of the more important new provisions in the Act. The digest is not exhaustive, but attention will be drawn to the less noteworthy new features, in the body of the work, where the sections are more fully discussed under the respective headings. The remainder of the Act is, generally speaking, merely a repetition of the repealed Statutes.

Having thus glanced broadly at the origin and development of patents for inventions, and traced the history of the successive Statutes up to the present day, the law as it now stands can be discussed with greater profit. For the purpose of preserving some order in the arrangement

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of the work, it is proposed to group the different phases of the subject under the following headings:—

Headings of contents.

1. Procedure in Obtaining Patents.
  2. Who may be a Patentee.
  3. Subject-matter of Patents.
  4. The Specifications.
  5. Opposition to Grant of Patent.
  6. Sealing of the Patent.
  7. Amendment of Specifications.
  8. Action for Infringement.
  9. Revocation of Letters Patent.
  10. Action to Restrain Threats.
  11. Extension of Patents.
  12. Assignments, Licences, &c.
  13. Register of Patents.
  14. Miscellaneous.
  15. Foreign and Colonial Patents, with a Reference to the International Convention.
-

## CHAPTER III.

## PROCEDURE IN OBTAINING PATENTS.

Application  
for patent.How to fill  
in forms.Communi-  
cation  
form.Convention  
form.Provisional  
protection.Certificate  
of filing  
Provisional.Advertise-  
ment and  
acceptance  
of applica-  
tion.

SO far as the merely formal steps are concerned, an application for a patent is a very simple matter. The respective forms and stamps are on sale at the Patent Office and at all postal money order offices in the United Kingdom, and when filled in can be delivered or posted direct to the Patent Office in London. The application papers consist of a declaration (Form 1) stamped with £1, in which the applicant must insert his full name, address, and occupation, and give the title of the invention. He must declare that he is the true and first inventor, and that the invention is not in use by any other person or persons to the best of his knowledge and belief, and he must sign his name at the foot of the form. Form 1a is to be used in the case of inventions communicated from abroad to an agent in this country; and Form 1b where application is made under International and Colonial arrangements; Form 1c is used for an application for a Patent of Addition; and Form 1d for the rare instance of an application for a Secret Patent.

If the applicant wishes to apply for provisional protection only, he will receive with the application form two unstamped copies of Form 2, upon which he should write and sign his Provisional Specification. The declaration, with the two copies, may then be posted to the Comptroller-General at the Patent Office, and the business is complete. By return of post the applicant will receive his certificate of filing, and in the next week's issue of the *Illustrated Official Journal (Patents)* the application is advertised. In about three weeks or a month afterwards (provided that his specification is sufficiently intelligible, and that his papers have been filled up according to the instructions given) he will receive the certificate of acceptance. The specification itself is kept secret during the term of provisional protection. No examination as to novelty takes place with regard to the Provisional Specification.

At any time within six months from the date of his application the applicant may file his Complete Specification. The form for this (Form 3) can also be purchased at the Patent Office or at a postal money order office. These forms are supplied in duplicate, and one copy bears a £3 stamp. The Complete Specification must be prepared in accordance with this form and upon the lines and limits laid down by the Provisional. It should conclude with a clear statement of what the inventor claims as new. It should be noted that Form 3 issued under the Patents Rules of 1908, has a footnote referring to Rule 14, and urging clearness, curtness, and simplicity of language in preparing the claim or claims. The Complete should, when necessary or desirable, be accompanied by line drawings executed in absolutely black ink, and without the use of colour or brush shading, so as to be suitable for reproduction by photo-lithography or zincography. Such drawings are to be made on pure white, hot-pressed paper of smooth surface and good quality, each sheet to be in duplicate, size 13 inches in length by 8 to 8 $\frac{1}{4}$  inches in width, or, if this is too small, 13 inches in length by 16 to 16 $\frac{1}{2}$  inches in width. On one of the copies of the drawing (marked "Original") the reference lettering should be in black ink; the other copy, which may be on tracing linen, should be marked "True copy," and the lettering should be in black-lead pencil. Both copies should be signed. The drawings must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases. In chemical inventions, the Comptroller may require typical samples and specimens to be furnished in duplicate before the acceptance of the Complete Specification. The filing of such samples is advertised in the *Journal* in connection with the advertisement of the acceptance of the Complete Specification.

Complete Specification.

Must agree with Provisional.

Claims.

Drawings.

Chemical samples.

When the Complete Specification has been dispatched to the Patent Office, a certificate of filing will in due course be received by the applicant.

Certificate of filing Complete.

The Complete Specification is now taken in hand by the Examiner in the Patent Office, who first of all compares it with the Provisional and satisfies himself that the documents are in order, that they describe the same invention, and are properly prepared in compliance with the Rules.

Comparison by Examiners of Provisional and Complete.

If the Complete does not sufficiently clearly ascertain and claim the invention, the Comptroller may, under Rule 28 of 1908, require amendment, and he may also, under the same Rule, alter the date of the application so as to give sufficient time for subsequent procedure. The examination is also directed towards ascertaining that one invention only is included in the specification, and if more than one invention is included, the applicant may be allowed to make a separate application for the surplus invention bearing the same date as the original application.

Comptroller may alter date.

One invention only.

Unpatentable inventions.

Apparently also the Examiner, in fulfilling these duties, if the subject-matter appears to him to be unpatentable—that is to say, something which is not an “invention” within the meaning of Section 93 of The Patents Act, 1907—may report to that effect to the Comptroller, who, after hearing the applicant, may refuse the patent outright (*Cooper's Application*, 1901, 19 R. P. C. 53; *Johnson's Application*, 1901, 19 R. P. C. 56).

Examination as to novelty.

Section 7.

These preliminary points disposed of, should they crop up, the Examiner then addresses himself to the further investigations prescribed by Section 7 of the Act of 1907, *i.e.*, to ascertain the novelty of the invention described and claimed. The field of examination is confined to all Complete British Specifications deposited and published in pursuance of any application for a patent made in the United Kingdom within fifty years next before the date of the application under consideration. By the further examination provided for in Section 8 of the Act the investigations are now extended to specifications published after the date of the application, but deposited in pursuance of prior applications.

Section 8.

Acceptance of specification.

If the Examiner can find nothing to affect the novelty of the invention, he reports this to the Comptroller, who, in the absence of any other lawful ground of objection, will accept the specification, and such acceptance is notified to the applicant and advertised in the *Official Journal*.

Examiner's report.

If, on the other hand, the Examiner reports that the invention has been wholly or in part claimed or described in any such prior specification, the Comptroller advises the applicant of the objection, and specifies a time (two months according to Rule 30 of 1908) within which the application must be amended and returned to the

Comptroller. If the amendment submitted is not to the satisfaction of the Comptroller, he may require further amendments or will appoint a hearing, giving ten days' notice, to allow the applicant or his agent or counsel to attend and urge orally the merits of his case; or the applicant might be asked to attend to make oral explanations; or he may be required to send an explanatory statement in writing.

Hearing the applicant.

Unless the amendments of the specification are such as to meet the objections of the Comptroller, he has power, after hearing the applicant, to decide what references to prior patents must be made in the specification by way of notice to the public (Section 7, Sub-section 4 of the Act of 1907).

Inserted reference to prior patents.

The exact wording of the inserted reference is given in Rule 32 of 1908. It runs thus: "Reference has been directed in pursuance of Section 7, Sub-section 4, of The Patents and Designs Act, 1907, to Specification No. of 19 . ." The reference is inserted after the claims. Where the reference is inserted as the result of a provisional report under Rule 29 a statement to that effect shall be added to the reference.

Terms of reference.

Reference under Rule 29.

But if the Comptroller is satisfied that the invention claimed has been already wholly and specifically claimed in any specification to which the investigation under Section 7 has extended, he may refuse to grant any patent on the application.

Refusal of patent.

But no such power of refusal attaches to the result of examination under Section 8. Here the Comptroller can only order a reference to the anticipating specification or specifications. The reason for the difference of treatment under the respective sections is that under Section 7 the Comptroller is dealing with prior publication, but under Section 8 with prior grant.

Difference of procedure under Sections 7 and 8.

The applicant may so amend his specification as not to require any references to prior patents; but if he declines to do so, and insists on retaining or objects to disclaiming portions which the Comptroller regards as lacking in novelty, then the Comptroller will require references lest the public should be misled or left in the dark as to what prior patentees have described or claimed. But so far as present practice is a guide, it

Avoidance of references.

is evident that references are not to be indiscriminately made. Thus the mere fact that a specification contains one or more elements already described in prior patents will not call for a reference to these patents, so long as it is made indisputably plain that the applicant does not claim these elements.

Appeal.

An appeal lies from the decision of the Comptroller to the Law Officer, who will appoint a hearing and either uphold, modify, or reverse the Comptroller's decision.

Comptroller's directions under the Act and Rules.

As a general guide to the administrative carrying out of the procedure under Section 7 of the Act and the Patents Rules 28 to 32, it may be of value to reproduce the latest official notice on the subject:—

- (1) Rule 30 must be complied with, but where good cause is shown time will be allowed—*e.g.*, when the applicant is abroad or the complexity of the case requires it.
- (2) The interviews and correspondence between Examiner and applicant will be restricted as far as possible to the absolute necessities of the case, and will aim at bringing to a clear issue at the *earliest possible date* the differences between the applicant and the Examiner. A time limit will be imposed wherever practicable in accordance with the circumstances and complexity of the case.
- (3) No hearing will be appointed unless there is a direct issue between the Examiner and the applicant, or unless the applicant fails to submit amendments or make a real endeavour to avoid the citations within the time limited. When the issues are defined or when agreement is clearly impossible, notice of a hearing for a future date will at once be given.
- (4) If the applicant desires any amendments to be considered at the hearing, other than those which he has submitted to the Examiner under Rule 30, such amendments should be submitted seven days at least before the date of the hearing.
- (5) At the hearing, whether attended or not by the applicant, the Comptroller may, as an

alternative to the insertion of references, prescribe amendments which will be to his satisfaction under Section 7, Sub-section (4), and in such case the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the prescribed amendments or to the insertion of a reference. If no communication is received within the time prescribed, the references will be inserted. In cases requiring special treatment, a limited time may be allowed for the precise form of amendment to be settled, and the hearing adjourned if necessary.

(6) As far as possible, all questions between Examiner and applicant will be decided at the hearing and, except as indicated herein, no further opportunity of amendment will be allowed to the applicant and the specification will only be accepted with the amendments or references prescribed in the Comptroller's decision.

(7) If, after the decision has been given or the applicant has made his election under Paragraph 5, the applicant desires to amend, he must make a special application for that purpose to the Comptroller, and for this purpose Form 17, having a 30s. stamp, may be used. If the amendments suggested are satisfactory to the Comptroller, a statutory reference may be removed.

On the acceptance of the Complete, such acceptance is notified to the applicant and is advertised in the *Official Journal*. About three weeks afterwards the Complete Specification, together with the Provisional, is printed and published. Within two months from the date of the *Journal* in which such advertisement appears, any person interested in so doing and being entitled to oppose, may give notice of opposition to the application; but if these two months should pass without opposition being offered, the applicant may then pay the sealing fee of £1, whereupon the patent is sealed and issued to the applicant.

Acceptance of Complete and publication.

Period for opposition.

Sealing patent.

The foregoing is an exact account of the procedure when a Provisional Specification only is filed with the application.



Provisional Specification may be dispensed with.

Advantages of Provisional with application.

Applicant may work invention during Provisional Protection.

Infringements after publication of Complete.

Renewal of abandoned application.

Filing Complete with application.

and is afterwards followed up within six months by a Complete Specification. But it should be said here that the applicant has the option of filing a Complete Specification in the first instance, instead of a provisional description. Each course has its advantages, and the simpler plan will be to lay these in order before the reader.

*First.*—If application is made for provisional protection only in the first instance, the advantages are that the preliminary cost is less—viz. £1 instead of £4—while the applicant has six months during which he may, without fear, test the value of his invention either publicly or privately, improve upon the details, make searches as to its novelty, sell or agree to sell his discovery or its products, and, in short, deal with his invention just as if he had a patent, except in this respect, that he has no right of action against infringers until he has obtained his patent, and then only in respect of infringements committed after publication of his Complete Specification (Patents Act, 1907, Section 13). To these should be added the consideration that, as the Provisional Specification may be a document less exact in its terms than a Complete Specification, an application for provisional protection may be filed at a stage in the conception of the invention when it might be impossible or injudicious to give full details. Lastly, if the invention should prove disappointing, the application may be abandoned without incurring further expense, and without rendering the invention public property, seeing that the specifications of all abandoned applications are never published, but remain secret. Therefore, if the applicant should afterwards be able to remedy the defects in his invention, there is nothing to prevent him from renewing and completing his application, provided that he has not in the meantime published his idea, or that some other inventor has not crept in after the date of his first, but before the date of his second, application. In practice the great majority of applications for patents are accompanied in the first instance by a Provisional Specification only.

*Secondly.*—If, on the contrary, application is made accompanied by a Complete Specification, the advantages which arise from such a course are less obvious. Where

an agent is employed there is no doubt some slight saving in agency fees. The total stamp amounts are the same in both cases: viz. £4. The acceptance and publication of the Complete Specification at once places the applicant in a position to deal with infringers as soon as he gets his patent into his hands. On the whole it may be said that a Complete Specification should only accompany the application in those cases in which the details of the invention are fully worked out, and where the applicant has no reasonable doubt of the novelty, utility, and assured practical success of his invention.

Only recom-  
mendable  
where  
invention  
is perfect.

The preceding remarks are intended chiefly for the guidance of British inventors and applicants. The conditions governing applications for patents by foreigners and others under the International Convention differ in some respects from home applications, and are governed by The Patents Act, 1907 (Section 91), and The Patents Rules (15 to 18), 1908. An application under the Convention must be made on Form 13, and, according to Rule 15 of The Patents Rules, 1908, the declaration must specify the Foreign States or British Possessions in which applications have already been made, setting out the official dates. The application must be made within twelve months of the first foreign application; must be accompanied by a Complete Specification and drawings (if any); must be in the English language, and must be signed by the foreign applicant. A copy of the specification and drawings of the first foreign application must accompany the papers, and these must be certified by the official head of the Foreign Patent Office. If in a foreign language, a translation of the documents, verified by statutory declaration, must accompany the application.

Applica-  
tions under  
the  
Convention.

Conditions  
to be  
observed  
by Appli-  
cants under  
Convention.

It must be remembered that an applicant under the Convention can include in his specification only what has been applied for abroad. In a decision on a Convention application reported in the *Patents Journal* of the 11th August, 1909, the Comptroller says:—"It appears to me to be clear from Section 91 that an applicant applying for a Convention patent in this country is only entitled to include in his specification what has substantially been protected abroad. The language of the claim or of the description may no doubt differ, but the specification ought

Limits of  
Convention  
application.

Comp-  
troller's  
directions  
re Con-  
vention  
applica-  
tions.

not in my view to claim protection for anything which is not protected in the foreign country. How then is this to be decided? I think *prima facie* the foreign specification should be considered and examined on precisely the same principles as that of an English patent, and that what is protected should be gathered from the claims as interpreted by the description and the drawings. Where different principles apply in foreign countries, to determine what is in fact protected under the terms of the patent, some *prima facie* evidence must be given by the applicant or agent to show the foreign practice. Strict proof will not be necessary upon this point, but a *prima facie* case must be made to secure a wider and more liberal interpretation of the foreign specification. The questions to be determined in each case are—“What has in fact been protected by the foreign patent, and does the English patent apply to that and nothing more?” Since the date of this decision the Comptroller has intimated that in using the phrase “protected by the foreign patent” he meant “claimed in the foreign application.”

If not accepted by the Comptroller within twelve months from the date of the first foreign application, the Complete Specification and drawings are thrown open to public inspection at the expiration of that time. Subject to these preliminary conditions, Convention applications are then dealt with exactly as in the case of British Complete Specifications, except that the date of the British Patent will be the same as that of the first foreign application.

Patent  
Rules.

Rules 7, 15, 16, 18, and 83 of The Patents Rules, 1908, govern these Convention applications, and these Rules are set out in full at the end of this division of the work. Readers are advised to supplement their perusal of this chapter by an examination of the Rules.

Some  
reasons  
for the  
employ-  
ment of  
Patent  
Agents.

In the foregoing description of the mode of procedure it has been assumed that the Provisional and Complete Specifications are prepared by the inventor himself. But if the writer may be allowed to express an opinion, grounded upon long experience, the preparation of the specification by the inventor himself is not a course to be recommended. No prudent man attempts to draw a conveyance, mortgage, will, or other legal instrument without the assistance of a properly qualified adviser, and such

care is no less essential in the case of Patent Specifications, especially in view of the increased difficulties and responsibilities thrown upon an applicant by the advent of the examination system. The fatal facility with which any person, fired by some crude idea, can enter a post-office, buy a form, scribble down his inspiration, and incontinently post the whole to the Comptroller, is by no means an unmixed benefit, and has its result in a flood of rubbish poured into the Patent Office every year. Probably a large proportion of the applications made every year by inventors themselves would never have been filed, if they had been submitted in the first instance to the calmer judgment of an experienced and properly trained Patent Agent or solicitor.

But, apart from this, should the invention really contain some valuable subject-matter, the assistance of a professional adviser would in many instances enable the inventor to reap results of which his own precipitancy and self-confidence deprive him. Undoubtedly there are many inventions so simple that a plain man using plain language can express the gist of his invention sufficiently well to satisfy requirements; but in all cases the burden is laid upon the applicant that the specification and claims shall be prepared with "reasonable skill and knowledge," and if these essentials are wanting nothing can save the patent from being upset should it come to be tested in a Court of Law.

Specifi-  
tion must  
be prepared  
with reason-  
able skill  
and  
knowledge.

It has been said that, where a Provisional Specification has been first filed, the Complete Specification should be lodged before the expiration of the succeeding six months. If from any cause this term should elapse without the Complete Specification being filed, it may be filed within one month after, on payment of a fine of £2. If it be not filed within the extreme time allotted—that is, within seven months from the date of application—the application is considered to be abandoned. Under Sub-section 5 of Section 6 of the Act, the Complete Specification must be accepted within twelve months from the date of the application, except when the delay arises from an appeal, but the time for acceptance may be extended from one to three months on payment of the fee, which amounts to £2 for one month's, £4 for two months', and £6 for three months' extension.

Extension  
of time to  
complete  
application.

Extension  
of time for  
acceptance  
of Com-  
plete.

Opposition.

Oppositions will be treated under the heading specially devoted to that subject (see Chapter XV.).

Date of patent.

If no opposition is entered, or if the opposition is unsuccessful, the applicant may give notice at any time on or before the last day on which the patent can lawfully be sealed, that he desires a patent to issue on his application. This notice is given on Form No. 10, bearing a stamp of £1, and on receipt of the notice, the patent is sealed and issued as of the date of the application.

Extension of time to pay sealing fee.

Where there has been neglect or failure to pay the sealing fee, the applicant may apply to the Comptroller on Form 11 for an extension of one month, or two months, or three months, at respective fees of £2, or £4, or £6, within which to pay the fee. The circumstances and causes of the failure to pay must be set out in detail in the form, and if the Comptroller is of opinion that there was reasonable excuse for the failure, he may seal the patent within the extended period.

Secret patents.

An application for a secret patent (Form 1d) is likely to be so rare an event that it is hardly worth discussing. The subject-matter must be some improvement in instruments or munitions of war. By Section 30 of the Act, the inventor must be a party to a contract of assignment to the Secretary of State for War or the Admiralty, who certifies that the Complete Specification and drawings are to be handed to the Comptroller in a sealed packet, instead of being left at the Patent Office in the ordinary manner. Section 30 gives full information as to the procedure.

Patents of Addition.

Applications for Patents of Addition are made on Form 1c, which varies from the ordinary form in describing the subject-matter as "an improvement in or modification of" the invention for which the mother patent was granted. No renewal taxes are payable on such Patents of Addition, and they expire with the mother patent.

Duration.

Patents are granted for fourteen years, and cover Great Britain and Ireland and the Isle of Man, but not the Channel Islands.

Patent Office hours.

The Patent Office hours are from 10 to 4. An application handed in after 4 is dated of the following day (*Matthew's Application*, 1910, 27 R. P. C. 228).

## CHAPTER IV.

## WHO MAY BE A PATENTEE.

ANY person, of either sex, whether a British subject or an alien, may be a patentee. Even those who are generally considered under legal disabilities, such as infants and lunatics, may become patentees, so long as the necessary documents are prepared in the prescribed manner. No inquiry is made by the Patent Office as to the age, sanity, or coverture of the applicant. Applicants must apply in their real names, and not under assumed or trade names. A corporate body is a "person" within the Statute, and may be a patentee. But a corporate body alone cannot make the necessary declaration, not having the mind to invent, but must be coupled with the true inventor. Foreign corporations owning patents abroad, and desirous of obtaining British patents, frequently communicate the invention to a representative or agent in this country, who thus becomes the grantee on behalf of his foreign correspondents. Under the Convention, where a foreign corporation has applied for a patent abroad—in one of those countries where a patent can be granted to a corporate body—the corporation may apply for and obtain a patent in this country in its corporate name alone (*Carez's Application*, 1889, 6 R. P. C. 552).

Persons entitled to become patentees.

Corporate bodies.

A firm as such cannot obtain a patent. The application should be made jointly by the individual members of the firm.

Firms.

It is submitted that the general rule—viz., that any person may be a patentee—is subject to exception in the case of the Sovereign, on the principle that the Crown cannot make a grant to itself. It follows from this that should the legal estate in a patent become vested in the Crown as *bona vacantia*, apparently as the Crown cannot be a patentee under its own grant, the patent ceases to exist by merger (*per* Buckley, J., in *Taylor's Trusts*,

Exceptions.

Crown.

1904, 21 R. P. C. 715). Further, although many such patents exist, some authorities have doubted whether a beneficed clergyman can legally become a patentee, in view of the prohibition from trading under 1 & 2 Vict. c. 106, Sections 28 to 30. The question whether an alien enemy is incapacitated as a patentee was raised, but not decided, in *Bloxam v. Elsee* (1825-7, 1 C. & P. 558; 1 Web. P. C. 132). The probability is that he would not be ousted on that account.

Two or more persons may make a joint application for a patent, and it is provided that a joint application may legally be made by the inventor or inventors in conjunction with another individual or with persons who are not joint inventors. Thus an invention may be patented in the joint names of the inventor and a capitalist with whom he has agreed to associate himself. The name or names of the actual inventor or inventors must, however, be specified in the declaration.

The "true and first inventor" is, in the eye of the law, the first legitimate applicant for a patent. If another person has previously discovered the invention, but has neither disclosed it in a manner sufficient to constitute publication nor applied for a patent, he cannot prevent a subsequent independent inventor from obtaining a valid patent. *A fortiori*, where two people simultaneously and independently evolve the same invention, the true and first inventor is the first applicant for a patent.

Neither is the term "inventor" under the Act confined to a person who evolves an invention from his own mind. The term is also used to designate one who first introduces or imports an invention from abroad. A patent granted to such an applicant would be perfectly valid if it could be shown to be unknown and unpublished in this country at the date of the application, and if no fraud within the jurisdiction and as against the true inventor has been practised. However, if the invention has been previously patented or protected abroad, the foreign or other inventor has the privilege, in those countries which have become parties to or share in the privileges of the International Convention, of making an application here within twelve months and obtaining the

Clergyman.

Joint patentees.

True and first inventor.

Independent inventors.

Importers.

Rights of foreign inventors under International Convention.

same date as that of the original patent abroad. Such foreign applications under the Convention must, when made in this country, be accompanied by a Complete Specification and if not accepted within twelve months from the date of the earliest foreign application, will be thrown open to public inspection.

A person who originates the fundamental idea of an invention, and then takes it to a skilled man and employs him to work out the details, is entitled to include the suggestions of his assistant in his specification, and the assistant has no right to patent in his own name the improvements he may have made (*re David & Woodley*, Griff. A. P. C. 26; *Smith's Patent*, 1904, 22 R. P. C. 57). A servant or paid assistant taking out patents in this improper manner at home and abroad may be declared trustee of the patents for the benefit of the rightful owner (*Richmond v. Wrightson*, 1904, 22 R. P. C. 25). But if an employer merely tells his servant to devise something to fulfil a specific function, without telling him how it is to be done, and pays him for doing so, the servant is the inventor, and he alone can properly patent it (*Marshall & Naylor's Patent*, 1900, 17 R. P. C. 553). On the other hand, the mere relationship of master and servant does not justify the master in patenting the servant's invention, even when made in the master's time and with the master's tools (*re Heald*, 1891, 8 R. P. C. 429). But when the relationship between employer and employed is of an intimate and confidential nature, and the servant has allowed his masters to use the patent in their business, the subsequent severance of their connection might not justify the ex-employé in holding and using the patent as against his former employers, much less prevent them from continuing the use of the invention in their business (*Worthington v. Moore*, 1902, 20 R. P. C. 41). But the actual circumstances of each case of this description must be carefully considered.

If an inventor should die before applying for a patent his legal representatives may make the application, and if his death should occur after the application, but before completing, his legal representatives may proceed and obtain the grant of the patent (Sections 43 and 93).

Position of persons assisting an inventor to perfect his idea.

Master and servant.

Rights of deceased inventor's representatives.



Communi-  
cated inven-  
tions.

A person resident in this country may patent in his own name an invention communicated to him by the actual inventor abroad. In such case it is usual, though not essential, to indicate the source from which the knowledge has been derived.

Revocation  
of fraudu-  
lently  
obtained  
patent.

Where a patent has been applied for and granted in fraud of the true and first inventor, the latter may apply to revoke the patent on that ground, and if successful he may apply to the Comptroller to issue to him a patent in lieu of and bearing the same date as the patent so revoked (Section 15, Sub-section 2).

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## CHAPTER V.

## SUBJECT-MATTER OF PATENTS.

IT has been said that in none of the repealed Patent Statutes has any attempt been made to define the meaning of the term "Invention." In all instances the reader was referred back to the ancient Statute of Monopolies. The new Act of 1907 preserves the same discretion (see Section 93). Turning, then, to Section 6 of the Statute of Monopolies, we find that Letters Patent and Grants of Privilege are limited in favour of "the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others, at the time of making such Letters Patent and Grant, 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."

Definition of "Invention."

Section 6 of Statute of Monopolies.

Therefore, the subject-matter of Letters Patent must be some "*manner of new manufactures*." It is very unlikely that the old draftsman, in setting down this definition of subject-matter, had any glimpse of the magnitude of the interests that would be created by this Section 6 of his Bill. The clause was the earliest effective legislative recognition of the public policy of allowing temporary privileges to the inventors of new manufactures. It is the basis of our present law and the cradle of the gigantic patent system in force across the Atlantic.

"Invention" means new manufacture.

The discussions that have taken place upon the true meaning of the "working or making of any manner of new manufactures" only prove how unintentionally well chosen and comprehensive the expression really is. "Manufacture" has been held to be synonymous with "invention," and to mean not only the process of making, but also the thing produced. For example, "manufacture" as applied to hatting might mean (a) the machinery by which the hat is made, or (b) the successive steps or processes to which the hat body is subject, or (c) the

"Manufacture" means both method of making and product.

But does  
not include  
bare  
principle.

hat itself. "It was admitted," says Chief Justice Eyre, in *Boulton v. Bull* (1795, 2 H. Bl. 463; 3 Ves. 140), "that 'manufacture' is applicable 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." Thus the term excludes a mere barren principle, no matter how great the discovery may be, so long as no immediate practical result useful to individuals or to trade is brought about. And apart from a principle the term also excludes any mere scientific discovery which does not result in the production of some useful tangible thing or process of manufacture. Said Lord Cranworth in *Ralston v. Smith* (1860, 11 H. L. Ca., at p. 250): "It is not every useful discovery that can be made the subject of a patent, but you must show that the discovery can be brought within a fair extension of the words 'a new manufacture'" (see also Lord Davey in *Chamberlain & Hookham v. Mayor of Bradford*, 1903, 20 R. P. C., at p. 687). In other words, the mere laying bare of a physical law or force which has been in existence since the world began, no matter how tremendously it may increase the scope of our knowledge and the sum of our wealth, cannot be patented. Thus, to instance extreme cases, Newton could not have patented his discovery of the laws of gravity; nor Harvey his of the circulation of the blood; nor Franklin his of electricity. But lesser minds coming after these great intellects may, by special devices, put these newly discovered forces into harness, so that they shall grind corn, pump water, or transmit messages, and for these devices patents will be granted.

Discovery  
not "inven-  
tion."

"Manufac-  
ture"  
includes  
"process."  
*Crane v.  
Price.*

At one time it was doubted whether the language of the Statute extended to processes; but by a long series of decisions, of which *Crane v. Price* (1842, 1 W. P. C. 393; 12 L. J. C. P. 81; 4 M. & G. 580) is one of the oldest, it has been placed beyond controversy that a process, whether it be chemical or mechanical, is good subject-matter for a patent.

To those having any knowledge of the varied stand-points from which patentable inventions can be surveyed, it need hardly be said that it is impossible to cut up and label the legitimate subject-matter of patents into a distinct and exhaustive number of areas. One portion

of any such arbitrary division is sure to be found overlapping or trenching upon the others. But for the sake of convenience it might be found profitable in a work of this nature to consider patentable inventions as being roughly divided into the following six classes: viz.—

1. New and useful machines for new or old purposes, and improvements in existing machinery.
2. New and useful combinations of mechanical parts and of materials.
3. Improvements in existing manufactures, processes, or parts of processes.
4. Novel and useful results and products of manufactures and processes.
5. New or improved processes for which special machinery may or may not be necessary.
6. New principles, and modes of carrying the same into practical effect.

Classes of subject-matter.

A short examination of each of these heads, with a few annexed practical examples, will assist the reader to understand them more fully.

#### 1. *New and Useful Machines for New or Old Purposes, and Improvements in Existing Machinery.*

A new machine or contrivance may be for an entirely new purpose, or it may be for use in connection with an old purpose. The first is an extremely rare class of invention. The second is most common. As an example of the first, take the subject of the transmission of speech over long distances by electricity. Here was a new purpose, and the telephone, with its vibrating plates, transmitter, and receiver, formed a new apparatus for this new purpose. Therefore the telephone was a patentable invention of the highest order—namely, a new apparatus for a new purpose. Wireless telegraphy, where the atmosphere is made to perform the duties of the usual connecting and conducting wires, might also be cited as an epoch-making advance

New and improved machinery.

Example of the highest type of invention.

upon the existing electric telegraph ; and the electric wave-collectors, with their later synchronising and syntonising developments, would all constitute new apparatus for this new purpose.

Example of  
a lower  
type.

As an example of the employment of machinery to effect for the first time by a mechanical operation what had hitherto been done by hand, the original sewing machine might be instanced. Sewing is among the oldest of arts. But the first sewing machine was an absolutely new contrivance for this old purpose : therefore it formed patentable subject-matter, though of a less high class than the telephone, seeing that the purpose to which it was applied was old.

Improvements in  
existing  
machinery.

Improvements in existing machinery may be said to form the bulk of patented inventions. For example, there are hundreds of patented improvements on the original sewing machine. Indeed, in all classes of machinery of which large quantities are used, an improvement which to an outsider may seem but a very slight advance is often the source of fortune to its inventor, and is patentable subject-matter.

Instances of  
apparently  
slight  
advance.

*Moser v.  
Marsden.*

In *Moser v. Marsden* (1893, 10 R. P. C. 350) Lopes, L. J., said that a new mode of using an old machine by altering it, involving the exercise of invention and ingenuity in its application, is good subject-matter for a patent. In the above case, in which the Court of Appeal and the House of Lords (1895, 13 R. P. C. 24 ; 73 L. T. N. S. 667) affirmed the validity of the patent for the well-known Moser "raising" machine, the evidence showed that the advance effected by the patentee upon prior inventions for the same object, although apparently slight, had *practically* been exceedingly successful, and this had great weight with the Court in supporting the patent.

Instances  
of very  
slight  
advance.

*Goddard v.  
Lyon.*

In *Goddard v. Lyon* (1894, 11 R. P. C. 354) the only essential difference between the plaintiff's disinfecting machine and similar disinfecting apparatus made before the date of the patent was, according to Lord Watson, that "in the plaintiff's, the purifying chamber is fitted with a door capable of resisting, and therefore enabling the process to be carried on with, high pressure steam. If the 'Aberdeen'" (*i.e.* the alleged anticipation) "had been made with a door to the inner chamber which would

have permitted the use of high pressure steam, the plaintiff's invention would, in my opinion, have been thereby anticipated." It may be said that, in spite of the apparent obviousness of the improvement, the patent was sustained.

To multiply examples of what have been held to be patentable improvements in existing machinery (no change being made in the purposes for which such machines are used) would be to cite more than half of all decided patent actions, and the two foregoing cases have been selected as examples of comparatively slight improvements in existing mechanism which have been upheld as patentable matter. Still, let it be noted that obvious alterations and additions, such as might occur to a man of average intelligence in constructing a machine, are not as a rule patentable. The advance must betray *invention* as well as involve *utility*. What these expressions have been held to mean will be discussed under their proper headings.

Obvious  
alteration  
not  
invention.

Additions to or improvements on existing patented machinery or things may also be made, and in their turn patented (see *For v. Dellestable*, 1866, 15 W. R. 194; *Lister v. Leather*, 1857-8, 8 E. & B. 1004; 27 L. J. Q. B. 295). If the improvement is separable from, and is no essential part of, the existing patented machine or thing, it may be made and sold separately. But if it forms an integral part of the machine or thing, and is useless apart from it, it would evidently be of little advantage to the inventor, as he could not make use of the original invention without the sanction of the original patentee. On the other hand, the original patentee could not make use of the improvement without the permission of the second patentee, and, as a consequence, the second patentee might find his reward in selling or licensing to the original patentee.

Improve-  
ments upon  
existing  
patents.

## 2. *New and Useful Combinations of Mechanical Parts and of Materials.*

Although patents are granted for combinations, it must be said at the outset that a combination to warrant a patent should show invention. Obvious combinations are not good subject-matter. Therefore, in every case it

Patents for  
combina-  
tions.

Mere  
judicious  
arrange-  
ment not  
patentable.

More  
putting  
together  
two known  
things not  
invention.

*Williams v.  
Nye.*

*Sarby v.  
Gloucester  
Waggon Co.*

But mere  
coupling  
together if  
invention is  
required is  
patentable.

is necessary to take the merits into consideration to decide whether or not the effecting of the combination shows the exercise of invention. All engineers have at their disposal a certain number of well-known parts and motions which are the *disjecta membra* of the mechanical arts. In building a machine for a certain purpose he may make use of these known parts and motions, and by combining them produce an apparatus fit to perform a certain function. So long as he merely exercises judicious selection, and puts the different parts to their obvious uses, he does not *primi facie* exercise invention, but only ordinary workman's skill, and in that case the machine, although perhaps the first of its kind, is not necessarily a patentable invention. Take as an example the simplest form of combination: viz., the mere coupling together of two well-known things which have heretofore acted separately, but which on being connected give a continuous operation. A good illustration of this is to be found in *Williams v. Nye* (1890, 7 R. P. C. 62). The plaintiff in this case had merely taken a well-known mincing machine and an equally well-known machine for filling skins and connected them together, so that the mincing and filling operations were continuous instead of being interrupted as before. The result was a sausage-making machine which was proved to be most useful, meritorious, and economical. Nevertheless, the Judges of the Court of Appeal expressed themselves as satisfied that there had been no such exercise of the *inventive* faculty as to make the plaintiff's machine subject-matter for a patent. Even where the combination was apparently not quite so easy to effect, the patent could not be upheld. In *Sarby v. Gloucester Waggon Co.* (1880-3, L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577) a decision adverse to the patent was grounded on the same objection. As was pointed out by Field, J., the evidence showed that any person conversant with the subject could, by placing the two known parts side by side, effect the patented combination without further experiment or information.

Still, even this simplest type of combination—viz., the connecting of two well-known machines—might be patentable if the method and means used to connect them required invention. For example, merely to place a folding machine in line with a printing machine, so as to print

and fold continuously, instead of separately as before, would not be an invention if nothing more were done.

Oddly enough, although this simple illustration of a non-patentable combination was given by the author in the Second Edition of this book in 1902, a case occurred in 1906 which was strangely similar (*Northern Press, &c. v. Hoe & Co.*, 1906, 23 R. P. C. 613). The alleged invention consisted in interposing a double folding machine between two printing machines arranged end to end. The results were undoubtedly advantageous, but the Court of Appeal scarcely condescended to consider the patent seriously. As Romer, L. J., remarked: "The two separate parts of the machine are really doing each their own work, and not the less because you put them into one machine."

*Northern  
Press v. Hoe.*

Nevertheless, if the continuous printing and folding had involved some necessary transmitting mechanism, requiring design and the exercise of invention, to pass each printed sheet separately to the folders, then the combination might well be patentable subject-matter.

It is impossible to patent the combination of a concrete thing with an abstract property or qualification. Chief Baron Pollock, in trying to express this, once said: "You cannot have a valid claim for the combination of 2½d. with a pound of butter." An example will help the point to be better understood. We will suppose that rollers covered with porcelain were well known as being the best rollers that could be used for crushing grain. Suppose it were afterwards discovered that to make one roller run a little faster than the other produced a grinding as well as a crushing effect, which vastly improved the result by separating the germ from the starch part of the grain. Here is a real invention. It cannot be said that the idea is unpatentable. But, at all events, the claim that was really made—viz., "The combination of porcelain rollers with *differential velocity*"—proved to be untenable. Neither is it possible to patent a combination of two things between which no functional combination exists. In criticising a faulty claim of this nature in *Osmond's Limited v. Balmoral Cycle Co.* (1898, 15 R. P. C. 505) Chitty, L. J., remarked that the patentee might as well have said: "I claim that gear with a hat on a man's head." Mere improved adjustment of the parts of a machine was held not to

Combina-  
tion of a  
concretion  
and  
abstraction  
not  
patentable.

Combina-  
tion of  
things  
having no  
functional  
coopera-  
tion.



be patentable in *Kay v. Marshall* (1836-41, 2 W. P. C. 39, 71, 79; 8 L. J. C. P. 261).

Combina-  
tions of  
known  
parts.

Almost the largest class of patented inventions is that of combinations of known mechanism. In *Spencer v. Jack* (1862-4, 3 D. J. & S. 346; 11 L. T. N. S. 242) Lord Westbury took occasion to say that "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 rightly denominated a *substantial improvement*, it is, I say, impossible to deny that that is the subject of a patent."

Again, in *Klüber's Patents* (1906, 23 R. P. C. 461) Lord Davey said: "A proper combination for a patent is the union of two or more integers, every one of which elements may be perfectly old, for the production of an object which is either new, or at any rate is for effecting an old object in a more convenient, cheaper or more useful way. But the point in a combination patent must always be that the elements of which the combination is composed are combined together so as to produce one result."

Patents for  
mere com-  
binations  
of known  
parts  
usually  
narrow.

Such combinations may consist of arrangements of known mechanical parts or groups of parts. The combination may consist of mere re-arrangement, addition, or subtraction. The known parts or groups must not be independent of each other, nor must the connection of the groups be known or obvious. The combination may consist entirely of old parts or groups, and in such a case the patentee is usually tied somewhat closely to the arrangement shown and described. Therefore, another inventor might, by changing the combination to a greater or less extent, place himself outside of the scope of the patentee's claims (see *Ashworth v. Roberts*, 1890, 7 R. P. C. 451; L. R. 45 Ch. D. 623; 60 L. J. Ch. 27; *Curtis v. Platt*, 1863-4, 35 L. J. Ch. 852; 11 L. T. N. S. 245; Good. P. C. 144; *Nettlefolds v. Reynolds*, 1892, 9 R. P. C. 270; *Lambert Co. v. International Record Co.*, 1904, 21 R. P. C. 247; *Morrison v. Asplen*, 1904, 21 R. P. C. 557). An interesting example of a non-infringing deviation from the plaintiff's claimed arrangement is also to be found in *Pilkington v. Massey* (1904, 21 R. P. C. 696).

*Curtis v.  
Platt.*

As examples of combinations of old parts too obvious to constitute subject-matter, reference might be had to *Longbottom v. Shaw* (1891, 8 R. P. C. 333; L. R. 43 Ch. D. 46), where hooks, formerly attached separately to a cloth-winding frame, were, according to the patent, attached first in rows to a carrying strip of metal, and this strip with its attached hooks then secured to the reel. This was held not patentable. In *Newsom v. Mann* (1890, 7 R. P. C. 307) a patent was held bad where the invention consisted of combining in one casting several parts of a frame which had hitherto been cast separately. In *Deeley's Patent* (1895, 12 R. P. C. 192) a combination of old parts in gun mechanism under the first claim was held to show no invention and no substantial advantage, and to be bad. In *Wood v. Raphael* (1897, 14 R. P. C. 496) the patent was upset on proof that the patentee had only combined in double eyeglasses certain features—viz. a rigid bridge, pivoted plaquets, and spring arms—which had before been separately used in double eyeglasses. The admitted advantages of the combination did not save it, no new function being performed.

Examples  
of obvious  
combina-  
tions.

*Wood v.  
Raphael.*

But, on the other hand, combinations of old parts for old purposes are generally sustained where, in addition to increased utility, it is obvious that ingenuity is present. In *Hayward v. Hamilton*, (1881, Griff. P. C. 115) the combination of the old prism with the old pavement light was upheld, the Court coming to the conclusion that ingenuity had been exercised in effecting the combination. In *Siddell v. Vickers* (1887-9, 5 R. P. C. 81, 416; 6 R. P. C. 464) the combination of an endless chain, chain-wheel, and ratchet arrangement for turning large forgings was upheld, notwithstanding that the endless chain and chain-wheel had been in common use for this very purpose, and the internal ratchet teeth and pawl constituted a mechanical appliance of the commonest knowledge, although not before used for this specific purpose. It must be said, however, that Lord Herschell, in his judgment, admitted that this case was near the border line, and that no great exercise of the inventive faculty had been required. A difference between this and the *pince-nez* case is, that in *Wood v. Raphael* (*supra*) all of the parts of the combination had before been used separately in a *pince-nez*, whereas in

Examples of  
combina-  
tions held  
not too  
obvious.

*Siddell v.  
Vickers.*

Combina-  
tions of  
known  
parts must  
show new  
functional  
advantages.

*Siddell v. Vickers*, one of the elements of the combination had not been used for such a purpose before, and in addition a new functional advantage was gained by the combination. It would be unsafe, however, to deduce any general rule that no combination, the parts of which had been separately used for the same purpose, could, as a combination, be patentable subject-matter.

Rigby, L. J.,  
on inven-  
tion in com-  
binations.

Rigby, L. J., in discussing the essentials of a combination of old parts, said, in *The Lancashire Explosives Co. v. The Roburite Co.* (1895, 12 R. P. C. 482): "Invention consists in many cases in putting together items of common knowledge which no one else has ever thought of combining." Abbott, C. J., also, in *Brunton v. Hawkes* (1820-21, 4 B. & Ald. 541; Good. P. C. 97) said that "a patent for a machine, each part of which was in use before, but in which the combination of the different parts is new and a new result produced, is good, because there is a novelty in the combination."

Commercial  
success.

It should be said at this point, that the tendency of the Court under recent practice is rather in favour of sustaining combination patents without enquiring too narrowly into the *quantum* of invention, if it is clear that a public want has been met and a considerable commercial success obtained.

*Taylor &  
Scott v.  
Amand.*

Thus, in *Taylor & Scott v. Amand et al.* (1900, 18 R. P. C. 53), the plaintiffs' patent was for apparatus to print late racing and other news in successive editions of a newspaper. Previously, the ordinary method in use was to cut out a portion of the stereo. plate, or to leave a gap in the plate, which was filled in when required by a small fudge-box, containing the late news set up in type. The objections to these methods were the time consumed and the difficulty of securing the type in the small box. The plaintiffs' appliance consisted of an auxiliary short baby-roller carried on an eccentrically mounted shaft, and moveable to any position along the shaft. The short baby-roller carried the late news type, and could be shifted on the shaft so as to bring the type opposite to the blank left in the earlier edition to receive this late news. Evidence showed that auxiliary rollers for printing matter, other than or additional to the matter on the main cylinder, had been previously used in printing machines, but those

rollers had been of equal length with the main printing cylinder. A baby-roller, or short drum adjustable on a shaft, was *per se* of common knowledge for other purposes, and shafts carried in eccentric bearings are quite usual in other machinery; for instance, in throwing toothed wheels in and out of gear. In short, as far as the immediate claim of the plaintiffs against the defendants was concerned, there was no single item of the arrangement which was not old in machinery generally, and certainly invention was not strikingly evident. The Court of First Instance felt this so much that the patent was declared bad, *inter alia*, for want of subject-matter. But this judgment was reversed and the patent sustained by the Court of Appeal and House of Lords. Lord Halsbury, L. C., in his judgment, admitted that "there is nothing more difficult, when one is dealing with a mechanical combination, than to keep one's mind free from the impression created by the fact that all the elements or most of the elements are old," and further quoted with approval the dictum of Lord Herschell in *Vickers v. Siddell* (1890, 7 R. P. C. 304) on the difficulty of applying the law relating to combination patents to particular cases. The deft manner in which the apparently simple and obvious appliance of the plaintiffs coped with the particular requirements of adding late news in a hurry to successive editions of a paper, and the fact that many newspapers had taken licences, were pointed to, as indicating utility, novelty, and commercial success. "And," said the learned Lord Chancellor in concluding, "to say that it is so obvious that it requires no invention seems to me to be absolutely contrary to the reasonable inference to be drawn from the condition of facts to which I have referred."

Halsbury,  
L. C., on  
combina-  
tions.

Instances of very slight advances in combination patents are to be found in *Fawcett v. Homan* (1896, 13 R. P. C. 398), which related to concrete flooring; *Goddard v. Lyon* (1894, 11 R. P. C. 354), where the invention, broadly speaking, consisted in strengthening a steam door in an otherwise old disinfecting machine; and *Birch v. Harrop* (1896, 13 R. P. C. 615), where the plaintiff, although unsuccessful in proving infringement, nevertheless successfully upheld the validity of his patent for a combination in which the only new feature appears to have been a not very striking variation

Examples of  
slight com-  
bination  
patents.

in the mode of moving the feed ring of a piece-goods sewing machine. Although the defendant used an apparently obvious mechanical equivalent, the Court of Appeal said the patent was too narrow to allow them to go into the question of mechanical equivalents.

Narrow nature of mere combination patents.

The often quoted cases of *Curtis v. Platt*, *Nettlefolds v. Reynolds*, *Birch v. Harrop*, and others, are, therefore, instances of the narrower type of combination patent in which the patentee is practically tied down to what he has shown and described, and a patent of this limited range is always liable to be defeated, if the alleged infringer has changed or modified the details sufficiently to place himself outside of the scope of the claim.

Combination containing a new feature.

But this evasion is not so easy when a combination, otherwise old, includes an essentially new element, although this may not have been separately claimed and may depend for its utility entirely upon its connection with the combination. Here the patentee is in a better position, and although an infringer may vary the arrangement and details of the combination, so long as he uses the novel element, or a colourable imitation of it, he will be held liable if on a fair construction of the plaintiff's specification it appears that he had it in his mind to claim it. In *Lister v. Leather* (1857-8, 8 E. & B. 1004; 27 L. J. Q. B. 295) Lord Campbell said: "A valid patent for an entire combination for a new process gives protection to each part thereof *that is new and material for that process.*" But this dictum can no longer be accepted in its entirety since the judgment of Lord Cairns in *Clark v. Adie* (1875, L. R. 2 App. Cas. 315), the effect of which was discussed by Moulton, L. J., in *British United Shoe Machine Co. v. Fussell & Sons* (1908, 25 R. P. C. 631). James, V.-C., in *Parke v. Stevens* (1869, L. R. 8 Eq. 358; 38 L. J. Ch. 627), also says: "The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for the process, which is nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part, of a man's invention; and the question in every case is a question of fact—Is it really and substantially a part of the invention?" But to this dictum also must now be attached the further condition—Has the patentee

*Lister v. Leather.*

*Parke v. Stevens.*

made its importance plain, and has he either inferentially or in terms claimed the new and material part?

It is instructive at this point to refer to the case of *Proctor v. Bennis* (1887, 4 R. P. C. 333; L. R. 36 Ch. D. 740; 57 L. J. Ch. 11), where the plaintiff had patented a combination forming an improved mechanical stoker. Every part of the combination was old for the purpose except a pivoted flap or shutter, which threw the coal with a circular sweep into the furnace. This swinging flap replaced the old horizontally moving pusher or ram. The evidence showed that the circular sweep of the flap had many advantages over the old fuel pusher in more evenly distributing the coal on the grate and reducing the shocks and strains on the tappets and springs. The swinging flap was not specifically pointed out as the novel part, and the claim was simply for the combination of the tappets, the shafts, the springs, and flaps as described and shown.

Relying upon the opinion of Lord Westbury in *Forwell v. Bostock* (1863-64, 4 De G. J. & S. 77, 298; 9 L. T. N. S. 362, 528; 10 L. T. N. S. 144), that where there is a patent for a combination, the specification must point out wherein the novelty and merit of the invention lies, the defendant, who used the flaps with a different combination of springs and tappets, took the objection that the combination only was claimed, and that the plaintiff could not pick out the flaps as if these had been separately claimed or discriminated. But Cotton, L. J., corrected the reading of Lord Westbury's dictum, by the ruling of Lord Cairns, in *Harrison v. The Anderston Foundry Co.* (1876, L. R. 1 App. Cas. 574), wherein it was laid down that where the claim is for a combination, the combination is *ex necessitate* the invention, and no discrimination between old and new is required, a rule which holds good whether or not the combination includes new integers. The decision of the Court of Appeal in *Proctor v. Bennis* was not founded on the fact that the defendant in using the swinging flaps, had taken the "pith and marrow" of the plaintiff's combination, but that the combination of the defendant included the substance of the invention and was *substantially the combination of the plaintiff*. The fact is that each case of the kind will be

*Proctor v.  
Bennis.*

Novel  
element in  
combina-  
tion.

*Harrison v.  
Anderston  
Foundry Co.*

considered on its own merits, and where a combination includes an important element, novel and material for the purpose, but not specifically claimed, the Court will not be astute to relieve a defendant, if by any means it can be held that his combination is substantially the plaintiff's combination, especially where the new element is of great importance and value, a fact which should be established by evidence, as was done in *Proctor v. Bennis*.

While on the subject of distinguishing new from old in a combination, the reader may be helped by what fell from L.L. J. Vaughan Williams and Moulton in *British United Shoe Co. v. Fussell* (1908, 25 R. P. C. 631). *Per* Vaughan Williams, L. J.: "*Forwell v. Bostock* is not overruled, and it is doubtful whether it is true to say that in a combination, the whole of which is claimed as new, there is no obligation to distinguish old from new." *Per* Moulton, L. J.: "It is not a good objection to a claim for a combination that the patentee has not distinguished old from new. *Forwell v. Bostock*, so far as it laid down any duty in a patentee to distinguish what is new in a combination, is not in accordance with and must be taken to be overruled by *Harrison v. Anderston Foundry Co.* The dictum of Lord Campbell in *Lister v. Leather*, that a patent for a combination gives protection to each part thereof that is new and material, is erroneous and is now overruled."

If essential of combination is taken the patent is infringed.

Of course if the new element is specifically claimed, all of these difficulties of construction are got rid of. Thus in *Wenham v. May* (1887, 4 R. P. C. 303), the patentee had invented a gas lamp in which wire gauze screens were used in certain specified positions, the said gauze screens being claimed "as described and shown." The defendants also used gauze screens, but not in the same positions as in the plaintiff's lamp, their defence being, practically, that they had not infringed the specific combination claimed. It was held that, both upon the evidence and the specification, the object of the plaintiff's invention was to equalise and regulate the regenerative air-currents by means of wire gauze screens, irrespective of the specific arrangement, and that the defendants by adopting such gauze screens had infringed the essence of the plaintiff's patent. A lesson on the essentials of an apparatus or combination may also be had from

a consideration of *The Automatic Weighing Machine Co. v. National Exhibitions Association, Limited* (1891, 9 R. P. C. 41).

In *Combination Hubs v. Seabrook* (1906, 23 R. P. C. 209), where the essence of the invention was a longitudinally sliding clutch, positively actuated through a screw from the pedals so as to drive, free-wheel, or brake, the Court held that, although adopting a materially different combination from that of the plaintiffs, the defendants had in fact taken and adopted the substance of the plaintiffs' combination, *i.e.* the longitudinally slidable part.

But, on the other hand, if someone makes use of the combination, omitting an element which the patentee has described and claimed as an essential part of the combination, there is no infringement, though the evidence of the plaintiff may bring into prominence the utility and importance of the parts actually taken by the alleged infringer (*Bunge v. Higginbottom*, 1902, 19 R. P. C. 187; *Stone v. Broadfoot*, 1909, 26 R. P. C. 361).

But no infringement if part described as essential, but not really so, is not taken.

In passing from mechanical combinations to those of materials we enter another field. A number of possible examples could be easily suggested. Thus, different materials may be mechanically mixed so as to produce new and useful results, such as linoleum floorecloth for example. New compositions of colours, varnishes, and cements might be so produced. In the same manner the combination of two materials, *viz.* caoutchouc with a woven fabric, results in a new product: *i.e.* a waterproof cloth; or the combination of two or more metals results in a new alloy. All of these are patentable.

New compositions of materials.

### 3. *Improvements in Existing Manufactures, Processes, or Parts of Processes.*

In order to differentiate the selected heads that have been set down as representing the main divisions of subject-matter, and so to avoid repetition, it will be necessary to consider the word "manufacture," not always in the broad and general terms extracted from the Statute of Monopolies, but sometimes in its narrower and more generally understood sense.



Restricted  
meaning of  
"Manufac-  
ture."

"Manufacture," under the present heading, must therefore be taken to represent the "making of anything by hand or by art," such, for instance, as the weaving of cut pile fabrics, the making of lead piping, or the production of gas.

Examples.

For example, in the manufacture of pile fabrics, instead of the usual plan of weaving the pile in loops and cutting these loops by an after operation, an inventor might produce a new method of weaving pile fabrics face to face in a double web, and cut the pile by the after operation of separating one fabric from the other, thus saving time both in the weaving and in the pile-cutting. Another inventor might propose to cut the pile in the very act of weaving, each pick as it is beaten up being severed by a series of knives worked from the healds. Both of these inventions would be patentable improvements in that special manufacture.

Again, take the production of lead piping. For many purposes, although it makes so convenient and cheap a tubing, lead is unsuitable. Metals of a higher cost have therefore to be used. But suppose a cheap and easy method were invented of thinly lining the interior of the lead pipe in the course of manufacture with this superior metal, so that all the advantages of the more expensive metal were obtained, at the cost of only a slight increase in the price of the lead tubing. Here would be a patentable improvement in the manufacture of such tubing, based both upon the mechanism, if new mechanism had been devised, and also in respect of the new product—viz., the lined lead tubing.

Then to glance at a suppositious improvement in the manufacture of gas. The improvement might relate to the retorts, or to the purifiers, or to the materials distilled in the retorts; or the inventor might make an entire change in the process, and, as has been lately done, manufacture gas from a mixture of decomposed steam or water gas and vaporised oil.

Just as an inventor may effect a radical change in the whole of a mechanical or chemical manufacture or process, so the invention may relate to a part only of the process.

With this general introduction a few of the decided cases bearing on the present division of subject-matter may now be considered.

In *Lister v. Norton* (1886, 3 R. P. C. 199) the plaintiff had patented an improvement in the manufacture of imitation seal skins, which consisted in blending silk with the mohair fibre before spinning. The silk gave smoothness and brilliancy, and the mohair elasticity. Before the date of the patent, imitation seal skins were well known, and silk and mohair, blended before spinning, had been used in the production of dress goods. Nevertheless, as an improvement in that particular manufacture (*i.e.* imitation seal skins) the patent was upheld.

Example of improvement in existing manufacture.

But the mere substitution of one known material for another in the production of a known article—as, for instance, the substitution of steel for whalebone and cane in crinolines—was, in *Thompson v. James* (1863, 32 Beav. 570), held not to be subject-matter. But where the substitution of one material for another requires adaptation, and shows some ingenuity, the patent may be upheld. Thus, in *American Braided Wire Co. v. Thomson* (1889, 6 R. P. C. 518; L. R. 44 Ch. D. 274), woven wire was for the first time used to make ladies' bustles, which had formerly been made of cushions and of elastic pads of horsehair and whalebone. The House of Lords upheld the patent, not with any great enthusiasm, but because they believed some thought and ingenuity had been expended on it. Great commercial success attended the patent, and this, no doubt, had its effect on the decision.

Substitution of one known material for another analogous purpose.

If invention required, such substitution is patentable.

*American Braided Wire Co. v. Thomson.*

The application of a known article or apparatus to a purpose analogous to that to which it has been already applied is seldom subject-matter, and is never so held if the extension to this analogous purpose appears obvious. Thus an old form of locking apparatus, formerly used in cycles when in motion, was held, in *Singer v. Rudge* (1894, 11 R. P. C. 463), not to be subject-matter when applied to lock the head of a bicycle at rest. In *Rose's Patents Co. v. E. Braby & Co.* (1894, 11 R. P. C. 198) the use of steam pressure, in a manner analogous to the well-known oil vapour pressure in lighting apparatus of the "Wells" type, was held not patentable. So the use of a common mode of joining the abutting ends of wires by a split tube and solder, for the specific purpose of connecting the joined ends of the inextensible wire

Obvious analogous user not patentable.

Examples of obvious analogous user.

rings of tyre covers, was held in *Shaw v. Barton* (1895, 12 R. P. C. 282) to be bad subject-matter. In *Dredge v. Parnell* (1899, 16 R. P. C. 625) an apparatus for cutting necktie linings by clamping several layers of material between templates and cutting through the mass with a hand-knife, the knife being guided by the conformation of the templates, was held bad. The evidence showed that cutting piles of cloth with a hand-knife was old, and also the use of guiding templates for the same purpose. There certainly were difficulties to be overcome in dealing with such soft and fluffy material, but the House of Lords, sustaining the Courts below, held that the alleged invention was merely a more skilled application of well-known tools and processes. The Judges were not unanimous either in the Court of Appeal or in the House of Lords.

*Harwood v. Great Northern Railway Co.*  
The Fish-plate Case.

An old and frequently quoted case on the point of analogous use, is *Harwood v. Great Northern Railway Co.* (1860-5, 2 B. & S. 194, 222; 11 H. L. Cas. 654; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27), where the plaintiff had patented a channelled fish-plate for securing together the abutting ends of rails. The patent was upset, on proof that plates having the same characteristics had been used to fish together the ends of wooden beams. Another case bearing on the same point is that of *Morgan v. Windover* (1890, 7 R. P. C. 131), where a "cee" spring, long in use at the rear of a carriage, was claimed when applied to the front. The plaintiff failed on the ground that it was a mere analogous user, and that no sufficient invention was apparent. In *Acetylene Co., Limited v. United Alkali Co., Limited* (1904, 22 R. P. C. 152), Lord Halsbury, referring to these two cases, said: "Whether you look at the cases of the fish-plates or the 'cee' springs, the principle has been established beyond all doubt that, under such circumstances, finding out that a thing which is known and practically used can be applied to another purpose, is not the subject-matter for a patent."

*Morgan v. Windover.*  
The "Cee" Spring Case.

Example by Blackburn, J., of patentable analogous user.

Sometimes, however, when the user is apparently analogous, invention may be so apparent as to support the patent. Blackburn, J., in considering the case of *Bamlett v. Picksley* (1875, Griff. P. C. 40), gave an example of

what he considered could be a patentable analogous user, by supposing the apparatus commonly in use for the making of macaroni piping of paste, adapted so as to be used for the manufacture of metal tubing; just as in *Ehrlich v. Ihlee* (1888, 5 R. P. 437) the Jacquard principle was used for the production of musical sounds and harmonies, instead of for weaving patterns in a loom. But instances of much closer analogous user have been sustained as patentable. Thus in *Pirrie v. York Street Flax Spinning Co.* (1894, 11 R. P. C. 429), although the use of thin paper cop-tubes in the dry spinning of cotton was of ordinary common knowledge, the plaintiff, who claimed the employment of similar thin paper tubes in the spinning of wet wax fibre, had his patent sustained. The facilities in removing the tubes with the wound-on flax from the wooden bobbins after the drying process, and the better preservation of the form of the wound-on flax by reason of the presence of this thin paper core, were points in the evidence which induced the Court to find increased utility and invention. In *Gadd v. Mayor of Manchester* (1892, 9 R. P. C. 516) the plaintiff's mode of supporting gasometers had been previously used in connection with docks and pontoons, but in spite of this alleged analogous prior user the patent was sustained. The old case of *Penn v. Bibby* (1866, L. R. 1 Eq. 548; L. R. 3 Eq. 308; L. R. 2 Ch. 127; 36 L. J. Ch. 455), sometimes quoted as a case of analogous user, was only so to a small degree. The plaintiff's wooden bearings for propeller shafts, with the spaces for the free circulation of water, had little in common with the rough wooden chocks used to support the bearings of grindstones and the like, which were advanced as anticipations. The Court sustained the patent.

Examples of users held not to be analogous.

*Penn v. Bibby.*

In chemical inventions the rule of law against mere analogous user is not so strong. As was said by Lord Herschell, in *Badische Anilin Fabrik v. Lerenstein* (1887, 4 R. P. C. 449), "analogy does not go a long way in chemistry."

The rule against analogous user not so strong in chemical inventions.

A just consideration of the cases only shows how dangerous it would be to attempt to lay down any general rule. Each case must be decided on its own merits, and evidence alone can decide whether or not in the application

No general rule applicable.

of old things to analogous or apparently analogous uses, such invention and experiment have been required, and such increased utility proved, as will entitle the patentee to have his patent upheld.

4. *Novel and Useful Results and Products of Manufactures and Processes.*

The Courts seem to be still in doubt as to whether a new product *per se*, and apart from the process or means used to produce it, is good subject-matter for a patent. The most reliable writers on Patent Law lean rather against the proposition. The point has never been directly and in terms decided. On the other hand some strong expressions of opinion from the highest authorities might be quoted in favour of the suggestion that a product *per se* may be validly patented. Of course it is not, and never has been, disputed that when claimed as the result of a particular process or mode of manufacture, itself new, the product so produced is protected. In *Vorwerk v. Kraus* (1890, 7 R. P. C. 265) the patentees had invented a new mode of weaving ladies' waistbands to the required curved shape, each waistband being woven, lined, and turned out by the loom as a finished article. Before the date of the patent, such waistbands had been cut from woven material to the required curve and then lined and finished, the whole process entailing considerable waste of material and expenditure of time. The new apparatus comprised a specially designed loom with the warp in separate sections and conical warp drawing rollers. The waistband produced was something perfectly new in construction, and in addition to the claim for the apparatus, a specific claim for the product—*i.e.* the curved woven waistband—was made. The defendants attacked this claim, saying that a mere product was not patentable. But Cotton, L. J., although not feeling called upon to adjudicate on the claim as for a mere product apart from the method of production, intimated that in his opinion, even considered as a claim for the product *per se*, it might be sustained. The learned Lord Justice referred to the case of *American Braided Wire Co. v. Thomson* (1889, 6 R. P. C. 518), where the patented product was a lady's bustle, and said: "If

Products  
as  
subject-  
matter for  
patents.

there is a new thing produced, and that is useful and complies with other requirements, then in my opinion there could be a thoroughly good patent taken out for that."

In *Rickmann v. Thierry* (1896, 15 R. P. C. 105) Lord Chancellor Halsbury said: "The learned counsel, when asked what the invention was, stated that it was the product itself, and there can be no doubt that the product itself may be good subject-matter of a patent." So also Lord Davey in *Acetylene Co., Limited v. United Alkali Co., Limited* (1904, 22 R. P. C. 145), plainly stated that if an inventor discovers a new material having valuable commercial qualities, the material *per se* is good subject-matter; and that although the patentee is bound to describe some process by which the material can be produced, the process would matter nothing: "because the merit and novelty of the invention would consist *in the substance produced itself*."

Halsbury,  
L. C., in  
*Rickmann v.*  
*Thierry.*

Lord Davey  
in *Acetylene*  
*Co. v.*  
*Alkali Co.*

One would suppose that in view of these expressions of opinion, it might reasonably be contended that when a product is new and useful and complies with other requirements it can be claimed by itself and apart from any process or mode of manufacture. But apparently considerable hesitation still exists in the minds of able Judges: whose doubts cannot be ignored. For example, in *Kopp v. Rosenwald* (1902, 19 R. P. C., at p. 211) Mr. Justice Buckley says: "I doubt myself whether in the strict sense of the word an article can ever be treated as being *in itself* the subject of a patent."

Judicial  
doubt as to  
patent-  
ability of  
products.

But, with the greatest deference to this *obiter dictum*, surely there are cases where a new product, apart from the particular mode of manufacture, would be the subject of a patent? What, for example, of a new metal alloy where the mere selection of the ingredients was the invention, not the melting and casting? Or a new artificial stone or floorcloth, depending purely for its novelty upon the selection of the components?

There is no authority for saying that one may patent the mere production by machinery of something which has heretofore been produced only by hand. Nor is it possible to patent as a new product something which, although old as produced by hand, has for the first time been put upon the market as made by machinery. A man could not patent,

No patent  
for produc-  
ing by  
machinery  
a formerly  
hand-made  
article.

as a new product and by itself, a machine-made cigarette as against the old hand-made cigarette.

New compositions of materials.

In examples of mechanical admixtures of materials, resulting, for instance, in a new artificial stone or a new cement, where there is no invention in the process of mixing or making, but only in the selection of the materials, clearly the materials separately and apart from each other cannot be claimed as destined for that purpose. It is only when amalgamated and formed into the new and useful thing, whether artificial stone or cement, that they become appreciable subject-matter. Therefore the proper object to which to direct the claim is the product. In the same manner the novel result of a chemical process, such as new dye, is a product capable of being patented. But the results of mere changes or variations in operations capable of indefinite change are doubtful subject-matter, even when the product is something appreciably different from what has been produced before. For example, although a number of patents are taken out for so-called new cloths, produced merely by a re-arrangement of the ordinary operations of a weaver's loom, it is more than doubtful whether any such patent could be sustained, unless the result exhibited an advance of such importance as to justify the maintaining of the patent.

##### 5. *New or Improved Processes with or without Special Machinery.*

Process patents.

Old cases on process patents.

If the result or product of a process is good subject-matter for a patent, it is clear that a new or improved process itself, whether applied to the making of a new product or to the manufacture of an old product, is equally good subject-matter. Lord Eldon, L. C., in *Hill v. Thompson* (1817, Good. P. C. 214; 8 Taunt. 375), where the process related to the manufacture of iron, said that a new combination of old materials is patentable; and in *Gibson v. Brand* (1841-2, Good. P. C. 211; 11 L. J. C. P. 177), where the patent related to a new process in the manufacture of silk, Coltman, J., said that a process is good subject-matter. James, V.-C., in *Elmslie v. Boursier* (1869, L. R. 9 Eq. 217; 39 L. J. Ch. 328), said that one of the most useful of inventions is that of a process by which

*Elmslie v. Boursier.*

a common article may be made more economically than it was before. The old authority usually cited in maintaining that a process is good subject-matter, is the case of *Crane v. Price* (1842, Good. P. C. 131; 4 M. & G. 580). But at the present time, when process patents are sustained every year, it would be thrashing a dead horse to cite the modern cases where process patents have been upheld.

*Crane v. Price.*

A patentable invention may of course be constituted by an *addition* to an existing process. As was said by Stirling, L. J., in *Ashworth v. English Card Co.* (1902, 19 R. P. C. 470), "A new additional step in an old process, by which a better article is produced may, we think, be the subject-matter of a patent." It has also been held, as in *Russell v. Cowley* (1835, Good. P. C. 407; 1 C. M. & R. 864) and *Wallington v. Dale* (1851, Good. P. C. 487; 23 L. J. Ex. 49), that the *omission* of one or more steps from an existing process is patentable subject-matter. Where both process and product are new, both may be claimed; where the product is old and the process new, the process can be claimed. Thus in *Sterens v. Keating* (1847, 2 Web. P. C., p. 182), Pollock, C. B., said: "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 produced by a different process."

An addition to or subtraction from a process is patentable.

A new process producing an old thing is patentable.

In the case of *Badische Anilin Fabrik v. Levenstein* (1887, 4 R. P. C. 449) it was held that the prior use of an analogous chemical invention will not go far as an anticipation of an after-invention. The cause of this is, probably, that analogy and deduction in chemistry are not so obvious as in mechanical operations. The same rule holds good in cases of alleged infringement. Thus, in *Nobel's Explosives Co. v. Anderson* (1895, 12 R. P. C. 164), the plaintiffs, who had claimed the use of a *soluble* nitro-cellulose in the manufacture of a certain explosive, were unable to succeed against the defendant, who used *insoluble* nitro-cellulose.

Cases illustrating the dictum that analogy does not go far in chemistry.

A process may be new and the product may be new, yet the process may be worked by apparatus which has been in common use before, and cannot be claimed merely because of its application to a new purpose. But in some

Patent might be for process, product, and apparatus.



cases, the apparatus for carrying out the process may require to be specially devised, and then it may constitute a separate invention.

Thus there might be an invention in which apparatus, process, and product may all be new, and in such a case each may constitute subject-matter for a separate claim or separate patent.

### 6. *New Principles and Modes of Carrying the Same into Practical Effect.*

A bare principle not patentable.

It has again and again been laid down by the highest authorities that a principle *per se* cannot be patented. Thus Lord Chancellor Halsbury, in *Pneumatic Tyre Co. v. Tubeless Tyre Co.* (1898, 16 R. P. C. 77), said: "You cannot appropriate to yourself a mere principle; you can only appropriate the application of the principle." In practice one of the difficulties attending the general application of the rule is, whether the particular invention under consideration is or is not within the vague lines which define a principle.

"Discovery" not invention.

It is undoubtedly true that the discovery of an abstract and fundamental law of nature or of a natural or scientific truth—such, for example, as the law of gravity, the circulation of the blood, the principles of electricity—cannot be validly patented. For, although our knowledge of these things is the result of logical reasoning, thoughtful observation, and well-weighed deduction, nevertheless they are in no sense inventions. Columbus, although he discovered America, did not invent it. "An invention is not the same thing as a discovery. When Volta discovered the effect of an electric current from the battery on a frog's leg, he made a great discovery, but no patentable invention" (*per* Lindley, L. J., in *Lane-Poe v. Kensington Lighting Co.*, 1892, 9 R. P. C. 416).

Principles and their practical application.

But, passing from these landmarks in human progress to the consideration of smaller issues, it is questionable whether it is not too much the custom to seek to narrow down the field of invention, by describing as principles, and therefore as unpatentable, matters which are really improvements legitimately due to invention, and relating rather to practice than to principle. Take, for example, the

well-known "Hot-blast" Case of *Neilson v. Harford* (1841, 1 Web. P. C. 295; 8 M. & W. 806; 11 L. J. Ex. 20), which is quoted so often as a test case on this very matter of principle. The action was tried in 1841, at a time when patent actions were remarkably rare, and when Judges had but little opportunity of making acquaintance with technical matters. The invention was simple. Prior to the date of Neilson's patent, iron smelters had used a blast of cold air to blow up the smelting furnaces. Neilson's improvement was that he heated the blast. The advantages which have been derived by the iron industry of this country from this simple advance have been held to be incalculable. Fortunately for the patentee, the Court held that his claim was not for the principle of using a hot blast *per se*, but for the hot blast in conjunction with the means by which the blast was heated. Otherwise it is perfectly plain, from the observations of the Judges, that had it been construed that Neilson claimed "heating the air-blast of smelting furnaces" irrespective of any air-heating means, his patent would have been considered bad, as laying claim to a principle.

*Neilson v.  
Harford.*

It was not and cannot be pretended that the air-heating means involved any invention at all. Neilson briefly alluded to a heating box as a suitable means. But the invention lay altogether in the use of a hot blast. The least intelligent of ironmasters, when once told in three words what the object of the invention was—viz., to "heat the blast"—would have had no difficulty in constructing at once, a more or less efficient heating means, such as a heating box, or a cylinder, or a heating coil, or a jacketed flue. He would have been astounded if he had been told that the patentable part of the invention lay, not in the grand secret of heating the air-blast, but in the self-evident heating means at his feet, although this had scarcely given him any trouble to devise, and had called for the exercise of no invention at all. During the hearing of the above case of *Neilson v. Harford*, Alderson, B., said: "I take it that the difference between a patent for a principle and a patent that can be supported is, that you must have an embodiment of the principle, in some practical mode described in the specification, of carrying the invention into practical effect, and then you take out your patent not for the principle, but for the mode in carrying the

principle into effect." It is useless to speculate whether the Court, constituted as it is to-day, might not, in the case of *Neilson v. Harford*, have given a different ruling upon the question as to whether the mere heating of the blast fell within the domain of principle. The precedent has been established, and all that can be said is, that wherever it is a question of claiming anything which seems to be of the nature of a principle, the rule is to claim it in conjunction with and as effected by, the means for carrying the principle into effect, however simple and self-evident such means may be.

*Boulton  
& Watt v.  
Bull.*

Practically the same conclusions were arrived at in the case of *Boulton & Watt v. Bull* (1795, 2 H. Bl. 463; 3 Ves. 140; Good P. C. 70), the plaintiffs being the patentees of the separate condenser in steam engines. This difference, however, might be noted, that the means for carrying into effect the principle or plan of separate condensation were not self-evident, like the air-heater, but might have called for the exercise of the inventive faculties. Still more so was this the case in *Otto v. Linford* (1881, 46 L. T. N. S. 35). One of the chief features of this invention was what Jessel, M. R., called the "idea," or principle, of putting a cushion of air between the explosive mixture and the piston of a gas engine so as to regulate or make gradual what would otherwise be a sudden shock. "Of course," said his Lordship, "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 there is the idea which he wishes to carry out; but he also describes other kinds of machines which will carry it out, and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent." It will, however, be evident to the reader, that the mere "idea" of interposing this elastic fluid cushion in the cylinder, would be but a half-told tale, if the ingenious mechanism for carrying it into effect were not also described and shown.

*Otto v.  
Linford.*

*Hickton v.  
Patents Co.*

A reiteration of the accepted views of the patentability of a new "idea," coupled with some means for giving it practical shape, took place in the recent case of *Hickton's Patent Syndicate v. Patents and Machinery Improvements Company* (1909, 26 R. P. C. 313). The idea embodied in the patent was the "shogging" of the comb bars in a "levers and

go-through" lace machine for the purpose of equalising the thread drawn from each bobbin. Such "shogging" was old in other types of lace machines, but had never been used for this specific purpose. It was admitted that there was no invention in the means shown to produce the "shogging." The Court of First Instance held that for this reason there was no subject-matter, although the idea was meritorious. The learned Judge, in the course of his judgment, said: "An idea may be new and original and very meritorious, but unless there is some invention necessary for putting the idea into practice it is not patentable."

The Court of Appeal had no difficulty in disposing of this heresy, and incidentally expressed opinions that may in the future bear fruit. Cozens-Hardy, M. R., said: "When once the idea of applying some well-known thing for a special and new purpose is stated, it may be very obvious how to give effect to that idea, and yet none the less is that a good subject-matter for a patent."

As for the judgment of Fletcher-Moulton, L. J., it is so instructive that it is worth reproduction. Said the learned Lord Justice: "After the judgment of the Master of the Rolls I do not intend to enter into the facts of the case, but I do wish to deal with the dictum of the learned Judge in the Court below, which really gives the ground for his decision. The defendants contend that although the idea of traversing by 'shogging' in order to equalise is new, yet it is not proper subject-matter for a patent, as no invention whatever was necessary to carry it out. The learned Judge says: 'An idea may be new and original and very meritorious, but unless there is some invention necessary for putting the idea into practice it is not patentable.' With the greatest respect for the learned Judge, that, in my opinion, is quite contrary to the principles of Patent Law, and would deprive of their reward a very large number of meritorious inventions that have been made. I may say that this dictum is to the best of my knowledge supported by no case, and no case has been quoted to us which would justify it. But let me give an example. Probably the most celebrated patent in the history of our law is that of *Boulton & Watt*, which had the unique distinction of being renewed for

A new idea carried out by obvious means is patentable.

Moulton, L.J., on principle patents.

the whole fourteen years. The particular invention there was the condensation of the steam, not in the cylinder itself, but in a separate vessel. That conception occurred to Watt, and it was for that that his patent was granted, and out of that grew the steam engine. Now can it be suggested that it required any invention whatever to carry out that idea when once you had got it? It could be done in a thousand ways and by any competent engineer, but the invention was in the idea, and when he had once got that idea the carrying out of it was perfectly easy. To say that the conception may be meritorious and may involve invention and may be new and original, and simply because when you have once got the idea it is easy to carry it out, that that deprives it of the title of being a new invention according to our patent law, is, I think, an extremely dangerous principle and justified neither by reason nor authority. I have taken the case of *Boulton & Watt* with the condenser, but I can give another. Take the case of the safety valve for boilers. The man who first discovered the idea of a properly weighted valve in the boiler solely for the purpose of relief, if the pressure rose too high, would have been making a most valuable and meritorious invention. So soon as he conceived that idea of guarding against the danger of explosion the carrying out of the idea required no invention at all. In my opinion, invention may lie in the idea, and it may lie in the way in which it is carried out, and it may lie in the combination of the two; but if there is invention in the idea plus the way of carrying it out, then it is good subject-matter for Letters Patent. As a matter of fact in the present case I have not the slightest doubt that there is good subject-matter."

Obvious  
means of  
carrying  
out  
principle.

Apparently, in this case, the patent would have been sustained even had the inventor simply formulated his "idea" and contented himself with saying "the 'shogging' of the comb-bars may be effected in any suitable or known manner," or even if he had left this direction out. If the idea is new, and the means for carrying it out are obvious, surely it is mere pedantry to insist upon these obvious means being described and claimed as part of the consideration for the grant.

In *Booth v. Kennard* (1856-7, Good. P. C. 68; 26 L. J. Ex. 23, 305) a general claim for making oil gas direct from seeds, without reference to apparatus, was held to be in effect a claim for a principle, and the patent was declared invalid.

Example of principle claimed without apparatus.

Alderson, B., whose remarks in *Neilson v. Harford* have already been quoted, said in the later case of *Jupe v. Pratt* (1837, 1 Web. P. C. 145), "You cannot take out a patent for a principle. You may take out a patent for a principle coupled with a mode of carrying the principle into effect. . . . If you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention." This dictum of the learned Baron was quoted with approval by Lord Davey in the comparatively recent case of *Chamberlain & Hookham v. Mayor of Bradford* (1903, 20 R. P. C. 684). On the other hand, to claim all possible ways of carrying a principle into effect would be bad and equivalent to claiming the principle *per se*.

Alderson, B., in *Jupe v. Pratt*.

A distinction should be drawn between inventions entitled to the broad term "principle" and those which are rather of the nature of a quasi-principle or idea. In *Automatic Weighing Machine Co. v. Knight* (1889, 6 R. P. C. 297) the quasi-principle disclosed was the existence of a "break" between the weighing and the indicating apparatus, which break was keyed together or bridged over so as to make the machine operative when a coin was inserted. The defendant submitted that a claim for this would be a claim for a principle, but the Court of Appeal held it to be merely a patentable peculiarity in the arrangement of mechanism, rendering *all* arrangements of mechanism with this peculiarity an infringement. Later actions by the same plaintiffs against *The National Exhibitions Association* (1891, 9 R. P. C. 41) and against *Fearby* (1893, 10 R. P. C. 442) were successful upon this reading of the claim.

"Principle" as compared with "essence" of invention.

*Automatic Machine Co. v. Knight*.

The vibrating flap, in *Proctor v. Bennis*, is another instance of essence or quasi-principle, or pith and marrow in an invention, constituting the patent a master or pioneer patent in respect of this essence.

Master patents.

Distinction  
between  
"principle"  
and  
"essence."

The indicated distinction between the broad term "principle" and its narrower subdivision of "essence" or "quasi-principle" was briefly referred to by the writer in former Editions of this book. That it has forced itself upon the notice of other authorities is evident from the remarks on the subject which are to be found in the scholarly brochure by Dr. W. Martin, of His Majesty's Patent Office, on *The Construction or Interpretation of Specifications of Letters Patent*, published in 1900. The learned Author says, on page 19 of his work: "That there is a principle in every invention would seem to be somewhat contradicted by the popular statement—an echo of the Courts—that 'you cannot patent a principle.' The seeming contradiction simply arises from the ambiguity in the word 'principle.' That a mere philosophical abstraction or elementary maxim or truth cannot be the subject of a valid grant admits of no doubt; for such an abstraction is not a manner of manufacture within the meaning of the Statute of Monopolies. That the protection merely issues for the manner, as some would contend, in which the principle is to be carried into effect, is contradicted by facts; for, when after the enunciation of a new principle, the subject of an invention, the method of its performance is clear to the juridical expert, it is highly probable that no such method need of necessity appear in the specification (*Boulton v. Bull*, 1795, Dav. Pat. Cas. 162, at p. 214). If a method does appear, its presence in these circumstances is simply a guarantee that the essence of the invention is not a mere philosophical abstraction, but is indeed a workable manufacture." Dr. Martin's views which went rather beyond the canons accepted in 1900 have been amply justified by the dicta of the Court of Appeal in *Hickon's Patent Syndicate v. Patents and Machinery Improvements Company* (*supra*).

If quasi-principle exists it should be claimed.

If there is an essence or quasi-principle disclosed in the specification, which the patentee desires to claim, apart from the actual operating means shown, the claim should make such intention reasonably clear (*per Cozens-Hardy, L. J.*, in *Ackroyd v. Thomas*, 1904, 21 R. P. C. 750), and the addition of a limiting phrase such as "substantially as set forth" to the claim might defeat so wide an interpretation.

### 7. Unpatentable Subject-Matter.

A valid patent cannot be obtained for the external design or form of an element of mechanism, apart from the use to which it is applied (*Preston Davies v. Black*, 1894, 11 R. P. C. 80). But a patent may be obtained for an article the *shape* of which enables it to fulfil a useful purpose (*Werner v. Gamage*, 1904, 21 R. P. C. 621).

No patent for mere external design.

A mere scheme or system is not good subject-matter for a patent, however new or useful it might be. It is within the province of the Comptroller to refuse a patent for such a thing, and was so even under the late Statutes. Thus in *Johnson's Application* (1901, 19 R. P. C. 56) a system of business correspondence or, as the Law Officer called it, "a plan for the conduct of business in a particular way," was held not to be fit subject-matter within Section 46 of The Patents Act, 1883, although the claim sought to disguise the real invention as a printed envelope constituting a new article of manufacture.

Mere schemes and systems not patentable.

Inventions having illegal or immoral objects are unpatentable.

No patent for illegal or immoral objects.



## CHAPTER VI.

## ESSENTIALS IN SUBJECT-MATTER.

## INVENTION.

**T**HE remaining essentials in patentable subject-matter are Invention, Novelty, and Utility.

First, as to Invention. This has been to some extent treated under the foregoing chapter on subject-matter: but something still remains to be said. According to Section 93 of The Patent Act, 1907, "Invention" means any manner of new manufacture the subject of Letters Patent and Grant of Privilege within Section 6 of the Statute of Monopolies. This dry husk of information teaches us but little, and therefore to acquire a just conception of this most elusive quality in subject-matter, it will be necessary to devote some consideration to the question of what constitutes "invention" in accordance with the authorities.

Broadly speaking, invention in Patent Law means the using of a man's intelligence, reason, and brains in such a manner as to evolve, or recognise, or find, or make known a something out of the beaten track, and not noticeable or known to the ordinary mind. "Something," as Willes, J., said in *Tatham v. Dania* (1869, Griff. P. C. 213), "which requires some exertion of mind that would properly be called 'invention.'" Or, as Lindley, L. J., said in *Lane-Fox v. Kensington Co.* (1892, 9 R. P. C. 413): "A patentee must so use his knowledge and ingenuity as to produce a new result." *Per* Buckley, J., in *Reynolds v. Herbert Smith* (1902, 20 R. P. C., at p. 126), "Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product or a new result, or a new process, or a new combination for producing an old product or an old result." Unfortunately, there is no recognised and constant mete or measure we can apply to discover whether a man's device contains a sufficiency of the quality of invention. As Bowen, L. J., said in *Lyon v. Goddard* (1893, 10 R. P. C. 334): "The question whether there is any ingenuity in the subject-matter of a patent is a question of fact, which depends on a true view of all the circumstances."

Definition of "Invention" in Statute of Monopolies.

Attempts to define invention by the Bench.

Thus, the argument that the improvement was obvious and the advance slight may be successfully met, or at least combated, by showing that rival manufacturers had never thought of the so-called obvious modifications in an article of which very large quantities were made every year, and especially if substantial advantages in utility and convenience have been obtained under the invention.

The alleged obvious nature of an invention may be rebutted by evidence.

It does not follow that because a thing has never been done before, the element of invention is necessarily present. Said Cotton, L. J., in *Blakey v. Latham* (1889, 6 R. P. C. 184): "A thing is not to be called new simply because it has never been done before; there must also be invention." The same learned Lord Justice also expressed a similar opinion in *Britain v. Hirsch* (1888, 5 R. P. C. 226). In *Riekmann v. Thierry* (1896, 14 R. P. C. 105) Lord Halsbury said: "A thing may be new, but unless it has some invention it is not patentable."

Mere novelty does not imply invention.

In *Nicoll v. Swears* (1893, 10 R. P. C. 240) Wright, J., decided that the mere prolongation of a burstable seam in a lady's habit for the whole length instead of for a portion of the length only as before, was not a patentable invention. Mere adaptive skill and judgment in modifying an existing thing so as to make it more useful is not invention (*Beavis v. Rylands*, 1900, 17 R. P. C. 704).

Mere adaptive modification is not invention.

An invention might be accidentally made, as is said to have been the case with watered silks or "tabbies." But even then, a man's observation and thought must be exercised to recognise and utilise the idea he has accidentally hit upon.

An invention might be accidental.

As to the *quantum* of invention, where a device is new and useful very little invention will suffice to support the patent. As Lord Halsbury said in *Riekmann v. Thierry* (*supra*): "No smallness or simplicity will prevent a patent from being valid"; and *per* Lord Davey in *Patent Exploitation, Limited v. Siemens & Co.* (1904, 21 R. P. C. 549): "It may be that the invention is a small one, but slight differences in these cases sometimes produce large results." For similar expressions of opinion on simplicity in inventions the reader is referred to the dicta of Tindal, C. J., in *Crane v. Price* (1842, 1 Web. P. C. 393); Jessel, M. R., in *Otto v. Linford*

Amount of invention not material where novelty and utility are apparent.

(1881, 46 L. T. N. S. 35); and Bramwell, L. J., in *Hayward v. Hamilton* (1881, Griff. P. C. 115), where a combination of pavement light and prism, differing very little from what had been used before but giving materially increased useful results, was upheld as involving invention. "It is an invention," said the learned Lord Justice, "and not the less an invention because it requires small inventive powers to enable the patentee to do it."

Moulton,  
L. J., on  
apparent  
triviality of  
inventions.

"I remember," said Moulton, L. J., in *British United Co. v. Fussell* (1908, 25 R. P. C., p. 646), "a machine for printing newspapers and turning them out in a folded form, in which the whole difference between hopeless failure and most valuable commercial success depended on a trivial change in the arrangement between the nose of the plough over which the sheet was bent and certain rollers which actually folded the paper after it had been thus bent, a matter which, when you read it on paper, seemed to be perfectly trivial, but which . . . actually turned failure into success."

In the same case the learned Lord Justice dwelt on the importance of considering the conditions under which a machine was worked, such as high speed and the like, when determining whether or not a change apparently trivial was not in fact important.

Analogous  
application  
not  
invention.

Examples  
of patents  
held bad  
as mere  
analogous  
users.

As has already been pointed out in the preceding chapter, mere analogous application is not invention. A wheel well known before the introduction of railways cannot be patented for specific use on a railway (*Losh v. Hague*, 1837-9, 1 Web. P. C. 200; 8 L. J. Ex. 251). A fish-plate, used before the date of railways to connect wooden beams, cannot be patented for connecting iron rails on a railway (*Harwood v. Great Northern Railway Co.*, 1860-65, 11 H. L. Cas. 654; Good. P. C. 224). There is no invention in applying an ordinary water tap to a beer bottle (*Hazellhurst v. Rylands*, 1891, 9 R. P. C. 1); nor in using a spring in front of a carriage which has been long used at the rear (*Morgan v. Windover*, 1890, 7 R. P. C. 131). Driving the screen of a stone breaker from the top was held not to constitute a patentable alternative to the old bottom driving (*Baxter v. Marsden*, 1904, 22 R. P. C. 18). A method of fixing posts in concrete, old as used in structures on land, cannot be considered new

as applied to the construction of groynes on the seashore (*Case v. Oressy*, 1901, 18 R. P. C. 419). But the application of trunnions to a cylinder used in the production of photo-prints so as to secure rotation on its transverse axis was held good subject-matter, although the combination of trunnions and cylinders for other purposes was well known (*Halden v. Hall*, 1904, 21 R. P. C. 609).

Example of patentable analogous user.

The principle enunciated in *Morgan v. Windover* and other cases, that if a known article is applied to an analogous purpose, the application is not patentable simply because it produces advantages not produced before, received a new illustration in the well-known "Puttee Gaiter" case (*Stohwasser v. Humphreys*, 1900, 18 R. P. C. 116). Here the spirally wound strap or puttee, combined with the gaiter for protecting the leg (both having been previously used separately for an analogous purpose) was held not to show invention. The patent was therefore declared invalid, although enormous commercial success was shown and the advantages of the combination were beyond question.

The "Puttee Gaiter" case. *Stohwasser v. Humphreys*.

Commercial success does not prove invention.

On the other hand, many instances of apparently analogous user have been supported, as, for example, in the cases already referred to of *Pirrie v. York Street Flax Spinning Co.* (1894, 11 R. P. C. 429); *Gudd v. Mayor of Manchester* (1892, 9 R. P. C. 516); and *American Braided Wire Co. v. Thomson* (1889, 6 R. P. C. 518).

Examples of apparently analogous user sustained.

Mere evidence of commercial success, and even of increased utility, will not excuse the absence of invention (see *Stohwasser v. Humphreys*, *supra*). Thus in the "Boot Protector" Case of *Blakey v. Latham* (1889, 6 R. P. C. 184) both of these adjuncts were overwhelmingly proved, but the patent was upset for want of subject-matter. In *Hudson, Scott v. Barringer* (1906, 23 R. P. C. 502), the plaintiffs claimed the manufacture of embossed or ornamented articles from tinplate having a grained surface obtained by omitting the cold rolling process. Such tinplate *per se* was admitted to be old. Very great commercial success was proved, but the Court held that there was no invention in taking a well-known article and applying to it ordinary processes, although the result was something commercially new. The patent was held bad. In *Williams v. Nye* (1890, 7 R. P. C. 62) the same

Examples of patents not saved by commercial success.

fate befel the patent for a combined mincing and filling sausage machine, although great utility and commercial success was shown. In *Riekmann v. Thierry* (1896, 14 R. P. C. 105), celluloid eyelets; *Wood v. Raphael* (1897, 14 R. P. C. 496), pince-nez; *Slazenger v. Feltham* (1888, 6 R. P. C. 130), tennis racquets; *Cooper v. Bædeker* (1899, 16 R. P. C. 363), felt bicycle handle covers; *Haskell v. Hutchison* (1907, 25 R. P. C. 194) golf balls, in which a wound elastic core which was old in other types of balls, was covered by a relatively harder shell of gutta-purca, also old. In all of these cases the patentees were unsuccessful through (*inter alia*) lack of invention, although utility and, in some of them, enormous commercial success was proved.

Examples of patents upheld though showing small invention.

Whenever the Court finds a real or appreciable germ of invention, however small, it will uphold the patent. Thus the substitution of a round wick in a lamp, for a flat wick, was approved as patentable in *Hinks' Safety Lighting Co.* (1876, L. R. 4 Ch. D. 607; 46 L. J. Ch. 185). In *Perry v. Société des Lunetiers* (1896, 13 R. P. C. 664) the addition of a hinge to the folding sides of a camera previously unhinged was held to show invention. Another example of very slight invention is to be found in *Lyon v. Goddard* (1894, 11 R. P. C. 354), the "Disinfecting Machine" Case. Even the modification of one element in an old arrangement was upheld in *Edison-Swan v. Woodhouse* (1887, 4 R. P. C. 99); and the omission of a step in a process was held good subject-matter in *Wallington v. Dale* (1851-2, 7 Ex. 888), and in *Booth v. Kennard* (1856-7, Good. P. C. 68) was approved as such, although for other reasons the patent was not sustained.

Long felt want supplied strong argument for invention.

*Ehrlich v. Ihlee* (1888, 5 R. P. C. 437) and *American Braided Wire Co. v. Thomson* (1889, 6 R. P. C. 518) have been advanced as arguments that where an invention clearly meets a want long unsupplied, the patentee must be taken to have exercised invention. According to Kay, L. J., in *Savage v. Harris* (1896, 13 R. P. C. 364), such a test is, however, anything but conclusive.

Uselessness of alleged anticipations.

The fact that alleged anticipations were useless, and that the plaintiff's invention was extremely useful, has been held, in *Duckett v. Whitehead* (1895, 12 R. P. C. 187, 376), to be strong evidence of the exercise of invention.

## CHAPTER VII.

## ESSENTIALS IN SUBJECT-MATTER.

## NOVELTY.

THE next essential of valid subject-matter in a patent is that it shall be novel. The grant of a patent being upon the assumption that it is *a new manufacture* which the inventor is giving to the public, anything which disproves this view, militates against the validity of the grant. "Novelty" means novelty within the United Kingdom, for anything done abroad and not published or made known here, does not affect a British patent.

Novelty an essential in subject-matter.

It is therefore of the utmost importance that the novelty of an invention should be inquired into by a careful search among the Patent Records and other sources of information before the expense of taking out a patent is incurred. Under the system of examination now in force at the Patent Office, inventions of doubtful novelty are not so likely to be patented as formerly. But it must not be forgotten that not only do the authorities take no responsibility and give no assurance that the patent is valid, but the field of examination is restricted to published British Specifications of prior date up to fifty years next before the date of the application, and no investigations among other published sources of information are undertaken. Therefore, although the provisions for preliminary examination are most valuable, they are by no means exhaustive.

Methods of ascertaining novelty.

Official search as to novelty.

The novelty of every part claimed must be sustained in an action for infringement, and if it should transpire that any portion of the claimed matter is old, the whole patent is invalid, at least until amendment of the specification. In *Murchland v. Nicholson* (1893, 10 R. P. C. 417), for example, it turned out that the plaintiff's fifth claim for quite an unimportant detail, was bad for want of novelty. The whole patent thereby became invalid, and Lord Chief Justice Clerk, in delivering judgment, said: "I cannot but regret that the complainer, who, I think, has a good and patentable invention, should have made a claim, which is bad for an unimportant detail of his apparatus. Unfortunately, the

Each claim is judged by itself.

law is, as stated by the Lord Ordinary, that this claim being bad the whole patent must fall."

Cases establishing the rule.

This rule in Patent Law is founded on the older cases of *Huddart v. Grimshaw* (1803, 1 Web. P. C. 85); *Hill v. Thompson* (1817-18, 1 Web. P. C. 229; 8 Taunt. 375); and *Brunton v. Hawkes* (1820-1, 4 B. & Ald. 541; Good. P. C. 97), and has been followed in later cases, such as *McCormick v. Gray* (1861, 2 H. & N. 25; 31 L. J. Ex. 42); *Huslam v. Hall* (1887, 5 R. P. C. 1); *Pether v. Shaw* (1893, 10 R. P. C. 293); *Kelvin v. Whyte, Thomson & Co.* (1907, 25 R. P. C. 177), and is the rule in present practice.

Occasional relaxation of the rule in the case of subsidiary claims.

*Plimpton v. Spiller.*

The universal application of this rule, however, is relaxed if it can be shown that the matter claimed in the doubtful subordinate claim is meant to be used only with and as part of the main invention. Thus, in *Plimpton v. Spiller* (1877, Good. P. C. 380; L. R. 4 Ch. D. 286; 20 Sol. J. 860), the second subordinate claim, looked at by itself, was clearly bad for want of novelty; but, as the Court was of opinion that the subordinate matter claimed was meant to be claimed only for use in and as a part of the roller skate, which was the real invention, the patent was upheld.

*British Dynamite Co. v. Krebs.*

In *British Dynamite Co. v. Krebs* (1879, Good. P. C. 88; also reported as an Appendix in 13 R. P. C. 190) the patentee appeared to claim something separately (means for exploding) which, outside of his patent, was certainly old. The House of Lords held that this subordinate claim was intended to be appurtenant to the real invention, and was surplusage which might be disregarded: the patent was therefore upheld. But the patentee who depends upon this benevolent construction of his faulty subordinate claim is in a very risky position; and unless it is clear that the presence of this subordinate integer in a separate claim can only be explained on the supposition (supported by the specification) that it was meant as an adjunct to and as part and parcel of the real invention, then the rule will be let in and the patent will be held invalid. In *Cropper v. Smith* (1884, 1 R. P. C. 81) the plaintiff's third claim was for a bed-plate connecting the end standards of a lace-making machine. This was manifestly old, but Pearson, J., in the Court of First Instance, thought that such a claim came under the ruling in *Plimpton v. Spiller* (*supra*), and upheld the patent. The Court of Appeal,

Examples where rule was not relaxed.

*Cropper v. Smith.*

however, was of a different opinion, and held that the third claim was a separate claim, and had no functional connection with the rest, and that being for an old thing the patent was invalid. Again, in *Cassel Gold Extracting Co. v. Cyanide Gold Syndicate* (1895, 12 R. P. C. 232), the first claim was for any strength of cyanide of potassium solution "substantially as described," while the second was for a solution of a given strength. Strong efforts were made to get the Court to read the first claim (which, as it stood alone, was bad) as if it were limited by the specification and therefore the same as the second claim, which was good. But the Court of Appeal decided that they must be considered as independent claims, and the patent was held bad. In *Electric Construction Co. v. Imperial Tramways Co.* (1900, 17 R. P. C. 537) an attempt was made to read a separate claim, bad from want of novelty, into the main invention, but without success. In the report of this case there appears an interesting discussion on the principles which guided the decision in *Plimpton v. Spiller* (*supra*). According to Lord Alverstone, M. R., the benevolent view of a claim, on the face of it bad from want of novelty, can only be taken when the specification contains such a statement of the existing state of knowledge as to lead the Court to the conclusion that it would be manifestly absurd to suppose that the patentee really meant to claim as novel what at first blush he appears to have claimed. But in this connection it would be wise to note the warning of Lord Davey in *Kynoch v. Webb* (1899, 17 R. P. C. 100), where he says: "You are not to put a forced construction on the specification as not intending to claim something that is old, because it is foolish or suicidal of the patentee to claim it."

*Cassel Gold  
Extracting  
Co. v.  
Cyanide  
Gold  
Syndicate.*

*Electric  
Construction  
Co. v.  
Imperial  
Tramways  
Co.*

*Kynoch v.  
Webb.*

Where the invention is a process, the novelty is in the whole process, not in part; and where the patent is for a mere combination, the novelty must be sought for in the general construction and arrangement, not in the integers. But where an absolutely new and useful feature is included in a combination (like the swing flap in *Proctor v. Bennis*, 1887, 4 R. P. C. 333) a mere re-arrangement of the combination, or, where the new feature can be held to have been claimed, even a new combination which included the novel feature, would be an infringement.

*Process  
claims.*

*Combina-  
tion claims.*



General  
rule as to  
novelty.

The broad rule with regard to novelty is, that if the invention has by any means whatever become known in this country to one or more members of the public not under any obligation of secrecy, either by prior use or by prior publication, no patent can be afterwards granted for it. The reason is that in such circumstances the patentee has nothing to give to the public in return for the grant from the Crown; nor can any such grant deprive the public of the right freely to use what they already possess.

Un-  
authorised  
prior  
disclosure.

Section 41, Sub-section 2, of the new Act relieves the inventor from a possible wrong that might be inflicted on him by the premature public disclosure of his invention without his knowledge or consent. In that case the patent will not be held invalid if the inventor proves that such publication was in fact made without his knowledge and consent, and that if he became aware of the publication before the date of his patent, he applied for and obtained protection with all reasonable diligence.

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## CHAPTER VIII.

### ESSENTIALS IN SUBJECT-MATTER.

#### NOVELTY AS AFFECTED BY PRIOR USER.

PRIOR use by members of the public (or even by the inventor himself), if effected in a sufficiently public manner, will destroy the validity of any patent granted after the date of such user. As to prior use by the inventor himself, such use to prevail against his right to a patent, must be open and unquestionable. Mere experiment in his own closet or workshop, or mere confidential disclosure to, or experimental user on his behalf by another, will not destroy the inventor's right (*Electro-Plating Co. v. Holland*, 1901, 18 R. P. C. 521). For example, in *Morgan v. Seaward* (1837, 1 Web. P. C. 170; 2 M. & W. 544), the inventor of a paddle-wheel had two pairs of such wheels made for him before the grant of his patent by an engineer whom he had cautioned to keep silence. The wheels were made, packed, and exported before the date of the patent; nevertheless the patent was upheld so far as this issue was concerned. The authorities go to show that the inventor is allowed a reasonable latitude in proving the utility and practicability of his invention before making application for a patent, so long as these experiments do not discover the invention to others who are not in confidential relationship to him. But this doctrine must not be pushed too far. In most cases it is advisable that the inventor should not, even experimentally, use his invention for profit before protecting it. Thus, in *Germ Milling Co. v. Robinson* (1886, 3 R. P. C. 254, 399), the plaintiff, while under cross-examination, acknowledged having sold some flour treated according to his patent process, about three weeks before the date of his patent. No one could say that the flour disclosed the process, but the admission of the patentee showed that before the invention had been protected it had been used for profit, and on this ground the patent was held invalid. The same circumstances vitiated the patent in *Wood v. Zimmer* (1815, 1 Web. P. C. 44, 82).

Mere experimental use or confidential disclosure is not publication.

Must not be used even experimentally for profit.

But otherwise if goods not sold before date of application.

It is commonly maintained, on the authority of the latter two cases, that any continued secret operation of an invention *for profit* before the date of the patent amounts to such prior user as to cause invalidity. This would be true if the novelty lies in the goods produced and sold, unless perhaps in an isolated user experimentally, but incidentally beneficial to the inventor. Thus in *Newall v. Elliot* (1858, 27 L. J. C. P. 337; Good. P. C. 326), where, as a fact, experimental use in the presence of others, and necessarily for profit, had taken place, the patent was upheld. Said Byles, J.: "Is an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, necessarily a gift of the invention to the world? We think it is not." And again, "The coincidence of an experiment with actual immediate profit or advantage from it is unavoidable." In this case, be it remembered, the nature of the invention was apparent on the face of it.

Qy. If secret user for profit of necessity invalidates patent?

But take another example where the product is old and known, and the novelty lies entirely in the machine or process by which it is produced. Suppose, for instance, that the product is an ordinary machine-made cigarette, differing in no respect from the ordinary commercial article. Assume that the machine is novel and that the inventor instead of patenting his apparatus uses it secretly in his factory to manufacture cigarettes, and sells the cigarettes in the ordinary way of business, the workpeople who operate the machine being expressly warned against divulging the invention. Can it be said that the manufacture and sale of the cigarettes is a disclosure of the novel and unseen apparatus? Clearly not. And if the inventor should afterwards patent his machine, it is none the less a new invention to the public, although it has been secretly used by the inventor for profit for some time prior to the application.

*Germ Milling case* differentiated.

Those who uphold the contrary proposition on the authority of the *Germ Milling case*, are directed to the specification and report of the proceedings, from which it would appear that the claims of the specification covered not only the process but the products. It was admitted by the plaintiffs that these products had been sold before the date of the patent, which would, of course, account

for the adverse judgment. In *Betts v. Menzies* (1857-62, 10 H. L. Cas. 117; Good. P. C. 45), the patent was held good, although a quantity of the capsules forming the invention had been made in the plaintiff's own works by his own workmen, *but none sold or sent out*. In *Dolland's* case (Good. P. C. 175, decided in 1776) the patent was upheld because the prior secret user which was proved to have taken place had been confined to the closet, and had never been used for the purposes of profit. One of the reasons alleged why even secret user by one person for profit destroys the novelty of some subsequent patent of another is, that were it otherwise, the later inventor could under his grant prevent the former secret user from continuing to do what he had formerly freely done (see the cases of *Heath v. Smith*, 1854, Good. P. C. 238; and *Cornish v. Keene*, 1835-7, Good. P. C. 127). Another reason that has been advanced is that by secret user the inventor prolongs his monopoly, but there is nothing illegal in this, if he chooses to run the risk.

Secret use  
not for  
profit.

Public user might be brought about by sending round the article constituting the invention as a sample (*Blank v. Footman*, 1888, 5 R. P. C. 653), and by offering for sale, even although no sales were effected; or by manufacturing the article and storing it in a warehouse for the purposes of sale, as in *Mullins v. Hart* (1852, 3 Car. & K. 297). In *Taylor's Patent* (1896, 13 R. P. C. 482) revocation followed on proof that the petitioner had used in his own private house, and before the date of the patent, a fire-place similar to that of the respondent.

Circulation  
as sample.

Single user  
in private  
house.

Prior user which had been discontinued for a long period of years would, if fully proved, avoid a subsequent patent. In *Dewrance v. Fletcher* (1899, 16 R. P. C. 150) it was proved by three witnesses, one of them a man over eighty, that one water gauge similar to the plaintiff's had been used for a few weeks on a boiler about thirty years before the date of the patent. The works had been broken up, and no vestige of either gauge or boiler remained, so that the proof depended entirely upon the memory of the witnesses. But Romer, J., held the proof to be sufficient, and declared the patent to be invalid. In *Huggenmacher v. Watson* (1897, 14 R. P. C. 349, 631) the evidence of a witness, who spoke to certain alterations he had effected

Discon-  
tinued prior  
user.

Examples of  
cases where  
anticipating  
goods were  
no longer in  
existence.

Abandoned experiments not anticipations.

Prior user might be clumsy infringement after patent, but no anticipation before.

Publication during provisional protection afterwards abandoned.

*Orley v. Holden*

*Lister v. Norton.*

about eight years before the date of the patent, corroborated by two witnesses who had not a perfectly clear idea of what they had seen, was held to invalidate the patent, although in this case also the anticipating apparatus was no longer in existence. *Household v. Neilson* (1842-3, Good. P. C. 265; 9 Cl. & F. 788), *Guilbert-Martin v. Kerr & Jubb* (1887, 4 R. P. C. 18), and *re Sinnette's Patent* (1898, 15 R. P. C. 761), are cases bearing on the same point. But if such prior user was simply of the nature of an abandoned experiment, and especially if the prior user failed in something accomplished by the subsequent invention, the patent will be sustained. This was held in *Jones v. Pearce* (1832, Good. P. C. 269); *Edison-Swan v. Woodhouse* (1887, 4 R. P. C. 79); *Moseley v. Victoria Rubber Co.* (1886, 4 R. P. C. 241; 55 L. T. N. S. 482), and *Electro-Plating Co. v. Holland* (1901, 18 R. P. C. 521). It was said in *Daw v. Eley* (1865-7. L. R. 3 Eq. 496), by Wood, V.-C., that an unsuccessful or only partly successful prior user, which, if it had come after the patent, would have been held to be a clumsy infringement, might, nevertheless, be no anticipation of the patent.

Another incident of prior user or publication affecting the patent arises where the applicant, after having obtained provisional protection for an invention, and after having under such provisional protection sold and advertised articles in accordance with the invention, drops the first Provisional, and, incorporating some important addition or alteration, applies afresh for a patent. The question is: Does user of the original invention during the currency of the first unpublished and abandoned Provisional affect the validity of the patent obtained under the second? The answer is: Not if the patent, on the second application, is granted *within the original period of provisional protection*. This was decided in *Orley v. Holden* (1860, Good P. C. 350; 8 C. B. N. S. 666), and was followed by Chitty, J., in *Lister v. Norton* (1886, 3 R. P. C. 199). The learned Judge, in the latter case, said that such a conclusion might very fairly be drawn from the wording of Section 8 of the Act of 1852, which is practically repeated in Section 4 of the present Act. It is true that Section 8 of the Act of 1852 said that during

provisional protection the invention might be "used and published without prejudice to *any* Letters Patent to be granted for the same"; whereas Section 4 of the present Act (which allows of publication under the current application) says "without prejudice to *the* Patent to be granted for the invention." It is a nice point whether the use of the definite article in the present section would affect decisions on this question under the present Statute. As to the period of time which represents "provisional protection," Section 5, Sub-section 1, of the Act says that the applicant may leave his Complete within six months from the date of the application, and that (Sub-section 2) unless he does so the application shall be deemed to be abandoned. Sub-section 1 provides for the extension of time for leaving the Complete, to seven months instead of six. It would therefore appear that the period of "provisional protection" is six months, capable of extension to seven months if application for extension of time for filing the Complete is made.

Possible reading of present section.

Abandonment of Provisional.

Present period of provisional protection.

All circumstances considered, it would apparently be the best course to file the new and amplified Complete Specification accompanying the new application, within six (or with extension seven) months from the date of the original application. Such a course would seem to fulfil the requirements under the above-mentioned decisions. But in the case of important inventions it would be more prudent to eliminate risks by completing the original application and making a fresh application for the improvements.

In no case is it possible to maintain or keep alive one's claim to an invention which has been published or publicly used under the original provisional protection, by a series of over-lapping Provisional Applications.

Over-lapping Provisional Applications.

## CHAPTER IX.

## ESSENTIALS IN SUBJECT-MATTER.

## NOVELTY AS AFFECTED BY PRIOR PUBLICATION.

HAVING shown in the last chapter that undoubted prior public user of an invention destroys the validity of any subsequently granted patent for the same invention, some consideration may now be devoted to the effect of prior publication as distinguished from prior user in the United Kingdom. An invention is held to be published when a description or drawing of it has appeared in any book, newspaper, pamphlet, or specification accessible to the public, and conveying to the minds of persons skilled in the art, clear and full information regarding the invention. By such publication the public become possessed of the invention, and no subsequently granted patent for the same thing is valid. Publication might even take place in a Government report, not printed but open to two or three members of the public, as in *Patterson v. Gaslight Co.* (1875-6, 3 App. Cas. 239; 47 L. J. Ch. 492), where information known only to three co-referees, and embodied in a report, unpublished at the date of the patent, was held to anticipate a patent taken out in the interim between the preparation of the report and its issue.

What constitutes publication.

Publication by public lecture.

A lecture delivered to the public and fully describing an invention afterwards patented would constitute prior publication.

Tindal, C. J., on what constitutes publication.

Without citing the innumerable authorities on prior publication it will be sufficient to state the law as crystallised by Tindal, C. J., in *Stead v. Williams* (1843-4, Good. P. C. 437; 13 L. J. C. P. 218): "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 a case the patentee is not the first and true inventor within the meaning of the Statute."

Publication might be in a foreign language.

It is not necessary that the publication should have been printed or issued in this country. It might be a foreign book or journal, and be printed in a foreign language. In

*Lang v. Gisborne* (1862, Good. P. C. 278; 31 Beav. 133) a patent for a self-registering target was upset by prior publication in England of a French book; and in *Harris v. Rothwell* (1887, 4 R. P. C. 225; L. R. 35 Ch. D. 416) a knitting machine patent was held invalid because of the presence in the Patent Office Library of a German specification which described a similar invention. But the prior publication must be in a language ordinarily known to educated Englishmen. Apparently a book or specification in Arabic or Chinese would not do.

Granted that the prior publications are accessible to the public it is not necessary to prove that they have ever been consulted (*United Horseshoe Nail Co. v. Stewart & Co.*, 1885, 2 R. P. C. 122). But if, instead of being shelved and catalogued, the book has lain away in some chest or back room, its presence unsuspected until rooted out in a search for anticipations, it has been held that this could hardly be called prior publication—*Plimpton v. Malcolmson* (1875-6, Good. P. C. 374; L. R. 20 Eq. 37); *Otto v. Steel* (1885-6, 3 R. P. C. 109; L. R. 31 C. D. 241). A drawing published prior to the patent and clearly illustrating the subject-matter, though without any description, would anticipate the patent. This was held in *Herrburger v. Squire* (1889, 6 R. P. C. 194) and in the later case of *The Electric Construction Co. v. The Imperial Tramways Co.* (1900, 17 R. P. C. 537).

In any case of prior publication, the alleged anticipation must be sufficiently full and clear to enable a person skilled in the art to carry the invention into practical effect, without requiring to make experiments. Nothing less will do, and a patent cannot be upset by choosing a portion from one prior publication and a portion from another, and combining them so as to make up the invention it is desired to assail. In *Von Heyden v. Neustadt* (1880, L. R. 14 C. D. 230; 60 L. J. Ch. 126) James, L. J., said: "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." Chitty, J., was of a similar opinion in *Moseley v. Victoria Rubber Co.* (1887, 4 R. P. C. 241; 55 L. T. N. S. 482).

Where a prior specification or publication has been brought forward by the defendant, but which does not

If open to public, not necessary to prove actual perusal of publications.

Publication by drawing.

Mosaic of anticipations.

"Paper anticipations."



appear to have been carried commercially into effect, and does not exactly describe the plaintiff's invention, one frequently hears the deprecatory remark that it is "a mere paper anticipation," as if this were a separate kind of anticipation not subject to the rules holding good in other classes of prior discovery to the public. But granted that this alleged "mere paper anticipation" substantially discovers the invention, the phrase is meaningless, and the prior publication, although only on paper, is as effective as if the invention had been made commercially. Speaking on the subject of so-called "paper anticipations" Lord Westbury said, in *Hills v. Evans* (1862, Good. P. C. 248; 31 L. J. Ch. 457): "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." Groves, J., in *Philpott v. Hanbury*, (1885, 2 R. P. C. 33), went a little further than this, and was of opinion that if the prior publication is read and understood by "the highest class of skilled workmen" to indicate the subsequent invention, it will suffice as an anticipation. Kekewich, J., in the later case of *Thomson v. Macdonald* (1890, 8 R. P. C. 5), seems independently to have adopted the same view, and said that a prior specification, even although not so full and complete in its directions as the subsequent specification, and even although it had never been used practically, might nevertheless be sufficient for the purposes of anticipation. Then, in *The Anglo-American Brush Electric Co. v. King, Brown* (9 R. P. C. 313; 1892, A. C. 367) Lord Watson said of a so-called "paper-anticipation": "The sufficiency or insufficiency of the prior specification for that purpose does not afford a crucial test of prior publication"; i.e. it may be insufficient as a specification but sufficient as an anticipation (see also Lindley, L. J., in *Savage v. Harris*, 1896, 13 R. P. C. 364).

*Hills v. Evans.*

*Philpott v. Hanbury.*

Skilled workman test.

A specification less complete than the plaintiff's and never used might be an anticipation.

Even an insufficient specification might anticipate.

Resumé deduced from the cases.

Thus, an analysis of the cases dealing with so-called "paper anticipations" yields the result that if the prior publication instructs "the highest class of skilled workmen" (to quote Groves, J.) sufficiently to carry out the invention, even although it has never been used practically,

and even although the specification as a specification may show defects in sufficiency, it may nevertheless constitute an anticipation.

For those who are not content to rely absolutely on the investigations of the examiners in the Patent Office, the field which should be most carefully scanned, in searches to fortify or break down claims to novelty in a specification, is that afforded by the Patent Records and published specifications of British and Foreign patents. The classified indexes and abridgments of subject-matter which, together with the specifications, may be consulted at the Patent Office Library and at the public libraries of most large towns, render such a task comparatively easy.

Patent  
Office  
publica-  
tions.

By Section 41 of The Patents Act, 1907, no British specification of a date more than fifty years prior to the date of any patent granted on an application made on or after 1st January, 1905, can be deemed to be an anticipation of a patent so granted and published. Provisional specifications of any date are absolutely barred as anticipations. But it must be remembered that the foregoing privilege attaches only to patents applied for since the 1st of January, 1905.

Limitation  
of antici-  
patory  
specifica-  
tions.

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## CHAPTER X.

## REMAINING ESSENTIAL IN SUBJECT-MATTER.

## UTILITY.

Meaning of  
"Utility."

Utility  
alone not  
sufficient.

Must be  
useful  
for the  
indicated  
purpose.

Failure of  
utility  
avoids the  
patent.

THE remaining element in subject-matter is Utility. By "Utility" is not meant the mere capacity to be put to a useful or profit-earning purpose. Thus, as Kekewich, J., pointed out in *Cole v. Saqui* (1888, 5 R. P. C. 489: a Toy case), "the amusement of children is a useful thing." But utility is not in itself sufficient to impart patentability to a new analogous arrangement of an old thing (*Morgan v. Windover*, 1890, 7 R. P. C. 131); invention also is required. Utility, according to Groves, J., means "an invention better than the preceding knowledge" (*Young v. Rosenthal*, 1884, 1 R. P. C. 29), and means usefulness for the purpose indicated by the inventor. As was said by Lindley, L. J., in *Lane-Fox v. Kensington Co.* (1892, 9 R. P. C., at p. 417): "Utility is often a question of degree, and always has reference to some object. Useful for what? is the question which must be always asked; and the answer must be: Useful for the purposes indicated by the patentee." Thus, in *Easterbrook v. Great Western Railway Co.* (1885, 2 R. P. C. 201), it was demonstrated that the plaintiff's railway signal lock was liable, in certain circumstances, to such error as to make it a possible source of danger. The patent was, on these grounds, held void for want of utility. In *Sirdar Rubber Co. v. Wallington* (1907, 24 R. P. C. 539) the directions given in the specification failed to produce a tyre sufficiently firm in the rim to give a useful result. In *Tubeless Tyre Co. v. Trench* (1899, 16 R. P. C. 291) it was shown that, without the use of a subsequently invented soft soap seal (which was not indicated in the specification), a claimed form of the split tyre cover leaked under air pressure. Byrne, J., in giving judgment for the defendants said (see page 311 of Report): "You must have utility in the sense of the article being useful for the purpose for which the inventor designed it."

Incidentally, this case establishes the proposition that a patentee cannot call in subsequent invention to make useful that which, according to and at the date of his original specification and claim, was not useful. In other words, as was said by Lord Esher in *Nobel v. Anderson* (1894, 11 R. P. C. 519): "The specification must be construed as of the day after publication" (see page 523, line 10).

Subsequent improvement cannot be called in to make up absent utility.

The utility of an invention is always a question of fact and a matter of proof. The satisfying of a public demand and the commercial success of a patent are strong, although not conclusive, evidence of utility (*Ehrlich v. Ihlee*, 1888, 5 R. P. C. 198; see also *Cassel Gold Extracting Co. v. Cyanide Gold Syndicate*, 1895, 12 R. P. C. 232; and *per Wills, J.*, in *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, 1897, 14 R. P. C. 757). The amount of utility in an invention may be very small, but yet enough to support the patent. This was held in *The American Braided Wire Co. v. Thomson* (*supra*), and in *Day v. Davies* (1904, 22 R. P. C., at page 44). In *Philpott v. Hanbury* (1885, 2 R. P. C. 33) Grove, J., said that "the slightest amount of utility—I will not say an infinitesimal scintilla, but a very slight amount of utility—is sufficient to maintain a patent."

Utility a question of fact.

Commercial success not conclusive.

Amount of utility may be small yet sufficient.

A patent may even be supported for something which seems on the face of it retrogressive rather than an advance. Thus, in *Welsbach Incandescent Gas Light Co. v. New Incandescent Co.* (1900, 17 R. P. C. 237), a mantle of higher illuminating power was replaced by a mantle of lower illuminating power but of greater durability than the former mantle. Buckley, J., expressed himself that the advantage of durability, though combined with less lighting power, constituted such utility as would support the patent.

Utility not always evidenced by an advance in the same direction.

Care should be taken in preparing the specification to keep the claims confined only to those parts of the invention which carry utility, remembering that non-utility in the subject-matter of one claim will wreck the whole. In *United Horse Shoe Nail Co. v. Swedish Horse Nail Co.* (1888, 6 R. P. C. 1) the plaintiff's patent was declared void because the sixth claim referred to a mode of punching nail blanks which the evidence demonstrated could not be carried out in an economical and useful manner. In *Parkinson v. Simon* (1895, 12 R. P. C. 403) non-utility in

Non-utility in one claim invalidates the whole.

Non-utility  
in respect of  
ear-marked  
advantage.

the sense of not being effective for the indicated purpose caused the subject-matter of two claims, and consequently the whole patent, to be held bad. In *Wilson v. Wilson* (1902, 20 R. P. C. 1) the invention consisted in folding over upon itself the upper edge of a spun metal bobbin ferrule, which, folded over edge in applying the ferrule to the bobbin, was forced by pressure into the wood of the bobbin so as to hold the ferrule on by the sunken edge. Stress was laid in the specification on the advantage gained by not needing to nick or recess the bobbin with any tool to receive the folded over edge. A folded over edge at the other end of the ferrule had existed prior to the date of the patent, and a knife edge projecting at right angles at exactly the same point on the ferrule had been previously patented by the plaintiffs themselves. In practice it was found that the folded edge of the ferrule could not be forced into the substance of the bobbin, and a tool had to be used to recess the bobbin to receive the edge. It was held that non-utility for the chief indicated purpose had been established, and the patent was declared invalid. Lord Robertson said that "the invention as described in the specification had not only not been used by the alleged infringer, but it had not been used by the inventor, or, as far as appeared, by anyone else."

Old case on  
non-utility  
of one  
subordinate  
claim.

*Lewis v. Marling* (Good. P. C. 281; 1 Web. P. C. 493; 4 Car. & P. 52, 57) is apparently a ruling that if a subordinate and *non-essential* part of an apparatus has been claimed and should afterwards turn out to be unnecessary surplusage, the patent would not be held invalid on the ground of want of utility. *Per* Lord Tenterden: "It would be very hard to say that this patent should be void because the plaintiffs claim to be inventors of a certain part of the machine not described as essential, and which turns out not to be useful." But this is an old case (1829), and should be considered with caution.

Infringe-  
ment as  
evidence of  
utility.

The mere attempt of the defendant to infringe has been construed as evidence of the utility of the thing infringed. As Kay, J., said in *Lucas v. Miller* (1885, 2 R. P. C. 155): "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it."

## CHAPTER XI.

## THE SPECIFICATION (TITLE).

**H**AVING reviewed in the preceding chapters the essentials of subject-matter in patentable inventions, we may now proceed to consider the preparation of the specification and claims which constitute the instrument whereby the invention is described and ascertained.

The origin of the specification has already been indicated, and an attempt made to contrast the advantages and disadvantages of filing a Provisional or a Complete Specification with the application (see Chapter III). In dealing with the specification it will be assumed that the usual course of filing a Provisional Specification with the application is followed. The present and the three following chapters will deal successively with the Title, the Provisional Specification, the Complete Specification, and the Claims.

## TITLE.

In making an application for a patent the first thing that requires to be settled is the Title of the invention. This is an important point, and care should be taken to choose a title which will be properly descriptive. Fortunately, under present practice, there is little chance of going wrong in this particular. The Patent Office Examiners will decline to accept a title which is not in their opinion sufficiently descriptive, and the Comptroller has power to decline to date and number any such imperfect application. It might therefore happen that the applicant would find himself delayed and hampered by defects in his title.

Title to be properly descriptive.

In choosing a title the applicant should seek to make it wide enough to cover all that he has invented without trying to spread his net over too large an area. Vague generalities are to be avoided, but on the other hand the inventor must not run to the other extreme of making his title too narrow. The supervision exercised by the Comptroller is, as a rule, so discreetly carried out that very

Title should be neither too wide nor too narrow.

few questionable titles are passed. Even where the title is not all that could be desired, a defect in the title is seldom seriously urged in legal proceedings. Hence it has arisen that the old cases of *Cochrane v. Smethurst* (1816, Good. F. C. 124); *Welton v. Greaves* (1829, Good. P. C. 193); *Rex v. Metcalf* (1 Web. P. C. 141 n.); *Campion v. Benyon* (6 B. Moo. 71; Good. P. C. 103), and others, where patents were held bad on account of defects in the title, are now to some extent of academic interest only.

Example of objection to title.

In *Pirrie v. York Street Flax Spinning Co.* (1893, 10 R. P. C. 34) the defendants took objection to the title of the plaintiff's invention, "Improvements in wet spinning for flax or yarns," on the ground that it was actually winding and not spinning that took place on the cop. But the Court rebutted the objection, pointing out that the spinning took place simultaneously with the winding.

Objections to defective title still hold good.

But it must on no account be forgotten that where, in spite of the indicated safeguards, it turns out that the specification and claims contain matter clearly outside of the title, the validity of the patent will be in the greatest jeopardy. For example, if the title were "Improvements in apparatus for the manufacture of paper," and the specification and claims referred also to a process appurtenant to the invention but not absolutely hingeing on the use of the described mechanism, it would no doubt be a grave question whether the patent could be upheld. The proper title in such a case would be "Improvements in the process of and in apparatus for manufacturing paper."

No "fancy" titles accepted.

The applicant may not use a fancy name in the title to designate his invention. In examining the *Official Journal* one frequently comes upon such titles as "The 'Simplex' Bottle Stopper," "Smith's 'Triumphal' Cue Tip," or "The 'Nokorko' Screw Tap." This is ingenuity wasted, for all such titles are disallowed by the Comptroller, and the applicant requested to amend his papers in this respect. The proper title would be "An Improved Bottle Stopper"; "Improvements in Billiard Cues." &c.

## CHAPTER XII.

## THE PROVISIONAL SPECIFICATION.

SINCE its introduction under the Amendment Act of 1852 the Provisional Specification accompanying the application has been made use of in the bulk of cases, in so far at least as the applications of British inventors are concerned. Under the present Act the conditions governing the Provisional Specification are practically the same as before. Now, as then, the Provisional must sufficiently ascertain the nature of the invention. This does not mean that a mere intimation of the inventor's object will suffice. Suppose, for instance, the applicant had invented some improvement in friction clutches, it would not suffice to say in his Provisional Specification: "My invention relates to friction clutches," and stop there. He must go a little further, and state what the invention is, in as general terms as he pleases, but at least he must say enough to ear-mark the invention and enable it to be identified with the apparatus to be afterwards more fully described and illustrated in his Complete. It is a vice in a Provisional Specification to describe the invention so minutely that it only needs the insertion of the letters of reference on a drawing to transform it into a Complete Specification. In a properly framed Provisional, sufficient elasticity is left to include and admit of after modifications in detail, and even of general arrangement. In too precise and detailed a Provisional, the inventor often finds himself bound hand and foot when preparing his Complete, and if he includes modifications and additions to any extent he may well fear the creation of apparent disconformity between the Provisional and Complete Specifications.

The object of the period of provisional protection is to enable details and improvements to be made and elaborated by means of practical experiment, but that privilege may be wholly defeated by being too precise in the Provisional description. As Byles, J., said in *Newall v. Elliott* (1858, Good. P. C. 326; 27 L. J. C. P. 337): "The office

The Provisional Specification should simply ascertain the nature of the invention.

It should not describe the invention too fully.

Room should be left for modification.

Object of provisional protection.



Fry, J., on  
the office  
of the Pro-  
visional.

Necessity  
for careful  
drafting of  
Provisional  
under Act  
of 1907.

Feature  
mentioned  
in  
Provisional  
but dropped  
in Com-  
plete not  
within  
claims.

of the Provisional Specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out." And again, *per* Mr. Justice Fry, in *United Telephone Co. v. Harrison* (1882, Good. P. C. 472; L. R. 21, C. D. 720): "In a Provisional Specification you must find the nature of the invention described, though it need not be described otherwise than roughly, so long as it is fairly described."

It is apparent, in view of cases that already have occurred under the examination system now in force, that greater care and more forethought will have to be exercised in preparing Provisional Specifications than has hitherto been the case. The invention must be more precisely ascertained, and the actual advance clearly ear-marked. Already in many instances the results of examination or of opposition have shown the dangers of both over laxity and over particularity in the Provisional. For example, if an applicant omits specific mention of what he might at the time consider an obvious modification of his invention, he might find himself unable successfully to oppose an after application by another inventor for that modification, or might himself be prevented from including it in his Complete by the opposition of an applicant interposing between his Provisional and Complete. On the other hand, if he mentions a modification in his Provisional and omits, or fails to elaborate it in his Complete, he might be unable to stop an infringement based on this modification, if the defendant makes capital of the fact that the modification appears to have been discarded in the Complete and therefore left derelict. Nevertheless, where the modification indicated in the Provisional but not included in the Complete is an obvious variation of what is claimed, the infringer will not be able to shelter himself behind this plea. For instance, in *Sandow v. Szalay* (1905, 23 R. P. C. 6) the inventor of the well-known spring dumb-bell mentioned in his Provisional "compressed air springs" as an obvious alternative to his flat or spiral metal springs. In the Complete he confined himself to a description of flat and spiral metal springs, but the claims were in general terms for a divided dumb-bell with "springs or resilient means." Common sense would indicate that an inflated rubber ball

was a mere equivalent for a spiral spring; but the Court of Appeal held otherwise, and thought that the inference to be drawn from the Patentee's omission to mention air springs in the Complete was that he did not intend to claim them, and had in fact discarded them. From this view the House of Lords dissented and held that the plaintiff had not deliberately excluded air springs from his Complete and claims, and that the defendant had infringed.

According to Mr. Justice Romer, in *Pneumatic Tyre Co. v. East London Rubber Co.* (1896, 14 R. P. C. 77): "It is not necessary in the Provisional to detail the advantages of the invention." Advantages need not be set out.

The Provisional Specification remains a secret document until published with the Complete. If no Complete is filed the Provisional is deemed to be abandoned, but the Patent Office apparently preserves the Provisional for some time, as in *Pneumatic Tyre Co. v. English Cycle Co.* (1897, 14 R. P. C. 851) an official of the Patent Office produced on behalf of the plaintiffs, and on being called for by the Judge, a Provisional Specification filed nearly seven years previously. Provisional a secret document.

If during the six months of provisional protection the inventor devises modifications of his invention he may put in one or more supplementary Provisionals, and if the Comptroller is of opinion that the original Provisional and the supplementary applications may properly be said to constitute one invention, he may accept one Complete in respect of the whole and grant a single patent. In determining validity, the Court or the Comptroller may have regard to the respective dates of these supplementary Provisionals (Section 16, page 486). Supplementary applications.

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## CHAPTER XIII.

## THE COMPLETE SPECIFICATION.

The Complete must particularly describe the invention.

THE Provisional Specification having broadly set forth the invention, it remains for the inventor in his Complete Specification to “particularly describe and ascertain the nature of the invention and in what manner the same is to be performed.”

Must not extend beyond scope of Provisional.

In considering a Provisional Specification upon which it is proposed to found a Complete Specification, the first duty of the draftsman is to ascertain and digest the title and contents of the Provisional, and then to see that the matter of the Complete upon which it is proposed to found claims, does not extend beyond the true scope of the Provisional—that is to say, does not describe and claim an invention not fairly indicated in the Provisional. Before the present Act, if such a state of matters arose, disconformity was the result, and disconformity between the Provisional and Complete Specification was under any circumstances fatal to the validity of the patent. But, as will shortly be pointed out, under the present Act the plea of disconformity has shrunk into very narrow limits, if it has not, in fact, disappeared altogether.

Disconformity.

Former practice.

Before detailing the new Section and discussing its effects, it may be advisable to ascertain the practice under the former Statutes, since it has been said the plea of disconformity has not wholly disappeared.

Disconformity fatal to patent.

Said Lord Halsbury, in *Vickers v. Siddell* (1890, 7 R. P. C. 292; 15 App. Cas. 496): “I think it is an essential condition of a good patent that the invention described in the Provisional should be the same as that in the Complete Specification.”

Old examples of disconformity.

As examples of cases in which disconformity was held to have been proved, the following may be of interest:—

*Bailey v. Robertson.*

In *Bailey v. Robertson* (1878, 3 App. Cas. 1055) the Provisional described a meat preservative as made from gelatine mixed with bisulphite of lime. In the Complete not only was this composition claimed, but also a solution of bisulphite of lime *alone*. Patent held invalid.

In *Nuttall v. Hargreaves* (1891, 8 R. P. C. 273, 450; 61 L. J. Ch. 94; 1892, 1 Ch. 23) a gauze strainer for a beer tap, not mentioned in the Provisional, was claimed in the Complete. Patent held invalid. *Nuttall v. Hargreaves.*

In the *Cera Light Co. v. Dobbie* (1892, 11 R. P. C. 10) the Provisional described a metallic conductor of heat in a lamp as placed *near* the wick holder. The Complete described and claimed it as in metallic *contact* therewith. The patent was held bad for disconformity. *Cera Light Co. v. Dobbie.*

In *Brooks v. Lamplugh* (1897, 15 R. P. C. 33) the Provisional of one of the plaintiff's patents described a cycle saddle carrier radially adjustable on a pin. The Complete claimed an eye with trunnions where the radial adjustment had no place. The patent was held bad. *Brooks v. Lamplugh.*

The Provisional Specification in *Castner-Kellner v. Commercial Development Co.* (1900, 17 R. P. C. 593) described a *stationary* mercury cathode with moveable bells. The Complete claimed a *moveable* mercury cathode. The patent was held bad. *Castner-Kellner v. Commercial Development Co.*

In *Tubeless Tyre Co. v. Trench Tyre Co.* (1899, 16 R. P. C. 291) the Provisional detailed various forms of automatically sealed joints in split tubeless tyres, the joints being all made by contact of rubber with rubber. The Complete claimed a modification, where the seal was made between the rubber and the metal of the rim. The patent was held invalid both for disconformity and non-utility. *Tubeless Tyre Co. v. Trench.*

The case of *Lane-Fox v. Kensington &c. Co.* (1892, 9 R. P. C. 413) may also be referred to as an example of disconformity. *Lane-Fox v. Kensington &c. Co.*

But it was only where the substantial purpose of the inventor had been departed from or exceeded, and something like a new invention introduced, that disconformity held good. Improvements in details, so long as these were not of the nature of separate inventions but were directed towards and confined to the main object of the improvement, never were causes of disconformity (*Carter v. Leyson*, 1901, 18 R. P. C. 508). *Legitimate development not disconformity.*

Thus, in *Lucas v. Miller* (1885, 2 R. P. C. 155), which related to a patent for a bicycle lamp, the inventor in his Complete described certain clip washers which were important improvements in his method of suspending the lamp to the wheel hub. These washers were not referred to *Examples of disconformity not made out. Lucas v. Miller.*

*Woodward  
v. Sansum.*

at all in his Provisional, but were claimed as part of his combination in the Complete Specification. The defendant pleaded disconformity, but Kay, J., held that, by virtue of their close functional connection with the lamp, these washers constituted an improvement which the inventor was right in describing and justified in claiming. Again, in *Woodward v. Sansum* (1887, 4 R. P. C. 166), where the patentee had included, in his Complete Specification and claims, features which were admittedly improvements not referred to in his Provisional, but which made his pencil more useful, the patent was upheld, Cotton, L. J., saying that "A patentee putting in a Provisional Specification showing the nature of his invention is not bound to describe therein any mode of carrying it into effect; but if he does so, and before filing his Complete discovers an improvement upon such mode, or discovers a different mode, he is bound to give to the public in his Complete Specification the benefit of what he has discovered as to the mode of carrying the invention into effect."

*Welch-  
Dunlop  
Tyre Case.*

The well-known Welch tyre patent was challenged on the ground of disconformity in *Pneumatic Tyre Co. v. East London Rubber Co.* (1897, 14 R. P. C. 573). There is no doubt that at the date of the Provisional the inventor contemplated the application of his improved wire-edged cover to solid rubber treads only. In his Complete he claimed it as applied to pneumatic tyres also, and the Court of Appeal held he was justified in so doing.

*Gadd v.  
Mayor of  
Manchester.*

Objections on the ground of disconformity were also raised to the plaintiff's patent in *Gadd v. Mayor of Manchester* (1892, 9 R. P. C. 249, 516), the patentee having described and claimed mechanism for supporting gasometers which, as far as concerned Fig. 16 of the drawings, was not in the Provisional. But the Court of Appeal dismissed the objection and upheld the patent. Lindley, L. J., in delivering judgment, said: "The whole object of provisional protection is to enable a patentee to work at and improve his invention. The only limit set to what he can do in this respect is that the invention as finally specified must not be a different invention from that provisionally protected."

Discon-  
formity no  
longer a  
serious  
objection.

These instances are given as examples of the working of the doctrine of disconformity up to the 1st of January, 1908. At the present day their interest is chiefly academic.

Section 42 of the new Act provides that "A patent shall not be held to be invalid on the ground that the Complete Specification claims a further or different invention to that contained in the Provisional, *if the invention therein claimed, so far as it is not contained in the Provisional, was novel at the date when the Complete Specification was put in, and the applicant was the first and true inventor thereof.*"

Probably it is right to say that this section causes disconformity, as generally understood, to disappear. In almost every one of the examples of disconformity given above, the disconforming element had been evolved during the period of provisional protection, and was, either *per se* or in combination, new at the date when the Complete Specification was put in; so that under present conditions the patents would have been held good. In future the issue of disconformity, if raised at all, will be confined to those cases where the element of disconformity had been publicly used or published or protected by some other inventor prior to the date of the Complete, in which case lack novelty, or "not true and first inventor," rather than disconformity would appear to be the proper objection.

Disconformity now merged in anticipation.

As the Comptroller is the arbiter as to what post-provisional improvements may and may not be included in the Complete, as coming within the limits of the Provisional, it would be as well in doubtful cases to resort to the system of supplementary applications provided for by the Act, so as to secure the actual date of the improvement. Otherwise, if the Comptroller rejects the additional matter in the Complete as being in excess of the Provisional, he may, at the desire of the applicant, but at his risk as to novelty, treat this excess as a new application made on the date at which the Complete Specification was left (Section 6, Sub-section 3).

Precautionary course in dealing with improvements.

Another point to be observed in preparing the Complete Specification is that it must be sufficient and full.

Complete must be sufficient and full.

When an applicant files his Complete he is fulfilling his part of a contract with the public. On the one hand he gains the exclusive monopoly of his invention for a fixed period of fourteen years. For that privilege he undertakes, by means of his specification, so to instruct the public that at the end of his monopoly they will be able to use his invention as fully and advantageously

Require-  
ments of  
a Complete  
Specifica-  
tion.

Must not be  
ambiguous.

“Unfair”  
description.

Complete  
must be  
prepared in  
good faith.

Reasonable  
skill and  
knowledge.

as himself. Therefore, any ambiguity, suppression, or misdirection is a breach of faith, which only requires to be laid bare to destroy the privilege. *Per* the Earl of Halsbury in *British Ore Concentration Syndicate v. Minerals Separation, Limited* (1909, 27 R. P. C. 33): “The Statute requires the specification to be a distinct statement of what is the invention. In construing a specification one has to remember that it is a document not only assuring a monopoly to the patentee, which but for the Statute would be contrary to the Common Law, but also prohibiting anyone, other than the patentee, doing what he would be free to do but for the right which is granted subject to the condition, among other things, that the patentee states distinctly what his invention is. If he designedly makes it ambiguous the patent would be bad on that ground; but even if negligently, or unskilfully, he fails to make distinct what his invention is, I am of opinion that the condition is not fulfilled, and the consequence would be that the patent would be bad.”

Under present practice the Comptroller insists upon the removal of ambiguities and obscurities from the specification. The inclusion of irrelevancies he may hold not to constitute a “fair” description of the invention (*Francis’ Application*, 1909, 27 R. P. C. 86).

So, too, if a general disclaimer, or words purporting to describe the existing state of the art, can be held to set forth as common knowledge something which is in fact the subject of a prior existing patent, the Comptroller might hold this not to be “fair” description, and require amendment accordingly (*Hamilton’s Application*, 1901, 19 R. P. C. 33).

Accordingly, all specifications should be prepared in as transparently honest a manner as possible, and with every mark of anxiety on the part of the patentee thoroughly to instruct his readers in the best methods known to him at the time of carrying his invention into effect. He should also see to it that his specification clearly indicates and claims just what he has invented and no more, remembering the ordeal of examination as to novelty to which Complete Specifications are now subjected. Reasonable skill and knowledge must be apparent in the preparation of the specification, and a patentee will not be excused for shortcomings on account

of ignorance. Specifications and drawings must be prepared so as to be intelligible and complete, and the Court will not study to piece together what it was the duty of the inventor to make plain. In *Allen v. Duckett* (1893, 10 R. P. C. 397) the specification turned out to be so badly prepared that the Court was satisfied that the nature of the invention had not been properly ascertained. "Can anybody," said Hawkins, J., "reading this specification, form any judgment as to what the object of the invention is? . . . The more I look at it the more satisfied I am that both the Provisional and the Complete Specifications are absolutely wanting in the essential features which ought to present themselves upon both Provisional and Complete Specifications, and I therefore hold that it is bad for that reason."

Example of  
bad speci-  
fication.

*Allen  
v. Duckett.*

The specification is addressed to persons who are competent to understand and carry out processes or manufactures akin to the subject-matter of the patent. As Lord Eldon said in *Harmar v. Playne* (1807, Good. P. C. 219; 14 Ves. 130): "No sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch." Therefore it is not necessary that technical terms and trade expressions should be explained, unless they are more than ordinarily obscure or uncommon. Thus, if the invention deals with electricity, the inventor may use the scientific and accepted terms common among electricians; if with chemistry, those terms which are common knowledge with chemists. So in an invention connected with a loom, for example, the patentee may safely pre-suppose an acquaintance on the part of his readers with the ordinary mechanism and operations of weaving. For it would be insufferable that a chance mention of a shuttle, reed, picking-stick, or weftfork, should be a signal for the writer to stop and carefully explain to the reader what these were.

Specifi-  
cation  
addressed  
to skilled  
persons.

As a development of this implied knowledge on the part of the reader the Courts have in turn come to assess the sufficiency of a description by what is known as "the ordinary working test."

Test of  
sufficiency  
of speci-  
fication.

This means that a Complete Specification will be held to be sufficient in law if the directions are plainly enough



given to enable a person of average intelligence, and conversant with that particular industry, to carry the invention into effect.

Lord  
Cairns on  
sufficiency.

As was said by Lord Cairns in *British Dynamite Co. v. Krebs* (1879, Good. P. C. 88; 13 R. P. C. 190): "When the nature of the invention is ascertained by the Court as a matter of construction, the Court has then to enquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture; and this the Court can best do by the evidence of workmen of that description and by the evidence of what workmen of that description have actually done under the patent." At the same time let it be noted that it is only ordinary trade knowledge and skill that can be drawn upon to clear doubtful points in a specification. The present tendency in infringement actions is rather to overshoot these limits, especially in chemical and process patents, and submit the interpretation to very highly skilled experts. It is questionable whether this is not being carried too far, and Lord Shaw, in *British Ore Concentration Syndicate v. Minerals Separation, Limited* (1909, 27 R. P. C., at page 94), sounded a not unneeded warning against pushing the indulgence to extremes.

Skilled  
workman  
test.

The reader is not to be called upon to exercise extraordinary intelligence or invention, or to fill in evident gaps left by the patentee. But he must duly exercise his trade knowledge and trained intelligence as a workman in interpreting the instructions of the patentee. In *Crossley v. Beverley* (1829, 3 C. & P. 513; Good. P. C. 136) the defendants asserted that the description of a gas-making apparatus was incomplete because no mention was made of the condenser. Lord Tenterden, C. J., brushed this objection aside, saying that "a workman who was capable of making a gas apparatus would know that he must put in a condenser." But lack of exactness in the description which leads to a result short of the full useful effect contemplated by the patentee will vitiate the patent on the ground of insufficiency (*Sirdar Rubber Co. v. Wallington*, 1907, 24 R. P. C. 539).

Evident  
errors not  
fatal.

Where a patentee in his description makes an error which is on the face of it an error, and which could not possibly

mislead anyone acquainted with the subject-matter, such error will not vitiate his patent.

This was the opinion of Lord Westbury, L. C., in *Simpson v. Holliday* (1865-6, 12 L. T. N. S. 99; Good. P. C. 425). But his Lordship nevertheless went on to say that this was not a correct statement of the law when applied to errors which were only discoverable by experiment and further inquiry.

But not so with errors non-evident.

In a Complete Specification a patentee is not tied down to exact and definite proportion or detail if the nature of the invention reasonably admits of variation. Thus, in the description of a new alloy, the proportions of metal to form the alloy should be stated specifically; but where variations might be made in these proportions without essentially affecting the nature or utility of the alloy, it is quite permissible for the patentee to say so and to indicate the limits within which such variations might be made (*Patent Type Founding Co. v. Richards*, 1860, 6 Jur. N. S. 39; Johns. 381; Good. P. C. 360). On the same grounds, a combination claim, consisting of several parts, would not be defeated by mere variation or substitutes, where the characteristics of the combination were preserved. In short, whether in mechanical or chemical combinations or processes, a reasonable latitude will always be allowed in construing the specification.

Provision may be made for reasonable variation.

Wherever a Complete Specification can be made more easily understood by the addition of drawings these should be incorporated.

Drawings.

It was said by North, J., in *Lawrence v. Perry* (1865, 2 R. P. C. 179), that drawings are not an absolute necessity even for the explanation of mechanical patents. But the patent in question was under the Act of 1852, and Sub-section 3 of Section 2 of the present Act empowers the Comptroller to require drawings if he deems it desirable with either Provisional or Complete Specifications or at any later period. Nevertheless, a specification dealing with an appliance improvement has been held by Chitty, J., to be sufficient, though no drawings were annexed (*Savage v. Harris*, 1896, 13 R. P. C. 90). There is little doubt, however, that it is, if not essential, extremely desirable that drawings should be used wherever possible. Language is at the best a very poor and misleading substitute for a representation

Comptroller may require drawings.

Advantages of drawings.

of the thing itself, and, besides, a faithful and careful drawing is of use in explaining what might otherwise be an ambiguity in the description. Thus, if the descriptive part were to tell the reader something which is absurd—perhaps something so misleading that if it stood alone the very validity of the patent might be imperilled—if that misleading statement is coupled with a reference to the drawing, the error in the description can be cured, so long as the drawing is so unmistakably clear and correct that a competent person can at once see for himself that a mistake has been committed. An omission in the drawing, of one small air hole, which was an essential of the invention, upset the patent in *Hinks v. Safety Lighting Co.* (1876, L. R. 4 Ch. D. 607; 46 L. J. Ch. 185; Good. P. C. 252); but in *Otto v. Linford* (1881, 46 L. T. N. S. 35; Good. P. C. 343), and in *True Lamp Syndicate v. Bryant Trading Syndicate* (1908, 25 R. P. C. 461), an obvious error in the drawing, which would not have deceived an expert, was not allowed to prejudice the patent.

*Hinks v. Safety Lighting Co.*  
*Otto v. Linford.*

Ambit of wide claim not limited by drawing.

But where the description and claim are in general terms, and so wide as to include different types of apparatus, the fact that the drawing illustrates one particular type of apparatus will not entitle the patentee to contend that his claims must be limited to the use of the particular apparatus he illustrates. Thus, in *Scott's Patent* (1902, 20 R. P. C. 257) the description and the first claim referred to condensers generally, while the drawing showed a multi-tubular water condenser. The Court refused to limit the claims to condensers of this type only, and declared the patent invalid from want of novelty, condensers of other types having been used for the same purpose prior to the date of the patent.

Essential feature illustrated but not described held within claim.

On the other hand it has been held that where an essential feature of the invention is clearly shown in the drawings, but not referred to at all in the specification, a general claim for the combination includes and protects this essential feature (*Hattersley v. Hodgson*, 1904, 21 R. P. C. 517). In this case Mathew, L. J., said: "I should be loth to accept for a moment the suggestion that has been made that, although a drawing may be sufficient to indicate what the patentee intended, unless he incorporated

in his letterpress what he intended to convey by his drawing, his patent is invalid. There is no such rule, and I have not the least anticipation that such a rule will ever be laid down." The learned Lord Justice's opinion was approved in the House of Lords (23 R. P. C. 192).

In making a drawing the great object should be to clearly illustrate the subject matter of the invention. This is sometimes so far lost sight of that an inventor, in illustrating an improvement in locomotive furnace bars, for example, is content with nothing less than giving several complete views of an entire locomotive engine and tender. The result is that the illustrations of the improved bars are dwarfed, and the specification encumbered by the presence of matter that has nothing to do with the invention. The Comptroller has very wisely set his face against the practice of unnecessarily loading the specification with redundant matter. In *Francis' Application* (1909, 27 R. P. C. 86) the Comptroller says:—"Where an invention is confined to a detail or a small feature of a well-known machine, apparatus, or process, the applicant should no doubt describe the best way of carrying his invention into effect, and may give all necessary and reasonable directions to show its connexion with other parts of the machine, but in my opinion it is not his duty to describe or illustrate in detail special parts of or a special form of the machine with which his invention has no connexion, or to include matter which is wholly irrelevant to the claims."

Perspective drawings or isometrical projections are much in evidence in American specifications, and should be used where possible, as these appeal to the understanding of a much wider class than is the case with purely mechanical drawings.

As the drawings attached to the specifications are now reproduced by zincography, and generally to a reduced scale, it is incumbent upon the patentee to see that his drawings are neat, black, clear, and distinct, and to as large a scale as the prescribed sizes of sheet will conveniently hold. The lettering should be large and carefully formed, and each letter should unmistakably indicate the part referred to.

It should be mentioned that when drawings have been filed with the Provisional Specification, these drawings

Object of drawings.

Hints on the preparation of drawings.

Comptroller's warning against redundancy.

Perspective drawings.

Reproduction of drawings for publication.

Provisional drawings may serve for Complete.

can be referred to in the Complete Specification without the necessity for filing fresh copies of the drawings.

Chemical samples.

In chemical inventions the Comptroller may require typical samples or specimens to be furnished in duplicate. Particulars of the form in which these samples are to be filed are given in Rule 36 of the Patent Rules, 1908, which follow this portion of the book.

Differentiating old from new.

In pursuance of the advice already given as to the exercise of absolute good faith in preparing the Complete Specification, it might be useful also to point out the advantage of differentiating the old from the new in a specification, especially where a combination is concerned. As Cresswell, J., said in *Gibson v. Brand* (1841-2, 1 Web. P. C. 627; 11 L. J. C. P. 177; Good. P. C. 211): "Every party is bound to tell the public clearly by his specification what he claims, and what they may do or may not do without risk of an action for infringing his patent."

Present-day necessity of differentiating new from old.

In view of the powers given to the Comptroller under the present examination system, the differentiating of the old from the new is desirable, if the applicant wishes to escape the disagreeable necessity of having references to one or more prior patents endorsed on his specification.

*Macfarlane v. Price.*

In *Macfarlane v. Price* (1816, 1 Web. P. C. 74; 1 Stark. 199; Good. P. C. 294) certain improvements in umbrellas and parasols were described, no distinction being made as to which of the details were new and which were old. The patent was alleged to be infringed by the use of a certain part shown in the drawing, and admittedly of the essence of the invention. But Lord Ellenborough, C. J., nonsuited the plaintiff on the ground that no one could be fairly expected to gather from the specification what the novel parts really were.

*Foxwell v. Bostock.*

So in *Foxwell v. Bostock* (1863-4, 4 De G. J. & S. 298; 10 L. T. N. S. 144; Good. P. C. 200) certain improvements in a sewing machine were so described that Lord Westbury held that no one could properly distinguish between what was new and what was old, and on that account declared the specification insufficient. Again, in

*Harrison v. Anderston Foundry Co.*

*Harrison v. Anderston Foundry Co.* (1876, Good. P. C. 221; L. R. 1 App. Cas. 574), in which *Foxwell v. Bostock* was discussed, Lord Hatherly laid it plainly down that where the improvement was merely in an *integer* in an otherwise

known combination, it was the duty of the patentee, if he wished to claim this integer apart from the described combination, to lay his finger on the new part and tell the public that this was his improvement. Generally speaking, when describing an invention, differentiation of the new from the old need not be carried out, where common knowledge or the knowledge of the ordinary skilled workman is sufficient to identify the old parts.

For example, if the invention refers to a new equilibrium valve for governing the passage of steam to the valve chest of a steam engine, and the specification describes the valve in connection with an ordinary ball governor, it would not be necessary to disclaim the governor, for every one knows how old that is. But if the valve itself were partly old, it might be necessary to point out what parts of the valve were new and constituted the improvement. As regards any improvement upon a foregoing invention or existing patent, it will be sufficient, for the purposes of differentiation between old and new, to indicate the specification of the first invention.

Before leaving the question of differentiating the old from the new, it must *per contra* be pointed out that the newer practice does not always adhere to the older precedents. For instance, in *Goddard v. Lyon* (1894, 11 R. P. C. 354) Lord Watson said that a "patentee is not bound to state what is new and what is old," and *per Wills, J.*, in *Hookham v. Johnson* (1897, 14 R. P. C. 525), "a patentee is not bound in a combination claim to distinguish between new and old parts in the combination." In *Patent Exploitation, Limited v. Siemens* (1904, 21 R. P. C. 547) Lord Davey said: "In a patent for a combination of *well-known elements* there is no room for the common objection that the patentee has not sufficiently distinguished the old from the new, the combination itself constituting the novelty." *Per Moulton, L. J.*, in *British United Shoe Co. v. Fussell* (1908, 25 R. P. C., page 656): "If what you have claimed, and the monopoly which you have obtained, is for a combination, that combination is the novelty, and you have no obligation beyond accurately defining it. In my opinion that is the law as it now stands."

Where differentiation may be unnecessary.

Examples where differentiation held not to be obligatory.  
*Goddard v. Lyon.*

*Hookham v. Johnson.*

New combinations of well-known parts.

In combination claim, no obligation to define old from new.

But *contra*  
in *Kynoch*  
v. *Webb*.

Nevertheless, the old and useful rule cannot always be safely disregarded, as was shown in *Kynoch v. Webb* (1899, 17 R. P. C. 100), where the plaintiff's patent was upset in the House of Lords mainly on the ground that the specification did not distinguish the new from the old in a combination. Apart from the mere descriptive portion of the specification, differentiation of old from new in combination claims will be fully discussed in the next chapter.

Inutility of  
alternative  
method  
avoids  
patent.

When two or three methods of carrying an invention into effect are described and claimed in the specification, and one of them turns out to be useless, the patent is invalid. In *Simpson v. Holliday* (1865-6, Good. P. C. 425; 12 L. T. N. S. 99; L. R. 1 H. L. 315) a cold and a hot process for the production of a dye were described in the specification and claimed. The cold process turned out to be useless, and the patent was held invalid on that account.

Construc-  
tion of  
specifica-  
tions.

Former  
modes of  
construc-  
tion.

In construing specifications of Letters Patent for inventions, the practice of the Courts seems to have gone through a pendulum-like swing before settling down to the present rule of reasonable and fair construction. In former times Letters Patent for inventions suffered from the vestiges of that odium which attached to the bad old monopolies. As a result, when a patent came into Court it was subject to the most keen and searching scrutiny. The leaning of the Court was always dead against the patentee and in favour of the public. This might be termed the period of *malevolent* construction of specifications. But early in the last century more liberal conceptions concerning the inventor and his mission began to prevail, and the practice of the Courts swung into what has been called the *benevolent* construction.

Present  
practice in  
construing  
specifica-  
tions.

That, in its turn, has been succeeded by a very evident determination on the part of the Court to allow itself to be influenced neither by the benevolent nor the malevolent theory of construction, but to give fair consideration to the meaning of the language employed, and to decide accordingly.

In *Cropper v. Smith* (1884, 1 R. P. C. 81; 26 Ch. D. 700; 10 App. Cas. 249) Bowen, L. J., gives an excellent exposition of the rules governing the Courts at that date.

Chitty, J., in *Lister v. Norton* (1886, 3 R. P. C. 203), speaking of the construction of a specification, said: "It ought to be construed, like any other legal document, as a whole. It certainly ought not to be construed malevolently; I will not say it ought to be construed benevolently: I do say it ought to be construed fairly. It must be read by a mind willing to understand, not by a mind desirous of misunderstanding." Cozens-Hardy, J., in *Electric Construction Co. v. Imperial Tramway Co.* (1899, 16 R. P. C. 631), said: "A specification ought, I apprehend, to be regarded in the same manner as any other document which has to be interpreted by the Court—it must be looked at as a whole. The claims must not be looked at as if they stood alone. A strained and unnatural interpretation must be avoided." The whole modern principles of construction were crystallised by Lord Davey in *Patent Exploitation, Limited v. Siemens* (1904, 21 R. P. C. 549): "My lords, I disclaim putting either a benevolent or malevolent interpretation on the specification, or being astute either to uphold or invalidate the patent. I am of opinion that a specification, like any other document, should be construed by the Court according to the fair meaning of the language used, after being informed by evidence of the nature of the subject-matter, the state of knowledge at the date of the patent, and the meaning of any scientific or technical words that are found in it."

Chitty, J.,  
on con-  
struction.

Cozens-  
Hardy, J.,  
on con-  
struction.

Lord Davey  
on modern  
principles  
of con-  
struction.

Any part of the invention which has been indicated in the Provisional Specification may be abandoned or disclaimed in the Complete.

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## CHAPTER XIV.

## CLAIMS.

Claims  
required  
by the Act  
of 1883.

**N**EXT to a clear and comprehensive setting forth of the invention in the body of the Complete Specification, the most important task of the patentee is the framing of the claims, by which he points out and fences off the real fruits of his brain. Prior to the Act of 1883 it was not obligatory to conclude the specification with claims, although, for their own sakes, patentees usually did so. Now, however, every Complete Specification must end with "a distinct statement of the invention claimed" (Section 2, Sub-section 4).

Claims must  
be clear and  
succinct.

The requirement of the Statute is reinforced by the Rules of 1908 which under Rule 14 require that "The statement of the invention claimed, with which a Complete Specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification." A foot-note on Form 3 (which is the Form for the Complete) draws attention to this Rule 14, and requires that "any unnecessary multiplicity of claims or prolixity of language should be avoided."

Simple as these requirements may seem, it is sometimes a matter of considerably difficulty to select and limit in clear and comprehensive language not only the pith and gist of the invention, but also the subsidiary and collateral claims that may spring from the main trunk.

Powers  
of Comptroller  
to require  
claims in  
Complete.

The Comptroller has power to require that something in the shape of a claim shall be appended to the Complete, and apparently, as the Rules of 1908 are to be construed as one with the Statute, these powers are to be exercised more stringently than heretofore. It is therefore to be expected that patents granted under the new Act will have claims much less difficult of construction than those of earlier and existing patents. But even under present conditions, if the applicant presses for the acceptance of his claim in the form he prefers, the Comptroller has apparently no power to refuse acceptance, unless he considers that the unamended claims bring the applicant's invention wholly

and specifically within the limits of some prior specification in terms of Section 7, Sub-section 4. The utmost he can do is to insert such disclaimers, and, if need be, references to prior patents as in his judgment would neutralise the unacceptable form of claim.

References.

It appears that in any case there must be some attempt to indicate the scope of the invention in the claim. Herschell, S.-G., in *re Smith's Patent* (Griff. P. C. 268), expressed an opinion that to say "I claim the invention described in the specification" would not be a claim that should be accepted by the Comptroller. But he also said that if the claim read, "I claim the improved bicycle substantially as described," such a phrase might be accepted, as it clearly pointed to a particular machine.

Herschell, S.-G., on form of claim.

Claim must refer to invention as described.

The primary rule in drawing a claim is to take care that the claim shall not cover anything more than the actual invention. "The object of a claim," said Lord Chelmsford in *Harrison v. Aulerston Foundry Co.* (1876, L. R. 1 App. Cas. 574), "is to define and limit with precision what it is that is claimed to have been invented and therefore patented." In working out an invention and preparing the Complete Specification, it is often the case that extensions of the uses of and changes in the apparatus begin to suggest themselves more or less vaguely to the inventor, some of which he thinks might possibly lead to evasion if hit upon by other inventors. In this state of mind claims are prepared in which, not content with claiming the substance of the invention, the patentee endeavours also to secure some foothold in case of possible developments of his idea by others. With this object the claim is drawn in vague terms, which the patentee flatters himself not only cover the design originated by himself, but would trip up anyone who might come within measurable distance of his domain. As was said by Lindley, M. R., in deciding against the validity of the patent in *Dick v. Ellam* (1900, 17 R. P. C. 196), "the invention might have been patentable if the patentee had not thrown his net too wide, as patentees constantly do, to catch people who do not infringe the real invention."

Object of claim is to define invention.

*Harrison v. Aulerston Foundry Co.*

Danger of "fishing" claims.

*Dick v. Ellam.*

This ambition has often proved fatal, and in thus snatching at the shadow the patentee runs great risk of losing the substance.

Claims  
must not be  
too wide.

*Sterens v.  
Keating.*

In *Sterens v. Keating* (1847, 2 Web. P. C. 175; 19 L. J. Ex. 57; Good. P. C. 443) the patentee had described a mode of making a new cement by the use of sulphuric acid with limestone or chalk. The gist of the invention was the employment of the particular acid for the purpose. Not content with having proved the usefulness of sulphuric acid for his purpose, the patentee said, in the body of his specification, that other acids might be used, and claimed the process in combination with the use of acids "as hereinbefore described." This was held to be a claim for every acid, and as it was proved that certain acids would not do, the claim was upset as being too wide. The same objection proved fatal in *Scott's Patent* (1902, 20 R. P. C. 257).

*Minter v.  
Mower.*

Again, in *Minter v. Mower* (1837, 6 A. & E. 735; Good. P. C. 304), the patentee of an automatically self-balancing chair, instead of claiming his own construction of the chair, which was both novel and useful, claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of the chair, as above described." It was shown at the trial that a form of chair acting upon this claimed principle, but infinitely less cleverly constructed than the plaintiff's, had been made and sold before the date of his patent. It was held that Minter's claim, instead of being confined to his own invention, was wide enough to cover the anticipatory chair also, and was therefore bad. The same error of claiming a useful appliance in such broad terms as to cover a principle in mechanics which was shown to be old, caused the patent to be declared invalid in *Bowden's Patent* (1904, 22 R. P. C. 49).

Court will  
not extend  
claims be-  
yond their  
reasonable  
construc-  
tion.

On the other hand, if the claim as drawn is narrower than it need have been, the Court will not expand the ambit of the claim so as to cover the ground which might have been but was not claimed. *Per Romer, J.*, in *Nobel's Explosives Co., Limited v. Anderson* (1894, 11 R. P. C. 128): "In order to make out an infringement, it must be established to the satisfaction of the Court that the alleged infringer, dealing with what he is doing, as a matter of substance, is taking the invention claimed by the patent, not the invention which the

patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification." So if the invention really involves a novel essence or principle, but the claim covers only the actual construction described, the Court will not stretch the claim to cover the principle. *Per* Cozens-Hardy, L. J., in *Ackroyd v. Thomas* (1904, 21 R. P. C. 737): "If a patentee intends to claim a general principle, it is his duty to make that intention reasonably clear by his specification."

If an essential part of a combination, operation, or process, or an alternative arrangement or process, described and claimed should turn out to be useless, the patent is bad. The first would put an entire stop to the useful function of the machine or would nullify the process, and is clearly a fatal defect (see Lord Denman's remarks in *Reg. v. Cutler*, 1816, 1 Stark. 354; 1 Web. P. C. 76 n.). The second—viz., the failure of an alternative arrangement or process—is also a reason for upsetting a patent. The principle seems to be that the Court says: "Here you have two methods presented to you as equally useful. You are told that one is as good as the other. Having nothing to serve as a guide, you may choose the useless method. It fails. Practically, therefore, you are put to experiment to prove what is useful and what is useless, and that is distinct failure of a patent." In *Simpson v. Holliday* (1865-6, Good. P. C. 425; 12 L. T. N. S. 99) two methods of preparing dyes were described. The method first set forth was perfectly successful; the second (an alternative method) was a failure. The patent was held invalid on that account. Similarly, in *Pether v. Shaw* (1893, 10 R. P. C. 293), Kekewich, J., held the plaintiff's patent bad because, of two alternatives suggested in the claim, one was of no use, although the other had proved highly successful. In *Kurtz v. Spence* (1886-8, 5 R. P. C. 161; L. R. 33 Ch. D. 579) the patentee claimed as an agent in a process peroxide of manganese, whether hydrated or anhydrous. The latter proved to be useless for the purposes of the invention, and the patent was held bad. It must be remembered that the claim is always read together with the specification; therefore when a claim is made, and direct qualifying reference is had to the specification,

Non-utility in part of combination claimed makes the whole bad.

Or failure in alternative arrangement.

*Simpson v. Holliday.*

*Pether v. Shaw.*

*Kurtz v. Spence.*

Claim may be limited by specification.

the claim is limited thereby, and the reader must go to the specification to learn the extent of the limits. But as this course is very apt to lead to doubt and uncertainty, it is unquestionably better to formulate in the claim itself the feature which it is desired to secure.

True meaning of claim sometimes matter for evidence.

*Gandy v. Reddaway.*

Sometimes the interpretation of the true meaning of a claim is a matter for settlement by evidence; that is to say, that though a claim may seem too wide to an outsider it may have a more restricted meaning to a person well acquainted with the industry in question. Thus, in *Gandy v. Reddaway* (1885, 2 R. P. C. 49), the claim was for "constructing belts or bands, for driving machinery, of cotton, canvas, or duck *woven hard*," &c. It was shown that at least ten classes of "hard woven" canvas were known in the market. Of these, numbers two, three, and four only were suitable for the purposes of the invention. The other classes were useless. The plaintiff endeavoured to show that a workman acquainted with this class of manufacture would, without further instructions, have used number two, three, or four, and would never have thought of using any of the other numbers. It is to be gathered from the judgment that if this had been established on evidence, the Court might have upheld the patent. But no such evidence was forthcoming, and, consequently, the patent was held invalid.

Grove, J., on the use of the word "substantially."

Lord Alverstone on colourable alterations.

"Substantially as hereinbefore described" is a phrase often appearing as the termination of a claim. The words are used sometimes with the intention of giving increased breadth to a claim, sometimes for the purpose of narrowing it. In *Young v. Rosenthal* (1884, 1 R. P. C. 29) Mr. Justice Grove gave it as his opinion that it was unnecessary to use any such word as "substantially" to qualify a claim. The elasticity sought to be obtained in a claim by such a qualification, either by increasing or limiting its ambit, is already given by the law. "The law says if a man although not literally infringing the letter of the patent yet substantially infringes it, it is an infringement." As was said by Lord Alverstone in *Presto Gear Case Co. v. Orme* (1900, 18 R. P. C. 17): "In my judgment, be it a combination claim or be it not, you are only allowed to follow the words of the claim, but you are not to permit mere mechanical equivalents or mere

colourable alterations to prevent a thing being an infringement, having regard to what the meaning of the claim is." It is certainly reasonable to consider that all expressions which mean that anything practically or substantially the same will be deemed an infringement of the described invention are unnecessary and might as well be left out. They do no good, for it is always for the Court to decide what is and what is not an infringement, and no amount of fencing with such expressions as "mere mechanical equivalents," or "substantially the same arrangement of parts." &c., so commonly found in specifications, will influence the Court in any way. Nevertheless, where the claim is not intended to be broad and general but to refer to something the same, or practically the same, as the thing described and claimed, it is better to add the words "as described and shown" or "substantially as described and shown."

The subject of how far it is safe to claim anything savouring of a principle has already been referred to in the foregoing pages (see Chapter V., on "Subject-Matter"). It seems proper, however, at this point to repeat the rule already laid down, that although a bare principle *per se* cannot be patented, yet, if the principle is new and a method of carrying it into effect has also been described, the principle, coupled with the mode of carrying it into effect, may be patented. If this is done, any other substantially similar mode of carrying the principle into effect which another person might seek to use will be very narrowly scrutinised, and if possible held to be within the limits of the patent. The chief expressions of judicial opinion most favourable to the first exploiter of a new principle are to be found in *Neilson v. Harford* (1841, Good. P. C. 321; 8 M. & W. 806); *Otto v. Linford* (1881, Good. P. C. 343; 46 L. T. N. S. 35); *Jupe v. Pratt* (1837, Good. P. C. 274); and *Hickton's Patent Syndicate v. Patents and Machinery Improvements Company* (1909, 26 R. P. C. 313). But, as Farwell, J., pointed out in *Chamberlain v. Mayor of Bradford* (1900, 17 R. P. C. 493), in recalling the dictum of Cotton, L. J., in *Automatic Weighing Machine Co. v. Knight* (1889, 6 R. P. C. 297), the usual reading of Baron Alderson's opinion in *Jupe v. Pratt* is too wide. Said the learned Judge: "If the claim is in general terms for every mode of carrying the principle into effect, it becomes

Principles.

Claim should be for principle, coupled with mode of carrying into effect.

Claim must not be generally for every mode of carrying into effect.

a claim to the principle itself, and therefore fails." This was already noted by Lord Abinger in *Neilson v. Harford* (*supra*). For the latest pronouncements on the subject, the reader is referred to the judgment of the Court of Appeal in *Hickton's case* (*supra*).

Court will not extend claim.

It seems reasonable to submit that a claim which the patentee has not ventured to make for himself will not be made for him by the Court, and that a specific claim for a new mode of carrying out a new principle will be confined substantially to that mode, and will not extend to all other modes as one might judge from a perusal of Baron Alderson's words. For instance, in *Harrison's Patents Co. v. Nicholson* (1908, 25 R. P. C. 393) it was held that where a specification described a particular machine, varied as therein stated, and the patentee contended that rotating round a common centre so as to get parallelism was the governing idea of the patent, that if he desired to claim all arrangements which would produce that result, he ought in his specification to have stated and claimed in explicit terms that principle.

A claim is not a disclaimer.

*Parkinson v. Simon.*

According to Smith, L. J., in *Edison-Bell Phonograph Co. v. Smith* (1894, 11 R. P. C. 404), a claim is also a disclaimer; but, *per* Lord Herschell, in *Parkinson v. Simon* (1895, 12 R. P. C. 406), "it is no longer correct to speak of a claim as a disclaimer."

Apparently bad subsidiary claim not necessarily fatal.

The question as to how far a subordinate claim, *prima facie* bad by itself for want of novelty or utility, ought to be considered as annexed to and forming part of the good claim or claims, so as to be capable of being held valid in accordance with the ruling in *Plimpton v. Spiller* and *British Dynamite Co. v. Krebs*, has been already discussed in Chapter VII., to which the reader is referred.

When evidently separate and independent a bad subsidiary claim is fatal.

The risk and uncertainty attending the interpretation of a claim of this dubious nature are well exemplified by the sometimes apparently contradictory character of the decisions. It is true that a claim is not to be read as an isolated sentence but together with the specification (*per* Kay, L. J., in *Parkinson v. Simon*, 1894, 11 R. P. C. 493). But a patentee who has deliberately made a separate and independent claim for a part of his invention which is, *ab initio*, or afterwards turns out to be, not good subject-matter, will not be assisted by the Court, because it was

“foolish or suicidal” of him to do so (*per* Lord Davey in *Kynoch v. Webb*, 1899, 17 R. P. C. 100). In *Electric Construction Co. v. Imperial Tramways Co.* (1900, 17 R. P. C. 537) it was plain from the specification that spring suspension of a motor in a car was the object of the invention. But Claim 1 detailed an arrangement in which the spring suspension was absent, and which, in the absence of the springs, turned out to be old. The plaintiffs contended that the Court should read the claim with the specification, and construe it as referring only to apparatus in which spring suspension was used. *Plimpton v. Spiller* was quoted as an authority for this, but without effect, the Court declining to amplify the claim in such a manner as to assist the plaintiffs. In *Electric Construction Co. v. Imperial Tramways Co.* (*supra*) the part left out of the claim in dispute (*i.e.* the spring suspension) was not an essential or necessary part of the motor and car; that is to say, they were complete, as a working combination, without the springs. Where the feature omitted from the claim is an essential and necessary part of the mechanism, or is obviously necessary to the continuity of an operation, the omitted feature may be read into the claim by the Court (*Tubes, Limited v. Perfecta Tube Co.*, 1902, 20 R. P. C. 77).

*Kynoch  
v. Webb.*

*Electric  
Construction  
Co. v.  
Imperial  
Tramways  
Co.*

*Tubes,  
Limited v.  
Perfecta  
Co.*

Where a claim, although susceptible of being construed to have been made in gross, is plainly subsidiary to the main invention, and intended to be used only in combination with it, lack of novelty as a separate and independent thing will not cause invalidity (*per* Farwell, J., in *Parker v. Satchwell*, 1901, 18 R. P. C. 299). In this case the learned Judge was guided by the decision in *British Dynamite Co. v. Krebs*, already referred to. The same conclusion was arrived at in the cases of *True Lamp Syndicate v. Bryant* (1908, 25 R. P. C. 461) and *Lynch et al. v. Phillips & Co.* (1908, 25 R. P. C. 694).

Examples  
where  
apparently  
bad  
subsidiary  
claim was  
upheld.

*Parker v.  
Satchwell.*

If any principle can be deduced from the decisions in *Plimpton v. Spiller* and *British Dynamite Co. v. Krebs*, it might be fairly stated to consist in this: That where it is undeniable that it would be absurd and ridiculous to suppose from the then state of common knowledge and from the contents of the specification that the patentee could have intended to claim *per se* something which is

Principles  
deducible  
from the  
cases.



notoriously old or not fit subject-matter, the Court may, in the exercise of its discretion and common sense, construe the faulty claim as being intended to include or be combined with the portion of the invention which is clearly novel and useful, and so cure the defect. But this benevolent view of a *prima facie* bad claim will not be taken when it is arguable that the patentee might reasonably have thought at the time that the subject-matter of the claim was sustainable.

Where a portion of the invention although novel is not specifically claimed, it will not be construed as claimed.

*British Motor Syndicate, Limited v. Andrews & Co., Limited.*

*A fortiori*, if two methods of carrying an invention into effect are stated in the specification, and only one method is claimed, the claim cannot be stretched to include the absent modification. In *British Motor Syndicate, Limited v. Andrews & Co., Limited* (1901, 18 R. P. C. 85), the plaintiff's specification referred to two methods of igniting the explosive mixture in the cylinder of a gas engine: First, by reduction of pressure at an efflux nozzle through the operation of a cock; and, secondly, by the alteration of the richness of the issuing jet of mixture, the result in either case being that the flame at the proper times had access to the contents of the cylinder. The first method only was claimed—viz., the variation of the velocity of outflow. Strenuous efforts were made to show that this claim was meant to include the variation of the richness of the outflow, and the argument succeeded in the Court of Appeal. But the House of Lords, in restoring the decision of Kekewich, J., held that the claim covered no more than it actually expressed. Referring to an observation of Romer, L. J., that the patentee had *intended* to cover the second modification in his claim, Lord Davey said: "With great respect to the learned Lord Justice, that is a *petitio principii*, and assumes the very point to be decided." The result was that the defendants, who were using the second but not the first method, were held not to have infringed.

Omitted part may be read with claim where essential to continuity of operation.

The Court of Appeal may have had this direction in mind when dealing with an apparently similar question in *Tubes, Limited v. Perfecta Tube Co.* (1902, 20 R. P. C. 77). Here the Court of Appeal held the patent bad because they thought there was no ground for inferring that the water cooling and expelling apparatus was *intended* to be included in the claim, there being no specific mention of such apparatus in the claim. But the House of Lords differed from them, and held that this apparatus, being an essential

step in the process, was intended to be included in the claim, and upheld the patent.

The apparent contradiction is, however, susceptible of explanation. In the "Gas Engine" case there were two independent modes of ignition, of which one only was claimed; whereas in the "Tubes" case the water cooling and expelling were essential and constant elements in the continuity of the process, which would have been incomplete without them.

It is presumed that no two claims are co-extensive (*per* Lord Esher, M. R., and Kay, L. J., in *Parkinson v. Simon*, 1894, 11 R. P. C. 493). Therefore, when a patent has several claims, these claims must be construed so as to give an effective meaning to each. But if a claim, when exhaustively construed, evidently covers and means no more than a preceding claim, what is its effect? The answer seems to be found in the dictum of Brett, L. J., in *Plimpton v. Spiller* (*supra*): "If you can say that the subsidiary claim cannot under any circumstances increase the monopoly of the patent, it seems to me that the subsidiary claim is unimportant, is futile, has no effect, and therefore does not raise any objection to the patent." It follows, then, that a claim which is practically a repetition of a preceding claim is to be treated as surplusage and of no effect.

The presumption is that no two claims are co-extensive.

Brett, L. J., on repeat or surplus claims.

Where a part of a combination is claimed separately and *per se*, that part by itself being useless and fulfilling no useful function, the claim is bad (*per* Smith, M. R., in *Wilson v. Wilson*, 1900, 18 R. P. C. 152).

Claim for separate part of combination useless by itself is bad.

Combinations, whether chemical or mechanical combinations of materials, or combinations of parts or motions in machinery, or combinations of methods in industrial processes, are all fit subject-matter for claims.

Combinations may be either of moving parts or of chemical agents.

When the invention refers to a combination of materials mechanically mixed or combined so as to produce a new concrete or a new alloy or a waterproof fabric, or where the combination is chemically effected so as to produce a new dye or agent, the proper claim to frame is for the special product made from the materials and in the manner described.

Combination of materials.

A claim is bad which claims a combination of two or more things in a mechanical combination, or it might be steps in a process, between which no functional or interacting combination exists. For example, in *Osmonds*,

*Limited v. Balmoral Cycle Co.* (1898, 15 R. P. C. 505), the patentee had claimed a chain-adjusting gear in combination with a footstep which was entirely distinct from and had no co-relation to the gear, Chitty, L. J., remarked that the patentee might as well have said "I claim that gear with a hat on a man's head."

Construc-  
tion of  
combina-  
tion claims.

The construction of combination claims so frequently occupies the attention of the Courts that the question requires more than a passing notice, especially as some misunderstanding still exists among authorities. For instance, it is often erroneously said that if a combination contains one or more subordinate integers which are new and useful for the purpose, and the patentee has claimed simply the combination, without any earmarking or setting aside of the new subordinate integers, the Court will help him against an infringer who has taken the new integers and combined them with an arrangement for the same purpose, which arrangement may be substantially different from and not a mere equivalent for the combination of the patentee. But Moulton, L. J., in *British United Shoe Co. v. Fussell* (1908, 25 R. P. C. 631) expressly stated that the dictum of Lord Campbell in *Lister v. Leather* (1875-8. 8 E. & B., at p. 1023), that a patent for a combination containing *inter alia* old parts gives protection to each part thereof that is new and material for the purpose, without any express claim for the said parts, was erroneous and is now over-ruled. A more modern case which is sometimes cited in support of this erroneous contention is *Proctor v. Bennis* (1887, 4 R. P. C. 333). It is true that in Proctor's specification and claim he had nowhere referred to or particularised the pivotted flaps as being the real essence of his invention. As Cotton, L. J., pointed out. "he had cut himself down to the combination—the combination of three, lumped together with another—namely, his flaps or doors." The defendant had varied the particular combination described by the patentee, but the actions and results were the same. The Court held that the variations did not in fact take the defendant outside of the plaintiff's combination, and the decision was founded upon the ruling that the combinations were substantially the same, not merely that the defendant had taken the substance of the plaintiff's invention. It is quite evident that had the

defendant taken this substance, or "pith and marrow" as it has been called, and incorporated it with a combination *undeniably* different, the plaintiff would probably not have succeeded. Now all of this trouble would have been saved and the action probably averted, had the plaintiff put in a separate and specific claim for the pivotted flaps as a new element for the purpose, irrespective altogether of the particular combination he had described. Not having done so the Court had to exercise its ingenuity to save him from the consequences of his omission.

New subordinate integer should be specifically claimed.

Combinations fall into two classes:—

*First.*—Where the combination is simply a more or less novel arrangement or re-arrangement of old parts or groups of parts, evincing invention in the combination and producing either an improved result or an old result in an improved or more expeditious or economical manner; such a combination as formed the subject-matter of the patents in *Curtis v. Platt* (1863-4, 35 L. J. Ch. 852) and *Nettlefolds v. Reynolds* (1892, 9 R. P. C. 270). In such a combination the patentee is tied down substantially to the arrangement he has shown and described.

Narrow type of combination.

*Second.*—Where the improved combination contains, in addition to old parts or groups, some element or group which is new and useful for the purpose of the invention independently of the combination actually described, as, for instance, in *Proctor v. Bennis* (*supra*).

Broader type of combination.

In the first place there is one general rule applying to both of these circumstances, viz., that the inventor should in each case claim the combination. Under the first head, viz., a combination of old parts, this is usually enough, because the combination and the combination alone is *ex necessitate* the invention, and there is no need to point out what is new and what is old. *Per* Moulton, L. J., in *British United Co. v. Russell* (1908, 25 R. P. C. 631): "If what you have claimed and the monopoly which you have obtained is for a combination, that combination is the novelty, and you have no obligation beyond accurately defining it. In my opinion that is the law as it now stands."

Rule in claiming narrow combination.

Rule in  
claiming  
broader  
combina-  
tion.

But under the second head, viz., where the combination includes new subordinate integers, the inventor should do more if he desires to secure independent protection for these new integers. He should, in addition to his claim for the combination, claim separately and independently the novel subordinate or subsidiary integers. If he does so, then an infringer who plucks the new element or group from the described combination, and re-clothes it in another substantially different combination of parts, will not do so with impunity.

Unluckily this counsel of perfection has not been followed in many existing specifications of valuable patents where the combination includes a novel element or essence or "pith and marrow." In many such combination patents, the inventor has simply claimed the entire combination without laying his finger on this "pith and marrow," and saying, "Mind you, this element is new for the purpose, and although I claim it as part of the described combination, I warn all the world that it can be used in other combinations for the same purpose, and I will consider anyone who so uses it an infringer." By not doing so the inventor leaves the world in doubt as to what is new and what is old in his combination, and although there is no obligation upon him to so differentiate (if he is content to secure the combination only) he pays the penalty if someone takes the really novel part of his combination and dresses it up in another combination which is undeniably different from his own.

Judicial  
comments  
on the plea  
of non-  
differentia-  
tion of old  
from new.

Fletcher  
Moulton,  
L. J., in  
*British  
United  
v. Fussell.*

It is this condition of dubiety which has given birth to the plea, so often used by a defendant, that the patentee has not distinguished the old from the new. Moulton, L. J., in *British United Co. v. Fussell* (*supra*) argued that this is an obsolete plea, and in reviewing the judgment of Lord Cairns, in *Clarke v. Adie* (1875, L. R., 2 App. Cas. 315), he sought to crystallise what Lord Cairns had said by the remark: "In other words, you may have a monopoly for these subordinate integers, *but they must be claimed.*" If by this the learned Lord Justice meant that these novel subordinate integers must be specifically ear-marked by separate and independent claims, then he went further than Lord Cairns, for nowhere does the latter say that "they must be claimed." What Lord Cairns did say in discussing whether new subordinate integers included in

a general combination were or were not entitled to independent protection, was simply that—"The invention must be described in that way, it must be made clear to ordinary apprehension, upon the ordinary rules of construction, that the patentee *has had it in his mind and has intended to claim* protection for those subordinate integers."

Lord Cairns  
in *Clarke*  
v. *Adie*.

So also in *Harrison v. Anderston Foundry Co.* (1876, 1 App. Cas. 574) Lord Cairns said (see page 578): "If it is clear that the claim is for a combination and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new. If, indeed, it were left open on the specification to the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, as it was held a patentee might do in *Lister v. Leather* (1857-S. S E. & B. 1604), then it might be necessary to see that the patentee had carefully distinguished these subordinate or subsidiary parts, and had not left it *in dubio* what claim to parts, in addition to the claim for combination, he meant to assert."

Lord Cairns  
in *Harrison*  
v. *Anderston*  
*Foundry*.

In other words in the absence of a specific claim for the disputed matter, the Court must resort to the body of the specification, and if the new subordinate integer is there found ear-marked or particularised in any such way as Lord Cairns contemplated, so as to make it obvious that the patentee "had it in his mind" that he regarded this integer as new and material, the Court will put such a gloze upon the general combination claim as will enable it to say—"Here is the 'pith and marrow' or substance of the combination, and we shall not allow the defendant to re-clothe it in an equivalent or different combination and then contend that he does not infringe." This is something considerably less than saying that the subordinate integer "must be claimed," and Vaughan-Williams, L. J., was apparently right in doubting whether it was true to say that, in a case where new subordinate integers are wrapped up in a combination ascertained in a specification which claims the whole combination as new, "there is no obligation to distinguish what is new from what is old." At least, although it may be as Moulton, L. J., says, "that

Vaughan-  
Williams in  
*British*  
*United*  
v. *Funnell*.

this objection has become merged in others," the plea saddles the plaintiff with the onus of showing that it is so distinguished in his specification. Probably what Moulton, L. J., meant was that a fair construction of the body of the specification must enable the Court to credit the general combination claim with the intention to ear-mark the new subordinate integer, which would thus be in that sense "claimed." This is borne out by the other parts of his judgment, and notably where he said—"I should say that a man must distinguish what is new from what is old *by* his claim, but he has not got to distinguish what is new from what is old *in* his claim."

Differentiation of new from old *by* claim but not *in* claim.

Of course, it is always open to the Court to hold (where the defendant has taken the substance of the combination claim) that the defendant's combination, though alleged to be different, is substantially the same (*Proctor v. Bennis, supra*; *British United Co. v. Thompson, 1904, 22 R. P. C. 177*; *Linch v. Phillips, 1909, 26 R. P. C. 389*). But as in combinations of old parts it has been held that there is no room for the doctrine of mechanical equivalents (*Curtis v. Platt, supra*; *Nettlefolds v. Reynolds, supra*; *Birch v. Harrop, 1896, 13 R. P. C. 615*), it would be dangerous to depend upon the same rule not being held applicable to combinations containing one or more unclaimed new subordinate integers. Whether the Court would construe the claim favourably to the patentee would probably depend upon the importance of the integers as established by evidence.

Dictum of Moulton, L. J., on duties of patentee.

The duties of a patentee in preparing his specification and claims are thus outlined by Moulton, L. J., in *British United Co. v. Fussell (supra)*: "He must first make a useful invention; he must next, with the fullest *bonâ fides*, describe to the public the best way of carrying out that invention; and, thirdly, he must leave the public in no doubt whatever as to what constitutes the invention which he claims as his monopoly. The performance of these things completes his duty to the public."

Rules for the preparation of claims.

The following rules may be useful as guides in the preparation of claims:—

- (1) The claims should not embrace more than the actual invention, and should specifically claim all that is novel.

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- (2) A claim should be expressed in the clearest and most concise language; should refer unmistakably to the invention described in the specification; and should not contain vague and speculative phrases.
  - (3) If the invention discloses a new principle, the claim should be for the principle, coupled with means for carrying it into effect, even when such means are obvious and involve no invention.
  - (4) If the invention relates to a new thing or product, the claim should be for the product as described, and the method of producing it should also be claimed if that also involves invention and is novel.
  - (5) In combination claims, if the invention consists purely of a combination of old parts, the combination only should be claimed. If the combination contains new parts, or parts new as applied to the purposes of the invention, in addition to the combination claim, these parts also should be separately claimed for the indicated purposes.
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## CHAPTER XV.

## OPPOSITION TO GRANT OF PATENT.

Provisional Specification a secret document.

Advertisement of acceptance of Complete Specification invites opposition to grant of patent.

Publication of specification.

Effect of examination system on oppositions.

Persons entitled to oppose.

IT has already been said that the Provisional Specification during the period of provisional protection is a secret document. Its tenor is unknown to the public, and opposition thereto is not contemplated by the Act. It has also been said that when the Complete Specification has been filed, examined, and accepted, the fact of acceptance is advertised in the *Official Journal*. This advertisement is accompanied by a notification that all persons interested in opposing the grant of a patent on the indicated application may, at any time within two months from the date of the *Journal*, give notice of opposition. At the same time the specification and drawings are thrown open to public inspection at the Patent Office, and the printing of the specification is usually effected within three weeks after acceptance.

In all cases the specification is published and placed on sale in ample time to give an intending opponent, not resident near the Patent Office, every opportunity of examining it at his leisure, before filing his notice of opposition.

There is no doubt that the system of examination as to novelty now in force has affected and will materially affect cases of opposition to the grants of patents. The cutting down of specifications to the actual invention concerned, and the introduction of general statements as to public knowledge, with, if need be, special references to prior patents, are enforced by the Comptroller in such a manner as to satisfy many persons interested, who would otherwise have entered opposition.

It now becomes necessary to discuss the questions of who may oppose a grant; and upon what grounds opposition can be based.

The words of the Act (Section 11) are that "any person" may oppose, but it has now been finally settled by the

Court of Appeal in *Reg. v. Comptroller, ex parte Tomlinson* (1899, 16 R. P. C. 233; 1899, 1 Q. B. 909), that only those having a real interest in a prior patent or some other substantial interest as will be hereinafter defined, are entitled to oppose. The grounds of opposition are as follows:—

*Reg. v.  
Comptroller,  
ex parte  
Tomlinson.*

- (a) That the applicant obtained the invention from the opponent, or from a person of whom he is the legal representative.
- (b) That the invention has been claimed in any Complete Specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent.
- (c) That the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the Complete Specification.
- (d) That the Complete Specification describes or claims an invention other than that described in the Provisional Specification, and that such other invention forms the subject-matter of an application made by the opponent in the interval between the leaving of the applicant's Provisional Specification and the filing of the Complete Specification.

Grounds of  
opposition.

The expression "legal representative" in Clause (a) (where the opponent alleges that the invention was obtained from him) means executor or administrator, and excludes an assignee even where the assignment purports to convey the "invention," the subject-matter of the application or patent (*Spiel's Patent*, 1888, 5 R. P. C. 281; *Edmund's Application*, Griff. P. C. 281; *Gascoine's Patent*, 1909, 27 R. P. C. 78).

Clause (b) gives a wider ground than the corresponding Clause in the Act of 1883, and includes specifications coming under the extended search by virtue of Section 8 of the Act.

Clause (c) is new.

Person entitled to oppose may quote other patents besides his own.

An opponent once entitled to oppose under the second ground, Clause (b), may include in his grounds of opposition not only the prior specification or specifications in which he may be personally interested, but also any other patents or specifications in which he has no beneficial or personal interest (see *Stewart's Application*, 1896, 13 R. P. C. 627).

Opponent on first ground cannot include patents in which he has no interest.

But where a grant is opposed upon the ground that the applicant has obtained the invention from the opponent, and also upon the ground that the invention has been patented on an application of prior date, the opponent must be able to show an interest in the prior patent, or one of the prior patents, upon which his second ground of opposition is based (*J. & J's. Application*, 1902, 19 R. P. C. 555).

Notice of opposition.

The notice of opposition, Form 8, which bears a ten shilling stamp, must set forth the grounds upon which the opponent intends to rely. The Patent Rules of 1908 provide that the notice must be signed by the opponent, be accompanied by an unstamped copy, and give an address for service in the United Kingdom. If the ground of opposition or one of them is that the applicant's invention has been claimed in any Complete Specification, the number and date of the specification should be given.

Security for costs.

If the opponent is out of the jurisdiction, the Comptroller may order him to give security for costs, and if he does not do so, the opposition may be treated as abandoned (Section 39, Sub-section 2).

Supplementary statement with notice of opposition.

Where the person giving notice of an opposition recognises that he cannot insist upon the refusal of the grant, but wishes merely that the specification should be amended by disclaimer or limitation, or otherwise, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect, indicating as far as can conveniently be done, the general nature of the amendments desired, and the portions of the earlier specifications, if any, relied upon as necessitating such amendments (Rule 40).

Insufficient description.

Similarly, when the ground of opposition is that the nature of the invention is not sufficiently or fairly described, the opponent should point out in what respects the description is insufficient or unfair. So long as the notice of opposition undeniably places the applicant in

possession of the real grounds of opposition, quibbling objections to mere informalities in the notice will not affect its validity. Even after the expiry of the two months, the notice of opposition may be amended so as to include other specifications as grounds of opposition (see "Notes of Rulings by Comptroller," 1910 (C), 27 R. P. C., Appendix II.), and the Comptroller has power, under Rule 108 of the Patents Rules, 1908, to amend generally either before or, where there are strong reasons for allowing it, at the hearing (see *re Airey*, 1888, 5 R. P. C. 348; *re Lake*, 1887, Griff. A. P. C. 35; Good. O. C. 10; *re Pawcett*, 1889, Good. O. C. 10; *re Daniel*, 1888, 5 R. P. C. 413; Good. O. C. 9; *re Welch*, Good. O. C. 10; *re Jones*, Good. O. C. 11; Griff. A. P. C. 33). However, in the "Note" above referred to, the Comptroller takes care to say, "I desire in no way to weaken the Rule which calls for the opponent's case at the earliest possible moment. I am strongly of opinion that this should continue to be the practice insisted on, and if the opponent desires any amendment which will prejudice or inconvenience the applicant, he will have to pay the penalty by costs and an adjournment at his expense in proper cases."

Practice in amending defects in notice of opposition

On receiving the notice of opposition the Comptroller transmits the unstamped copy to the applicant. If the opponent intends to follow up his notice of opposition by declarations in support, which might or might not be necessary, he must do so within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification. On leaving these declarations at the Patent Office he must send copies of them to the applicant.

Declarations by opponent in support of opposition.

Within fourteen days from the date of receiving the opponent's declarations, the applicant may leave declarations in answer, delivering also copies to the opponent; and within a further period of fourteen days the opponent may leave declarations in reply, again sending copies to the applicant. These last declarations must be confined strictly to reply. In some cases further declarations or rejoinders might be filed by the parties, but only by special leave of the Comptroller, and in most instances the declaratory evidence is closed by the opponent's reply.

Declarations by applicant in support of application.

Declarations by opponent in reply.

Time for filing declarations may be extended; but never to opponent who alleges fraud.

Declarations should be concise.

Declarations not always necessary.

Declarations essential in opposition under Clause (a).

Parties may cite prior specifications or public knowledge to limit claims.

The discretionary power of the Comptroller to extend the time for filing declarations, or to give leave for the filing of additional declarations or evidence, is, by Rule 41 and by special direction of the Law Officers, never exercised in favour of an opponent who alleges that the applicant has obtained the invention from him—that is, where fraud is either asserted or inferred. Declarations should be as few and concise as possible: otherwise the Comptroller or the Law Officer may mulct the diffuse declarant in costs (*Brand's Application*, 1895, 12 R. P. C. 102).

As to the advisability or non-advisability of filing declarations, it may be said that this depends greatly on the grounds of opposition. Where the grounds are simply a reference to a prior specification, declarations are seldom necessary, as the question will, after all, be decided upon a comparison of the two specifications. But where the grounds are that the applicant obtained the invention from the opponent, or wherever fraud is alleged, declarations are absolutely necessary as evidence in support. If no evidence under this head is filed within the time stated, then under Rule 41, the opposition is deemed to have been abandoned. Under Rule 109 an enlargement of time for filing evidence other than that referred to in Rule 41 may be obtained.

Where the grant of a patent has been opposed on the ground that the invention has already been claimed in a British specification, either party may, under Rule 47, produce any evidence of public knowledge or prior patents or specifications which will tend to limit the ambit of the opponent's or applicant's specification. But he does so at the risk of having those publications directed against himself, for the Comptroller will not disregard any matter that is in evidence before him, simply because it injures the party who brought it to his notice.

Thus, in *re Jones* (Griff. A. P. C. 33; Good. O. C. 21), the applicant sought to minimise the scope of the opponent's patent by citing several specifications prior to the opponent's. The opponent objected, but the Law Officer intimated that it was material that he should be informed of the state of public knowledge; and such is now the well-established practice before the Comptroller and Law Officer. Without

pretending to try the validity of the opponent's patent, it is the practice to admit all anticipatory specifications and publications quoted by the applicant, for the purpose of seeing from what standpoint of public knowledge the opponent's patent must be regarded. Notice of these prior publications should be given to the opponent and to the Comptroller at least five days before the hearing, or copies might be attached as exhibits to the applicant's declarations, if such are filed. All models or samples referred to in the declarations of both sides should be constituted exhibits. But merely illustrative samples or specimens of the inventions under consideration, or of matters imputed in the declarations, may be produced and shown to the Comptroller or Law Officer at the hearing to assist explanations. Thus, in *re Lancaster's Application* (Griff. P. C. 293; Good. O. C. 21), the applicant sought to demonstrate the action of his spring piston packing at the hearing to the Law Officer, by means of a specimen. The opponent asked that this should be barred, but the Solicitor-General (Gorst) said it assisted him very much to see the specimen, and he would look at it to better his understanding of the drawings.

Exhibits.

Illustrative samples.

*Re Lancaster* also decided the point that an opponent may oppose on the specification of an expired patent.

Opposition may be founded on expired patent.

When the evidence is complete, one of the parties may apply for a hearing, and the Comptroller appoints a time, at least ten days' notice of the hearing being given to the parties. A hearing fee of £1 is payable by each side. At the hearing, the parties themselves may appear, or their agents or solicitors, or they may be represented by counsel. As a rule the applicant begins, the opponent follows, and the applicant replies. This procedure is not without inconvenience in many cases, as the opponent is practically the plaintiff, and the applicant may have to open a good deal in the dark as to what parts of his specification he may be called upon to defend. Under such circumstances it is clearly advisable that the opponent should open and point out his objections in the first instance. The applicant may then concentrate his attention upon the real issues, and much time might thus be saved. Where the *onus probandi* lies on the opponent—as, for example, where the applicant is charged with fraud, or with obtaining

Hearing before Comptroller.

Opponent confined to grounds of opposition in notice

the invention from the opponent—the opponent should begin, although in practice, the Comptroller is not accustomed to vary the order of beginning, even where fraud is alleged. At the hearing, the opponent must confine himself strictly to the grounds of opposition stated in his notice. Fresh grounds of opposition cannot be sprung without notice by the opponent upon the applicant (*re Bailey*, Griff. P. C. 269; Good. O. C. 25; but see also the Comptroller's Note, 1910 (c)). If the Comptroller is made aware at the hearing, by the Examiner, of an anticipatory specification not cited by the opponent, he has discretion to use it against the applicant (*Hughes & Kenning's Application*, 1910, 27 R. P. C. 281).

Notice of additional publications.

According to Rule 47 of 1908, if either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition or in any statutory declaration filed in the case, he must give five days' notice to the other party and to the Comptroller of his intention, and must specify the publication to which he means to refer.

Evidence *vis à vis*.

Under Section 77 of the Act, the Comptroller may take evidence *vis à vis* in lieu of or in addition to the declarations or allow any declarant to be cross-examined on his declaration. In requiring such attendances and taking such evidence on oath the Comptroller is in the same position as an Official Referee of the Supreme Court.

Decision.

The Comptroller, who is generally assisted by one or two of the Chief Examiners, seldom gives his considered decision at the hearing, but notifies the parties in writing. The attendance of the parties or their representatives at the hearing before the Comptroller is not an absolute necessity. If either should not desire to be heard, he should let the Comptroller know this as soon as possible. But either of the parties may attend in the absence of the other, in which case the Comptroller will hear him. After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, the Comptroller will decide the case and notify his decision to the parties. (See Rule 47.)

Comptroller's power to order costs.

Under Section 39 of the Act, the Comptroller has now power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a Rule

of the Court. Should these costs not be paid, execution cannot be issued under the Comptroller's order, until it has been made a Rule of the Court. The usual procedure is for the party in whose favour the order is made to issue a specially endorsed writ and obtain judgment under Order XIV; or he might apply to the specially appointed Judge (Parker, J.) and have the order drawn up by the Chancery Registrar.

Costs' order  
may be  
made a  
Rule of  
Court.

If either or both of the parties should be dissatisfied with the Comptroller's decision, appeal can be made to the Law Officer. Notice of such appeal must be filed at the Patent Office within fourteen days from the date of the decision.

Appeal to  
Law Officer.

The Rules regulating the practice and procedure on appeals to the Law Officer are as follows:—

Rules  
regulating  
appeals to  
Law Officer.

1. When any person intends to appeal to the Law Officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such his intention.

2. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so what part, of such decision.

3. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the Chief Clerk, Law Officer's Department, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

4. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the Chief Clerk, Law Officer's Department, all the papers relating to the matter of the application in respect of which such appeal is made.

5. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the Law Officer.



6. Seven days' notice at least of the time and place appointed for the hearing of any appeal shall be given by the Chief Clerk, Law Officer's Department, unless special leave be given by the Law Officer that any shorter notice be given.

7. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

8. The evidence used on appeal to the Law Officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given except with the leave of the Law Officer upon application for that purpose.

9. The Law Officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the Law Officer there is good ground for not making such order.

10. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

11. Where the Law Officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

12. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the Law Officer, the party to whom such costs are to be paid may apply to the Law Officer for an order for payment under the provisions of Section 40 of the Act.

13. All documentary evidence required, or allowed by the Law Officer to be filed, shall be subject to the same regulations in all respects as apply to the procedure before the Comptroller, and shall be filed in the Law Officer's Department.

14. Any notice or other document required to be given to the Chief Clerk, Law Officer's Department, under these Rules may be sent by a prepaid letter through the post.

The proceedings before the Law Officer amount to a rehearing of the case. When the Comptroller has decided partly in favour of the applicant and partly in favour of the opponent, cross notices of appeal should be filed if each intends to question that part of the decision which is in favour of the other.

Appeal or  
rehearing.  
Cross  
appeal.

When notice of appeal has been given, the Comptroller transmits all the papers in the case to the Law Officer's clerk. When the date of the hearing has been appointed, seven days' notice is given to the parties and to the Comptroller.

The hearing before the Law Officer is limited to the points raised in the notice of appeal. The whole or a part only of the Comptroller's decision may be questioned; and if the party upon whom the appeal is served wishes to do so, he may question other parts of the Comptroller's decision by counter-appeal. The evidence before the Law Officer must be the same as that used before the Comptroller. Under the old Rules further evidence was admitted at the hearing of the appeal as to matters which had occurred or come to the knowledge of either party since the date of the decision appealed against. But the new Rules are silent upon any such indulgence as a matter of right, and the admission of any fresh evidence is now left to the discretion of the Law Officer (Rule 8). In *re Bailey's Patent* (Griff. P. C. 269; Good. O. C. 25) Davey, S.-G., decided that the rule related to evidence pure and simple, and refused to allow the opponent to put in the specification of a prior patent which had come to his knowledge since the hearing. The Law Officer held that such was not evidence, but an additional ground of opposition.

Proceedings  
before Law  
Officer.

Rules as to  
further  
evidence.

Further-  
considera-  
tion of  
persons  
entitled to  
oppose.

The question of who is entitled to oppose deserves at this point to receive some further consideration. Section 11, Sub-section 1, of the Act, when dealing with opposition *before the Comptroller*, says "any person" may oppose. Of course, as regards "any person" opposing on the first and fourth grounds of opposition—viz., that the applicant had obtained the invention from the opponent, or that the applicant's Complete contained something which the opponent had protected between the dates of the applicant's Provisional and Complete, the opponent's *locus standi* is unquestionable. But this is not so clear when the second and third grounds of opposition are considered—viz., that the invention has already been claimed in a British specification, or that the invention is insufficiently or unfairly described. Seeing that the expression "any person" is unqualified in the first sub-section, it might have appeared to be open to any person to oppose on this ground. Sub-section 3 of the same section, which relates to appeals to the Law Officer, makes it clear that any person applying to be heard by the Law Officer must be some person, to quote the sub-section, "in the opinion of the Law Officer entitled to be heard." But no such qualification appears to attach in terms to opponents before the Comptroller.

Assignee of  
or manufac-  
turer under  
lapsed  
patent.

The same terms were used in the corresponding section of the Act of 1883 and the matter was soon raised when that Act came into force. In *re Glossop* (Griff. P. C. 285; Good. O. C. 12), where the opponent was the assignee of and a manufacturer under a lapsed patent, Herschell, S.-G., held him entitled to be heard, and, on the general question of *locus standi*, the learned Law Officer intimated that in his opinion it was not competent for *any* member of the public to oppose a patent.

Patent  
Agent on  
behalf of  
patentee.

In *re Heath and Frost* (Griff. P. C. 288; Good. O. C. 13) it was held that a Patent Agent could not oppose in his own name on behalf of the grantee of a prior patent.

Grantee of  
expired  
patent.

In *re Lancaster* (Griff. P. C. 293; Good. O. C. 14) it was decided that the grantee of a prior expired patent could oppose.

Manufac-  
turer under  
prior  
patent.

In *re MacEvoy* (1888, 5 R. P. C. 285; Good. O. C. 14) the opponent was a manufacturer under one of the prior patents relied on in the notice of opposition, but Clarke, S.-G.,

held him not entitled to oppose. But see now the more recent case of *re Meyer* (1899, 16 R. P. C. 526).

In *re Bairstow* (1888, 5 R. P. C. 286; Good. O. C. 15) the opponent, who alleged he was about to manufacture under the prior patent, was held not to have sufficient interest to entitle him to oppose.

Persons about to manufacture under prior patent.

In *re Hill* (1888, 5 R. P. C. 599; Good. O. C. 15) a licensee under a prior patent was held entitled to oppose.

Licensee.

In *re Everitt* (Griff. A. P. C. 28) a French patentee who, under the Convention, had his British application antedated, to be of the same date as his prior French patent, and thus got in front of an English applicant, was held not entitled to oppose.

Foreign grantee of antedated patent under Convention.

In *re Bailey* (Griff. P. C. 269) decided that a person having merely prior provisional protection cannot oppose. But *re L'Oiseau and Pierrard* (Good. O. C. 16, 75; Griff. A. P. C. 36) decided that an applicant whose Complete Specification has been accepted is in a position to oppose, and Section 11, Sub-section 1, Clause (b), now specifically provides for this.

Applicant under provisional protection.

Concurrent applications.

In *re Stewart* (1896, 13 R. P. C. 627) an important advance was made when Webster, A.-G., decided that in respect of the qualification of the opponent there was no distinction between the Comptroller's Court and that of the Law Officer, and that the persons entitled to be heard in opposition before the Comptroller are the same as those entitled to be heard on appeal before the Law Officer.

Comptroller's and Law Officer's Courts alike in deciding who is entitled to oppose.

Finally, in *Reg v. Comptroller, ex parte Tomlinson* (1899, 16 R. P. C. 233), the Court of Appeal approved of the ruling in *re Stewart*, and decided further that a member of the public having no interest is not entitled to oppose the grant of a patent on the ground merely that the invention has been patented by another person in this country on an application of prior date; and, *per Smith, L. J.*, that the Law Officer is also the final authority to decide whether a person is entitled to be heard before the Comptroller or Law Officer in opposition to a request for leave to amend a specification.

Ruling in *Reg. v. Comptroller, ex parte Tomlinson.*

Law Officer the final authority.

Thus, the decision as to who is the proper person to oppose either the grant of a patent or the amendment of a specification lies with the Law Officer, and his decision is final. The cases already given show upon

In deciding who is entitled to oppose, the Law Officer will consider each case on its merits.

But an interest of some sort must be apparent.

what points the Law Officer has pronounced, and by these the Comptroller is now guided. But it would be useless to say that the class of persons entitled to oppose can even now be exhaustively specified. Special circumstances will always be considered. Thus, in *re Meyer* (1899, 16 R. P. C. 526), which was the application forming the basis of the proceedings in *Reg v. Comptroller, ex parte Tomlinson*, the opponent (although he had no actual beneficial interest in the prior patents cited in opposition) nevertheless succeeded in obtaining a hearing before the Law Officer. The facts were that the opponent had undertaken the manufacture of looms in accordance with one of the prior patents (A), in virtue of which he opposed. But finding he could not proceed without a licence he stopped further work, and an earlier patent (B), prior to (A), was brought to his notice, which, as well as the patent (A), he alleged to cover the subject-matter of the new patent (C), which he opposed. Webster, A.-G., held that he had established sufficient interest to entitle him to oppose, and laid down the rule that "where there has been a *bona fide* attempt to carry out the invention sought to be protected, by the person who desires to be heard in opposition, and proof is shown that he may be damnified or affected by the application which he desires to oppose, he is entitled to be heard."

A person who has attempted to carry out commercially the applicant's invention may oppose.

It has already been pointed out that a person having a right to oppose under Clause (b), viz., on the ground that the invention sought to be patented has already been claimed in the Complete Specification of some prior British patent or application, may include in his opposition other specifications in which he has no personal interest. It is obvious that he may also include Clause (c) as a ground of opposition, viz., that the nature of the invention is not sufficiently or fairly described. But a person claiming a *locus standi* under Clause (a), viz., that the applicant had obtained the invention from him, could not include Clause (b) unless he had, in fact, some personal or beneficial interest in one at least of the specifications he relied on as anticipating the applicant (*J. & J.'s Application*, 1902, 19 R. P. C. 555).

Opponent must show that invention has been claimed.

Opposition cannot be founded upon mere description in a prior specification. The invention must be *claimed* (*re von Buch*, Griff. A. P. C. 40; Good. O. C. 17).

The Law Officer usually allows a sum for costs to the successful party. The average allowance is from five to ten guineas, but considerably larger sums have been awarded where costs have been heavy. An appellant who withdraws, without reason given, before the hearing, is liable to pay costs (*re Knight*, Griff. A. P. C. 35; Good. O. C. 26).

Costs on withdrawal.

Proceeding now to the grounds of opposition, the first is—That the applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.

First ground of opposition: Invention obtained from applicant.

This ground of opposition only holds good in respect of transactions in this country. If the information has been acquired abroad, and no fraud has been practised within the jurisdiction, the applicant being the first importer is, according to the Statute of Monopolies, the true and first inventor (*re Edmunds*, Griff. P. C. 281; Good. O. C. 27; *re Lake*, 1888, 5 R. P. C. 415; Good. O. C. 28; *re Higgins*, 1891, 9 R. P. C. 75; Good. O. C. 33, Appendix; *re McNeil*, 1907, 24 R. P. C. 680). The phrase “obtained from the opponent” means knowingly, but not necessarily fraudulently, obtaining from him, either directly or through his agent. Where the invention has been handed on through intermediate parties, so that the applicant has received it in entire innocence of the fact that it owed its origin to the opponent, it cannot be said that the applicant has obtained the invention from the opponent (Comptroller’s Note, 1910 (A), 27 R. P. C., Appendix I.). There must be some connection known and recognised by the law between the applicant and opponent, and not merely a casual connection in which no proof of knowledge or notice is shown against the applicant, and no agency or fiduciary relationship exists between him and the opponent.

Only transactions in this country considered.

Invention must have been knowingly obtained from opponent.

In supporting an allegation that the applicant has obtained the invention from the opponent the evidence requires to be very strong, especially if fraud is alleged.

Neither the Comptroller nor the Law Officer will stop a patent except upon evidence so conclusive that in their estimation no jury could fail to find for the opponent (*re Stuart*, 1892, 9 R. P. C. 452). There have been cases following the precedent laid down by Lord Cranworth in *re Russell* (2 De G. & J. 130), where the facts were such as to lead the Law Officer and Comptroller to issue

Test of evidence in fraud.

Patent might be issued jointly to applicant and opponent.

the patent to a trustee on behalf of both parties, or jointly to the applicant and opponent, as, for instance, in *re Luke* (Griff. P. C. 294), *re Garthwaite* (Griff. P. C. 284), and *re Evered and Ottway* (Griff. P. C. 279).

Declarant  
may be  
cross-  
examined  
before  
Comptroller and  
Law Officer.

The old Rule, which gave the Comptroller power to request or allow a declarant to attend at a hearing, was abandoned at the passing of the present Act. Section 77 now empowers the Comptroller, in any case in which he thinks proper, to take evidence *virâ voce* in lieu of or in addition to evidence by declaration, or to allow any declarant to be cross-examined on his declaration. In the matter of requiring the attendance of witnesses, and taking evidence on oath, the Comptroller is in the same position in all respects as an Official Referee of the Supreme Court. This evidence can, of course, be used in the appeal to the Law Officer or the Law Officer may, on the request of either party, order the attendance at the appeal of any declarant or witness, for further examination or cross-examination.

Master and  
servant.

*Re Heald.*

The relationship of master and servant does not give the master any rights in the servant's invention, even if the servant works out the invention in his master's time and with his master's tools. Thus, in *re Heald* (1891, 8 R. P. C. 429; Good. O. C. 25), Clarke, S.-G., said: "I am not aware of any authority which lays down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it." But where an inventor employs a workman to work out an invention, improvements in detail invented or suggested by the workman become the property of his employer, and the workman cannot afterwards take out a patent for these improvements. This was very plainly stated by Davey, S.-G., in *re David and Woodley* (Griff. A. P. C. 26). Said the Solicitor-General: "I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, these suggestions are the property of his employer, and the workman cannot afterwards take out

*David and  
Woodley.*

a patent for them." In the later cases of *Richmond v. Wrightson* (1904, 22 R. P. C. 25), and *re Smith's Patent* (1904, 22 R. P. C. 57), the same principle was upheld. The relationship of master and servant in the evolution of an invention was also considered in the revocation case of *Marshall and Naylor's Patent* (1900, 17 R. P. C. 553). In this case the petitioner was a workman in the employment of a company of which the two patentees were directors. The petitioner had been asked by one of the patentees to invent a tap which, by the introduction of steam, would give hot, warm, or cold water as desired. The petitioner did so, and perfected the invention. For his services he was paid £10. The Court held the invention was the petitioner's, and that the patentees had no right to the patent, which was revoked.

*Marshall and Naylor's Patent.*

When the opposition is based upon the second ground (*b*). viz., that the invention has been claimed in a Complete Specification for a British patent which is or will be of prior date to the patent, the grant of which is opposed, the similarity between the inventions must be very close to stop the patent. All the reported cases show that in most instances of refusal to seal a patent, the inventions have been practically identical, so that it would serve no useful purpose to instance specific causes of refusal.

Second ground of opposition: On prior patent.

When the person giving notice of an opposition does not claim that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect indicating, as far as can conveniently be done, the general nature of the amendments desired, and the portions of the earlier specifications (if any) relied upon as necessitating such amendments (Rule 40).

Limiting statement by opponent.

When the differences between the interfering inventions are at all appreciable, or if sufficient cause is shown to make it a matter of reasonable doubt, the patent is usually granted. For instance, in *re Tomming* (Griff. P. C. 277), although, as *Judge A.C.*, said, "the two inventions were very nearly the same," the patent was sealed. The Comptroller and the Law Officer are guided in this lenity by the consideration that from the refusal of a patent by the Law Officer there is no appeal, and that if the applicant's

Resemblance to prior patent must be very close.



patent turns out to be really an infringement of the opponent's, the opponent has his remedy in a Court of Law, or by petition for revocation.

Validity of  
opponent's  
patent  
never con-  
sidered.

The question of the validity of the opponent's patent is never considered (*per* Webster, A.-G., in *re Newman*, 1888, 5 R. P. C. 271). Clarke, S.-G., in *re Haythornthwaite* (1889, 7 R. P. C. 70), held that the applicants could not be allowed to contend that the opponents' patents were bad for disconformity; or as in *re Thornborough and Wilks* (1896, 13 R. P. C. 115), that the opponent's patent was invalid from prior user.

Disclaimer  
sometimes  
required in  
applicant's  
specifica-  
tion.

But, although the opponent may not succeed in stopping the applicant's patent, he may, nevertheless, compel the insertion in the applicant's specification of a short paragraph indicating generally, if need be, the state of the art at the date of the application, or, it might be, disclaiming generally such parts of the invention as the hearing may have shown to be claimed in the opponent's or other prior patents, but without any specific reference to the opponent's name or patent. Or if the circumstances warrant it, and especially if the opponent's is a pioneer or master patent, the applicant may be compelled by the Comptroller or Law Officer to insert in his specification a special reference by name and number to the opponent's patent, with an intimation that he disclaims anything covered thereby.

Special  
reference to  
master  
patent.

Object of  
disclaimers  
to protect  
the public.

These disclaiming clauses, and particularly the special references, are seldom pleasing to applicants, and special disclaimers were formerly difficult to obtain from the Comptroller or Law Officer. As was said by Webster, A.-G., in *Stell's Application* (1891, 8 R. P. C. 235), the true principles upon which the Law Officers act are—First, that there must be no repetition of the claim to the earlier invention in the later patent; and, secondly, it must be clear that the public are not misled. Therefore, in many cases a slight alteration in the specification or claim, or a short reference to the then existing state of the art, without anything of the nature of a disclaimer, may be sufficient to meet the opposition. Although no doubt the opponent is apt to regard the insertion of a special reference to his name and patent in the applicant's specification as a personal advantage gained, the Law Officer has been careful in a number of cases to lay down that these

Slight  
alteration  
may serve  
in lieu of  
disclaimer.

disclaimers are not inserted solely in the interests of either opponent or applicant, but chiefly to protect and inform the public (*re Lorraine*, 1888, 5 R. P. C. 142; Good. O. C. 35; *re Newman*, 1888, 5 R. P. C. 279; *re Hill*, 1888, 5 R. P. C. 599).

The insertion of a general disclaiming clause, and even of a special reference, besides being a protection to the public, is rather an advantage than otherwise to the applicant (*per Webster, A.-G., in re Guest and Barrow*), and in proper cases is readily ordered and inserted. But, as already observed, the special reference is sparingly used. As was said by Webster, A.-G., in *re Guest and Barrow* (1888, 5 R. P. C. 313; Good. O. C. 38): "I have never considered that a prior patentee has any right to be specially named unless the applicants are willing to name him, and unless it is clear that there is no other publication except the one that is mentioned." But under present practice the general applicability of this rule is likely to be largely relaxed unless the applicant is willing to make such concessions as will make special references unnecessary.

General disclaimers.

When a special reference may be ordered.

One of the principles still governing the insertion of such special references is that if the applicant's invention is no more than an improvement upon the prior patent, and is in no sense an independent invention (as in *re Hoskins*, Griff. P. C. 291), a special reference will be ordered. Webster, A.-G., practically adhered to this rule in the case of *re Newton* (1899, 17 R. P. C. 123), although in that case, in view of certain circumstances, he did not insist on a specific reference to number, name, and date, but adopted the middle course of requiring a disclaimer following the exact terms of the opponent's claim. The learned Law Officer said: "I have often laid down the rule as to cases in which I think specific references are right—viz., where there is substantial identity between the fundamental parts of the two inventions, but a difference which can only be justified on the ground of improvement." So also if the opponent's patent is a pioneer or master patent, or describes and claims something the like of which has not been done before, a specific reference is inserted. Webster, A.-G., in *re Hill* (1888, 5 R. P. C. 599), said: "It is not prudent or desirable to insert special references to particular prior patents unless there is,

Where applicant's invention is an improvement on opponent's.

Where opponent's is master patent.

Alleged master patent may be narrowed by references to prior specifications, &c.

But the mere validity of opponent's patent cannot be gone into.

practically speaking, no question that the earlier patent is what I may call a master patent." In construing the alleged master patent of the opponent, although prior specifications and other prior publications and evidence of common knowledge may be referred to by the applicant for the purpose of limiting the opponent's claim and rebutting the contention that it is a master patent, instances of alleged prior user or disconformity or other causes of invalidity will not be considered. The gist of the remarks of Finlay, S.-G., in *re Thornborough and Wilks* (1896, 13 R. P. C. 115), is that even if it be alleged that to read the opponent's patent so widely as to constitute it a master patent would invalidate it in a Court of Law, that contention will not avail to protect the applicant from a special reference. If the applicant, confronted with what is alleged to be a master patent, wishes to limit the apparently general nature of the opponent's claim, by reference to publications other than British specifications, he may do so. But to render these available he must give at least five days' notice to the Comptroller and to the other party, and specify, with details, each publication to which he intends to refer. Prior to the present Act it was the practice to admit such publications, and now Rule 47 of the Patents Rules, 1908, specially provides for their introduction.

Opponent alleging master patent must support by evidence.

When an opponent represents his patent to be a master patent "it is his duty," said Webster, A.-G., in *re Southwell and Head* (1899, 16 R. P. C. 361), "to support such a claim before the Comptroller by evidence, unless the parties agree as to the existing state of knowledge." The present practice is for the opponent in such a case to file a declaration that a careful search has been made among patent records, and that nothing has been found to destroy the opponent's claim to a master patent. If anything is found in the slightest degree affecting such a claim, it must be produced to the Comptroller. Such a declaration may be made by the opponent himself if he made the search, or by some skilled person who made the search on his behalf. The applicant may, of course, make an independent search, and produce whatever evidence he may find to rebut the contention that the opponent's is a master patent.

But even when all this is done the limits of the opponent's patent may be deducible from the claim, for a claim originally intended to be limited cannot afterwards be alleged to be broader than its terms, simply because subsequent knowledge shows that it might have been drawn in wider terms. Indeed, the addition to a claim of the usual phrase "as described" may prevent the patentee from alleging it to be a master claim. In *re Sielaff* (1888, 5 R. P. C. 484) Webster, A.-G., said: "I am not satisfied that Everitt's is the master patent. Looking at the claim 'as described,' I should doubt exceedingly whether it was a proper description to suggest that Everitt's was the first patent for connecting together two moving pieces of mechanism by a coin."

But limits of master patent deducible from claims.

Where the applicant's specification discloses a minimum of invention and the opponent's is not absolutely but of the nature of a master patent, according to Carson, S.-G., the position of the alleged master patent is not to be discussed in too narrow a spirit (*re Sachse's Application*, 1900, 18 R. P. C. 221).

Where applicant's invention is narrow master patent to be liberally construed.

It was the practice under the former Acts to refuse special references in the case of concurrent applications (*re Greenhalgh*, 1897, 14 R. P. C. 387); but Sections 7 and 8 of the present Act clearly provide for such references (Comptroller's notes, 1910 (G), 27 R. P. C., Appendix VIII). But a reference under Section 8 is conditional on the grant of a patent on the earlier application.

Reference to concurrent application.

Even if the applicant's invention would be an infringement of the opponent's patent, that is not *per se* a reason for a special reference (*re Marsden*, 1896, 13 R. P. C. 87). Although the patent quoted by the opponent may have expired, this was considered by Clarke, S.-G., in *re Hall and Hall* (1888, 5 R. P. C. 283), to be no reason why it should not be specially referred to. Special references are intended to protect the public, and when the public are not likely to be misled by anything appearing in the claims as they stand in conjunction with the specification, a reference will not be ordered (*Per Evans*, S.-G., in *Brockie's Application*, 1908, 25 R. P. C. 813).

Nor even when applicant's invention would infringe.

Reference to expired patent.

Where an invention is merely an improvement upon previously patented inventions; general words capable of being construed to mean or cover anything already patented

must not be used in the specification or claims (*Hamilton's Application*, 1901, 19 R. P. C. 33).

Comptroller's  
Note on  
special  
references.

Before leaving the subject of specific references, the reader is invited to peruse the following carefully reasoned decision on the subject by the present Comptroller (W. Temple Franks). The note appears as a ruling in a revocation case (*re Hopkin's Patent*, 1909, 27 R. P. C. 72). The learned Comptroller, in discussing and defining the principles upon which specific references are inserted, proceeds as follows:—

Former  
reasons for  
specific  
references.

“With regard to the whole question of specific references—including in the term all references by name and number, whether inserted in the more formal way before the claims or in the less formal description of the invention at the beginning of the specification—I have carefully considered the various decisions and reported cases upon the subject. As a result of such consideration, I do not find it easy to formulate any very clear or definite principle from the various decisions referred to, and in my opinion much of the reasoning and many of the principles enunciated have become less relevant or less applicable at the present time for the following reasons. Before the powers of search and the extensive powers of amendment in regard to the description and claim were conferred on the Comptroller, it was not the practice to call on a patentee to alter his description or his claims to any considerable extent. The specification was left as far as possible in its original form, and, as a consequence, a specific reference often became a necessity both in the interests of the public and of a prior patentee. There was no other way of attaining the desired object of distinguishing, as far as possible, between new and old. But where a specification is properly and scientifically drawn, there would appear to be, as a general rule, little or no need for specific references or disclaimers. The ideal specification would claim and claim only in clear and succinct language the patentee's invention, and distinguish it in the description from what had gone before, or show its relation to previous inventions. Matter which was irrelevant would be excluded, and only such matter inserted as would be reasonably necessary for showing the best form of, or the best method of carrying

out, the invention sought to be protected. In a specification so framed there could be no ambiguity, and no need, as a rule, for further protection of the public or prior patentees. Under existing circumstances it ought, I think, to be the aim of the office to secure, as far as possible, that specifications shall be so framed, and thus obviate the necessity for inserting references and disclaimers, which, in many instances, are only inserted as a rough and unscientific method of defining the real scope of the invention and its relation to former invention and discovery.

“After careful consideration of the whole subject, I think it will be for the general convenience if I attempt to formulate the principles which, in my view, ought to regulate the practice of this office in the future in directing specific references or disclaimers by name and number, and which, as at present advised, I desire to apply in all cases which come before me. Such principles can of course be only very generally suggested, and must be open to exception in special cases, but I think some definite practice is better than none, and may tend to prevent disputes and disagreements in the future. It is generally conceded that the real object of such references is not to advertise a prior patentee but to guide the public, to define the true scope of an invention, and to bring into clear light the relationship and importance of one patent to another. What is requisite is to ascertain the true values of the inventions involved: and I think the real underlying principle which should govern the insertion of specific references is this—‘Is the governing idea or basic principle of an invention, sought to be protected, claimed or protected in a specific earlier patent?’ In other words, the condition necessary is that the new invention should be based on a definite invention already protected, and the earlier invention should be clearly and unequivocally repeated or involved in the new specification.

Principles governing references and disclaimers.

True object of specific references.

Test of when a specific reference is necessary.

“Applying this general principle to more specific instances, it would seem that there are two classes of cases to be considered—(1) where what is called a ‘master patent’ is involved: (2) where there is no claim to a ‘master patent’ as such.

“Assuming that the specification is clear and unambiguous and otherwise free from objection, I think the

principle which calls for a specific reference in either of these cases is substantially the same, although the method of applying it may differ in the two cases.

Master  
patent.

“(1) To take first the case of a ‘master patent.’ I think that in all discussions in regard to specific references this term should be strictly construed and confined to cases where there has been the discovery of a new and important pioneer principle—so to speak—which has been embodied in practical form or shape and claimed in general terms. There should be some wide and governing principle not hitherto claimed or described, to bring the invention within the meaning of the term ‘master patent.’ Used in this sense a specific reference is rightly inserted if the new invention is merely an improvement or amendment on the ‘master patent’ and for this reason. The ‘master patent,’ *ex concessis*, stands alone, it has broad claims which, in view of the importance of the principle involved, are allowed a wide construction. It may be said to comprehend and foreshadow any construction embodying the principle or providing any similar means for carrying it into effect. Thus any later patent, which amends or improves, may be rightly looked upon as merely defining or shaping an invention already specifically or generally claimed in the ‘master patent.’ The governing principle of the later patent is found in the former and the reference is rightly inserted in accordance with the principle stated above because the earlier invention is, in effect, taken and appropriated as the basis of the later.

“It is not indeed every case where a ‘master patent’ is concerned that will call for such references, but only when a wide and generous construction of the ‘master patent’ claimed appears to involve or foreshadow the later invention. The mere connection of an invention with a ‘master patent’ will not necessarily be sufficient. The later invention must be formed directly or by implication on the former patent.

Reference  
may be  
superfluous  
where  
master  
patent is  
of common  
knowledge.

“Further, there may possibly be cases where time and notoriety have made the ‘master patent’ so well known that a specific reference may become superfluous and unnecessary.

“Where a ‘master patent’ in this sense is claimed, the proper notice should be given under the Rule so that an

adequate search may be made both by the office and the applicant. The office search at the examination stage must not be relied on as conclusive on this point.

“In the cases where there is no proper ‘master patent’ involved, I think the same general principle in regard to specific references applies; but the conditions are stricter and more severe. I think in such cases a specific reference should only be allowed where the following conditions are present:—(a) The patent to which reference is asked should be clear and distinct in its own field and, as far as can be gathered, free from anticipation. (b) The invention claimed therein must be clearly and unequivocally claimed or included in the later specification. (c) It must be claimed or included substantially as a whole and not merely in part. (d) The improvement or addition claimed by the applicant must be small and insignificant and the governing principle, so to speak, must come from the prior patent.

Conditions  
of reference  
more severe  
in case of  
*quasi*  
“master  
patent.”

“The danger to be guarded against in these cases is the undue preference which may be given by the naming of one patent which is not alone in the field, and I think the practice should, therefore, be confined generally within the limits indicated above. In such cases a specific reference is necessary, because the prior invention is distinct, and is re-claimed *in toto* in the later patent; it is the principal or governing factor, and there is little or no advance in inventive power. In many such cases such a reference would be an alternative to the refusal of the patent or of a specific claim. In these cases I think that, generally speaking, the office search will be sufficient to raise a *prima facie* case under (a) as to absence of anticipation, &c.

“In my opinion specific references ought in general to be confined to the two classes of case indicated above; and that in all other cases general disclaimers only should be inserted in the later patent, embodying, if need be, the substance of any prior patent which appears involved, but without name or number. In this connection I think it is clearly important in the interests of the public that what is the subject of a recent and existing patent should not be stated as if it was a matter of common knowledge, and I think protection should be given to prior patentees when

General  
disclaimers.



this is the case, by suitable amendment or disclaimer. I do not indeed think that it is any part of the Comptroller's duty to consider the question of infringement; or that the public can ask this Office to protect it by special reference or otherwise where infringement is likely or possible. This has been clearly laid down in many reported cases. I think, however, the public have a right to be warned, as far as possible, of what is special and what is matter of common knowledge. In certain cases also it may amount to a disparagement of the invention of a prior patentee to state it in terms of common knowledge, and the practice is thus rightly open to objection.

Ambiguous specifications.

“(3) So far I have dealt with specifications which are clear and unambiguous or can be made so by proper amendment; there remains the class of case where the specification is ambiguous, and it is difficult or impossible to introduce amendments or disclaimers, or to rewrite it so as to disclose the true scope of the invention and distinguish it from what has gone before. In these cases it may still be necessary to protect the public, and do justice to prior patentees by the rough and ready means of inserting specific references in certain special cases. It should, however, I think, be borne in mind that this is not the best or most scientific method, and that it is merely employed to save time and trouble in cases where other amendment seems impracticable.

“It should further be added that in the early examination stages, specific references must, of course, still be inserted where necessary to penalise a patentee who cannot or will not meet the objections of the Office. Finally, in all that has been said above on the question of specific references, it has been assumed that there is some patentable invention involved in the proposed patent, and that it has escaped rejection on the ground of complete anticipation.”

Quantum of applicant's invention sometimes considered.

Although apparently the Law Officer will not consider whether or not the applicant's invention is subject-matter for a patent, unless on an appeal by an applicant from the decision of the Comptroller on the point of bad subject-matter, nevertheless he may weigh the quantum of invention, and if it shows no appreciable advance upon the opponent's patent he may refuse to seal (*re Todd's*

*Application*, 1892, 9 R. P. C. 487; *Hodgkin's Application*, 1906, 23 R. P. C. 527). This discretion of the Law Officer to adjudicate upon the quantum of the applicant's invention was exercised in *Bridge's Application* (1901, 18 R. P. C. 257), where Carson, S.-G., decided that the mere stringing together of separate items, previously patented by the opponent and others, did not show sufficient invention to justify the grant of a patent. This decision goes considerably beyond the ruling in *Todd's Case*. *Bridge's Case* can only apply where there is obviously no invention and no new result in the stringing together of old things. Where there is any doubt, or any appreciable reason for urging that there is a better result or any *scintilla* of invention, a patent will not be refused (*Krupp's Application*, 1908, 25 R. P. C. 809).

Subject-matter.

The mere selection of the best conditions for carrying out a known process already covered by a claim susceptible of being construed as covering broadly the selected conditions was held not to constitute invention in the *Deutsche Gasglühlicht's Application* (1908, 26 R. P. C. 101). In this case the opponents' claim was for treating tungsten filaments by an electric current, not distinguishing between an alternating and a direct current. The applicant found out that a direct current was much the more advantageous, but a patent was refused on the ground that the opponents' claim inferentially covered both. Almost the same question arose in *Bosch's Application* (1909, 26 R. P. C. 710) and this patent also was refused.

Mere selection of known conditions.

Quantum of invention was also considered in *Van Wye's Application* (1909, 26 R. P. C. 490) the patent being refused on the ground that there was no distinguishable or inventive advance in merely reducing the number of supports to a single support, in a vacuum insulated vessel.

Quantum of invention.

A common result of opposition to the grant of a patent is that the applicant's claim may be cut down to a shadow of its former self, if not completely destroyed. Many applicants, rather than accede to the total refusal of their application, cling to some trifling detail of which they originally thought nothing, and request that a patent may be granted on this surviving wreckage. It is within the province of the Comptroller or Law Officer to do so if the surviving detail formed part of the original claim, and if

Applicant may obtain patent for residuum of original claim.

But  
residuum  
must have  
been within  
original  
claim.

it is in any degree an advance. But when it is plain that after eliminating the part objected to there is nothing patentable left, the patent will be refused (see *re Hodge*, 1895, 12 R. P. C. 136; *re Whittaker*, 1896, 13 R. P. C. 580; *re Harrild and Parkins*, 1900, 17 R. P. C. 617). It is true that in *re Harrild and Parkins*' case Carson, S.-G., said: "If I found something substantially new, and clearly the object of the inventor, on the evidence before me I might order the patent to be sealed with an entirely different claim." But it would be dangerous to interpret this dictum as meaning that the applicant would be allowed to claim something not within the ambit of his original claim or claims. If he meant this, the learned Law Officer corrected himself in the later case of *in re Mills* (1901, 18 R. P. C. 322, *infra*), and in *Crist's Application* (1903, 20 R. P. C. 475). As Finlay, S.-G., said when refusing a patent in *re Lupton and Place* (1896, 14 R. P. C. 261): "When an applicant has put forward a specification making a claim manifestly the subject of previous patents, would it be right to amend the specification in the manner proposed by the Comptroller so as to limit his claim to this one point on which reliance is now placed? In my judgment it would not be right to do so." The same learned Law Officer, in *re Whittaker* (*supra*), refused to allow the applicant to shift his ground and amend his specification so as to claim a trifling feature not originally claimed. Said the Law Officer: "If all that the applicant claims is the improvement of having a joint instead of a fixed bar at this bend, *he ought to have said so.*" In *re Thomas and Prevost* (1898, 16 R. P. C. 69) the Law Officer said that a specification ought to be properly framed in the first instance, and, if not, it is by no means a matter of course that amendment will be allowed. See also *Crist's Application* (*supra*). In *re Garnett* (1899, 16 R. P. C. 154) Finlay, S.-G., made some observations to the same effect. In *re Mills* (1901, 18 R. P. C. 322) Carson, S.-G., also decided that an applicant whose claim *as originally drawn* is anticipated by the patent relied on by the opponent, even where the applicant's specification contains something that may distinguish his alleged invention from the patent of his opponent, will not be allowed to amend his claim by introducing or substituting such distinguishing

Applicant  
not allowed  
to shift his  
ground.

matter; still less so when the distinguishing feature left is not to be found in the Provisional (*Lancaster's Application*, 1902, 20 R. C. P. 366).

If after the opponent has done his worst, there still remains something apparently novel of the original claim of the applicant, a patent may be granted on such restricted claim, either with or without a general disclaimer or special reference. But where the residuum of the applicant's claim appears to be trifling and immaterial, the patent is and ought to be refused outright.

In comparing the applicant's and opponent's specifications, questions of mechanical equivalents will be considered; and if it is obvious that the applicant's alleged improvements are merely mechanical equivalents for the opponent's parts, the application will be refused (*per Clarke, S.-G., in re Haythornthwaite*, 1889, 7 R. P. C. 70); and in *re Smith* (1896, 13 R. P. C. 200) Webster, A.-G. reaffirmed the doctrine that the Law Officer can consider the question of mechanical equivalents as bearing on the identity of inventions.

The doctrine of mechanical equivalents may be considered.

The third ground of opposition (Clause (c)) is that the nature of the invention, or the manner in which it is to be performed, is not sufficiently or fairly described in the Complete Specification. This is a new ground of opposition introduced by the Act of 1907. According to Rule 41 the notice of opposition should be accompanied by a written statement indicating, as far as can conveniently be done, in what respects the invention is alleged to be insufficiently or unfairly ascertained. The scope of enquiry opened by this ground of opposition must of necessity be wide. It may include actual poverty of description, leaving the reader uncertain of the exact meaning of the applicant; or it may mean insufficiency of differentiation between what has been claimed by the opponent and others and what is intended to be claimed by the applicant. In the latter case it might merge in the grounds of opposition set forth under Clause (b). Probably, under this ground, consideration of the questions involved would be largely governed by (A) the rulings of the High Court upon the issues of insufficiency, and (B) by the impression made upon the mind of the Comptroller or Law Officer by the reading of the applicant's specification. From the common-sense point of view, if the specification

Invention not properly described.

Skilled  
workman  
test.

is obviously deficient or misleading in accurately ascertaining the meaning and ambit of the invention, further description and particularisation will be ordered. But, if the state of the art has to be taken into consideration, copious evidence may be necessary to show that, although the specification may seem insufficient and even unintelligible to the ordinary reader, it is perfectly clear to the expert or skilled workman in the specific industry to which the invention relates (*Fletcher Moulton, L. J., in British Ore Syndicate v. Mineral Separation, 1909, 26 R. P. C., p. 138*). In such a case all of the authoritative decisions of the High Court as to sufficiency may require to be considered. Thus, a specification dealing with a chemical invention would have its sufficiency determined by the evidence and construction of skilled chemists; a mechanical or electrical contrivance, by the evidence of expert mechanics or electricians; a specification relating to any particular branch of industry by the evidence of skilled workmen in that specific branch (*Beard v. Egerton, 1846, Good. P. C. 39*). The test is that a skilled person, versed in the particular art to which the specification relates, should have no difficulty in carrying out the invention from the description (*Edison v. Woodhouse, 1887, 4 R. P. C., p. 108*), even although he may have to correct errors in the description from his own acquired knowledge of the subject (*Edison v. Holland, 1889, 6 R. P. C. 243; Otto v. Linford, 1881, 46 L. T. N. S. 35*).

But where the specification, construed on the foregoing lines, still falls short, and leaves the reader in doubt, or puts upon him the onus of experimenting before he can carry out the alleged invention, insufficiency will be held to exist.

Cases in which the patent has been held void for insufficiency are *Coles v. Baylis (1886, 3 R. P. C. 178)*; *Harmar v. Playne (1870, Good. P. C. 219)*; *Hastings v. Brown (1853, Good. P. C. 229)*; *Owen's Patent (1899, 17 R. P. C. 68)*; *Hinks v. Safety Co. (1876, L. R., 4 Ch. D. 607)*; *Bailey v. Robertson (1878, 3 App. Cas. 1055)*; and *Sirdar Rubber Co. v. Wallington (1907, 24 R. P. C. 539)*.

Cases in which the alleged insufficiency was not proved were *Crossley v. Beverley (1829, Good. P. C. 136)*; *Beard v. Egerton (1846, Good. P. C. 39)*; *Otto v. Linford (1881,*

46 L. T. N. S. 35); *Edison v. Holland* (1889, 6 R. P. C. 243); and *Leonardt v. Kallé* (1894, 11 R. P. C. 534).

It would be incorrect to say that the question of sufficiency and fairness of description has not been hitherto a constant element in the consideration of specifications by the Comptroller and Law Officer. On the contrary, one of their most valuable functions has been that of clearing up uncertainties and remedying deficiencies in specifications. But heretofore mere insufficiency has never been a separate ground of opposition. In the absence of specific reported rulings under Clause (c) it is impossible to discuss the practice that will govern the consideration of the objection in question. But much light may be gained from the reported decisions under the other grounds of opposition.

As to the question of unfairness in a description, this might be held to exist where, for instance, the state of the art was set forth in such a manner as apparently to include under common knowledge something which was in fact the subject-matter of a prior patent. In such a case it might well be that the Comptroller would require either amendment of the objectionable passage, or else, a specific reference to the prior patent.

Unfairness  
of descrip-  
tion.

The last of the four grounds of opposition—Clause (d)—viz., that the Complete Specification describes or claims an invention other than that described in the Provisional Specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the applicant's Provisional Specification and the leaving of his Complete Specification—was originally introduced by the Amending Act of 1888, and now forms part of the present Act. The additional ground was intended to remedy a possible abuse, such as was disclosed in *re Green* (Griff. P. C. 286), where the applicant's claims for certain features were struck out although the specifications made it clear that the opponents had not originally, in their Provisional Specification, contemplated these improvements, for which the applicant had thereafter made provisional application.

Fourth  
ground of  
opposition.

Applicant  
introducing  
inter-  
mediate  
improve-  
ments  
made by  
opponent  
and  
protected  
by him.

Now, however, such a case is impossible; and even if the first applicant were to describe part of the second applicant's invention without laying claim to it, the second applicant might oppose the patent and get such part

Description  
without  
claiming.

*Re Hetherington.*

of the description expunged. In *re Hetherington* (1890, 7 R. P. C. 419) the Complete Specification of the applicant described, but did not claim, a modified arrangement of flexible bend for carding engines not foreshadowed in his Provisional Specification. The opponents had filed a subsequent Provisional Application which contained a clear description of this arrangement of flexible bend. The applicant's patent was allowed to go forward only upon condition that the description of the opponents' flexible bend should be struck out. In *re Hudson's Application* (1904, 22 R. P. C. 218) the same ground of opposition was considered and acted upon.

Applications of same date.

Obviously this is not a ground of opposition that can exist between parties where both applications were filed on the same date (Comptroller's Note, 1910 (a) 27 R. P. C., Appendix I.)

But applicant still allowed to develop invention under Provisional.

This ground of opposition is not, however, allowed to interfere with the privilege which the inventor has of developing the invention upon the general lines laid down in his Provisional Specification. Thus, in *re Millar and Miller* (1898, 15 R. P. C. 718), the patent was unsuccessfully opposed on these grounds, Webster, A.-G., holding that the applicants had merely described a legitimate development of the invention indicated in their Provisional Specification. The same was held in *re Edwards* (1894, 11 R. P. C. 461). But where any doubt exists in the applicant's mind as to whether the development may come within the original Provisional, he should file a supplementary application. If the Comptroller thinks this development can legitimately be included in the Complete, he will allow it to be so included. If not, the development may be separately patented, either independently of the first or as a Patent of Addition.

Utility of supplementary applications.

Law Officer's decision final, except where fraud discovered.

The decision of the Law Officer on appeal from the Comptroller is final, but a case may be ordered to be reheard on the ground of fraud or serious mistake or miscarriage (*per Finlay, S.-G., in re Thomas and Prevost*, 1898, 15 R. P. C. 257). Costs usually follow the event.

Bogus oppositions.

Bogus oppositions, entered collusively with the applicant for the purpose of delaying the sealing for ulterior purposes, may result in the grant of the patent being refused (see *A. B.'s Application*, 1902, 19 R. P. C. 403, 556).

If the period has expired within which opposition can be entered under Section 11, the right to oppose under that section is gone. But as will be seen in the chapter on "Revocation" a person who would have been entitled to oppose under Section 11, or his successor in interest, may apply to the Comptroller under Section 26 to revoke the patent within two years from its date upon the same grounds as in Section 11. The successor in interest of a person so entitled to apply under Clause (a), Section 11, must be his legal representative. His assignee would not be so entitled (*Gascoine's Patent*, 1909, 27 R. P. C. 78). On an application to revoke, the Comptroller may revoke or amend or correct the challenged patent as he may think fit. Such an application to revoke may therefore be described as a belated opposition.

Belated  
of position.

One word more on the question of costs. The law Officer has always had the power to award costs. By Section 39 of the present Act, the Comptroller also can now give costs. Discussion sometimes arises when the opponent has asked for the refusal of the grant, with no alternative suggestion in default of success. In such a case the Comptroller, although he may not accede to the refusal of the grant, has complete discretion to amend the applicant's specification or insert a specific reference. When such happens the Comptroller may still, and usually does, give costs to the opponent (*Comptroller's Notes*, 1910 (H). 27 R. P. C., Appendix X.). Generally speaking, even when refusal of grant is asked, it is better to add an alternative proposal for amendment of the applicant's specification. If the applicant offers, prior to the hearing, to adopt one of the suggested courses, and the opponent presses the matter to an issue on his more drastic demands, he may lose his costs if he does not succeed in obtaining *substantially more* than the opponent offers. The determining questions are--(a) Was the opposition justifiable? and (b) Has the opponent been successful to a sufficiently substantial extent?

Costs.



## CHAPTER XVI.

## SEALING OF THE PATENT.

## NATURE OF THE PROPERTY SO CREATED.

Patent sealed as of date of application.

**E**VERY Patent is dated and sealed as of the day of application.

Under Rule 48 of the Patent Rules of 1908 an additional fee of £1 is payable on the sealing of the Patent. Form 10 is made use of for this purpose, and the request to seal must be made on or before the last day on which a patent can lawfully be sealed.

Disuse of Great Seal.

Letters Patent are sealed with the Seal of the Patent Office, which has the same effect as if sealed with the Great Seal of the United Kingdom. The use of the Great Seal for this purpose was discontinued in 1878.

Periods within which sealing must be effected.

The sealing should be effected within fifteen months from the date of application. Nevertheless it is provided in Section 12 of the Act that, where the Comptroller has granted an extension of time for the leaving or for the acceptance of the Complete, under Section 5 or Section 6, a further extension of four months is allowed for sealing. Where the sealing is delayed by opposition or by an appeal to the Law Officer, the patent may be sealed at such time as the Law Officer directs. Again, where the applicant has died before the time for sealing has expired and the patent is granted to his legal representative, the patent may be sealed within twelve months from the death of the applicant. Lastly, where the applicant has neglected or failed to seal the patent within the time allowed by Section 12, he may apply on Form 11 for an extension of time not exceeding three months within which to pay the sealing fee. The Comptroller has discretion, governed by the circumstances of each case, as to whether he will or will not grant the extension.

Patent may be issued to legal representative of deceased inventor.

Extension of time for sealing.

The latter provision is new and is intended to prevent loss of the patent by forgetfulness or other excusable circumstances. Delay artificially created by the applicant may cause refusal to seal (*A. B.'s Application*, 1902, 19 R. P. C. 403, 556).

Under the terms of the grant the patent privilege lasts for fourteen years, and is maintained in force by payment of the following annual renewal fees, which come into existence at the end of the fourth year :—

	£	s.	d.	Duration of patent.
Before the expiry of the fourth year, and in respect of the fifth year ...	5	0	0	Annual taxes.
Before the expiry of the fifth year, and in respect of the sixth year ...	6	0	0	
Before the expiry of the sixth year, and in respect of the seventh year ...	7	0	0	
Before the expiry of the seventh year, and in respect of the eighth year ...	8	0	0	
Before the expiry of the eighth year, and in respect of the ninth year ...	9	0	0	
Before the expiry of the ninth year, and in respect of the tenth year ...	10	0	0	
Before the expiry of the tenth year, and in respect of the eleventh year . .	11	0	0	
Before the expiry of the eleventh year, and in respect of the twelfth year	12	0	0	
Before the expiry of the twelfth year, and in respect of the thirteenth year	13	0	0	
Before the expiry of the thirteenth year, and in respect of the fourteenth year	14	0	0	

When by accident or otherwise the payment of the annual tax has been overlooked or neglected, an extension of time can be obtained on payment of the following fines :—

	£	s.	d.	Extension of time to pay taxes.
On extension of time for one month ...	1	0	0	
“ “ “ two months ...	3	0	0	
“ “ “ three months ...	5	0	0	

If these periods have passed and the fee remains unpaid, the patent becomes void, and formerly could only be revived by a special Act of Parliament. Not so, however, under the present Act. Section 20 makes special provision for the restoration of lapsed patents. Where a patent has been unintentionally allowed to lapse, the patentee may apply to the Comptroller for an order for

Restoration of lapsed patent.

its restoration. In this application, all of the circumstances which led to the omission of the payment of the renewal fee must be stated. The stamp on the application (Form 15) is £20. Accompanying declarations must be filed verifying the statements in the application. If the Comptroller entertains the application, he causes it to be advertised in the *Journal*, and invites opposition within two months from the date of advertisement. If opposition is entered the opponent must leave declarations, verifying his intended evidence, within fourteen days after leaving his notice of opposition. Within fourteen days of this the applicant must leave declarations in answer to which the opponent must reply within fourteen days. A hearing is then appointed and the Comptroller gives his decision, which is subject to an appeal to the Court.

Conditions  
of restora-  
tion.

If the patent is ordered to be restored, the order shall contain conditions protecting those who may have availed themselves of the invention after the patent has been announced as void in the *Journal*. (See Rules 55 to 59 inclusive, of the Patents Rules of 1908).

Nature of  
patent  
property.

A patent falls under the head of personal estate. As such it is transmissible by assignment, by devolution, or by operation of law, as, for example, to a trustee in bankruptcy.

Rights of  
co-  
patentees.

When a patent has been granted to more than one person, the mutual rights and obligations of the co-patentees are worthy of a short consideration. Their position is in no degree that of an ordinary commercial partnership. They possess a joint interest which, however, is not now subject to the right of survivorship. Section 37 of the new Act provides that where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants; but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit, without accounting to the others, but shall not be entitled to grant a licence without their consent; and if any such person dies, his beneficial interest in the patent shall devolve on his personal representative as part of his personal estate.

Joint  
interest.

Devolution  
of interest.

It is to be noted that the section is not retrospective so that all patents granted before the 1st of January, 1908, are still subject to the old Rule at law.

It is therefore necessary to state the still existing conditions of co-ownership under which patents are held, when of a date prior to the 1st of January, 1908.

Co-owner-  
ship in  
patents  
dated prior  
to Act.

In all such patents the co-owner holds a joint interest which passes by survivorship, unless there has been severance of the joint estate (*National Co., v. Gibbs*, 1899, 16 R. P. C. 339; 2 Ch. 289; 48 W. R. 499).

According to the decision in *Mathers v. Green* (1865, L. R. 1 Ch. 29; 34 Beav. 170; 35 L. J. Ch. 1) each co-owner of such a patent can assign his share, and sue for an infringement, independently of the other or others. He can work the patent himself and for his own benefit without accounting to his co-patentees, and apparently can also grant licences under his own hand, although this point is doubtful. This was the substance of Lord Chancellor Cranworth's decision in *Mathers v. Green*. Lord Romilly, M. R., in the Court below, ruled that a co-patentee who granted a licence independently of his fellow-patentees was liable to account to them for their proper share of the royalties accruing under such a licence, but the Lord Chancellor apparently thought otherwise, although he gave no express decision. Section 37 now settles the matter so far as patents under the new Act are concerned.

Independ-  
ent rights.  
*Mathers v.*  
*Green.*

The ruling in *Mathers v. Green* was approved and followed in the House of Lords in the later case of *Steers v. Rogers* (1893, 10 R. P. C. 245; 1893, App. Cas. 233; 63 L. T. 726). The defendant was part owner of a moiety of a patent by assignment, and was mortgagee of the other moiety. It was sought to make the defendant liable to account to the mortgagor for a share of the profits made by working the patent, but without success, the House of Lords approving and confirming the judgment of Romer, J., in the lower Court, that a part owner of a patent, even when only so by assignment, can work the patent, without accounting to his co-owner.

*Steers v.*  
*Rogers.*

Rights of  
assignee of  
part of  
patent.

Of course, a mortgagee of a patent or share in a patent alone would not be in the same position, but must account for profits as mortgagee in possession in the usual way.

Mortgagee.

Desirable to define mutual rights of co-patentees by agreement.

As the new Section definitely empowers each co-owner to work the patent for his own profit independently of the others, and as such a situation might be productive of great injustice, it would be advisable that where there is a possibility of disputes arising from this cause co-patentees should, as the section suggests, clearly define their relative positions and rights by means of a properly prepared agreement or such severance of the joint interest as would prevent any co-owner from taking an unfair advantage of his fellows. For example, it might be provided that no one of the co-owners should use the invention without the consent of the other or others, or without accounting to him or them in respect of a just or specified share of the profits. Again, it might be mutually agreed that none of the owners should sell his share without the consent of the others, or that the patent should be sold only in its entirety. Provisions should also be made regarding the granting of licences, the payment of renewal fees, the prosecution of infringers, and other points likely to breed differences if unprovided for. If it is not desired that the law of survivorship should take effect in the case of patents granted before the Act, severance of joint interest should be effected by the co-patentees.

Severance of interest.

Register of Patents.

A Register of Patents is kept at the Patent Office in accordance with Section 28 of the Patents Act. Every patent upon being sealed is entered upon this Register, and all dealings with the patent, whether by assignment, licence, amendment, extension, or revocation, and, in short, everything affecting the validity or proprietorship of the patent, should be entered on the Register by those concerned.

Entries on the Register.

Documents affecting patent only registrable after sealing.

The patent is registered immediately upon being sealed, and, as the Comptroller recognises no property in the invention until after the grant, no documents affecting to deal with the patent will be registered until the patent has been sealed.

Notices of trusts not entered on Register.

Apparently no notice of any trust can be entered on the Register (*Haslett v. Hutchinson*, 1891, 8 R. P. C. 457); but an equitable assignment of a patent or share therein may be entered on the Register as a document affecting the proprietorship of the patent (*Stewart v. Casey*, 1891.

9 R. P. C. 15). An agreement made *before* the filing of an application, and referring to proposed dealings with the patent to be afterwards obtained, was refused entry on the Register, even after the sealing of the patent.

This was decided in *Parnell's Patent* (1888, 5 R. P. C. 126); but North, J., in refusing the motion to compel entry on the Register, declined to lay down as an absolute rule that no document executed before the date of application could be entered on the Register after sealing. Probably an agreement made before the date of application, but having attached to it, as an exhibit, a model or description and drawing of the invention, would be capable of registration if the model or description or drawing corresponded clearly with the invention for which application was afterwards made.

Query as to agreements made before application.

An assignment, agreement, licence, or other deed affecting the ownership or use of the patent should be immediately registered by the person claiming to be entitled under the assignment, licence, &c. The fee for each entry in the Register is ten shillings. A joint patentee is not entitled to have any entry put upon the Register which will affect the rights of his co-owner; and such entry may, on application by the party prejudiced, be expunged by the Court (*Horsley and Knighton's Patent*, 1869, L. R. 8 Eq. 475; 39 L. J. Ch. 157).

Registration of assignments and licences.

Entries by joint patentees.

A notification of a mortgage of a patent may be entered on the Register (Section 71, Sub-section 2), but the mortgagee is not entitled to be registered as proprietor (*Van Gelder, Apsimon & Co., Limited v. Sowerby Bridge, Limited*, 1890, 7 R. P. C. 208).

Entry of mortgages.

A request for entry of any document on the Register should be left at or posted to the Patent Office, together with the original assignment, licence, or other document, and also a copy of the same. The Comptroller, having made the entry in the Register, returns the original, bearing his certificate of entry, but retains the copy. If the assignment, licence, or other document should refer to other documents of title, not being matters of record, an official or certified copy of these should accompany the request. A body corporate may be registered as proprietor in its corporate name, and any change of name, whether of a company or individual, arising by

Procedure in placing entries on the Register.

Bodies corporate registrable as proprietors, &c.

Change of  
name.

operation of law may be placed on the Register by the Comptroller under Section 70 of the Act (*per North, J.*, in *ex parte New Ormonde Cycle Co.*, 1896, 2 Ch. 523; 13 R. P. C. 475). In the case of a body corporate, a certificate of the change of name should be obtained from the Registrar of Joint Stock Companies and filed with the request to vary the entry.

Inspection  
of Register.

The Register of Patents is open to inspection by the public, and a certified copy of any entry may be had on payment of a small fee. The Register is *prima facie* evidence of any matters directed or authorised to be inserted therein. Written or printed copies or extracts, certified by the Comptroller, and bearing the seal of the Patent Office, of patents, specifications, or of registers, books, and other documents kept there, are admitted in evidence, without proof or production of the originals, in all Courts of Law.

Certified  
extracts  
*prima facie*  
evidence.

Rectifica-  
tion of  
Register.

The Register may be rectified by an order of Court made on the application of any person aggrieved (*re Horsley*, L. R. 8 Eq. 475; and see also Section 72 of the Act). Any person interested in a particular patent may, on payment of a small fee, leave a request at the Office to be informed when any attempt is made to register any dealings in connection with the patent in question (see Comptroller's letter to Kekewich, J., in *Viola v. Sharpe*, 1904, 22 R. P. C. 24).

Duplicate  
Letters  
Patent.

In the event of the Letters Patent being lost or destroyed, the Comptroller may, on a satisfactory explanation of the disappearance of the original, cause a duplicate to be sealed or issued on payment of a fee of £2 (Patent Form 32).

## CHAPTER XVII.

## AMENDMENT OF SPECIFICATION.

**T**HIS chapter is intended to deal more particularly with the amendment of the specification at the instance of the patentee by the Comptroller or by the Court after the patent has been issued. The preceding chapters have already dealt with the minor and ministerial amendments to which the specification may be subjected in the earlier part of its career. For example, the Provisional Specification might be required to be amended, clerically and otherwise, by the Comptroller prior to acceptance; or the applicant may amend his Provisional by discarding part of it at any time before the acceptance of the Complete, in which case the discarded part is not published. The Complete may also be amended before acceptance on the suggestion of the Examiner or at the request of the applicant, these amendments not being advertised or notified in the printed copy. Or the Complete may be amended as the result of an opposition to the grant under Section 11, or an application to revoke under Section 26, in which cases the specification bears a notification that it has been amended; or it may be amended after acceptance as a result of the extended search under Section 8. (See Chapter III. on "Procedure in Obtaining Patents.")

Amendments before sealing at instance of Comptroller.

But what is intended to be dealt with in this chapter is the amendment of the specification by the Comptroller or by the Court upon the initiative of the patentee himself. Section 21 provides for amendment by the Comptroller where there are no proceedings before the Court in respect of the patent. Section 22 provides for the amendment by the Court while such proceedings are going on.

Amendment by patentee.

Dealing first with amendments competent to be made on application to the Comptroller, it often happens that after the Complete Specification has been filed, or after the patent has been granted, the applicant or patentee

Reasons for amendment.



finds that he has claimed something which turns out to be old, or that in some other respect his specification requires amendment.

Section 21,  
Sub-  
section 1.

Provision for such amendment has been made in Section 21, Sub-section 1, of the Patent Act:—

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

Limits of  
amend-  
ment.

The words in italics show the limits within which amendments must be confined. The amendment may consist of striking out, correcting, or making clear, but it must not in the slightest degree increase the scope of the patent.

Claim too  
wide.

The most usual cases of amendment are those in which the patentee has made his original claim too wide: but there are also instances where the amendment may be only of the nature of correction or explanation.

Amend-  
ment of  
drawings.

In several instances mistakes in the drawings have been allowed to be amended without altering a word in the specification, as, for example, in the case of *re Abel's Patent* (*Lawson on Patents*, 3rd ed., p. 73), the specification of which was found faulty in respect of the drawings during the trial in *Otto v. Linford* (1881, 46 L. T. N. S. 35), the defects being afterwards corrected by the filing of new drawings. New drawings may also be added to define the amendment (*per Clarke, S.-G.*, in *re Lang's Patent*, 1890, 7 R. P. C. 469; Good. O. C. 1st Appendix 17).

Persons  
entitled to  
amend.

The persons entitled to amend are the applicant or patentee, the term “patentee” meaning (*per* Section 93) the person for the time being entitled to the benefit of the patent. Thus, an assignee may amend, and where a patentee has assigned part of his patent, the part-assignee should join with him in amending. Where a patent has been mortgaged, the mortgagee should join with the beneficial owner in amending (*re Church's Patents*, 1886, 3 R. P. C. 95). A mortgagee alone could not amend.

The expression "at any time" in Section 21 imports that a specification may be amended and re-amended more than once. But repeated disclaimers are not encouraged, and where amendment has succeeded amendment the successful applicant to amend may be refused costs (*re Huddan's Patent*, Good. O. C. 62; Griff. A. P. C. 12).

Specifica-  
tion may be  
amended  
more than  
once.

The nature of such amendments as are permissible under Section 21 cannot be set down in general terms; but in all cases they must, in accordance with the Statute, only cut down and explain and never add to the scope of the patent. But a description originally insufficient cannot generally be made sufficient (*Johnson's Patent*, 1896, 13 R. P. C. 659), especially where the patent is old or where the amendment introduces subsequent knowledge. The scope of a specification cannot be extended to cover apparatus subsequently brought into use. Thus it was not allowed to extend the application of a steam escape nozzle to a gas engine exhaust (*Beck and Justice's Patent*, Good. O. C. 72; Griff. A. P. C. 10). Where it is clear that a patentee has not prepared his original specification in good faith and with reasonable skill and knowledge, in many cases he cannot, under colour of an amendment, retrieve his shortcomings (*Nordenfelt's Patent*, Good. O. C. 70; Griff. A. P. C. 18); but in *Morgan's Patent* (Good. O. C. 70; Griff. A. P. C. 17) the patentees were allowed to correct a misdescription, and describe more fully a figure of the drawings which had before been insufficiently described. A general claim having been originally made, no amendment which strikes out the general claim and substitutes claims for subordinate parts will be allowed. When a patentee has described and claimed an improved method of manufacture, without indicating particular means or machinery, no amendment introducing and claiming particular means or machinery will be allowed (*Nairn's Patent*, 1891, 8 R. P. C. 444; *Lang's Patent*, 1890, 7 R. P. C. 471).

Nature of  
amend-  
ments.

Insufficient  
description.

Amend-  
ment must  
not extend  
patent.

General  
claim can-  
not usually  
be altered  
to claims for  
subordinate  
parts.

When the specification and drawings are clear, but the claim has been drawn in such a manner as to be ambiguous, the claim may be amended so long as the amendment is clearly of a restrictive nature (*Ashworth's Patent*, Good. O. C. 66; Griff. A. P. C. 6). It is evident from the remarks of Webster, A.-G., in *Johnson's Patent* (1896, 13 R. P. C. 659), that a manifest error made by a British agent in

Ambiguous  
claim may  
sometimes  
be  
corrected.

Clear error  
may be  
amended.

translating or describing a foreign principal's invention may be cured by amendment.

Error in claim.

Where a feature in a claim is apparently set forth as an essential, whereas evidence adduced shows that it could not have been so meant, the defect might be cured by amendment (see *Moser v. Marsden*, 1895, 13 R. P. C. 24).

Claim for combination cannot be made claim for details.

General claims for subordinate features cannot be turned into one claim for a combination; nor can a claim for one feature be enlarged by the addition of another feature so as to make it a combination claim including both, especially where the proposed addition has not been claimed or has previously been disclaimed (*Hattersley and Jackson's Patent*, 1904, 21 R. P. C. 233). The Law Officer in this case expressed an opinion which does not seem unfavourable to the contention that in certain circumstances separate claims might, by amendment, be consolidated into one combination claim. *Kelly v. Heathman* (1890, 7 R. P. C. 343) was quoted as an example. A claim for a combination cannot be altered to a claim for details described in the specification (*Serrell's Patent*, 1889, 6 R. P. C. 103).

No special reference to opponent's patent.

An opponent to an amendment cannot obtain a special reference to his patent in the applicant's specification (*Hampton and Facer's Patent*, Good. O. C. 71; Griff. A. P. C. 13). In the same case it was held that the applicant may not impute disadvantages to a method of manufacture of the kind described and claimed by the opponent; and, further, that if the applicant accepts the Comptroller's decision he cannot advance further evidence before the Law Officer.

Old patents more difficult to amend.

An application to amend a patent which is nearing its expiration is more narrowly scrutinised than amendments of less mature patents (*Johnson's Patent*, 1896, 13 R. P. C. 659).

Amendment once granted cannot be questioned except where fraud alleged.

Before the decision of the House of Lords in *Moser v. Marsden* (1895, 13 R. P. C. 24), to the effect that an amendment once granted by the Patent Office cannot afterwards be contested in a subsequently tried action for infringement, except on the ground of fraud, the Law Officer, in case of doubt, was accustomed to incline in favour of the patentee. Now, however, that *Moser v. Marsden* has established that the propriety of an amendment cannot be questioned in after proceedings, and in view of Sub-section 7

*Moser v. Marsden.*

of Section 21, which provides that leave to amend shall be conclusive as to the right of the party to make the amendment, except in case of fraud, the Comptroller or Law Officer is more strict, and no doubt amendments which might formerly have been accepted with some dubiety will not now be allowed. Nevertheless, it is sometimes contended that, to get at the true meaning of an amended specification, the text of the unamended specification can be referred to. In delivering judgment in *Moser v. Marsden* (*supra*), Lord Watson compared parts of the amended with the unamended specification, and from this it was argued in *Birmingham Pneumatic Tyre Co. v. Reliance Tyre Co.* (1902, 19 R. P. C. 312) that it was legitimate to do so for the purpose of getting at the true meaning of the amended specification. In *Hattersley v. Hodgson* (1904, 21 R. P. C. 517) Collins, M. R., declined to allow any reference to the unamended specification, basing his ruling on the commercial contract case of *Inglis v. Buttery* (3 App. Cas. 552), but on appeal to the House of Lords the unamended specification was taken into consideration by Lord Lindley (1906, 23 R. P. C., p. 204). It is therefore tolerably clear that the struck out parts of an amended specification may for certain purposes be referred to (*per* Buckley, J., in *Klüber's Patents*, 1904, 22 R. P. C. 10).

Reference to unamended specification.

The reasons given in the "request in writing" to amend must, of course, vary with circumstances. A discovery by the patentee that part of the claimed invention is old, or that the description is not perfectly clear, or that the new parts are not sufficiently differentiated from the old, forms usually the reason for amendment. But if the reason given in the request should turn out to be erroneous, the request could be corrected without affecting the acceptance of the amendment. Any reason which gives colour to the deduction that lack of good faith or of reasonable skill and knowledge affected the preparation of the original specification and claims would, however, seriously prejudice the acceptance of the amendment.

Reasons for amendment.

Request to amend may be corrected.

Although Sub-sections 4 and 5 of Section 21 give the Comptroller and Law Officer power to impose conditions in respect of amendments, and although according to *Finlay, S.-G.*, in *Ainsworth's Patent* (1895, 13 R. P. C. 76)

Power of Law Officer to impose conditions, Section 19, Sub-section 4.

and in *Allison's Patent* (1898, 15 R. P. C. 408), the Law Officers recognise that they have such power, and might under exceptional circumstances use it, nevertheless it was early held by Clarke, S.-G., in *Allen's Patent* (Good. O. C. 64; Griff. A. P. C. 3), that the Law Officer will not as a rule impose conditions, but will leave the Court to deal with the matter under Section 23 of the Act.

Section 23.

Power of Court to impose conditions in action for infringement.

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

Relief for infringements before amendment.

So jealous is the Court of giving damages for things done before amendment, that in only two cases have damages for breaches before amendment been given. These are *Hopkinson v. The St. James' and Pall Mall Electric Light Co.* (1892, 10 R. P. C. 46); and *Brooks v. E. Lycett, Limited* (1903, 20 R. P. C. 390). In the latter case the defendant did not appear at the trial, and Buckley, J., granted the necessary certificate that the original specification had been framed in good faith and with reasonable skill and knowledge.

Fees on amendment.

There is practically no more difficulty in amending the specification of a patent which has been sealed than there is in amending a specification not yet sealed. In the former case the official fee is £3, and in the latter case £1 10s.

The formalities to be complied with in making application for leave to amend may be briefly stated.

Procedure in amending.

The request for leave to amend a specification (Form 17) must be signed by the applicant or patentee, must give an address for service in the United Kingdom, and, where a patent has been sealed, must contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. This latter provision was made, apparently to obviate such an accident as became evident in *Brooks and Co. v. Lycett* (1904, 21 R. P. C. 651), where a patent had been amended under the mistaken idea that the action had been discontinued, whereas it was

still pending, though asleep. The amendment thus obtained was held invalid.

The amendment or amendments should be shown in red ink on an officially certified copy of the printed specification. If accepted by the Comptroller, the request to amend is advertised in the *Official Patent Journal*, and generally in one or two newspapers. For example, if the patent relates to knitting machines, the Comptroller might require the proposed amendment to be advertised in a district devoted to such an industry; for instance, in Leicester. If to cotton machinery it might be required to be advertised in Manchester. The heading of the advertisement invites opposition from anyone interested.

Advertisement.

According to Section 21, Sub-section 2, "any person" may oppose the granting of the amendment, but practically to entitle an opponent to be heard, he must be a person interested or who is threatened or aggrieved or prejudiced by the proposed amendment. His interest must be equivalent to the interest of a person entitled to be heard in opposition to the grant of a patent, and the Law Officer may decide finally whether or not he is entitled to be heard (*per* Smith, L. J., in *Reg. v. Comptroller, ex parte Tomlinson*, 1899, 16 R. P. C. 233; 1899, 1 Q. B. 909; 68 L. J. Q. B. 568). In *Bell's Patent* (Good. O. C. 13; Griff. A. P. C. 10) the opponents contended that the amendment would make the invention the same as that comprised in two prior patents in which the opponents had no interest. Here it was ruled that the opponents were not entitled to be heard on these grounds.

Persons entitled to oppose amendment.

Decision rests with Law Officer.

The time within which opposition to an amendment will be entertained is one month from the date of the advertisement in the *Official Patent Journal*. The notice of opposition (Form 18) bears a stamp of ten shillings. It must contain the full name and address of the opponent, and state the reasons of opposition. The applicant is advised of the opposition by the Comptroller, and thereafter declarations are filed by the opponent in support of his opposition within fourteen days of the expiry of one month from the date of the advertisement. The proceedings and rules as to declarations are identical with those already described with reference to the opposition to the grant of a patent.

Limit of time for opposing.

Declarations by opponent and applicant.

Decision.

The decision of the Comptroller is subject to an appeal to the Law Officer, whose decision is final.

Amendment during legal proceedings.

It now remains to consider the question of the amendment by the Court of a specification in respect of which legal proceedings are pending, such, for example, as an action for infringement or proceedings for revocation. The plaintiff patentee sometimes finds on receipt of the defendant's defence and particulars of objections that there are defects in his patent which very greatly minimise his chances of success. His claim, for example, may be so wide as to trench upon the subject-matter of some prior user or prior patent which the defendant cites, or his attention may have been called to some question of disconformity. So he makes up his mind to disclaim the dangerous surplusage. But having submitted himself to the Court he cannot, unless he drops his action and pays the defendant's costs (*Brooks and Co. v. Lyckett*, 1904, 21 R. P. C. 651), apply to the Comptroller to amend. Before the present Act the plaintiff had to apply to the Court for leave to amend on the usual terms, and then having obtained that leave he went to the Comptroller who decided the question of amendment with a right of appeal to the Law Officer. The Court itself had nothing to do with the material of the amendment. That they left to what Cozens-Hardy, M. R., called, "the proper tribunal appointed by Statute to decide that question" (*Alsop's Patent*, 1905, 23 R. P. C. 65). Under the present Act the procedure is changed, and by Section 22 it is provided that—

Plaintiff wishing to amend must either drop action or obtain leave of Court.

Amendment is in the hands of the Court.

"In any action for infringement of a patent or proceedings before a Court for the revocation of a patent, the Court may by order allow the patentee to amend his specification *by way of disclaimer* in such manner and subject to such terms as to costs, advertisement, or otherwise, as the Court may think fit.

"Provided that no amendment shall be so allowed that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before the amendment; and where an application for such an order is

made to the Court, notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court."

Thus the duty of considering the actual terms of the proposed amendment is taken out of the hands of the Comptroller and left in the hands of the Court. The reader will note that the scope of the proposed amendment must be more limited than in Section 21. It is to be by way of *disclaimer* only. It should also be observed that the provision in Section 21, Sub-section 7, to the effect that leave to amend shall be conclusive as to the right of the party to make the amendment, except in case of fraud, is absent in Section 22.

Disclaimer  
only.

The section does not indicate how the order of the Court is obtained. But Order 53A, R. S. C., Rule 23, provides:—

Order 53A,  
R. S. C.

“Where an application is made by a patentee for leave to amend his specification by way of disclaimer under Section 22 of the Act, the following Rules shall apply:—

- (a) “The application shall be made by motion in the proceedings pending before the Court, and notice of such motion, together with a King’s Printers’ copy of the specification showing in red ink the amendment proposed to be made, shall be served on the parties to such proceedings, and in the first instance upon such parties only.
- (b) “On the hearing of such motion the Court shall decide whether, and on what terms as to costs or otherwise, the application shall be allowed to proceed, and, if the application be allowed to proceed, shall give directions as to whether such application shall be heard on oral or affidavit evidence, and, if on affidavit evidence, shall fix the times within which affidavits shall be filed by the parties respectively, and by any other person entitled to be heard under the Act or these Rules.



- (c) "If the application be allowed to proceed, the applicant shall forthwith serve the Comptroller with a copy of the notice of motion, together with such copy specification as aforesaid, and also a copy of the order allowing the application to proceed, and also with the name and address of the applicant's solicitor, and the proposed amendment shall be advertised in the *Illustrated Official Journal (Patents)*, such advertisement stating that any person desiring to oppose the amendment must, within fourteen days of the issue of the advertisement, give notice in writing of such desire to the applicant's solicitor, whose name and address for that purpose shall also be stated in the advertisement. Any person giving such notice shall be entitled to be heard upon the hearing of the motion.
- (d) "Within seven days after the receipt of any such notice, the applicant shall, if the person giving such notice shall have stated therein an address for service within the United Kingdom, serve on such a person a copy of the notice of motion together with such copy of the specification as aforesaid, and also a copy of the order allowing the application to proceed. Such service may be made by prepaid registered letter sent to such person through the post at his address for service.
- (e) "In the case of an application directed to be heard on oral evidence, the applicant shall as soon as he shall have complied with the requirements of the preceding Rules, set the same down for hearing in the witness list and, in the case of an application directed to be heard on affidavit evidence, the applicant shall after such compliance as aforesaid, and after the times fixed for filing evidence have expired, set the same down for hearing in the non-witness list, and the application so set down shall be heard and disposed of in due course.
- (f) "Where the Court allows a specification to be amended, the applicant shall forthwith lodge with

the Comptroller an office copy of the order allowing such amendment, and the Comptroller shall advertise the same once at least in the *Illustrated Official Journal (Patents)*. He shall also, if required so to do by the Court or by the Comptroller, leave at the Patent Office a new specification and drawings as amended, the same being prepared, as far as may be, in accordance with the Rules of the Patent Office for the time being in force."

As the motion will be heard before the Judge who is hearing the action, he will be in an excellent position to decide what amendment he should allow and upon what terms. As the Court of Appeal will not interfere with the exercise of the Judge's discretion, unless satisfied that injustice has been done (*Woolley v. Broad*, 1892, 9 R. P. C. 492; *Wilson Bros. v. Wilson & Co.*, 1899, 16 R. P. C. 315; *re Allison's Patent*, 1900, 17 R. P. C. 513) it is necessary to present the evidence on the hearing of the motion with the greatest care. The patentee and his experts should seek to show that reasonable skill and knowledge were exercised in preparing the original specification and claims. If the Court decides to allow the amendment, the conditions as to costs may be varied in accordance with what has been done in the action. For instance, in *Fusee Vesta Co. v. Bryant & May* (1887, 4 R. P. C. 71), where little had been done beyond the issue of the writ, it was ordered that the costs of the defendants up to and including the application to amend and consequent upon the amendment should be paid by the plaintiffs in any event. But in *Haslam Foundry Co. v. Goodfellow* (1887, 5 R. P. C. 28; L. R. 37 Ch. D. 118), where the pleadings had been closed and the action set down for trial before the application was made, the plaintiffs were ordered to pay in any event the costs of the application and the costs of and occasioned by the disclaimer, except so far as the proceedings in the action might be utilised for the purposes of the trial, other costs being reserved.

Conditions vary in accordance with circumstances.

Where application to amend has been made to the Comptroller, there being at the time no action for infringement or petition for revocation pending, the application

to amend may proceed without the leave of Court under Section 21, notwithstanding that an action for infringement or proceeding for revocation may *subsequently* have been commenced (*Woolfe v. Automatic Picture Gallery, Limited*, 1902, 19 R. P. C. 425). But an amendment obtained while an action or petition is effectively pending, although dormant, is invalid (*Brooks and Co. v. Lycett*, 1904, 21 R. P. C. 651).

Plaintiff and defendant allowed to amend pleadings after disclaimer without leave.

The order giving leave to amend usually provides that the plaintiff and defendant shall be allowed to make the necessary amendments in their pleadings after disclaimer, and that the action should meanwhile be stayed (*Haslam Foundry Co. v. Goodfellow, supra*; followed by Byrne, J., in *Chutwood's Patent*, 1899, 16 R. P. C. 370).

Exceptional conditions sometimes imposed.

*Deeley v. Perkes.*

The further conditions usually imposed, must, of necessity vary with each case, and exceptional circumstances will increase or modify the severity of the conditions. For example in *Deeley v. Perkes* (1896, 13 R. P. C. 581) the House of Lords imposed the terms that the plaintiff should not bring or maintain any action for infringement in respect of anything done before the date of the hearing of the appeal. But the circumstances here were very exceptional. One claim only of the original five was proposed to be retained. The patent had been revoked for over a year, and large quantities of guns with the patented parts had been sent out by the defendants and by others in the trade. Kekewich, J., in *Luddington Cigarette Co. v. Baron Cigarette Co. (in re Pitt's Patent)*, 1900, 17 R. P. C. 745, thought himself bound by the decision in *Deeley v. Perkes* to impose this condition as a common form; but the Court of Appeal, although upholding the order, emphatically repudiated any such idea. Lindley, M. R., said: "I protest altogether against the notion that the order in *Deeley v. Perkes* ought to be regarded as the laying down of a settled form." On appeal the House of Lords were of the same opinion. The exceptional circumstances in this case were, *inter alia*, that out of the twenty-two claims twenty were disclaimed. Exceptional circumstances—viz., the dropping of nine claims out of fourteen, delay in seeking amendment, and other points prejudicial to the applicants—led to the imposition of similar conditions in *Allison's Patent* (1900, 17 R. P. C. 513).

*Luddington Cigarette Co. v. Baron Cigarette Co.*

Lindley, M. R., on conditions of amendment.

In considering the nature of the conditions to be imposed the Court will take into account the age of the patent, the amount of matter disclaimed (in the *Luddington Cigarette Case, supra*, twenty claims were dropped out of twenty-two), the character and cost of the patented article, and other incidental points.

Considerations in imposing conditions.

In *Corrigall v. Armstrong Whitworth* (1903, 20 R. P. C. 523) the plaintiff had been aware of the infringement for nine years, but had delayed taking action although he had carried on correspondence about it. Swinfen-Eady, J., gave leave to amend, but only on terms that no relief or damages be given in the action for any infringements committed prior to the amendment.

The present general tendency of the Courts seems to be in favour of imposing terms in the bulk of cases that no action shall be brought or maintained for infringement of the patent in respect of any goods made prior to the date of the order (*Jandus Arc Lamp Co. v. Arc Lamp Co.*, 1904, 21 R. P. C. 115).

Present practice as to terms.

Damages in respect of infringements committed prior to amendment are scarcely ever awarded, but such damages were given in *Hopkinson v. St. James Electric Light Co.* (1892, 10 R. P. C. 46), where the invention was exceedingly meritorious and good faith was apparent in the original claim. Damages were also given in *Brooks v. E. Lycett, Ltd.* (1903, 20 R. P. C. 370). The claim for such damages should be specially pleaded (*Kane v. Boyle*, 1901, 18 R. P. C. 325). Such damages are never given in cases where the patent has, prior to amendment, been declared invalid by the Court.

Damages very seldom given in respect of infringements before disclaimer.

The defendant in an action for infringement of the patent, as well as others having the required *locus standi*, may oppose the amendment as provided for in the Order, and appear at the hearing in opposition.

## CHAPTER XVIII.

## ACTION FOR INFRINGEMENT.

Infringe-  
ment.

Importation  
is infringe-  
ment.

But not  
where con-  
tract though  
made in  
England is  
executed  
abroad.

Experiment  
not in-  
fringement.

Mere user is  
infringer.

User in  
foreign  
vessel.

Sale or  
offering for  
sale is in-  
fringement.

**D**URING the fourteen years' term of patent right, the privilege of making, using, exercising, and vending the invention is limited to the owner of the patent and his representatives. Any person making or dealing with the patented article in an unauthorised manner is an infringer. Importation from abroad is an offence (*British Motor Syndicate v. Taylor*, 1900, 17 R. P. C. 723), even if the infringing articles are immediately re-exported. But an English merchant who, in pursuance of a contract made in England, delivers a patented article at a foreign port to an English importer, does not infringe, seeing there is no actual making, using, exercising, or vending of the invention within the realm (*Saccharin Corporation v. Reitmeyer*, 1900, 17 R. P. C. 606; 1900, 2 Ch. 659). If a person makes a sample of the patented thing merely experimentally, he does not infringe, but if he sells it or uses it for profit the case is otherwise (*per Jessel, M. R.* in *Frearson v. Lee*, 1878, L. R. 9 Ch. D. 48; 26 W. R. 138). But the very slightest real use of such an experimental manufacture would constitute infringement.

A person who merely uses something which is an infringement is liable as an infringer, and it does not matter whether he is an innocent user or not; but no damages can be recovered against him if he can prove that he was not aware of the existence of the patent (Section 33).

Necessary use of an infringing article in a foreign vessel touching at a British port is not an infringement, unless the vessel is under the flag of a Foreign State which denies corresponding privileges to British vessels (Patent Act, Section 48).

Sale of the infringing article is an offence, and, as in the case of user, the ignorance of the seller is no excuse unless he can bring himself, so far as damages are

concerned, under the protection of Section 33. Even the mere offering for sale, although no sale is effected, constitutes infringement (*Incandescent Co. v. New Incandescent Co.*, 1898, 15 R. P. C. 81; *British Motor Syndicate v. Taylor*, 1900, 17 R. P. C. 723), in respect of which an injunction can be obtained. According to a dictum of Lord Alverstone in the latter case, mere possession with a view to sale is infringement.

Possession with view to sale.

Advertising an infringing article justifies an action to restrain infringement. Jessel, M. R., in *Frearson v. Loe* (*supra*), laid down that "if a patentee has reasonable ground to apprehend that a man will infringe his right, he can come to the Court and obtain an injunction to restrain him from carrying out his intention" (quoted and approved in *Douling v. Billington*, 1890, 7 R. P. C. 191). Even where the infringement has been slight, say to the extent of one article only, and has been discontinued, an injunction has been granted. As was said by Cotton, L. J., in *Proctor v. Bailey* (1889, 6 R. P. C. 538): "When a patent is infringed, the patentee has a *prima facie* case for an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so." Again, if there has not been any infringement but an intention to infringe has been shown, an injunction will be granted.

Unauthorised advertising is ground for injunction.

But the Court will not countenance harsh proceedings, or proceedings maintained vindictively or obviously to make costs. Therefore where full submission has been made, and it is manifest the defendant has no intention of continuing the infringement—where, in short, the defendant has offered all the plaintiff is entitled to—no injunction will be granted, and the defendant may get costs from the date of his offer (*Proctor v. Bailey, supra*; *Jenkins v. Hope*, 1895, 13 R. P. C. 57).

Harsh proceedings not encouraged.

The sale of a component part (not *per se* protected) of a patented combination, even where the vendor knows that the purchaser intends to use the article for the purpose of infringing the patent, is not an infringement by the vendor of the part (*Sirdar Rubber Co. v. Wallington*, 1905, 22 R. P. C. 257; *Dunlop Pneumatic Tyre Co. v. Moseley & Sons*, 1904, 21 R. P. C. 274; *Townsend v. Haworth*, 1875, 12 Ch. D. 831 *n.* followed). But a vendor selling all the

Infringement of part of combination.

component parts of a patented combination ready to be put together would apparently infringe (*per* Pearson, J., in *United Telephone Co. v. Dale*, 1883, 25 C. D. 778).

Exhibition  
without in-  
tent to sell.

Merely showing a machine carrying the patented invention, at an exhibition, without the intention of selling, is an offence (*Dunlop v. British Car Co.*, 1901, 18 R. P. C. 313).

Repair of  
patented  
invention.

A patented article may be repaired by its purchaser so long as no renewal of the essential parts of the invention is effected. In *Dunlop Co. v. Neal* (1899, 16 R. P. C. 247; 1899, 1 Ch. 807; 80 L. T. 746) the defendant was held to have infringed because he had fitted a fresh cycle tyre cover to the old inextensible wire rings, the patent being for the combination (see also *Dunlop v. Excelsior Rubber Co.*, 1901, 18 R. P. C. 209, and *Dunlop v. Holborn Tyre Co.*, 1901, 18 R. P. C. 222). But where the defendant had fitted a rubber tyre to a rim the section of which was patented, and which rim had been supplied by the plaintiffs, no infringement was held (*Sirdar Rubber Co. v. Wallington*, 1905, 22 R. P. C. 257).

Implied  
licence by  
authorised  
seller.

When a patented article has been sold by anyone who does so lawfully, an implied licence attaches to all subsequent sales and resales (*Thomas v. Hunt*, 1864, 17 C. B. N. S. 183). But a patented apparatus taken under a distress from a personal licensee cannot be used without a fresh licence (*British Mutoscope Co. v. Homer*, 1901, 18 R. P. C. 177).

Infringe-  
ment by  
disregard of  
conditions  
of sale.

Formerly, a patentee in selling his goods or licensing their sale could impose any conditions however harsh: for instance, in compelling the purchasers of a gas mantle to use with it a burner which is no part of the patent (*Incandescent Co. v. Brogden*, 1899, 16 R. P. C. 179). It was held that such conditions were binding only on those to whose notice the conditions had been brought when purchasing (*Incandescent Co. v. Cantelo*, 1895, 12 R. P. C. 272), but others who were aware of but disregarded the conditions were liable as infringers.

Section 38  
on  
restrictive  
conditions.

Now, however, by Section 38 of the new Act, it is declared that it shall not be lawful to impose certain unduly restrictive conditions in selling or licensing patented goods. This section will be separately discussed in the chapter on "Licences."

A workman who has infringed in disobedience to the express orders of his master is liable, and also renders his master liable, for infringement (*Betts v. De Vitre*, 1864-73, L. R. 3 Ch. 429, 442; 6 H. of L. 319; 34 L. J. Ch. 289, 291).

Infringe-  
ment by  
workman.

In *Saccharin Corporation, Limited v. Anglo-Continental Works, Limited* (1900, 17 R. P. C. 307; 1901, 1 Ch. 414), a material was imported into this country which had been manufactured abroad by the aid of constituents patented by the plaintiffs. The nature of the constituents was chemically changed by the process of manufacture, and the imported product was not the patented invention. The Court held that the defendants were indirectly depriving the patentees of the benefit of their invention, and granted an injunction. Carriers who transport infringing articles into this country are liable to be restrained by injunction (*Washburn Manufacturing Co. v. Cunard Co.*, 1889, 6 R. P. C. 398), but mere customs house agents, not having possession or control of the goods, are not (*Nobel v. Jones*, 1882, 8 A. C. 5).

Indirect  
infringe-  
ment: use  
of patent  
materials  
abroad in  
making  
imported  
product.

Carriers.

Customs  
agents.

When the owner of a patent discovers that it is being infringed by manufacture, or use, or sale, or importation, or that the invention is otherwise being dealt with in a manner constituting infringement, he may seek his remedy by instituting an action for infringement. He must not threaten unless he means business. If he does he may find the tables turned by having an action brought against him by the threatened party under Section 36 of the Act. But before commencing proceedings a patentee should always make sure that he is upon firm ground. Therefore, if he has not done so before, let him get a careful search made among the patent and other records to see if in any respect his patent is anticipated wholly or in part. If anything should be found that causes him doubt, let him amend his specification as set forth in the last chapter. Having re-assured himself as well as he can as to the soundness of his patent, he may then, after reasonable negotiation with the infringer (*Lyon v. Mayor of Newcastle*, 1894, 11 R. P. C. 218), issue the writ. The action should by preference be entered on the Chancery side, as the machinery of the Chancery Courts is better fitted than that of the King's Bench Division for the trial of patent actions. The practice also in interlocutory proceedings in

Action for  
infringe-  
ment.

Threats.

Clearing for  
action.

Preliminary  
negotia-  
tions.

Chancery  
Division for  
patent  
actions.



Where the validity of the patent is in dispute, County Court no jurisdiction.

Endorsement of writ.

Service abroad.

Plaintiff.

Co-owner.

Licensee.

Assignee.

patent matters has been much better ascertained and crystallised into recognised precedents, which do not always hold good on the Common Law side. The Vice-Chancellor of the County Palatine of Lancaster has jurisdiction to try patent actions; but County Courts have no such power where the validity of the patent is in dispute (see Section 92, Sub-section 1, and *Reg. v. County Court Judge of Halifax*, 1891, 8 R. P. C. 338; 60 L. J. Q. B. 550).

The writ should be endorsed with a claim for—(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's Patent No. of 19; (2) Damages, or, in the alternative, an account of profits; (3) Delivery up or destruction of the infringing articles. It is not necessary to ask for costs; but if the plaintiff is in possession of a certificate that the validity of his patent has been questioned in a former action, costs as between solicitor and client should be claimed. If the defendant is neither a British subject nor in British dominions, leave may be obtained to serve him with notice of the writ, and Order XI., Rule 4, indicates the evidence which should be given in support of an application to serve such notice. In conjunction with this Rule the observations of Lords Macnaghten and Davey in *Chemische Fabrik v. Badische Anilin Fabrik* (1904, 21 R. P. C. 539) as to the nature of such evidence should be carefully read. As to what may constitute domicile, where a Foreign corporation exhibited a car at the National Cycle Show in London, service of the writ upon the person in charge of the stand was held good (*Dunlop Co. v. Actien Gesellschaft, &c.*, 1902, 19 R. P. C. 46).

As to the parties in the action, the plaintiff might be the patentee or the assignee or the mortgagor, either alone or joined with the mortgagee. Co-owners of a patent should join, but one co-owner alone may take action (*Sheehan v. Great Eastern Railway Co.*, 1880, Good. P. C. 425). In *Day v. Davies* (1904, 22 R. P. C. 34), the plaintiff was owner of one half share only of the patent. A licensee, whether exclusive or general, cannot sue; neither can an exclusive agent for the sale of a patented article, although it has been said that an exclusive licensee may use the name of the patentee for this purpose (*Renard v. Levinstein*, 1864-5, 2 H. & M. 628; Good. P. C. 400). The assignee

and trustee of a bankrupt patentee or legal owner may sue. If the plaintiff has acquired the patent from someone else, and if any of the infringements have taken place during the former proprietorship, it would be advisable to join the former owner as co-plaintiff. Apparently an assignee might sue alone for damages for infringements committed before the date of his assignment if he succeeds to the rights and property of his predecessor in title (*United Horse Nail Co. v. Stewart*, 1888, per Lord Macnaghten on p. 269 of 5 R. P. C.). But it would be wise to join the assignor.

Joinder of assignor.

When the plaintiff is an assignee, registration of his assignment is not a condition precedent to his right to take action. Apparently, under the Act of 1852, it was (*Chollett v. Hoffman*, 1857, 7 Ell. & B. 686; and *Hassall v. Wright*, 1870, L. R. 10 Eq. 509; Good. P. C. 229). *Ihlee v. Henshaw* (1886, 3 R. P. C. 15) decided, under the Act of 1883, that a legal assignee of a trade mark was entitled to sue, although not on the Register. To prevent vexatious questions arising, it is always better that the assignment should be registered preferably before the issue of the writ or at least immediately after. But a mere equitable assignee, for example, a person to whom the benefits of an invention provisionally protected had been assigned before the grant of the patent, cannot sue without joinder of the registered owner (*Bowden's Syndicate, Limited v. Herbert Smith & Co.*, 1904, 21 R. P. C. 438). Where an agreement to assign exists without the assignment having been executed, the proposed or equitable assignee may bring an action, joining the patentee as defendant to a claim against him for specific performance of the agreement (*Spennymore v. Catherall*, 1909, 26 R. P. C. 822).

Unregistered assignee may sue.

Equitable assignee may not.

The plaintiff cannot take action for infringement until the patent has been sealed and issued, and then only in respect of infringements committed after the acceptance and publication of the Complete Specification (see Section 13).

No action till patent sealed.

The defendant might be the person manufacturing the infringing goods or the user or seller. An importer into this country of goods patented here could be sued, even if a mere carrier (*Washburn Manufacturing Co. v. Cunard Co.*, 1889, 6 R. P. C. 398). A corporation, and also its servants, can be sued for infringement.

Defendant.

Default of appearance.

If defendant is in default of appearance to the writ, a statement of claim, accompanied by affidavit of service, should be delivered by filing in default at the writ department or district registry. After the expiration of ten days, notice of motion may be served by filing in default in the same way and the motion set down. Beyond this, and proof of service of notice of motion, no evidence is required on the hearing of the motion (*Webster v. Vincent*, 77 L. T. 167). The relief claimed in the statement of claim and notice of motion should be exactly in the terms of the relief asked for by the writ (*Kingdon v. Kirk*, 37 C. D. 141). But where appearance has been made, and there has been default in defence, the relief asked for in the statement of claim may be wider in its terms than the writ, and such judgment shall be given as upon the statement of claim the Court may consider the plaintiff entitled to (A. P. Order 27, Rule 11). The particulars of breaches may be considered as part of the statement of claim for the purposes of this rule (*United Telephone Co. v. Smith*, 61 L. T. 617).

Entering appearance by defendant.

The defendant should enter an appearance within eight days. Until he does so no further steps can be taken in the action within this time. If the case is of great urgency leave might be obtained to serve notice of motion with the writ, or an *ex parte* application might be made before appearance for an interlocutory injunction, but exceptionally good cause would require to be shown. After appearance of the defendant the plaintiff might apply for an interlocutory injunction, but this is very seldom granted, since, if the defendant has any defence at all, it would necessitate going into the whole question of the cause of action, which at this stage could not conveniently be done. No interlocutory injunction will be granted if the Court is satisfied that the defendant has no intention of continuing the infringement (*Lyon v. Mayor of Newcastle*, 1894, 11 R. P. C. 218). If the patent is of some age and its novelty has not previously been challenged, and a *prima facie* case of infringement is established, the plaintiff is, generally speaking, entitled to an interlocutory injunction (*Shillito v. Larmuth*, 1884, 2 R. P. C. 1; Jessel, M. R., in *Dudgeon v. Thompson*, 1877, L. R. 3 App. Cas. 34). The same may also be said where the validity of the plaintiff's patent has been upheld in a former action (*Heine v. Norden*, 1904, 21 R. P. C. 513),

Interlocutory injunction.

Interim injunction never granted where defendant discontinues.

Depends on standing of patent and proof of infringement.

or where the defendant has not ventured to challenge the validity: but in either case a *prima facie* case of infringement must be shown. When the patent is recent, and its validity is disputed, no interlocutory injunction will be granted (*Spencer v. Holt*, 1903, 20 R. P. C. 142; *Holophone, Limited v. Berend*, 1898, 15 R. P. C. 18). Undue delay in bringing an action after knowledge of the infringement will also prejudice the plaintiff's claim to an interlocutory injunction (*Bovill v. Crate*, 1865, L. R. 1 Eq. 388; *North British Rubber Co. v. Gormully Co.*, 1894, 12 R. P. C. 17; *Leonhardt v. Kallé*, 1894, 11 R. P. C. 534), unless there are special circumstances which excuse delay (*United Telephone Co. v. Equitable Telephone Co.*, 1888, 5 R. P. C. 233). A defendant may often avoid being subjected to an interlocutory injunction by undertaking to keep an account pending trial (*Leonhardt v. Kallé, supra*). Where hardship to the defendant would ensue by the stoppage of large works or expensive machinery, an interlocutory injunction is not readily granted (*Neilson v. Forman*, 1841, 2 Coop. Ch. Cas. 61).

Offer of defendant to keep account.

Any order granting an interlocutory injunction should, and generally does, in the defendant's interests, contain a clause that, in the event of the defendant succeeding in the action to be afterwards tried, any damage suffered by the defendant through the order should be made good by the plaintiff.

Condition in order *re* damages.

Even where the defendant appears and consents to an injunction the Court may still use its discretion. For example, in *Dorer, Limited v. New Townend Cycle Co.*, (1904, 21 R. P. C. 135), Buckley, J., said: "I have recently heard that sometimes in patent cases injunctions are taken by consent upon terms which are arranged between the parties, and then these injunctions are advertised as if they had been granted by the Court in an opposed matter. That ought not to be done. 'The defendant appearing and undertaking' of course precludes that."

Undertaking by defendant in lieu of injunction.

In this case the order was drawn in the form suggested by the Judge.

The writ having been served and appearance entered, it then falls upon the plaintiff to deliver his statement of claim. This is governed by the ordinary rules, but there is an additional statutory obligation upon the plaintiff

Statement of claim.

Particulars of breaches.

Contents of statement of claim.

to deliver at the same time particulars of breaches, showing the particular instances of infringement of which he complains. In his statement of claim the plaintiff should allege (1) the grant of his patent, identifying it by number, date, and title, and showing the devolution of ownership should the plaintiff be other than the original patentee. He might also allege (2) that the Letters Patent are valid and subsisting (although this is not necessary), and state generally (3) that the defendant has infringed. The concluding claim should be similar to that endorsed on the writ: viz. (1) For an injunction to restrain the defendant, his servants, workmen, and agents, from making, selling, supplying, using, advertising, or offering for sale, or otherwise wrongfully dealing with or in goods made in infringement of the plaintiff's patent; (2) damages or an account; and (3) delivery up or destruction of the infringing articles. If the plaintiff possesses a certificate that the validity of his patent has been challenged in a former action, then he should claim (4) Costs as between solicitor and client, and should plead the certificate (*per Chitty, J., in Pneumatic Tyre Co. v. Chisholm, 1896, 13 R. P. C. 488*).

Certificate of validity if existing should be pleaded.

Particulars of breaches to contain alleged instances of infringement.

In the particulars of breaches delivered with the statement of claim, all the alleged instances of infringement known to the plaintiff should be set out with date, place, and name (Order 53A, R. S. C., Rule 13). The purpose of particulars is to let the defendant know exactly what he has to meet at the trial; and if the transactions alleged to constitute infringement are not admitted, they must be proved.

Particulars should, as a rule, be unqualified.

The allegations of infringement should be, generally speaking, unqualified. Such words as "in particular" or "by way of example and not of limitation" or the like are liable to be struck out (*Haslam v. Hall, 1887, 4 R. P. C. 203*). When the plaintiff's patent contains more than one claim, he should point out the claim or claims alleged to be infringed, and should give at least one instance of each type of infringement of which complaint is made (Order 53A, R. S. C., Rule 16). Except by leave of the Court, which is not easily obtained, instances of infringement not appearing in the particulars of breaches cannot be proved at the trial (*Henser v. Hardie, 1894, 11 R. P. C. 421*).

The defendant should deliver his defence within ten days from the delivery of the statement of claim, or within such enlarged time as the plaintiff or the Court may allow; and if he disputes the validity of the patent he must deliver with his defence particulars of the objections on which he relies in support of his challenge to the validity (Order 53A, R. S. C., Rule 14). The usual defence is (a) that the defendant has not infringed; (b) that the patentee was not the true and first inventor (but in such case the defendant must be prepared to show who was the true and first inventor); (c) that the patent is invalid from want of novelty or utility or want of subject-matter, or because of disconformity, or from insufficiency, or from other causes. Other available defences are that the defendant was not aware, nor had reasonable means of making himself aware of the existence of the patent (see Section 33). If the defendant succeeds upon this plea, the plaintiff is not entitled to recover any damages for infringement of a patent granted after the 1st of January, 1908, but he will not escape an injunction. Apparently the word "damages" in the section covers any form of compensation. Therefore the plaintiff is not entitled to an account of profits (*per* Neville, J., in *Slazenger v. Spalding*, 1909, 27 R. P. C. 26). The defendant may also plead the existence of any contract made by the patentee which by virtue of Section 38 was null and void (see Sub-section 4 of Section 38). A counterclaim for the revocation of the plaintiff's patent may now be incorporated in the defence (Section 32), but if the defendant is not entitled as of right to petition for the revocation of the patent, he should first obtain the Attorney-General's fiat. The defendant must also deliver with his defence particulars of objections to the patent. The particulars of objections should be divided into paragraphs, and must give full particulars of the grounds upon which the defendant disputes the validity of the patent.

Defence.

Contents of defence.

Counter-claim for revocation.

Particulars of objections.

Particulars of objections should clearly point out and limit grounds for attacking validity of patent.

Order 53A of the Rules of the Supreme Court was specially framed in pursuance of Section 98, Sub-section 1, Clause (b), of the Act of 1907, and is intended to govern procedure in actions for infringement of patents and other legal proceedings under the Act. The whole object of the Rules is to narrow the issues and place both parties in complete

New Rules of Supreme Court.

Order 53A,  
R. S. C.

possession of the exact points they will have to meet at the trial of the action. Rule 17 of the Order provides that:—"Particulars of objections (whether delivered with the defence in an action for infringement of a patent, or with a petition for revocation under Section 25 of the Act, or with a counter-claim for revocation under Section 32 of the Act) must state every ground upon which the validity of the patent is disputed, and must give such particulars as will clearly define every issue which it is intended to raise."

New Rule  
as to  
particulars  
of prior  
user.

Rule 18 continues:—"If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of the patent, must also specify the names of the person or persons who are alleged to have made such prior user, and whether such prior user is alleged to have continued down to the date of the patent, and, if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user relates to any machinery or apparatus shall specify whether the same is in existence and where the same can be inspected.

Evidence  
strictly  
limited by  
particulars.

"No evidence at variance with any statement contained in the particulars shall be given in support of any objection, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent, and which is in existence at the date of the delivery of the particulars, shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or, if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings."

It will be noted that Rule 17 says that the particulars of objections must state *every ground* upon which the validity of the patent is disputed, while Rule 18 shows with what exactness the particulars of want of novelty as regards alleged prior user must be set out.

It will, therefore, be advisable to refer seriatim to the grounds upon which validity can be disputed, and

indicate how far particulars of objections require to be carried in each case.

Thus, if the defendant pleads prior publication, he must clearly identify the prior specifications, books, or publications he depends on by time, name, and place. As far as anticipatory specifications are concerned, it must be remembered that where the plaintiff's patent has been applied for and granted since the 1st of January, 1905, no British specification of older date than fifty years back from the date of the plaintiff's patent can be deemed to be an anticipation (Section 41, Sub-section 1 of The Patents Act, 1907). If the prior anticipatory specification or publication cited by the defendant is very short and simple, he may refer to the whole; but if the prior publication is long and involved, and if it contains matter other than that affecting the plaintiff's patent, then the defendant ought to give the pages, lines, and figures he relies on. According to Scotch practice it was apparently not required that the defendant should give pages and lines of alleged anticipating specifications (*Rose's Patents Co. v. F. Braby & Co.*, 1894, 11 R. P. C., p. 206, line 28). If the plaintiff's specification has more than one claim, the defendant should point out the particular claim or claims affected by the anticipatory matter (*London and Leicester Co. v. Higham*, "Lawson on Patents," 3rd ed., p. 172; *Harris v. Rothwell*, 1886, 3 R. P. C. 243; *Boyd v. Farrer*, 1887, 5 R. P. C. 33; *Holliday v. Heppenstall*, 1889, 6 R. P. C. 320; *Sidebottom v. Fielden*, 1891, 8 R. P. C. 266). But apparently he need only do so when the plaintiff's specification is long and involved and the claims numerous. North, J., in *Heathfield v. Greenway* (1893, 11 R. P. C. 19), said that there must be special grounds for imposing such an order on the defendant. If the plaintiff thinks the particulars of objections with regard to prior publication are insufficient or too vague, he may apply by summons for further and better particulars (Order 53A, Rule 20). It must, however, be said that under present practice it is difficult to get the Court to compel the defendant to narrow his particulars of objections to pages and lines of the alleged anticipatory specifications, even when it may appear desirable that this should be done. If the defendant says that it would embarrass him to do so, the Court will seldom interfere.

Prior specifications.

Scotch practice.

Should indicate the claims attacked.

Present practice in applications for further and better particulars.



Prior publi-  
cations.

To enable the Judge to come to any decision on his own initiative, he would require to go carefully through all the specifications, which would be equivalent to a partial trial of the action at this stage of the proceedings, and this he will not do. Therefore when the defendant says that he cannot discriminate parts of the specifications without embarrassing himself in his defence, he is generally allowed to refer to the whole. If at the trial it turns out that he is wrong, he will have to pay the costs (*per Buckley, J., in Edison-Bell, Limited v. Columbia Phonograph Co., 1900, 18 R. P. C. 4*).

Prior user  
as an  
objection.

If the defendant relies upon prior user he must, in his particulars conform to all of the instructions set forth in Rule 18, which Rule has been set out in full (*supra*). The whole object of the particulars is to identify the alleged prior user both by description and by the aid of drawings if necessary. If the apparatus is in existence exactly or substantially similar to the condition it was in before the date of the patent, and is offered for inspection so that the plaintiff can satisfy himself, no description or drawings will be ordered (*Crossthwaite Fire Bar Syndicate v. Senior, 1909, 26 R. P. C. 260*). Such offer to inspect should be made at the time of delivery of the particulars of objections. The extent to which particulars should be carried in inventions relating to process and machinery patents was discussed by Cozens-Hardy, M. R., in *Minerals Separation, Limited v. Ore Concentration Co., Limited* (1909, 26 R. P. C., pp. 421-3). If the defendant relies on general common knowledge he need plead no specific instances of prior publication or user if the publications are contained in well known journals or text-books and the user is of common trade knowledge (*Holliday v. Heppenstall, 1889, 6 R. P. C. 320*); but he must be prepared to prove such a general and common trade knowledge and user as will bring it within this category. Also if he relies on any specifications as part of common knowledge he must set them out (*English and American Machinery Co. v. Union Boot Co., 1894, 11 R. P. C. 367*). A specification or specifications indicated in the particulars of objections may be referred to at the trial on the question of the state of public knowledge (*Sutcliffe v. Abbott, 1903, 20 R. P. C. 50*; see also *English and American Machinery*

No particu-  
lars need be  
given of  
general  
common  
knowledge.

*Holliday v.*  
*Heppen-*  
*stall.*

Prior speci-  
fications  
cited are  
part of  
common  
knowledge.