LAW AND PRACTICE

OF

PATENTS FOR INVENTIONS.

A CONCISE TREATISE

ON THE

LAW AND PRACTICE OF PATENTS

FOR

INVENTIONS.

CONSISTING OF THE

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

The New Rules,

AND NUMEROUS NOTES AND CASES.

BY

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PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

(46 & 47 Vict. c. 57.)

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An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs and of Trade Marks. [25th August, 1883.]

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I. PRELIMINARY.

PART I.

PRELIMINARY.

Short title.

S. 1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division of Act into parts.

S. 2. This Act is divided into parts as follows:—

Part I.—PRELIMINARY.
Part II.—PATENTS.
Part III.—DESIGNS.
Part IV.—TRADE MARKS.
Part V.—GENERAL.

Commencement of Act.

S. 3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

PART II.

PATENTS.

Application for and Grants of Patent.

S. 4. (1.) Any person, whether a British subject or not, may make an application for a patent.

Persons entitled to apply for patent.

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

The generality of the words "any person" are limited by the provision in the 5th section that the application for a patent must contain "a declaration to the effect that the applicant is in possession of an invention, whereof he, or, in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors." The question as to who may obtain a grant is best considered under the following heads:—

1.—*The person who discovers a new manufacture.*

The person who invents a new manufacture, and obtains a patent for it, is the true and first inventor within the statute, notwithstanding that somebody else had invented it before, but had not published it within the realm. (Dolland's Patent, cit. in *Boulton* v. *Bull*, 2 H. Bl. 469; *Lewis* v. *Marling*, 1 Web. P. C. 493; *Hills* v. *London Gaslight Co.*, 5 H. & N. 336; *Plimpton* v. *Malcolmson*, per Jessel, M.R. 3 Ch. D. 556; *Gibson* v. *Brand*, 1 Web. P. C. 628.)

If several persons simultaneously discover the same thing, the party first communicating it to the public, under the protection of letters patent, becomes the legal inventor. (Chitty, Prerog. Crown. 182; 1 Web. P. C. 97.)

A man who discovers the principle of a new manufacture, but employs others to carry it out in detail is still the true

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and first inventor within the statute. (*Bloxam* v. *Elsee*, 1 Web. P. C. 132 (n); *Minter* v. *Wells*, 1 Web. P. C. 127; *Allen* v. *Rawson*, 1 C. B. 574; *Tennant's Case*, 1 Web. P. C. 125.)

It was held in *Chappel* v. *Purday* (14 M. & W. 318) that an alien subject of a country with which we are at amity may be the grantee of a patent, and it would seem that the words "whether a British subject or not," appearing in this section, now remove all restrictions of nationality. This will probably in time do away with the practice, now usually followed, of foreign inventors taking out British patents in the names of their patent agent, and subsequently taking an assignment from them.

2.—*The importer from abroad of a new manufacture.*

As a person who is not a British subject can now obtain a patent, applications of this nature are likely to be much less frequent.

The 6th section of the Statute of Monopolies has not been repealed, and as it has long been held that a person to whom an invention is communicated from abroad is the "first and true inventor" within that section (*Edgeberry* v. *Stephens*, 2 Salk. 447; *Marsden* v. *The Saville Street Foundry Co.*, 3 Ex. Div. 203), a patent may still be granted to the importer of an invention. Rule 27, p. 197, provides that the form A 1, in the second schedule to the rules, p. 216, shall be used in applications of this nature.

It is immaterial that the patent is held in trust for a foreigner, the subject of a state in amity with this country, and that the inventor has parted with his invention abroad, before the grant of a patent in England. (*Beard* v. *Egerton*, 3 C. B. 97.) So, if a person resident abroad communicates an invention to A. who communicates it to B., it is competent to B. to apply for a patent (*Plimpton* v. *Malcolmson*, 3 Ch. D. 552), and a patent may be granted to an alien

resident abroad, for an invention communicated to him by another alien also resident abroad. (*In re Wirth's Patent*, 12 Ch. D. 803.) But a communication made in England, by one British subject to another, of an invention, does not constitute the person to whom the communication is made the true and first inventor within the statute. (*Marsden* v. *The Saville Street Foundry Co.*, 3 Ex. Div. 203.) S. 4.

Before the passing of the present Act it was held that when a patent is taken out as for an original invention, the subject of the patent being in fact a communication from a British subject resident abroad, the patent is void (*Milligan* v. *Marsh*, 2 Jur., N. S. 1083), also that when the patent relates partly to original inventions, and partly to communications from abroad, they should be distinguished in the specification. (*Renard* v. *Levinstein*, 10 L. T. Rep., N. S. 177.)

3.—*Any person or persons who, not being the true and first inventor or inventors, makes or make a joint application with the person who claims to be the true and first inventor.*

In the case of *concurrent applications* in respect of contemporaneous discoveries, a joint patent has sometimes been granted (*Heath* v. *Smith*, 2 Web. P. C. 271), or a patent to one in trust for both (*In re Russell*, 2 De G. & J. 130); but in other cases a patent has been granted either to the person who first applies for the seal (*In re Bates and Redgate*, L. R., 4 Ch. 577; *Ex parte Henry*, L. R., 8 Ch. 167; *In re Lowe*, 25 L. J., Ch. 454; *Ex parte Dyer*, Holroyd, 59), provided there is no fraud (*Ex parte Scott and Young*, L. R., 6 Ch. 274), or to the first applicant for provisional protection (*In re Derring*, 13 Ch. D. 393), or to both (*In re Derring*, 13 Ch. D. 393), and a patent may be granted jointly to an adult and a minor (*Cheavin* v. *Walker*, 5 Ch. Div. 858). Joint patentees are not, in contemplation of law, partners, and each may use the invention without accounting to the other. (*Mathers* v. *Green*, 1 Ch. App. 29.)

S. 4. 4.—*The legal representative of a person possessed of an invention, who dies without making application for a patent.*

The application must be made within six months of the decease of the inventor, and declare him to be the true and first inventor (sect. 34, p. 116), and must be accompanied by an official copy or extract from his will, or the letters of administration granted of his estate and effects, in proof of the applicant's title (rule 24, p. 196).

Prior to the passing of this Act, the legal representative could not obtain a patent. (*Marsden* v. *The Saville Street Foundry Co.*, 3 Ex. D. 203.)

5.—*Semble, a member of an official commission or committee in respect of an invention relating to the subject-matter of their official investigation, and embodied in their official report, cannot be an applicant.* (See *Patterson* v. *The Gas Light and Coke Co.*, 2 Ch. D. 832, and 3 App. Cas., 242, 247, 251.)

Application and specification.

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

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification (*a*, p. 11).

(3.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required (*b*). s. 5.

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required (*c*, p. 18).

(5.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed (*d*, p. 26).

(*a*) By section 34, p. 116, the legal representative of a deceased inventor may, in certain events, obtain a patent. This case forms an exception to the provision of this subsection, for the application must contain a declaration by the legal representative that he believes *such deceased person* to be the true and first inventor. No Form is given for use in this class of cases. See forms A and A 1, in 2nd Sch. to the Rules, p. 215. The application must be signed by the applicant (r. 8, p. 192) and accompanied by a statement of an address to which all communications may be made (rule 9, p. 192). As to the prescribed manner of leaving or sending applications see rr. 19 and 22, p. 194. Every applicant must also supply additional drawings under rule 31, p. 198, when his specification is accompanied by drawings.

(*b*) Rule 6, p. 192, makes the use of the form of provisional specification given in the 2nd Sch. to the Rules, p. 217, compulsory. As to the size, &c., of documents see rule 10, p. 193. The 6th section of the Patent Law Amendment Act, 1852, to which this section corresponds, directs that every petition for the grant of Letters Patent shall be accompanied

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by a provisional specification "describing the nature of the invention." A provisional specification, therefore, which satisfied the old Act, will be sufficient under the present Act, except that drawings must now accompany, "if required," so that all the decided case relating of this branch of Patent Law are still applicable.

A provisional specification was never intended to be more than a mode of protecting an inventor until the time for filing the final specification. It is not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly, no doubt, but in its rough state, until the inventor can perfects its details. (Per Jessel, M.R., in *Stoner* v. *Todd*, 4 Ch. D. 59; and see *In re Newall* v. *Elliott*, 4 C. B., N. S. 269.)

The object of the provisional specification is, on the one hand, to enable the inventor to perfect his invention by experiments, which, although open and known, will not be a user and publication to the prejudice of Letters Patent to be afterwards granted, so that he may be in a condition to describe in his complete specification, as the result of his experience, the best manner of performing the invention (*Penn* v. *Bibby*, L. R., 2. Ch. 132), and, on the other hand, to ascertain the identity of the invention, and to make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance. (*Newall* v. *Elliott* 10 Jur., N. S. 955.)

The vagueness or generality of the provisional specification is an objection that may well be taken before the grant of a patent, but it affords no ground for avoiding the patent after it has been granted. (*Penn* v. *Bibby*, L. R., 2 Ch. 132.)

The provisional specification, cannot be prayed in aid, for the purpose of supplying a defect in the subsequent complete specification (*Mackelcan* v. *Rennie*, 13 C. B., N. S. 52.) But

any part of a provisional specification may be omitted in the complete specification, if there is no fraud, and the effect of the remainder is not altered by the omission. (*Thomas* v. *Welch*, L. R., 1 C. P. 192; *Penn* v. *Bibby*, L. R., 2 Ch. 134.)

(*c*) For the form of specification to be used see form C, in 2nd Sch. to Rules, p. 217. And see rule 30, p. 197. The words of this sub-section, requiring that the complete specification shall "particularly describe and ascertain the nature of the invention, and in what manner it shall be performed," are taken from the 9th sect. of the Patent Law Amendment Act, 1852, with the addition that drawings may be required under this sub-section, and that it must commence with the title, and end with a distinct statement of the invention claimed. Subject to the 5th sub-sect. of this section, any complete specification that was sufficient before the passing of this Act will be sufficient still, and all, or nearly all the reported cases are still useful law.

The following general rules as to the sufficiency of the complete specification are deduced from the reported cases.

(A.) The complete specification must not only describe and ascertain the nature of the invention, but must also describe in what manner it is to be performed, otherwise the patent will be void.

Illustrations.

(1.) The complete specification of a patent for "improvements in preserving animal substances," said: "The manner in which our said invention is performed is as follows:—We employ a solution, hereinafter distinguished as solution No. 1, being a solution of bisulphide of lime (usually expressed by the formula $CaO,2SO_2$), in water of the specific gravity 1050." The specification then described the formation of solutions Nos. 2, 3 and 4, by mixing solution No. 1 with other bodies, and the mode of employing them in preserving various animal substances, but contained no statement as to how the solution No. 1 was to be applied or used for the purposes of the invention. The patentee claimed the use of solution No. 1 for preserving animal

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substances, and the preservation of particular animal substances by the various other solutions "in manner hereinbefore described." *Held*, that, if the final specification claimed the independent and separate use of solution No. 1, for preserving animal substances, there was no sufficient description of the manner in which the invention was to be performed. (*Bailey* v. *Robertson*, 3 App. Cas. 1055.)

(2.) Patent for certain improvements in extracting sugar or syrup from cane-juice and other substances containing sugar, and in refining sugar and syrup. In the specification the patentee said: "The invention consists in a means of discolouring syrups of every description by means of charcoal, produced by the distillation of bituminous schistus alone, or mixed with animal charcoal, and even of animal charcoal alone." The specification then stated that the "discoloration" was to be produced by means of a filter of the charcoal, and continued: "The carbonization of bituminous schistus has nothing particular; it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it." The specification said nothing as to any previous operation on the syrup before it was submitted to the filter, but it did state that syrup in a proper state might be obtained by a mixture of sugar and water. The defendant objected to the sufficiency of the specification. *Held*, first, upon proof that the invention was applicable with advantage to the syrup, after it had undergone a certain degree of heat, though it failed when applied to the first drawings of the syrup, that the specification was sufficient. Secondly, that it was incumbent on the patentee to prove, that the presence of iron in the bituminous schistus, used in the process of filtering, would not be injurious; or else, that the method of extracting the iron from it was so simple and well known, that a person ordinarily acquainted with the subject could remove it with ease; or, that the bituminous schistus, as known in England, could be used in the process with advantage. (*Derosne* v. *Fairie*, 2 Cr. M. & R. 476.)

(3.) Patent for "a new or improved method of drying and preparing malt." In the specification it was stated, that the invention consisted in exposing malt previously made, to a very high degree of heat: but it did not describe any new machine invented for that purpose; nor the state, whether moist or dry, in which the malt was originally to be taken for the purpose of being subjected to the process; nor the utmost degree of heat which might be safely used; nor the length of time to be employed; nor the exact criterion by which it might be known when the process was accomplished. *Held*, that the specification was not sufficiently precise. (*Reg.* v. *Wheeler*, 2 B. & Ald. 355.)

(B) The specification must so disclose the manner in which the invention is performed as not to necessitate a recourse to experiment, invention, addition or correction. (*Neilson* v. *Harford*, 8 M. & W. 806; *Reg.* v. *Wheeler*, 2 B. & Ald. 354; *Morgan* v. *Seaward*, 1 Web. P. C. 174.) S. 5.

Illustrations.

(1.) The description in the specification of a lamp burner omitted to state where the hole for the admission of air was to be made. *Held*, that the patent was bad, as it required corrections or invention to make the lamp useful. (*Hinks* v. *Safety Lighting Co.*, 4 Ch. Div. 607.)

(2.) The invention consisted of an improved mode of cutting or forming stone, or other suitable material for paving or covering roads, and the specification directed the blocks to be bevelled both inwards and outwards, but said nothing as to the precise angle at which the bevels were to be made. *Held*, that if any angle was a benefit, the specification was sufficient, but if experiment were necessary to determine the proper angle, it was bad. (*Macnamara* v. *Hulse*, 2 Web. P. C. 129.)

(3.) The specification of a patent for an improved manufacture of metal plates for sheathing the bottoms of ships, directed copper and zinc to be melted together in proportions between 40 per cent. of copper to 50 per cent. of zinc, and 63 per cent of copper to 36 per cent. of zinc. It was objected that the specification left it uncertain whether the above were to be taken with reference to the measured quantities to be put into the fusing pot, or whether they meant to specify the result of the two combined together when taken out. *Held*, that if this necessitated experiments the patent was void. (*Muntz* v. *Foster*, 2 Web. P. C. 96.)

(C.) The specification must be intelligible to an ordinary careful workman possessed of reasonable skill and intelligence, but not such scientific knowledge or power of invention as would enable him, unaided, to supplement a defective description or correct an erroneous description. (*Plimpton* v. *Malcolmson*, 3 Ch. D. 568; *Neilson* v. *Harford*, 1 Web. P. C. 314; *Reg.* v. *Arkwright*, 1 Web. P. C. 66; *Househill Iron Co.* v. *Neilson*, 1 Web. P. C. 676, 682; *Heath* v. *Unwin*, 2 Web. P. C. 245.)

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(D.) There must be no fraudulent concealment, but the specification must disclose the invention, and in what matter it is to be performed, in as ample and beneficial a way as the patentee himself knows, otherwise the patent will be void. (*Reg.* v. *Arkwright*, 1 Web. P. C. 66; *Bovill* v. *Moore*, Dav. P. C. 400; *Lewis* v. *Marling*, 10 B. & C. 26; *Walton* v. *Bateman*, 1 Web. P.C. 622.)

Illustrations.

(1.) The specification of a patent for making verdigris described a method sufficient for that purpose, but made no mention of *aqua fortis*, which the patentee had been accustomed clandestinely to add for the purpose of dissolving the copper more rapidly. The verdigris produced with the *aqua fortis* was neither better nor cheaper than that made according to the specification, but it involved less labour. *Held*, a prejudicial concealment which rendered the patent void. (*Wood* v. *Zimmer*, 1 Web. P. C. 82.)

(2.) If the patentee can make the article patented with *cheaper* materials than those which he has enumerated in his specification, although the latter will answer the purpose equally well, the patent is void. (*Turner* v. *Winter*, 1 Web. P. C. 81.)

(3.) The patentee is bound to communicate to the public, not only all the information he has at the time he applies for his patent, but all the knowledge he has at the date of his specification. (*Crossley* v. *Beverley*, 1 Web. P. C. 117.)

(E.) If the specification is *misleading* or *ambiguous* the patent is void. (*Crompton* v. *Ibbotson*, 1 Web. P. C. 83; *Neilson* v. *Harford*, 3 M. & W. 806; *Patent Type Founding Co.* v. *Richards*, 1 John. Rep. 381; *Campion* v. *Benyon*, 6 B. Mo. 71; *Turner* v. *Winter*, 1 Web. P. C. 77).

Illustrations.

(1.) The specification of a patent for making seidlitz powders gave three recipes for preparing the ingredients, to which no names were given. The three recipes were the common processes, for preparing the ingredients, which were Rochelle salt, carbonate of soda, and tartaric acid, which were sold in shops before the date of the patent. *Held*, that the patent was void, as the specification misled the public, by

making them believe an elaborate process essential to the invention. (*Savory* v. *Price*, 1 Web. P. C. 83.) S. 5.

(2.) The invention consisted in putting a glazed or enamelled surface on paper to be used for copper and other plate printing, by means of white lead and size. The enamel was directed to be made by mixing size with "the finest and purest chemical white lead." The finest and purest white lead obtainable in the London shops, or generally in the trade, would not answer the purpose, but there was a purer white lead, prepared on the Continent, and imported into this country, which alone could be successfully used. *Held*, that as this was not pointed out in the specification, the patent was void. (*Sturtz* v. *De la Rue*, 1 Web. P. C. 83; and see *Wegmann* v. *Corcoran*, 13 Ch. D. 65, 83.)

(3.) The patent was for an improvement in drying and finishing paper. The patentee said in his specification: "The invention I claim consists in conducting the paper, by means of cloth or cloths, against the heated cylinders, which cloth may be made of any suitable material, but I prefer it to be made of linen warp and woollen weft." The evidence showed, that, before the date of the specification, the patentee had tried several fabrics for the purpose, but none had answered, except the one made of linen and wool. *Held*, that the specification was bad, as it tended to mislead the public. (*Crompton* v. *Ibbotson*, 1 Web. P. C. 83; and see *Bickford* v. *Skewes*, 1. Q. B. 948.)

(4.) The insertion or representation of anything as material, not being so in fact, is fatal. (*Huddart* v. *Grimshaw*, 1 Web. P. C. 93.)

(5.) A specification in a patent, for a particular construction of windlasses, stated that the object was "to hold, without slipping, a chain cable of any size." Before the date of the patent, constructions were known by which a windlass might be made to hold a single chain cable of any assigned size. *Held*, that the specification did not unequivocally show, that the object was to construct a single windlass which might hold different chain cables, whatever their size, and that such a windlass was, therefore, not protected by the patent. (*Hastings* v. *Brown*, 1 E. & B. 450.)

(F.) The specification should distinguish what is new from what is old, and confine the claim to what is new, otherwise the patent is void. (*Dangerfield* v. *Jones*, 13 L. T. Rep., N.S. 144; *Tetley* v. *Easton*, 2 Ell. & Bl. 956; *Manton* v. *Manton*, Dav. P. C. 349; *Carpenter* v. *Smith*, 1 Web. P. C. 532; *Lister* v. *Leather*, 8 Ell. & Bl. 1004, 1031; *Foxwell* v. *Bostock*, 4 De G., J. & S. 298; *Williams* v. *Brodie*, Dav. P. C. 96.

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Illustrations.

(1.) The plaintiff obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument. *Held*, that the specification was bad, as it did not distinguish what was new from what was old. (*Holmes* v. *London and North Western Ry. Co.*, Macr. P. C. 13.)

(2.) The patent was for improvements in central-fire breech-loading cartridges. The specification, describing the method of performing the invention, referred to certain figures in drawings annexed thereto, but did not distinguish between what was new and what was old. The patentee claimed the manufacture of cartridges described with reference to figs. 1, 2, and 1*, and also the manufacture of cartridges described with reference to figs. 3, 4, and 3*. *Held*, that the patent might be upheld by limiting the claim (as in *Seed* v. *Higgins*, 8 H. L. C. 550), for the manufacture of cartridges described with reference to the above-mentioned figures. (*Daw* v. *Eley*, L. R., 3 Eq. 500 (n).)

(3.) In a drawing of a machine attached to a specification there was shown an intervening space, or opening, between two parts of the machine, the subject of the patent; it was intended as the arching of a cutter-plate, but this was not referred to and explained in the specification. In the specification there was the statement of an evil in existing machines, and upon careful examination by a skilful person, he might suppose that the space exhibited in the drawing was intended to obviate this evil, but there was no statement to that effect, nor was the form of the opening described, and described as a necessary quality of improvement in the machine. This form was afterwards relied upon as one of the great improvements in the combination of the patented apparatus. *Held*, that as it had not been properly explained, described and claimed, the specification was defective. (*Clark* v. *Adie*, 2 App. Cas. 315.)

(4.) If the claim is too large and vague, or covers more than, or something different from, what is described in the specification, or something which will not succeed in practice, the patent is void. (*Thomas* v. *Foxwell*, 6 Jur., N. S. 271; *Jordan* v. *Moore*, L. R., 1 C. P. 624; *Arnold* v. *Bradbury*, L. R., 6 Ch.

706; *Rushton* v. *Crawley*, L. R., 10 Eq. 527; *Gamble* v. *Kurtz*, 3 C. B. 425.) S. 5.

Illustrations.

(1.) The patent was for "an improvement in the construction, making, or manufacturing of chairs." "The patentees 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 such chair as above described." It appeared from the evidence, that a chair, acting upon the same principle as that which the patentee claimed, had been constructed and sold by a person of the name of Brown, before the date of the patent. *Held*, that the patent was void, as it claimed more than the patentee had invented, and would preclude Brown from continuing to make the chair he had invented prior to the date of the patent. (*Minter* v. *Mower*, 6 A. & E. 735.)

(2.) The patent was for a machine for making paper in single sheets, without seam or jointing, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. *Held*, that this imported that paper, varying in width between those extremes, should be made by the same machine, and that the patentee at the time of taking out the patent, not having any machine capable of producing paper of different widths, the patent was void. (*Bloxam* v. *Elsee*, 6 B. & C. 169.)

(3.) Where a patentee claimed the exclusive liberty of making lace, composed of silk and cotton thread mixed, and not any particular mode of mixing, it was held to be void, on proof that silk and cotton thread had been before mixed on the same frame for lace, although not in the same mode. (*R.* v. *Else*, 1 Web. P. C. 76.)

(4.) Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships or other such vessels." The patentee, in his specification, directed copper and zinc to be melted together "in the usual manner, in proportions between 50 per cent. of copper to 50 per cent. of zinc, and 63 per cent. copper to 37 per cent. of zinc, both of which extremes, and all intermediate proportions, will roll at a red heat." *Held*, that if the invention could not be made in one or two of the different proportions of zinc and copper mentioned in the specification, the patent would be void. (*Muntz* v. *Foster*, 2 Web. P. C. 110; and see *Wegmann* v. *Corcoran*, 13 Ch. D. 65.)

(5.) Action for the infringement of a patent for "improvements in the manufacture of gas." The specification stated the invention to "consist in the direct use of seeds, leaves, flowers, branches, nuts,

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fruit, and other substances and matters containing oil, or oily or resinous matter." The specification also stated "that the mode of using seed, and constructing the apparatus used under this my patent in preparing gas, may be the same as the apparatus used in the ordinary mode of making gas with coal." The claim was as follows: "I claim for making gas direct from seeds, and matter herein named, for practical illuminations, or other useful purposes, instead of making it from the oils, resins, or gums, previously extracted from such substances." A previous patentee had, by his specification, proposed, for the manufacture of gas, to use fatty substances, such as greaves or graves; also the residuum after the oil had been expressed from seeds, such as oil cake; also beech nuts, mast, cocoanuts, and other matters abounding in oil, and he proposed to use these substances separately and in combination. *Held*, that the claim, being merely for making gas direct from seeds and matter stated in the specification, without reference to any method of doing it, was too large and general, and could not be supported. (*Booth* v. *Kennard*, 2 H. & N. 84.)

(6.) A patent for "improvements in the preparation of red and purple dyes," thus described the process: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour." It was proved (and not denied by the patentee) that it was necessary to apply heat in order to produce the colour; but evidence was given that a competent workman would apply heat. *Held*, however, that this description in the specification was bad, and the patent founded thereon was invalid. (*Simpson* v. *Holliday*, L. R., 1 H. L. 315; see also *R.* v. *Cutler*, Macr. P. C. 124, and *Beard* v. *Egerton*, 19 L. J., C. P. 40.)

(7.) Patent for "a process or method of combining various materials so as to form stuccoes, plasters, and cements, and for the manufacture of artificial stones, marbles, &c., used in buildings." The specification, after stating the invention to consist in producing certain hard cements of the combination of the powder of gypsum, powder of limestone, and chalk, with other materials, such combinations being (subsequent to their mixing) submitted to heat, described the method or process of making a cement from gypsum to consist in mixing with powdered gypsum, strong alkali (*ex. gr.* best American pearl-ash) dissolved in a certain proportion of water; this solution to be neutralized with acid (sulphuric acid being the best), the mass to be kept in agitation, and the acid to be added gradually till the effervescence should cease; and then a certain proportion of water to be added (if other alkali were used, the quantity to be varied in proportion to its strength); and the mixture having been brought to a proper consistence

by the further addition of powdered gypsum, to be dried in moulds, and finally subjected to a furnace capable of producing a red heat. The specification concluded by stating that other alkalies and acids, besides those before mentioned, would answer the purposes of the invention, though not so well, and that the inventor claimed the method or process thereinbefore described. *Held*, that the specification was bad. "It must either be a claim of all acids and alkalies, or of all acids and alkalies that will answer the purpose. If it be a claim of all acids and alkalies, it is clearly bad, as there are some which will not answer the purpose. If it be a claim of those only which will answer the purpose, it is as clearly bad, in consequence of not stating those which will answer the purpose, and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not." (*Stevens* v. *Keating*, 2 Exch. R. 772.)

Drawings.

Before the passing of the present Act it was never compulsory upon a patentee to annex drawings to his specification, if he could make his invention intelligible without them. (*Boulton* v. *Bull*, 2 H. Bl. 481.)

Drawings when employed form part of the specification (*Morgan* v. *Seaward*, 1 Web. P. C. 173), and may be employed to explain an ambiguity in the written description of the invention (*Hastings* v. *Brown*, 1 E. & B. 454; *Bloxam* v. *Elsee*, 1 C. & P. 564), or to limit the claim (*Daw* v. *Eley*, L. R., 3 Eq. 500 (n)), and might, before the passing of this Act, even form a complete specification without any written description. (*Poupard* v. *Fardell*, 18 W. R. 129; *Foxwell* v. *Bostock*, 4 De G. J. & S. 303.) It has not been considered necessary that drawings should be well executed, or skilfully drawn, and they have been considered sufficient if they enabled a workman of fair and competent skill to carry out the invention (*Bovill* v. *Moores*, Dav. P. C. 369.) Their intelligibility was considered to be a question for the jury. (*Morton* v. *Middleton*, 1 Cr. S. 3rd. Ser. 722.)

Under the present Act it will be for the examiners to report whether the drawings are in the prescribed form (sect. 6, p. 27), and the comptroller may require them to be amended (sect. 7 (1), p. 30). The question of their sufficiency

S. 5. and intelligibility may still be questioned in Court. Drawings must now comply strictly with rules 28 and 29, p. 197.

The following are the principles which apply to the construction of the specification:

Construction of Specification.

(A.) The rules that govern the construction of specifications are the ordinary rules for the interpretation of written instruments, and the specification ought not to be subjected to a benign interpretation or to a strict one, but it should be construed fairly and truly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. (*Simpson* v. *Holliday*, 13 W. R. 578; *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 581; *Dudgeon* v. *Thomson*, 3 App. Cas. 53; *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 612; *Plimpton* v. *Spiller*, 6 Ch. D. 422; *Stevens* v. *Keating*, 2 Web. P. C. 187; *Thomas* v. *Foxwell*, 6 Jur., N. S. 272; *Otto* v. *Linford*, 46 L. T. Rep., N. S. 35; *Tetley* v. *Easton*, Macr. P. C. 74; *Palmer* v. *Wagstaff*, 9 Exch. 494.)

Illustrations.

(1.) If a claim in the specification can be read in two ways, one claiming something that has a merit of novelty, and the other claiming something which would show the man to be ignorant of all the ordinary appliances used in every workshop in the world, it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible, rather than that construction which makes the patent utterly absurd. (*Plimpton* v. *Spiller*, 6 Ch. D. 422; *Clark* v. *Adie*, 3 Ch. D. 142; *Trotman* v. *Wood*, per Byles, J., 16 C. B., N. S. 504.)

(2.) Patent "for improvements in giving signals and sounding alarums in distant places, by means of electric currents transmitted through *metallic circuits*." Subsequently to the patent, it was discovered that the return current could be conducted back to the battery through the earth as effectually as through a continuous metallic circuit. The defendants contended that, by using this method, they did not infringe the patent. *Held*, that the specification, in speaking of metallic circuits, comprehended all circuits which were metallic, so far as it was material to the improvements claimed that they should be so, and therefore that the defendants were guilty of infringement. (*The Electric Telegraph Co.* v. *Brett*, 10 C. B. 838.)

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(B.) The construction of a specification belongs to the Court; but the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which it is the province and right of a jury to decide. (*Hills* v. *Evans*, 31 L. J., Ch. 457; *Neilson* v. *Harford*, 1 Web. P. C. 370; *Derosne* v. *Fairie*, 1 Web. P. C. 156.)

Illustration.

(1.) The specification described the invention to consist in the application to the covering of buttons, of such figured woven fabrics "wherein the ground, or the face of the ground thereof, is produced by a warp of *soft or organzine silk*, such as is used in weaving satin and the classes of fabrics produced therefrom." The jury asked how they were to understand the word "or" in the specification; whether it was used disjunctively, or whether "*organzine*" was the construction of the word "*soft*." The judge told them, that, in his opinion, unless the silk was *organzine*, it was not within the patent. *Held*, that this direction was erroneous; for that the judge should not have told the jury, absolutely, that soft and organzine silk were the same, but that the words were *capable* of being so construed, if the jury were satisfied that, at the date of the patent, there was only one description of soft silk—and that organzine—used in satin weaving; but, otherwise, that the proper and ordinary sense of the word "or" was to be adopted, and the patent held to apply to every species of soft silk, as well as to organzine silk. (*Elliott* v. *Turner*, 2 C. B. 446; and see *Hills* v. *London Gas Light Co.*, 27 L. J., Ex. 60, and 29 L. J., Ex. 409.)

(C.) A specification of a patent should be construed with reference to the state of knowledge upon the subject-matter of the patent at the date of the grant. (*Heath* v. *Unwin*, 25 L. J., C. P. 19; *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; *Lewis* v. *Marling*, 10 B. & C. 22.)

Illustrations.

(1.) Action for the infringement of a patent for "an improved gas apparatus." In the specification the patentee said: "My improved

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gas apparatus is for the purpose of extracting inflammable gas by heat from pit coal, or tar, or any other substance from which gas or gases capable of being employed for illumination can be extracted by heat." It was objected to the sufficiency of the specification, that the retort described would not do for making gas from oil. Before the date of the specification, however, oil had never been employed for that purpose. *Held*, that the specification was sufficient. (*Crossley* v. *everley*, 1 Web. P. C. 106.)

(2.) A patent for a chemical process only gives an exclusive right to use those substances which are known, at the date of the patent, to be chemical equivalents for the substances mentioned in the specification, and does not extend to those subsequently discovered to be equivalent. (*Heath* v. *Unwin*, 25 L. J., C. P. 19.)

(3.) Where the patentee in his specification describes his invention in the best form that science could then give it, it is immaterial that a cheaper way of carrying out the invention has been subsequently discovered. (*Simpson* v. *Holliday*, 20 Newt. Lon. Jour., N. S. 116.)

(D.) *Semble*, prior patents and specifications are admissible in evidence, for the purpose of informing the Court of the state of knowledge relating to the subject matter of a patent, so as to enable the Court rightly to construe the specification of such patent. (*Trotman* v. *Wood*, 16 C. B., N. S. 479; *Clark* v. *Adie* (second appeal), 2 App. Cas., 423, pp. 430, 436; in Court of Appeal, 3 Ch. D. 142.)

Semble, also for the purpose of construing a specification which is ambiguous or doubtful. (*Clark* v. *Adie*, 2 App. Cas. 430.)

(E.) In construing specifications the popular or commercial, and not the mathematical or scientific, meaning is to be placed upon the words used. (*Clark* v. *Adie*, 2 App. Cas. 423.)

Illustrations.

(1.) A patentee, in his specification of a patent for preparing red and purple dyes, said: "I mix aniline with *dry* arsenic acid," &c. At the date of the patent an arsenic acid entirely free from water was known to chemists as anhydrous arsenic acid, but could not be commonly bought in the trade. This would not produce the dyes. A hydrated acid, containing from 12 to 14 per cent. of water, was commonly sold

by manufacturers, which was dry to the touch, and known in the trade as "dry arsenic acid." This would produce the dyes. Wood, V.-C., found, on the ground that the specification was addressed to manufacturers, and not to scientific chemists, that "dry arsenic acid" meant dry hydrated arsenic acid. (*Simpson* v. *Holliday*, 20 Newt. Lon. Jour., N. S, 118.)

(2.) Patent for "improvements in a horse-clipping machine." The improvements described in the specification, among other items, the parallelism of the teeth of the comb. *Held*, that the word "parallel" should be construed in its popular and not in its mathematical sense. (*Clark* v. *Adie*, 2 App. Cass. 423.)

(F.) In the comparison of two specifications, each of which contains terms of art, and the description of technical processes, the duty of the Court is confined to giving the legal construction to such documents taken independently, but the comparison of the two instruments, and ascertaining whether the words, as interpretated by the Court, and contained in one specification, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in the other specification, is a matter of fact, and within the province of the jury. (*Hills* v. *Evans*, 31 L. J., Ch. 457; *Betts* v. *Menzies*, 10 H. L. Cas. 134.)

Illustration.

The plaintiff obtained in 1849 a patent for the purification of coal gas by means of *hydrated* oxides of iron. In 1847, F., having obtained a patent for the purification of gas by chloride of calcium, specified a mode of making the chloride of calcium by decomposing muriate of manganese, iron or zinc, and said, "the oxides or carbonates which result are useful for the said purification of gas, and need not be removed." The oxides so prepared would be hydrates. *Held*, that the Court, on a comparison of F.'s specification with that of the plaintiff, could not say as a matter of law, that F. had anticipated the plaintiff's invention. (*Hills* v. *London Gas Light Co.*, 5 H. & N. 312.)

(G.) The intelligibility and sufficiency of a specification is a question of fact for the jury, and not a question of law for

S. 5. the Court. (*Parkes* v. *Stevens*, L. R., 8 Eq. 358, affirmed L. R., 5 Ch. 36; *Wallington* v. *Dale*, 7 Exch. 888; *Hill* v. *Thompson*, 1 Web. P. C. 235; *Bickford* v. *Skewes*, 1 Web. P. C. 214.)

(*d.*) The provisions of this sub-section have been in practice usually carried out. It has, however, been held, prior to the passing of the present Act, that the claim was not an essential part of a specification, or necessary for the protection of a patent. (*Lister* v. *Leather*, 8 E. & B. 1054; *Dudgeon* v. *Thomson*, 3 App. Cas. 54.) The claim always was and still is an extremely important part of the specification, and should be very carefully worded in order to avoid a difficulty such as that which arose in the case of *Tetley* v. *Easton* (2 E. & B. 956), where it was held that a specification must, unless a contrary intention appears, be deemed to claim all that it describes, not only as a whole taken in combination, but also all the essential parts of which such combination is composed.

In future a complete specification will not be passed by an examiner, or accepted by the comptroller, as prepared in the prescribed manner, unless it ends with a distinct statement of the invention claimed. In the absence of such claim an amendment may be required. It should be remembered that the real object of the claim, as pointed out by James, L.J. (*Plimpton* v. *Spiller*, 6 Ch. D. 426), is not to claim anything which is not mentioned in the specification, but to disclaim something. A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use—he describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says: "But take notice, I do not claim the whole of that machine, I do not claim the whole of that *modus operandi*, but that which is new, and that which I claim is that which I am now about to state."

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Not only must care be taken to exclude everything from the claim which is old, and therefore not patentable, but also to include all that the patentee has in fact invented, for everything described in the specification and not specifically claimed becomes public property. (*Hinks* v. *Safety Lighting Co.*, per Jessel (M.R.), 4 Ch. D. 612.)

Reference of application to examiner.

S. 6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject matter of the invention.

Under this section it is the duty of the examiner to ascertain and report to the comptroller upon the following points.

(1.) Whether the *nature* of the invention has been fairly described.

Every application for a patent must be accompanied by either a provisional or complete specification (sect 5 (2), p. 10). To this the examiner must look for a description of the nature of the invention. It will be observed that when the application is accompanied by a *complete* specification the examiner is not here required to consider its sufficiency as such, but only so far as it fills the office of a provisional specification, namely to disclose the *nature* of the invention claimed. See sect. 5 (3) and notes thereto, p. 11.

(2.) Whether the *application* has been prepared in the prescribed manner. See sect. 5 (1), and (2) and notes thereon, p. 10, and the First Sch., p. 181.

(3.) Whether the *specification* has been prepared in the prescribed manner.

The specification here spoken of is that which accompanies the application, and may be either the provisional or complete

S. 6. specification. See sect. 5 (3), (4), and (5), and notes thereon, p. 11.

The specification must describe but one invention (sect. 33, 113).

(4.) Whether the *drawings* have been prepared in the prescribed manner. See sect. 5 (4), and notes thereon, p. 21.

(5.) Whether the *title* sufficiently indicates the subject-matter of the invention.

It will be observed that the requirements under the Act of the title, the provisional specification, and the complete specification are very different. The title must indicate the *subject matter* of the invention; the provisional specification must describe the *nature* of the invention; and the complete specification must *particularly* describe and ascertain the nature of the invention, *and in what manner it is to be performed.*

If the examiner reports that the title does not sufficiently indicate the subject matter of the invention, the comptroller may require it to be amended; sect. 7 (1), p. 30. It was formerly of importance that as little information as possible respecting the *nature* of the invention should be conveyed by the title, as advantage might be taken of it by rival inventors, and by opponents to the grant of a patent. All danger from this source is, however, now removed, as neither the title, nor either of the specifications, or drawings (if any), can be inspected until the acceptance of the complete specification has been advertised (s. 10, p. 36), and all may be inspected at the same time.

Formerly patents were held void because the title was too large, and covered more than had actually been invented, which was construed as a fraud upon the Crown (*Morgan* v. *Seaward*, 2 M. & W. 544; *Cook* v. *Pearce*, 8 Q. B. 1058); or for variance between the title and the specification (*Rex* v. *Wheeler*, 2 B. & Ald. 345; *Rex* v. *Metcalf*, 2 Stark, 249).

Although these objections to patents are not taken away by the Act, and may still be set up for the purpose of

defeating them, it is very unlikely that such pleas will be successfully urged in cases that have satisfied the examiner. S. 6.

For the purpose of determining whether or no the title sufficiently indicates the subject matter of an invention it may still be useful to refer to the reported cases, as examiners are hardly likely to be satisfied with titles which formerly were held insufficient and led to the patent being invalidated. Those cases where objections were unsuccessfully taken to the title are perhaps not so useful, as it by no means follows that the examiner will pass a title although, if passed, it would not invalidate the patent obtained.

Illustrations.

(1.) Patent for "a method or methods of more completely lighting cities, towns and villages." The invention described consisted of improvements in street lamps. Patent held void. (*Cochrane* v. *Smethurst*, Dav. P. C. 354.)

(2.) Patent for "certain improvements in copper and other plate printing." Invention consisted in putting a glazed or enamelled surface on paper, to be used for copper and other plate printing, and in a mode of polishing the enamel. *Held*, that the title was sufficient. (*Sturtz* v. *De la Rue*, 5 Russ. 322.)

(3.) Patent for "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, *scissors*, and other cutting instruments." As the machine described in the specification would not do for sharpening *scissors*, the patent was held void. (*Felton* v. *Greaves*, 3 C. & P. 611.)

(4.) Patent for "improvements in weaving figured fabrics." Objected that the improvements were applicable only to figured fabrics having terry surfaces. *Held*, that the title was sufficient. (*Crossley* v. *Potter*, Macr. P. C. 242.)

(5.) The title "an improvement in locomotion" is too general. (*Newall* v. *Elliott*, 13 W. R. p. 15.)

(6.) Patent for "improvements in manufacture of plaited fabrics." The specification described that which together amounted to but a single improvement. *Held*, not such an inconsistency between the title and the invention specified as to invalidate the patent. (*Nickels* v. *Haslam*, 8 Scott. N. R. 97.)

(7.) Patent for "improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting

S. 6. and measuring gas." In the specification, the words "therein and" where interpolated between "used" and "when." So that the specification was represented to be for improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used *therein and* when transmitting and measuring gas." (Patent held bad. *Croll* v. *Edge*, 9 C. B. 379.)

(8.) Patent "for improvements in the manufacture of frills or ruffles and in the machinery employed therein." The complete specification extended the invention to the manufacture of frills, ruffles, *or trimmings*. *Held*, that as the words "frills, ruffles, and trimmings" are all *ejusdem generis*, and as they are only important as showing what is to be made by the machinery, of which alone the patentee claimed to be the inventor, there was no such variance as to render the patent invalid. (*Wright* v. *Hitchcock*, L. R., 5 Ex. 37.)

For other instances see *Oxley* v. *Holden*, 8 C. B., N. S. 707; *Reg.* v. *Mill*, 10 C. B. 379; *Neilson* v. *Harford*, 8 M. & W. 806; *Fisher* v. *Dewick*, 3 Q. B. 1056; *Hill* v. *Thompson*, 8 Taunt. 375; *Bainbridge* v. *Wigley*, 1 Carp. P. C. 270; *Stead* v. *Williams*, 2. Web. P. C. 137; *Bloxam* v. *Elsee*, 6 B. & C. 169; *Brunton* v. *Hawkes*, 4 B. & Ald. pp. 552, 558; *Campion* v. *Benyon*, 6 B. Mo. 71 *Rex* v. *Else*, 1 Web. P. C. 76; *Beard* v. *Egerton*, 3. C. B. 97; *Patent Bottle Envelope Co.* v. *Seymer*, 5 C. B., N. S. 164; *Parkes* v. *Stevens*, L. R., 8 Eq. 358.

Power for comptroller to refuse application or require amendment.

S. 7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.

(2.) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer (*a*, p. 31).

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted (*a*). S. 7.

(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

(5.) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

(6.) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant. (*b*)

(*a*) As to practice on appeal, see sect. 38, p. 118, and rules p. 208.

(*b*) Under this sub-section a patent may be refused on the ground of want of novelty, but only, in case of an appeal, when the examiner, the comptroller, and the law officer agree upon this issue of fact. This provision will probably involve much trouble and expense, and may, unless great care is exercised, lead to injustice to inventors. Probably in all cases of real doubt the patent will be granted upon the same principle that has already been recognised in cases of opposition. See

S. 7. *In re Russell's Patent*, 2 De G. & J. 130; *In re Spence's Patent*, 3 De G. & J. 523; *In re Simpson's Patent*, 21 L. T. Rep., N. S. 81. By rule 16, p. 194, both applicants may attend the hearing of the question whether the invention comprised in both applications is the same, but neither party shall be at liberty to inspect the specification of the other.

Time for leaving complete specification.

S. 8. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application (*a*).

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

(*a*) As none of the papers left at the Patent Office are open to public inspection prior to the acceptance of the complete specification (Sect. 10), and the Reports of Examiners are not in any case published, or open to public inspection, there appears to be no reason why, after one application has been abandoned under this section by not leaving a complete specification, another application may not be made for a patent for the same invention.

Comparison of provisional and complete specification.

S. 9. (1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification (*a*, p. 33).

(2.) If the examiner reports that the conditions herein-

before contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer. S. 9.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, other than an appeal to the law officer under this Act, unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

(*a*) Under this subsection the examiner is required to ascertain and report whether,

1. The complete specification has been prepared in the prescribed manner (see sect. 5, subsections 4 and 5, p. 11, form C. p. 217, rule 2, p. 192, and rules 10, 28, 29 and 30), and

2. Whether the invention particularly described in the

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complete specification is substantially the same as that which is described in the provisional specification.

In determining this question it is presumed that the examiner will be guided by what the Courts have considered a material variation between the provisional and complete specifications.

The principle acted upon would appear to be this, that the complete specification must not lay claim to an invention different from, or larger than, that disclosed in the provisional specification. (*Bailey* v. *Roberton*, 3 App. Cas. 1055; *Foxwell* v. *Bostock*, 4 De G., J. & S. 298.)

Illustrations.

(1.) The provisional specification of a patent stated the object of the invention to be the preserving of animal substances in a fresh state; and the patentees therein claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphite of lime, but in the complete specification they claimed as "solution No. 1" a solution composed of bisulphite of lime alone. In an action for infringement for the use of bisulphite of lime, pure and simple:—*Held*, that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than, and different from, that disclosed in the provisional specification. (*Bailey* v. *Roberton*, 3 App. Cas. 1055.)

(2.) The title of the patent being for improvements in the manufacture of frills or ruffles, and the provisional specification describing the invention as relating to a particular manufacture of frills and ruffles, the complete specification described the invention as relating to a particular manufacture of frills, ruffles, *or trimmings*:—*Held*, that this was no such material variation as to render the patent invalid. (*Wright* v. *Hitchcock*, L. R., 5 Exch. 37.)

(3.) A. was the inventor of "improvements in apparatus employed in laying down submarine electric telegraph wires." In the provisional specification the invention was thus described: "The cable or rope containing the insulated wire or wires is passed round a cone, so that the cable in being drawn off the coil is prevented from kinking by means of the cone, and there is a cylinder on the outside, which prevents the coil from shifting in its place." In the complete specification, after describing the invention in the same terms, the inventor proceeds to

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say: "When the wire or cable is to be laid down, I place over the cone an apex or top, which is conoidal or conical, and round this I suspend several rings of iron or other metal by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is, to prevent the bight of the rope from flying out when going at a rapid speed, and the combination of these parts of the apparatus prevents the wire or cable from running into kinks;" and the claim at the end ran thus: "What I claim as my invention is, first, coiling the wire or cable round a cone; second, the supports placed cylindrically outside the coil round the cone; third, the use of rings in combination with the cone as described":—*Held*, that the validity of the patent was not affected by the omission of all mention of the metal rings in the provisional specification. (*Newall* v. *Elliott*, 4 C. B., N. S. 269.)

(4.) The provisional specification of a patent for an improvement in the bearings and bushes for the shafts of screw and submerged propellers, described the invention as consisting in employing wood in the construction of such bearings and bushes. The complete specification, after describing the mode in which the wood was used, claimed the employment of wood in the construction of the bearings and bushes "as therein described":—*Held*, that this was no such variation between the provisional and complete specification, as would invalidate the patent. (*Penn* v. *Bibby*, L. R., 2 Ch. 127.)

(5.) The provisional specification of a patent for sewing machines, claimed, amongst other improvements, that a certain instrument which moved the work, "or another acting therewith," acted to hold the work during the insertion of the needle, while the complete specification appeared to describe only one instrument as moving and holding the work:—*Held*, that such a variance would not invalidate the patent. (*Thomas* v. *Welch*, L. R., 1 C. P. 192.)

The effect of a material variance, in the Courts of law, has been to render the patent invalid. The effect of the report of such variance by an examiner will be, that the comptroller will refuse to accept the complete specification, and unless such amendment is made, and the specification accepted within twelve months from the date of the application, such application becomes void.

Should the examiner report favourably upon the point, and the specification be accepted, it may still be raised in a Court of law should contentious proceedings be instituted.

S. 10. Advertisement on acceptance of complete specification.

S. 10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection (*a*).

(*a*) See rules 25 and 26, p. 196.

Opposition to grant of patent.

S. 11. (1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the patent office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground (*a*, p. 37).

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer (*b*, p. 40).

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and

being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made (*c*, p. 41). S. 11.

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

(*a*) The notice must state the grounds of opposition, and be signed by the opponent, and give his address (rule 32, p. 198); a copy is furnished to the opponent (rule 33, p. 198). No opposition is allowed in respect of any ground not stated in the notice (rule 40, p. 199). Hitherto oppositions to the grant of a patent have been heard (1) by the Law Officer of the Crown, after an applicant had given notice to proceed under the 12th section of the Patent Law Amendment Act, 1852, and (2) by the Lord Chancellor, after the Law Officer had issued his warrant for sealing the patent under the 15th section of the same Act.

Oppositions were conducted before the publication of the provisional specification (*Re Tolson's Patent*, 6 De G. M. & G. 522), and the case of the applicant was heard in the absence of the opponent, so that the opponent could do little more than guess at the subject-matter of the alleged invention, from the title.

Under the present Act and rules notice of opposition may be given at any time within two months from the time that the applicant's application and specification or specifications with the drawings (if any) have been open to public inspection (sect. 10, p. 36).

It has been held more than once, both by Law Officers and by Lord Chancellors, that where there is doubt as to the validity of the grounds of opposition, the proper course is to grant the letters patent, as an error in refusing them would

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be irremediable, while an error in granting them would not. (*In re Russell's Patent*, 2 De G. & J. 130; *In re Spence's Patent*, 3 De G. & J. 523; *In re Simpson and Isaac's Patent*, 21 L. T. Rep., N. S. 81; *In re Dance's Patent*, Prac. Mech. Jour., 2nd Series, vol. 6. p. 298; *In re Tolson's Patent*, 6 De G. M. & G. 422; *In re Lowe's Patent*, 25 L. J. Ch. 454.)

So also in opposing the grant of letters patent, the burden of proof is on the opponent to show that the grant would be clearly wrong. (*Ex parte Sheffield*, L. R. 8 Ch. 237.)

By this section three grounds of opposition only are allowed to opponents:—

1.—*That the applicant has obtained the invention from him, or from a person of whom he is the legal representative.*

This opposition is based upon an allegation of *mala fides* which was always considered a sufficient reason for refusing to grant a patent. Thus, where a servant having filed a provisional specification, his master afterwards filed a provisional specification for the same invention, and then a complete specification, and obtained a patent. There was grave suspicion that the master had surreptitiously obtained a knowledge of the servant's invention, and the servant's patent, notwithstanding the existence of the master's patent (which would otherwise have been a sufficient ground for refusing the patent), was ordered to be sealed, and dated as of the day of his application. (*Ex parte Scott and Young*, L. R., 6 Ch. 274; and see *Ex parte Henson*, 1 Web. P. C. 432; but see *Ex parte Bailey*, L. R., 8 Ch. 60.)

2.—*That the invention has been patented in this country on an application of prior date.*

When this ground of opposition is relied upon the title, number, and date of the patent granted in such prior application must be specified in the notice (rule 34, p. 198), and unless this is done the opposition shall not be allowed (rule 40, p. 199). It is important to observe that the mere

fact, that a patent for the same invention exists, is no ground of opposition, unless the application for the same was of *prior* date; and see sect. 13 of the Act (p. 45). S. 11.

This is in accord with the principle of the decision in the case of *In re Deering's Patent* (13 Ch. D. 393), where Lord Cairns, L. C., disapproved the decision of Lord Hatherley, L.C., in the case of *In re Bates* (L. R., 4 Ch. 577). In the latter case it was decided that where a provisional specification is filed, but, pending the six months' provisional protection, and before obtaining letters patent, a second inventor files a provisional specification, and obtains letters patent for an invention, partly covered by the first provisional specification, letters patent will not, in the absence of fraud, be granted to the first applicant, for any part of his invention which is covered by the letters patent already obtained by the second applicant. See also *Ex parte Manceaux*, L. R., 6 Ch. 272; *Ex parte Bailey's Patent*, L. R., 8 Ch. 60; *Ex parte Harrison*, L. R., 9 Ch. 632; *In re Lowe's Patent*, 25 L. J. Ch. 454. Lord Cairns's objection to this decision was that the legislature intended patentees to have the full term of protection given by the provisional specification for perfecting their inventions.

In *Deering's* case D. and R. independently, on the *same day*, viz., the 29th April, 1879, applied for letters patent for inventions, which were, for the purpose of the decision, taken to be similar. R.'s patent was sealed on the 25th of July, 1879, and on the 5th August 1879, he entered an opposition to the sealing of D.'s patent. There being no suggestion of fraud, it was held that D.'s patent ought to be sealed, and be dated as of the day of application, which was also the date of R.'s patent. (13 Ch. D. 393.)

It would seem that an inventor, who has obtained protection by leaving a complete specification with his application for a patent, does not, under sect. 15 of this act (p. 46), acquire the rights of a patentee so as, between the date of the acceptance of the complete specification and the expiration of

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3.—*That an examiner has reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application.*

This ground of opposition is new, and must be stated in the notice of opposition (rules 32, 40, p. 198). The authority for the examiner to report to the comptroller is contained in sect. 7 subsection 5 (p. 31): and under the same section, subsection 6, the comptroller may refuse to seal a patent upon the above ground, although there is no formal opposition. In fact it is difficult to see how this ground of opposition can be taken advantage of by any person outside the Patent Office, because the reports of the examiner are not to be published or open to public inspection. (Sect. 9, subsection 5, p. 33.)

When the report of the examiner is to the effect that *part* only of the invention for which a patent is sought is comprised in a specification bearing the same or a similar title, and accompanying a previous application, protection will probably be given to the rest of the invention. This would be in accord with the practice adopted by the Law Officers. (*In re Craig and Macfarlane's Application*, Prac. Mech. Jour., 3rd Series, vol. 4, p. 366.)

(*b*) A copy of the notice of opposition is to be furnished by the comptroller to the applicant (rule 33, p. 198). This subsection gives an appeal from the comptroller to the Law Officer in all cases. Formerly there was no appeal from the Law Officer to the Lord Chancellor when the former refused to issue his warrant for the sealing of the patent under the 15th section of the Patent Law Amendment Act, 1852. The power given by the 38th section (p. 118) to the Law Officers to examine witnesses on oath is not extended to the comptroller,

who will hear evidence by means of statutory declarations. Within fourteen days after the expiration of the two months the opponent must leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof (rule 35, p. 198). Within fourteen days from the delivery of such list the applicant must leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent must leave at the Patent Office his statutory declarations in reply, and deliver to the applicant a list thereof. Such last mentioned declarations must be confined to matters strictly in reply (rule 36). No further evidence shall be left on either side except by leave of the comptroller upon the written consent of the parties duly notified to him, or by his special leave on application made (rule 37) of which notice must be given (rule 38). On the close of the evidence, the comptroller will give at least seven days' notice of the hearing (rule 39), and his decision will be notified to the parties (rule 41).

(*c*) By the first subsection of this section "any person" may give notice of opposition, and by the 2nd subsection is entitled to be heard in opposition before the comptroller. But under this subsection only such persons, so giving notice, as are, in the opinion of the Law Officer, entitled to be heard in opposition to the grant, can claim a right to be heard before the Law Officer.

This seems to be in analogy with the practice formerly existing in opposing before the Lord Chancellor, who generally refused to hear any person who had not opposed before the Law Officer (*In re Mitchell's Patent*, L. R. 2 Ch. 343), though this rule was not always strictly adhered to. (*Ex parte Henson*, 1 Web. P. C. 432; *Ex parte Manceaux*, L. R. 5 Ch. 518; *Ex parte Yates*, L. R., 5 Ch. 1.) In cases where no opposition had taken place before the Law Officer it was usual for the Lord Chancellor not to enter into the merits of the case but to refer it back to the Law Office. (*Re*

S. 11. *Fawcett's Patent*, 2 De G. M. & G. 439; *Ex parte Manceaux*, L. R., 5 Ch. 518; *Ex parte Yates*, L. R., 5 Ch. 1.)

Any person intending to appeal must within fourteen days from the date of the decision appealed against file in the Patent Office, a notice of such intention (Law Officers Rules, rule 1, p. 208). A form is given in the schedule, p. 228, and must state the nature of the decision, and whether the appeal is to the whole, or what part of such decision (rule 2). A copy of such notice is to be sent to the Law Officers' clerk, and when there has been an opposition before the Comptroller also to the opponents, and if any such to a prior applicant (rule 3). The time for appea' may be extended by the Comptroller or the Law Officers (rule 5, and Board of Trade rules, 47, p. 201). Usually seven days' notice of the hearing will be given (Law Officers' Rules, rule 6) to the Comptroller, the applicant, the opponent and the prior applicants (rule 7).

The evidence to be used is to be the same as that used at the hearing before the Comptroller; and no further evidence is to be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the Law Officer upon application for that purpose (rule 8).

This rule follows the practice laid down in *Ex parte Sheffield* (L. R., 8 Ch. 237). In this case it was also held that where the facts on which the opponent relies were within his knowledge when he opposed before the Law Officer, he could not, when before the Lord Chancellor, raise a new legal argument on those facts. The case of *In re Vincent's Patent* (L. R., 2 Ch. 341) decided that the Lord Chancellor, on an application for sealing a patent, would not interfere with the decision of the Law Officer, except in a case of fraud or surprise, or of some material fact having come to the knowledge of the party since the case was before the Law Officer. These decisions will probably both be followed by the Law Officers in appeal from the Comptroller.

Section 38, p. 118, authorizes the Law Officers to examine

witnesses on oath, and to administer oaths for that purpose. And the Law Officers shall, at the request of either party, order the attendance, 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 (rule 9, p. 209), but the person requiring the attendance of a witness must tender him a reasonable sum for conduct money (rule 10). S. 11.

The Law Officer may order costs to be paid by either party, and such order may be made a rule of Court (section 38, p. 118 and rules 12 and 13, p. 209). In exercising their discretion as to costs the Law Officers will probably be guided by the practice adopted by the Lord Chancellors on application to seal, and the cases are therefore shortly referred to.

There the opposition to sealing was considered reasonable, no costs were given (*Ex parte Fox*, 1 Web. P. C. 431), but if no opposition had taken place before the Law Officer, and was unsuccessful before the Lord Chancellor, the opponent had to pay the costs. (*In re Cutler's Patent*, 4 My. & Cr. 510; *In re Alcock's Patent*, Ib. p. 511.) See also when the opposition was on the ground that the invention is similar to that protected by a prior patent, provided the applicant is not guilty of fraud (*Ex parte Manceaux*, L. R. 5 Ch. 518) and where objections have been withdrawn (*In re Copley's Patent*, 31 L. J. Ch. 333).

No costs were given against the opponent where the Lord Chancellor refused to read his affidavits owing to their not having been filed until the morning of the hearing (*In re M'Kean's Patent*, 1 De G. F. & J. 2). And if the opposition is successful the applicants were ordered to pay the costs. (*Ex parte Yates*. L. R. 5 Ch. 1.)

S. 12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall Sealing of patent.

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cause a patent to be sealed with the seal of the patent office.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases herein-after mentioned, that is to say—

(*a.*) Where the sealing is delayed by an appeal to the Law Officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct (*a*).

(*b.*) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

(*a*) This is a provision similar to that contained in sect. 20 of the Act of 1852, and sect. 6 of the 16 & 17 Vict. c. 115. See *Ex parte Bailey*, L. R., 8 Ch. 60; *In re Somerset and Walker's Patent*, 13 Ch. D. 397; *In re Johnson's Patent*, Ib. (n.) This section does not allow of a patent being sealed after the expiration of the fifteen months, upon any ground other than those stated therein; and no power is given to the Law Officers, either by the Act or the Rules, similar to that formerly possessed by the Lord Chancellor under the third set of rules made 12th Dec. 1833 (altered by Rule of the 14th May, 1878), enabling him "under special circumstances" to extend the time for sealing. This power was

exercised in the case of *In re Hersee's Patent*, L. R., 1 Ch. 518, and *In re Macintosh Patent*, 28 L. T. Rep. 280. S. 13.

S. 13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application (*a*). Date of patent.

(*a*) Under the 24th section of the Act of 1852, any letters patent sealed and bearing date as of any day prior to the day of the actual sealing were of the same force and validity as if sealed on the day as of which the same were expressed to be sealed and bear date. This is exemplified by the case of *Saxby* v. *Hennett* (L. R. 8 Exch. 210).

The custom has been to date and seal patents as of the day of the application, but under the 23rd section of the Act of 1852 the Law Officer to whom an application was referred, or the Lord Chancellor, could direct a patent to be sealed and bear date as of the day of the sealing thereof, or of any other day between the day of application or provisional registration and the day of such sealing. This power no longer exists, and *every* patent *must* be dated and sealed as of the day of the application.

As to concurrent applications see notes to sect. 11 (*a*), p. 38.

Provisional Protection.

S. 14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the Provisional protection.

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Protection by Complete Specification.

Effect of acceptance of complete specification.

S. 15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

Patent.

Extent of patent.

S. 16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man (*a*).

(*a*) The 18th section of the Act of 1852 provided that letters patent should extend to the whole of Great Britain and Ireland, the Channel Islands, and the Isle of Man.

The Channel Islands are now excluded.

Term of patent.

S. 17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date (*a*).

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails

to make the prescribed payments within the prescribed times (*b*).

(3.) If, nevertheless, in any case, by accident mistake or inadvertance, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment. (*c*).

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the abovementioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(*a.*) The time for making any payment shall not in any case be enlarged for more than three months.

(*b.*) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

(*a*) This is in accordance with the 21 Jac. 1, c. 3. In calculating when letters patent expire the day of the date of the patent must be reckoned inclusively. (*Russell* v. *Ledsam*, 14 M. & W. 574.)

(*b*) The payments are prescribed by sect. 24, p. 67, and the 2nd schedule to the Act, p. 187, and the 1st schedule to the rules, p. 211.

S. 17. (c) An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee, by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement (rule 46, p. 201). A form of application is given in the 2nd schedule to the rules. (See form K., p. 223.) The schedule to the 16th Vict. c. 5, prescribing the payments to be made, directed a certain payment to be made "before the expiration of the third year," and it was held that the three years did not expire until twelve o'clock at night of the anniversary of the day on which the letters patent were granted. (*Williams* v. *Nash*, 28 L. J., Ch. 886.) The words in the 2nd schedule to the present Act are "before end of four years from date of patent." This would seem to mean the same thing as "before the expiration of the fourth year," so that the above decision would apply.

Amendment of Specification.

Amendment of specification.

S. 18. (1.) An applicant or a patentee may, from time to time, by request in writing left at the patent office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same (*a*, p. 50).

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the patent office of opposition to the amendment (*b*, p. 55).

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(3.) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer (*b*, p. 55).

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed (*c*, p. 56).

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

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer (*c*, p. 56).

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed (*c*, p. 56).

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment (*d*, p. 56).

(9.) Leave to amend shall be conclusive as to the

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right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

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

(*a*) The 18th and 19th sections of the present Act deal with the subject-matter of the 1st section of the 5 & 6 Will. 4, c. 83 (1835), the 5th section of the 7 & 8 Vict. c. 89 (1844), and the 39th section of the 15 & 16 Vict. c. 83 (1852), into which certain amendments are introduced.

Under the Acts of 1835, 1844 and 1852, power was given only to a patentee or his assignee to amend his title or specification. Under this section "an applicant *or* a patentee" may seek leave to amend his specification."

The word "patentee" is defined to mean the person for the time being entitled to the benefit of a patent (s. 46, p. 145). The provisions of the 5th section of the Act of 1844 are, therefore, retained, and, when the original patentee has parted with the whole of his interest in the patent, his assignee may seek leave to amend, and when he has parted only with part of his interest therein, a joint application must be made.

The word "applicant" in this section appears to mean an "applicant for a patent," so that the provisional and complete specifications may be amended, before the grant of a patent, not only at the instance of the comptroller, but also at the instance of the person applying for a patent.

The words of the Act of 1835 were, "may enter a disclaimer or a memorandum of any alteration." These are changed to "may seek leave to amend his specification by way of disclaimer, correction, or explanation." It is im-

possible to foresee what interpretation may be placed upon these words, or how far the decisions under the old statutes may be followed. The reported cases cannot, however, fail to be useful in construing the section, which would appear to extend the statutory powers of amendment formerly existing. S. 18.

Upon an application for a disclaimer under the old Acts it was held that the matter must be decided on the words of the specification itself, irrespective of extraneous consideration, and in cases of doubt the amendment should be allowed, as the refusal is irrevocable and may be of serious consequence to the patentee, whereas if the disclaimer extends the claim of the invention, the public will not be injured, as the disclaimer will be void. (*In re Bateman and Moore's Patent*, Macr. P. C. 116; *In re Sharp's Patent*, 1 Web. P. C. 643.)

If on an *ex parte* application leave to amend has been given, a rehearing will be granted if the leave has been obtained by means of fraud (s. 18 (9), p. 49). This is in accord with existing practice. Thus in the case of *In re Pullan's Patent*, leave was given by the Lord Chancellor, upon an *ex parte* application, to correct a filed specification by adding drawings alleged to have been omitted through inadvertence. The drawings so added were not described in the specification. Some months after the addition was effected, an application was made to the Lord Chancellor by a patentee, who had been threatened with an action for infringing the amended patent, to rehear the original application. The Lord Chancellor decided to hear the matter afresh, and, upon reading the affidavits on both sides, and considering that his order had been made on imperfect information, ordered the added drawings to be struck out of the specification. (Not reported; see *Johnson's Patentees' Manual*, 4th ed. p. 103.)

In the case of *Ralston* v. *Smith* (11 H. L. Cas. 223), R. took out a patent for improvements in "embossing and finishing woven fabrics, and in the machinery and apparatus employed therein." In his specification he said: "I employ a roller

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of metal, wood, or other suitable material, and groove, flute, engrave, mill, or otherwise indent upon it any desired design;" he caused this roller to revolve with a bowl at unequal velocities, moving the fabric transversly when fed into the machine, and by these means he proposed to calender or finish, and to emboss the fabric by one process instead of two, as then practised. He afterwards entered a "disclaimer," in which he disclaimed the words in the title, "and in the machinery or apparatus employed therein," disclaimed the word "wood" from the description of the roller, and restricted the grooves or flutes on the roller to those of a circular kind. Any other grooves would not only not produce the desired effect on the fabric but would destroy it:—*Held*, that the disclaimer extended the exclusive right, and was consequently bad.

In another case a patentee claimed by his specification "the application of the principle of centrifugal force to the flyers employed in certain machinery for roving cotton and other fibrous substances," but declared that his improvements "applied solely to such part of the machinery, called the flyers, which is employed in connection with the spindle for the purpose of winding cotton." He attached drawings to his specification, and went on to say that these drawings and the specification represented "one particular and practicable mode of applying" his invention, but "I do not intend to confine myself to this particular method, but I claim as my invention the application of the law or principle of centrifugal force to the particular or special purpose above set forth, that is, to flyers used in machinery for preparing cotton." He afterwards disclaimed "all application of the law or principle of centrifugal force as being part of my invention, or as being comprised in my claim of invention contained in the specification, except only the application of centrifugal force, by means of a weight acting upon a presser so as to cause it to press against a bobbin, as described in the specification":—*Held*, that this disclaimer did not extend the claim, but confined it to a particular mod

of applying the principle of centrifugal force, and did not claim the discovery of that principle, or the application of it, except in a particular way, and that, therefore, the patent was good. (*Seed* v. *Higgins*, 27 L. J., Q. B. 148, aff. in Ex. Ch., Ib. p. 411, and in House of Lords, 8 H. L. Cas. 550; and see *Foxwell* v. *Bostock*, 4 De G., J. & S. 298.)

The person entering a disclaimer under the old Acts was required to state the reason for such disclaimer, just as he is required to do in his application for an amendment under the present section.

The reason for such disclaimer, however, forms no part of the disclaimer itself. (*Per* Lord *Westbury* in *Cannington* v. *Nuttall*, L. R., 5 H. L. p. 227.)

When an application to enter a disclaimer under the 5 & 6 Will. 4 c. 83, s. 1 was refused by the law officer, he had no jurisdiction to order the applicant to pay costs. (*Kynoch* v. *The National Arms Co.*, 37 L. T. Rep., N. S. 31.)

This is now changed by the 38th section (p. 118), which provides that "in any proceeding before either of the law officers under this part of the Act (Part 2, Patents), the law officer may order costs to be paid by either party, and any such order may be made a rule of Court."

Amendment at Common Law.

The Master of the Rolls, as Keeper of the Records, had power to direct the amendment of a clerical error in a specification, but the Lord Chancellor, as Keeper of the Great Seal, alone had power to amend the letters patent themselves. (*In re Nickel's Patent*, 1 Web. P. C. 650; *Ex parte Beck*, 1 Br. C. C. 578.)

Thus where in the specification the word "wire" was by mistake substituted for the word "fire" the mistake was ordered to be corrected. (*In re Whitehouse's Patent*, 1 Web. P. C. 649, note (*n*).)

So the Master of the Rolls ordered a specification to be amended which recited the letters patent to have been

S. 18. granted in "October" instead of "November." (*In re Rubery's Patent*, 1 Web. P. C. 649 (n.).)

An order to amend was also granted in a case where the specification contained the name "Charles" instead of the name "George." (*In re Dismore's Patent*, 18 Beav, 538.)

But an application for amendment of a patent by rectifying an error in the spelling of the name of the patentee, four years after it was granted, was refused on the ground of lapse of time. (*In re Blamond's Patent*, 3 L. T. Rep., N. S. 800.)

So when letters patent, specifications, and memoranda of alteration were enrolled, clerical errors in the enrolment were, in proper cases, ordered to be amended. (See *In re Redmund's Patent*, 5 Russ. 44; *In re Sharp's Patent*, 1 Web. P. C. 645; *In re Adams' Patent*, 21 L. T. Rep. 38; and for other instances, 1 Web. P. C. 647, note (*l*).)

Where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction, without bill filed, to order it to be taken off the file. (*In re Berdan's Patent*, L. R., 20 Eq. 346.)

The power of the Master of the Rolls to direct the amendment of a clerical error in a specification is saved by the Jud. Act, 1873, s. 17, sub-sect. 6 (*In re Johnson's Patent*, 5 Ch. D. 503); and there appears to be nothing in the present Act to limit his power.

The power of the Lord Chancellor to amend letters patent arises from his being Keeper of the Great Seal.

In future letters patent will bear the seal of the patent office (see sect. 12 (1), p. 43), and the impressions thereof are to be judicially noticed and admitted in evidence (sect. 84, p. 165), and a patent so sealed shall have the *same effect* as if it were sealed with the Great Seal of the United Kingdom (sect. 12, (2), p. 44). The question then arises whether the Lord Chancellor retains the power of ordering letters patent so sealed to be amended. The question is not, however, of much practical importance, as he would in all probability refuse to exercise the power, even supposing he retains it.

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The following are examples of conditions that have been imposed upon patentees or assignees seeking to disclaim:—

(1.) That an undertaking be given that no action shall be brought in respect of anything done prior to the hearing of the application for a disclaimer. (*In re Smith's Patent*, Macr. P. C. 232.)

(2.) That the applicants should bring no action against the persons opposing the amendment for any infringement of the said patent (which was for the preparation of red and purple dyes) by the use or continued use, during the continuance of the patent of any process or processes for manufacturing or preparing red and purple dyes which is or are in use by them or either of them at the present time. (*In re Medlock's Patent*, Newton, London Jour., N. S., vol. 22, p. 69.)

(*b*) A request for leave to amend a specification must be signed by the applicant or patentee and accompanied by a copy of the original specification and drawings, showing in red ink the proposed amendments, and must be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such manner (if any) as the comptroller may in each case direct (rule 48, p. 201). In the second schedule to the rules, a form of application for amendment of specification or drawings is given (Form F., p. 219).

The notice of opposition must state the grounds on which the opponent intends to rely, and must be signed by him, and state his address for service (rule 49, p. 201). For form, see Form G., p. 220. A copy of this notice is to be furnished by the comptroller to the applicant (rule 50, p. 201).

Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent must leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof (rule 51, p. 202). Within fourteen days from the delivery of such list, the applicant must leave at the Patent

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Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent must leave at the Patent Office his statutory declarations in reply, and deliver to the applicants a list thereof. Such declarations must be confined to matters strictly in reply. Copies of declarations may be obtained either from the Patent Office or from the opposite party (rules 36, p. 199, and 52, p. 202). No further evidence is to be left on either side except by leave of the comptroller on application made to him for that purpose (rules 37 and 52). For form of application, see Form E., p. 219.

The party making this application must give notice to the opposite party, who may oppose it (rules 38 and 52). On the completion of the evidence, the comptroller will appoint a time for the hearing, and give seven days' notice at least of such appointment (rules 39 and 52), and will subsequently notify his decision to the parties (rule 53). When leave to amend is given, the applicant must, if the comptroller so require, and within the time limited by him, leave at the Patent Office a new specification and drawings as amended, which must be prepared in accordance with rules 10, 28 and 29 (rule 54, p. 202). Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct (rule 56, p. 202).

(*c*) For the practice on appeal to the Law Officers see rules made by them, p. 208. The 6th subsection is not clearly worded. The applicant may appeal only when "leave to amend is refused by the comptroller." Probably this will be held to give an appeal in all cases where the comptroller has not given leave to amend *to the full extent of the request*. If this is so it will be well in all cases to make the *request* very wide, as it is impossible to anticipate the effect of a *partial* amendment "subject to conditions," and it will be well to secure a right of appeal in case of necessity.

(*d*) The wording of the 8th subsection seems to convey

the meaning placed by judicial decisions upon the provision of the 1st section of the 5 & 6 Vict. c. 83, which enables a patentee to enter a disclaimer or memorandum of alteration "not being such disclaimer or such alteration as shall extend the exclusive right granted by the letters patent." S. 18.

Lord Blackburn said in *Dudgeon* v. *Thomson* (3 App. Cas. p. 55), "The object of a disclaimer is merely to take out and renounce part of what has been claimed before, and it would vitiate the new specification if, by striking out that part, you gave an extended sense to what is left, so as to make it embrace something which it did not embrace before." And see *R.* v. *Mill*, 10 C. B. 395; and 14 Beav. 315; *Foxwell* v. *Bostock*, *per* Lord *Westbury*, 4 De G. J. & S. 306; and *Tetley* v. *Easton*, 2 C. B., N. S. 706.

So in *Ralston* v. *Smith* (11 H. L. Cas. 223) it was held that the object of the Act was only to permit a disclaimer to amend the specification of a patent, by removing from it something superfluous, but not to allow the introduction of that which would convert a description, in itself unintelligible or impracticable, into a practicable description of a useful invention.

Power to disclaim part of invention during action, &c.

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

Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office (rule 55, p. 202).

The 1st section of the 5 & 6 Will. 4, c. 83, provided that

S. 19. no disclaimer or alteration should be receivable in evidence in any action or suit (except by *scire facias*) pending at the time when such disclaimer or alteration was enrolled, and prior to the passing of the present Act, if a patentee amended his specification while an action for its infringement was pending, the action had to be abandoned and a fresh action brought, and even an injunction to restrain the infringement of the patent prior to amendment would not be enforced. (*Dudgeon* v. *Thomson*, 3 App. Cas. 34; *Lister* v. *Leather*, 3 Jur. N. S. 433; and see *R.* v. *Mill*, 14 Beav. 312.)

As to the payment of costs where the patentee gave a disclaimer in evidence on the trial of a *scire facias*, see *R.* v. *Mill*, 10 C. B. 379.

Restriction on recovery of damages.

S. 20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

The Act of 1835 provided that the disclaimer or memorandum of alteration should be deemed and taken to be part of the letters patent or specification in all Courts whatever. The judges did not, however, agree as to the time from which such disclaimer or amendment was to be operative. It was first held that a disclaimer or amendment had no retrospective operation so as to make a party liable for an infringement of the patent, prior to the time of entering such disclaimer, or in other words, that the Act of 1835 should be read as being, "shall be deemed and taken as part of the said letters patent, &c., *from thenceforth*." (*Perry* v. *Skinner*, 2 M. & W. 471; *Stocker* v. *Waller*, 9 Jur. 138. Reported as *Stocker* v. *Warner*, 1 C. B. 148.)

Doubt was, however, thrown upon this interpretation of

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the statute, and it was suggested that the disclaimer was to be deemed and taken to be part of the patent or specification from the time of the granting of the letters patent (*R.* v. *Mill*, 10 C. B. 379), and that there were exceptional cases where a disclaimer should enable a patentee to proceed for infringements prior to the date at which it was filed. (*In re Lucas's Patent*, Macr. P. C. 235; and see *In re Smith's Patent*, Macr. P. C. 232.)

This section now makes it clear that the amendment relates back to the date of the original grant, otherwise damages could not be recovered in an action for an infringement prior to such amendment. If this were not so the action would be based upon a patent different from that which was infringed. The section, however, throws upon the person bringing the action the burden of proving that the "original claim was framed in good faith and with reasonable skill and knowledge."

It is to be presumed that the mere fact that the specification has passed the examiner, will not necessarily satisfy this requirement so far as it relates to the skill and knowledge, although it would seem to be *primâ facie* evidence of it.

S. 21. Every amendment of a specification shall be advertised in the prescribed manner.

Advertisement of amendment.

The manner of advertisement is prescribed by rule 56 (p. 202), which provides that every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

Compulsory Licenses.

S. 22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

Power for Board to order grant of licenses.

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

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

(*c*) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

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

(*a.*) For the mode of procedure on an application or petition for the grant of compulsory licenses and opposition thereto, see rules 57 to 63, p. 202, and forms H., H. 1, and I., p. 220.

A license need not be under deed (*Chanter* v. *Dewhurst*, 12 M. & W. 823), and may be constituted by a verbal agreement (*Crossley* v. *Dixon*, 10 H. L. Cas. 293). When in writing it need not be stamped as a deed (*Chanter* v. *Johnson*, 14 M. & W. 411).

A license to manufacture a patent article is an authority to the vendees of the licensee to sell it without the consent of the patentee. (*Thomas* v. *Hunt*, 17 C. B., N. S. 183.)

So where the owner of a patent manufactures and sells the patented article in a foreign country as well as in England, the sale of the article in one country implies a license to use it in the other. But if he has assigned his patent in either country, the article cannot be sold so as to defeat the rights of the assignee. (*Betts* v. *Willmott*, L. R., 6 Ch. 239.)

Where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without any license from the other, and without accounting for the profits so made. (*Mathers* v. *Green*, L. R., 1 Ch. 29.)

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Where, however, a patent is vested in trustees upon trust for several tenants in common or joint tenants, *quære* whether any one of them is at liberty to work the patent on his own account. (*Hancock* v. *Bewley* John. 601.)

An exclusive licensee has a right to use the name of the patentee to restrain an infringement of the patent, and to recover damages in an action (*Renard* v. *Levinstein*, 2 H. & M. 628). It is also competent to the assignee of a separate and distinct portion of a patent to sue for an infringement of that part, without joining one who has an interest in another part, the damages to be recovered in the action accruing to the former alone. (*Dunnicliff* v. *Mallett*, 7 C. B., N. S. 209; *Walton* v. *Lavater*, 8 C. B., N. S. 162.) So also one of several co-owners of a patent has a right to sue alone for the recovery of profits due for the use of the patent. (*Sheehane* v. *Great Eastern Railway Co.*, 16 Ch. D. 59.)

When an assignment is made of a share of profits (arising, e.g. from the working of a patent by licensees), the assignee is entitled to an account from the licensee, but the account must be taken once for all, in the presence of all the parties interested. The licensee is not bound to account to the assignor and to each assignee of a share separately. An assignee who asks for an account must place himself in the position of the assignor by offering to pay to the accounting party anything which may be due to him by the assignor. An account of profits will not be directed if it is clear that no profits have been made. (*Bergmann* v. *Macmillan*, 17. Ch. D. 423.)

A licensee under a patent cannot in an action against him to recover royalties, or other proceedings, in any way question its validity during the continuance of his license (*Crossley* v. *Dixon*, 10 H. L. Cas. 293; *Norton* v. *Brooks*, 7 H. & N. 499; *Smith* v. *Scott*, 6 C. B., N. S. 771; *Besseman* v. *Wright*, 6 W. R. 719; *Lawes* v. *Purser*, 6 E. & B. 930; but see *Chanter* v. *Leese*, 4 M. & W. 295; in Exch. Ch. 5 M. & W. 698); but if the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other

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and more natural one would make it good, it is competent to him to insist that the latter is the true construction. (*Trotman* v. *Wood*, 16 C. B., N. S. 479.)

And he may show that what he has done does not fall within the limits of the patent, but is something extraneous to it; and *semble*, for this purpose, prior specifications may be put in evidence to assist in construing a doubtful or ambiguous specification. (*Clark* v. *Adie*, 2 App. Cas. 423). After the license has been determined a licensee may dispute the validity of the patent. (*Dangerfield* v. *Jones*, 13 L. T. Rep., N. S. 142; *Neilson* v. *Fothergill*, 1 Web. P. C. 290.) So where A. and B. had worked a patent, the property of B., in partnership, A. was not estopped from disputing the validity of the patent, on the termination of the partnership. (*Axmann* v. *Lund*, L. R. 18 Eq. 330; *Mayne* v. *Maltby*, 3 T. R. 438; *Per Cottenham*, L.C., 1 Web. P. C. 290.)

Where judgment was given by consent before declaration filed in an action by a patentee against the members of a partnership firm for an infringement, and the defendants immediately took a license to use the invention, a suit to restrain a subsequent alleged infringement having been brought by the patentee against the defendants at law and two fresh partners, it was held that the defendants in equity were not estopped by the judgment at law from disputing the validity of the patent. (*Goucher* v. *Clayton*, 11 Jur., N. S. 107.)

Neither can a licensee recover back royalties which he has paid under a license for the use of a patented invention which turns out to be old (*Taylor* v. *Hare*, 1 B. & P., N. R. 260), unless fraud is proved (*Lovell* v. *Hicks*, 2 Y. & C. 46 and 472.)

Nor will a licensee be permitted to use an invention, without complying with the terms of his license, on the ground that the patent has been held invalid in proceeding between third parties. (*The Grover & Baker Sewing Machine Co.* v. *Millard*, 8 Jur., N. S. 714.)

Not only is a licensee estopped from disputing the validity of the patent in an action for royalties, but in an action by

S. 22. Register of patents.

the assignee of the patentee, the latter is estopped by his own deed from showing that the patent was not valid. (*Oldham* v. *Langmead*, 3 T. R. 439; and see *Walton* v. *Lavater*, 3 L. T., Rep. N. S. 272; *Chambers* v. *Crichley*, 33 Beav. 374.) This rule does not, however, apply to the partner of the assignor who is sued for infringement. (*Heugh* v. *Chamberlain*, 25 W. R. 742.)

Again, a patentee who grants a license cannot, without derogating from his grant, publish advertisements and circulars which have the effect of deterring usual customers or the public from dealing with his licensee. (*Clark* v. *Adie*, 21 W. R. 456, affirmed, Ibid. 764.)

A covenant not to make or use a known machine without certain patented improvements, is not a covenant in restraint of trade. (*Jones* v. *Lees*, 26 L. J., Exch. 9.)

S. 23. (1.) There shall be kept at the patent office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2.) The register of patents shall be *primâ facie* evidence of any matters by this Act directed or authorised to be inserted therein.

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office (*a*).

(*a*) The rules applicable to the register of patents are

S. 23. numbered 64 to 76 inclusive. See p. 204. Sect. 85, p., 165, provides that there shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive. And it is enacted by sect. 87 (p. 165) that where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent in the register of patents. And see rules 65 to 70 inclusive, p. 204. The fee for every entry of an assignment, transmission, agreement, license or extension of a patent is 10*s*. See. p. 212. See also Forms L, M, R, and S, p. 224. The person for the time being entered in the register of patents, as proprietor of a patent shall, subject to any rights appearing from such register to be vested in any other person have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property.

The keeping of registers of patents and of proprietors was formerly regulated by the 34th and 35th sections of the Patent Law Amendment Act, 1852. The later section provided that until the assignment of any letters patent, or any share or interest therein, or any license or other matter relating to the proprietorship of a patent was entered in the register of proprietors, the grantee should be deemed the sole and exclusive proprietor of such letters patent and all licenses granted. Consequently an assignee could not bring an action for infringement against third parties until his assignment had been registered (*Chollet* v. *Hoffman*, 7 E. & B. 686), although he might have done so against his assignor, and subsequent licensees of the assignor who had notice of the assignment. (*Hassall* v. *Wright*, L. R., 10 Eq. 509.)

The above provision is repealed and not re-enacted, consequently the question may hereafter arise whether, seeing

that registration of all matters affecting the validity or proprietorship of a patent are still compulsory, and that the person appearing on the register as proprietor has power absolutely to assign and to grant licenses, an assignor or a licensee may now take proceedings against third parties for matters relating to the patent before the registration of the patent assignment or license. The point is not however of much importance, as registration when made relates back to the date of assignment (*Hassall* v. *Wright*, L. R., 10 Eq. 509), so that an action would not be defeated on this ground. S. 23.

Power was given, by the 38th section of the Act of 1852, to the Master of the Rolls, and to any Common Law Court at Westminster in term time, and to a judge of such Court in vacation, to order an entry in the register of proprietors, by which any person felt himself aggrieved, to be expunged, vacated, or varied. But it would seem that the jurisdiction over patents was vested in the High Court of Justice by section 16, subsection 6, of the Jud. Act, 1873. (*In re Morgan's Patent*, 24 W. R. 245.) This is, however, of little importance now as the 38th section of the Act of 1852 is repealed, and the rectification of the register of patents, as of all registers to be kept under the Act, is transferred by sect. 90 (p. 196) to "The Court" on the application of any person aggrieved. The section provides that—

(1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an

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issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

"The Court" is by sect. 117 (p. 179) defined as (subject to the provisions of Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England. The application may, therefore, be made in either the Chancery or Queen's Bench Division. Notwithstanding this transfer of jurisdiction the Courts will probably be guided by former decisions, which are, therefore, here given.

A patentee, in 1853, assigned his patent, but the assignees omitted to register it. In 1855 the patentee assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterwards. The Court, in 1857, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs. (*In re Green's Patent*, 24 Beav. 145.)

A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a license, to work and use, to A. B.'s assignment was first registered:—*Held*, that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register, that the license referred to in B.'s assignment was the deed of assignment to A. subsequently entered. (*In re Morey's Patent*, 25 Beav. 581.)

Where one of two joint patentees by deed assigned his interest in the patent to a third person, and released to him all the rights of action, &c., against him of both the patentees, and the deed was set out completely in the register of proprietors, it was held that the other patentee was entitled, under the 38th section of the Patent Law Amendment Act, to have the entry struck out. (*In re Horsley & Knighton's Patent*, L. R., 8 Eq. 475.)

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Inspection of the register, and the supply of sealed certified copies of entries therein, is provided for by sect. 88, p. 166, and rules 75 and 76, p. 206, and such copies, as also similar copies of other documents in the patent office, are made evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals (sect. 89, p. 166).

The comptroller may, on request in writing accompanied by the prescribed fee, correct any clerical error in the name, style or address of the registered proprietor of a patent (sect. 91 (b), p. 167). The applicant for such correction is not entitled to be heard personally, or by his agent, under the 94th section, p. 168, but should send his application by a prepaid letter through the post (sect. 97, p. 169.)

If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor (sect. 93, p. 168).

Fees.

Fees in schedule.

S. 24. (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct. (*a*)

(2.) The Board of Trade may, from time to time, if

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they think fit, with the consent of the Treasury, reduce any of those fees.

(*a*) The 4th rule (p. 191) provides that, in addition to the fees mentioned in the Second Schedule to the Act, so far as it relates to Patents, the fees specified in the First Schedule to the Rules must be paid (p. 211).

Extension of Term of Patent.

Extension of term of patent on petition to Queen in Council.

S. 25. (1.) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

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

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

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

(5.) If the Judicial Committee report that the patentee

has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit. S. 25.

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

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

Revocation.

Revocation of patent.

S. 26. (1.) The proceeding by scire facias to repeal a patent is hereby abolished. (*a*, p. 71.)

(2.) Revocation of a patent may be obtained on petition to the Court.

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by scire facias shall be available by way of defence to an

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action of infringement and shall also be a ground of revocation. (*b*, p. 74.)

(4.) A petition for revocation of a patent may be presented by—

(*a.*) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(*b.*) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

(*c.*) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims:

(*d.*) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

(*e.*) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention. (*c*, p. 75.)

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered. (*d*, p. 75.)

(6.) Particulars delivered may be from time to time

amended by leave of the Court or a judge. (*e*, p. 75.) S. 26.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply. (*e*, p. 75.)

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted. (*f*, p. 76.)

(*a*) Prior to the passing of this section letters patent for an invention could be cancelled or revoked in two ways—

(1.) By *scire facias*,

(2.) Under a proviso contained in the letters patent themselves.

(1.) *Scire facias.* The action of *scire facias* to repeal patents has of late years fallen into disuse. The reason for this is that by the 1st section of the 5 & 6 Will. 4, c. 83, a patentee was empowered to enter a disclaimer or memorandum of alteration of either the title of his patent or of the specification, and to give the same in evidence at the trial of any action of *scire facias*. In this way any suggestion of objection to the patent, which did not deal with the whole alleged invention, could be removed, and the prosecutor would fail in his action, and possibly have to pay the defendant his costs. (*R.* v. *Mill*, 10 C. B. 379.)

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If it appears that the Crown in granting letters patent has been deceived in any material particular, by a false representation or suggestion of the grantee, the patent will be wholly void (Vin. Abr. Prerog. (o. b.)). In such cases the Crown had by the Common Law a right to proceed by *scire facias* to repeal and cancel the patent (*Rex* v. *Butler*, 3 Lev. 220, 221). This proceeding was taken in the Common Law side of the Court of Chancery, being the Court in which the patent was made, and the patent and enrolment of it were cancelled by the Lord Chancellor. The action of *scire facias* was a remedy provided not only for the Crown on behalf of the public, but also for any subject who could show that a void or illegal patent operated to his prejudice (*R.* v. *Aires*, 10 Mod. 354), and as every one was assumed to be prejudiced by an illegal patent, all were entitled to institute the action, on obtaining the *fiat* of the Attorney-General giving leave to sue in the name of the Crown, This *fiat* was, however, only granted on condition that the prosecutor entered into a bond to pay the defendant his taxed costs as between attorney and client, in the event of the defendant obtaining a verdict and judgment.

The writ, which was in the nature of a pleading, stated the effect of the patent, and set out the suggestions upon which the prosecutor sought to repeal the patent, and might include anything that showed that the patent was originally void, or that it had become so since it was made. The writ directed the sheriff (12 & 13 Vict. c. 109, s. 29) to summon the defendant to appear in Chancery to show cause why the patent and enrolment should not be cancelled. Upon the return of the writ the defendant entered an appearance. The prosecutor then delivered his declaration and notice of objections, and the defendant his pleas, or demurrer, if the matters alleged in the writ were not sufficient to repeal the patent.

When any issues were joined which had to be tried by a jury, the trial took place in the Queen's Bench, the record being returned to the Court of Chancery, and judgment

signed there, but when no jury was required the trial took place in Chancery before the Lord Chancellor. The action was tried either at bar or *nisi prius*. S. 26.

If any one of the objections was substantiated that was sufficient to entitle the Crown to judgment. The effect of a judgment for the Crown was to render the patent wholly void, and the judgment was a bar to any subsequent proceedings on the patent.

The practice relating to the action of *scire facias* was unaltered by the Patent Law Amendment Act, 1852, the 15th section providing that the writ of *scire facias* shall be for the repeal of any letters patent issued under that Act in the like cases as the same would be for the repeal of letters patent which could then be issued under the Great Seal.

In *Smith* v. *Upton* (6 M. & G. 251) the Court stayed proceedings in an action for infringement to await the result of a motion pending on a *scire facias*, upon the terms that the plaintiff should pay the defendant any costs which he might have been put to in preparing for trial and the costs of the motion.

(2.) *Under the proviso contained in letters patent.*—The 33rd section of the Act provides that "every patent may be in the form in the first schedule to this Act." The form here referred to contains the following proviso:—Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything herein-before contained.

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Under this proviso the Crown, or any six or more of the Privy Council, could declare a patent void without the necessity of proceeding by *scire facias*, and can do so still without any petition to the Court under the 2nd subsection of the 26th section of this Act. It is believed that there is no modern instance of the determination of a patent under this proviso, but the opinion is expressed by Mr. Hindmarch (p. 432) that it was under this or a similar proviso that Queen Elizabeth was enabled to recall the patents for monopolies which were found to be so grievous to the public during her reign.

(*b*) It is laid down (4 Inst. 88) that a *scire facias* lies to repeal letters patent in three cases:—"*Firstly*, when the King by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the former patentee shall have a *scire facias* to repeal second patent; *secondly*, when the King granteth any thing that is grantable upon a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant; *thirdly*, when the King doth grant any thing which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patent."

The following may be taken as being generally the grounds upon which patents are sought to be repealed:—

(1.) That the patentee was not the true and first inventor within the realm;

(2.) That the alleged invention was not communicated to the patentee by any foreigner resident abroad as alleged;

(3.) That the alleged invention was not any improvement;

(4.) That the alleged invention was not new;

(5.) That it was false and untrue that the alleged invention was not in use by any other person than the patentee to the best of his knowledge and belief (see form of patent, p. 183);

(6.) That the alleged invention was not an invention of a new manufacture within this realm;

(7.) That the alleged invention was not of any use, benefit, or advantage to the public; S. 26.

(8.) That the specification does not particularly describe and ascertain the nature of the alleged invention and in what manner it is to be performed.

(*c*) Formerly no person could issue a writ of *scire facias* to repeal letters patent without first obtaining the *fiat* of the Attorney-General, and this was only granted on condition that the prosecutor entered into a bond to pay the defendant his taxed costs as between attorney and client, in the event of the defendant obtaining a verdict and judgment.

It would seem that this *fiat*, the grant of which may be made conditional as heretofore, will be required by any person who may desire to petition for the revocation of a patent, unless he falls within the descriptions contained within subsections (*c*), (*d*) or (*e*) of this section.

Now, however, any person who can make the allegations contained in subsections (*c*), (*d*) and (*e*) are quite free to petition the Court, but at the risk of having to pay the patentee his costs in the event of failure. This risk is, however, much reduced by the provision in sect. 18, subsection (10), p. 50, to the effect that no application to amend the specification by way of disclaimer, correction, or explanation, shall be made, so long as any legal proceeding in relation to a patent is pending, except (see s. 19, p. 57) by leave of the Court or a judge, subject to such terms as to costs and otherwise as they or he may impose. And even if such leave to apply for an amendment is granted, the application may be opposed by the person petitioning for revocation (s. 18 (2), p. 48).

(*d*) See notes to sect. 29, p. 84.

(*e*) This is a re-enactment of the latter part of the 41st section of the 15 & 16 Vict. c. 83.

The person who is entitled to the privilege granted by the patent, and has the custody of the patent itself, must be made defendant. The defendant should therefore be the patentee, or the assignee, or both where the patentee has assigned a part

S. 26. only of his patent right. In case of the death of the patentee, his executors or administrators should be made defendants.

(*f*) This provision is new. A patent obtained in fraud of the first and true inventor could be revoked under the old law, but no means existed of vesting the patent rights in the person entitled thereto. As the grant of the patent in lieu of that revoked is to be made "on the application of the true inventor made in accordance with the provisions of this Act," it would seem that the applicant will have to proceed in the same manner, and pay the same fees, as if no application had been made in respect of the invention in question. And see section 94, p. 168, and rules 11 to 16 inclusive, p. 193.

Crown.

Patent to bind Crown.

S. 27. (1.) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject. (*a*)

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

(*a*) This is an important change in the law, it having been held that letters patent, in their usual form, were not valid against the Crown, and that the Crown had the right to use a patented invention without compensation to the patentee. (*Feather* v. *The Queen*, 6 B. & S. 257.)

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The form of letters patent given in the schedule to the Act contains a recital that "the said inventor hath by and in his complete specification particularly described *the nature* of his invention." It is difficult to see how, in the face of this recital, the Crown, who makes the grant, can, either in a proceeding for revocation of a patent, or as defendant in an action for infringement, contend that the patentee has not "particularly described the nature of his invention," although the Crown would not be estopped from showing that the specification did not disclose "in what manner it is to be performed."

(*b*) This provision is also new, for it was held in *Dixon* v. *The London Small Arms Company* (L. R., 1 App. Cas. 632), that where the defendants, not being servants or agents of the Crown doing the work of the Crown, but being private contractors with the Crown to supply a certain manufactured article, were not protected in what they did by any particular privilege attaching to the Crown.

Legal Proceedings.

Hearing with assessor.

S. 28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct. (*a*)

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid. (*b*)

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the

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Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act. (*c*)

(*a*) The provision of this section is not the only one giving the Court power to call in the aid of an assessor. Sect. 56 of the Jud. Act, 1873, provides that the High Court or the Court of Appeal may in any cause or matter (other than a criminal proceeding by the Crown), in which it may think it expedient to do so, call in the aid of one *or more* assessors specially qualified, and try and hear such cause or matter wholly or partially with the assistance of such assessors. The remuneration, if any, to be paid to such assessors shall be determined by the Court.

Order XXXVI., rule 43, of the Rules of the Supreme Court, 1883, provides that "trials with assessors shall take place in such manner and upon such terms as the Court or a judge shall direct." And by rule 7a. of the same Order, that in every cause or matter, where the mode of trial is by a judge without a jury, the Court or judge may at any time order any cause, matter, or issue to be tried by a judge sitting with assessors, or by an official or special referee with or without assessors.

It is a curious circumstance that under the 28th section of the present Act only one assessor can be called in, whereas under the Jud. Act and Rules the assistance of one *or more* may be obtained.

The Jud. Act and Rules leave it entirely to the discretion of the Court or judge, whether or no one or more assessors shall be called in, but by this section either party has an absolute right to insist upon *one* assessor being secured to assist the judge, and probably in future few patent actions, in which any technical issues have to be decided, will be tried without the presence of an assessor, for if one side does not want him the other side probably will.

The selection of the assessor, a matter of great importance, however, rests with the Court. S. 23.

An action or proceeding for infringement or revocation of a patent may now be tried in the several modes following, viz:

(1.) By a judge alone.

(2.) By a judge with the aid of one or more assessors.

(3.) By a judge and jury, special or common.

(4.) By a judge assisted by one or more assessors and a jury, special or common.

(5.) By an official or special referee.

(6.) By an official or special referee with one or more assessors.

Prior to the passing of this Act, and the Rules of the Supreme Court, 1883, either party to an action for infringement of a patent, brought in the Queen's Bench Division, had, subject to the power of compulsory reference, an absolute right to have the issues of fact tried by a jury. (*Sugg* v. *Silber*, 1 Q. B. D. 362.)

This is now changed, for not only under this section, but also by the Rules of the Supreme Court, the discretion of ordering or refusing a trial with a jury in most cases rests entirely with Court or judge. See Order XXXVI., rules 4, 5, 6 and 7.

(*b*) The parties to the proceeding have no power to demand that the Court of Appeal, or the Judicial Committee of the Privy Council, shall call in the aid of an assessor. The 56th section of the Jud. Act, 1873, also empowers the Court of Appeal to call in the aid of one or more assessors. Where it is desired that the Court of Appeal should exercise this power an application must be made to the Court itself, as the judge at Chambers has no power to make the order, as he may do in trials under Order XXXVI., rule 43.

The proceedings before the Judicial Committee of the Privy Council here referred to, are those relating to the extension of the term of letters patent under sect. 25 of the Act.

S. 28. (c) The remuneration to be paid to an assessor *under this section* is to be paid in the same manner as the other expenses of the execution of this Act.

Sect. 83 (2), p. 165, provides that the expenses of the execution of this Act shall be paid out of money provided by Parliament.

Sect. 56 of the Jud. Act, 1873, directs the remuneration, if any, to be paid to assessors shall be *determined* by the Court. And Order XXXVI., rule 43, says, trials with assessors shall take place *upon such terms* as the Court or a judge shall *determine*. But no fund is provided for the payment of assessors whose remuneration has to be provided by the parties, or either of them, as the Court or judge shall direct.

Under the present Act one assessor is provided at the public expense.

Delivery of particulars.

S. 29. (1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds, is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of

any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Particulars of Breaches.

The Court has power, irrespective of any statute to that effect, to order the plaintiff, in an action for the infringement of a patent, to deliver particulars in writing of the infringement on which it is intended to rely. (*Perry* v. *Mitchell*, 1 Web. P. C. 269.)

The 15 & 16 Vict. c. 83, s. 41, provided that "the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action . . . and at the trial of such action no evidence shall be allowed to be given in support of any alleged infringement which shall not be contained in the particulars delivered as aforesaid . . . Provided always, that it shall and may be lawful for any judge at Chambers to allow such plaintiff to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit."

This statute was held applicable to suits in Chancery as well as actions at common law. (*Curtis* v. *Platt*, 35 L. J., Ch. 852; *Finnegan* v. *James*, L. R., 19 Eq. 72; *Crossley* v. *Tomey*, 2 Ch. D. 533; *Bovill* v. *Goodier*, L. R., 1 Eq. 35, overruled.) The present section, therefore, introduces no new practice with respect to particulars of breaches.

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The particulars of breaches are sufficient, if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him. (*Needham* v. *Oxley*, 1 Hem. & M. 248.)

If the patent is for an invention other than a chemical process, the plaintiff ought to give particular instances of infringement. Thus, where plaintiff's particulars of breaches alleged that the defendant "did make, use, exercise, and put into practice the said invention, and did counterfeit, imitate, and resemble the said invention, and, further, during the same period did make and sell large quantities of type manufactured according to the specification of the said letters patent, and divers other large quantities in imitation of the invention described in the said specification," Keating, J., at Chambers, made an order for further particulars. The further particulars delivered gave specific instances of infringement by manufacture and sale with dates, ending with these words: "and the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches. An application was made for better particulars on the grounds (1) that in some of the particulars there was no distinct statement of times and persons, and (2) that by the last clause of the particulars they were made utterly useless; and the plaintiff might at the trial give evidence of instances entirely different from those named in the particulars: *Held*, that the particulars were insufficient. (*The Patent Type-Founding Co.* v. *Richards*, 2 L. T. Rep., N. S. 359.)

So in an action by a patentee against his licensee for breach of covenant in not paying sums due for machines made by him with the plaintiff's invention, the plaintiff was ordered to furnish the best particulars he could, and to excuse himself upon oath for not giving better. (*Jones* v. *Lees*, 25 L. J., Exch. 241.) And Wood, V.C., stated that the object of furnishing these statements was that the defendant

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might know what were the *particular instances* on which the plaintiff relied. (*Curtis* v. *Platt*, 8 L. T. Rep., N. S. 657.)

But in an action for the infringement of a patent for a chemical invention, which was held to be substantially one process, for "improvements in obtaining pictures or representations of objects," the Court refused to compel the plaintiff to specify particularly the persons and occasions, or the particular parts of the specification alleged to have been infringed, although the declaration merely averred an infringement in general terms. The Court, however, stated that if the two processes described in the specification were wholly distinct from each other, and the defendant's process might be an infringement of the one and not of the other, he ought to have better particulars. (*Talbot* v. *La Roche*, 15 C. B. 310.)

The plaintiff, where his patent is for a complicated machine, and he has inspected and examined the alleged infringement, will be ordered to point out, by reference to the pages and the lines, the parts of his specification in respect of which such alleged breaches have been committed. (*Lamb* v. *Nottingham Manufacturing Co.*, not reported; cited L. R., 19 Eq. 230; *Seton on Decrees*, p. 349.)

A similar order was made where an action was brought in respect of injuries caused by letters written, and statements made, by the defendant to persons who purchased machines manufactured and sold by the plaintiffs, alleging such machines to be infringements of a patent obtained by him, and making claims in respect of the same. (*Wren* v. *Weild*, L. R., 4 Q. B. 213.)

So where the specification set forth and described thirteen different pens, containing an indefinite number of slits and adjustments, and the declaration charged the making of pens and nibs, in imitation of parts of the said invention, with divers additions thereto and subtractions therefrom, the Court ordered the plaintiff to give particulars by the numbers of the pens on which infringements were alleged. (*Perry* v. *Mitchell*, 1 Web. P. C. 269.)

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The order was, however, refused where the invention was not a complicated machine, and the patented article itself was made an exhibit in the action. (*Batley* v. *Kynock*, L. R., 19 Eq. 229.) It was also refused where the parties had previously been before the Court, in proceedings upon the same patent, though in a different action, in which affidavits were used which, to a sufficient extent, set forth in what particulars the infringement was supposed to have existed; and the order, if made, would from the nature of the patent have been embarrassing to the plaintiffs. (*The Electric Telegraph Co.* v. *Nott*, 16 L. J., C. P. 174.)

The plaintiff was allowed to amend his particulars after issue joined, and after interrogating the defendant. (*Jones* v. *Pratt*, 30 L. J., Exch. 365.)

Notice or Particulars of Objections.

The 5 & 6 Will. 4, c. 83, s. 41, enacted that in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant at such trial, unless he prove the objections stated in such notice, provided always, that it shall and may be lawful for any judge at Chambers, on summons served by such defendant on such plaintiff, to show cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit. The Court has power, under its general jurisdiction, and irrespective of the statute, to decide on the sufficiency of notices given under this statute. (*Bulnois* v. *Mackenzie*, 1 Web. P. C. 260.) The object of this statute was not to limit the defence, but to limit the expense of the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. (*Fisher* v. *Dewick*, 1 Web. P. C. 267;

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Morgan v. *Fuller*, L. R., 2 Eq. 297; *Flower* v. *Lloyd*, 45 L. J., Ch. 747; and see *Curtis* v. *Platt*, 8 L. T. Rep., N. S. 657.) After the passing of this statute, if a defendant neglected to deliver a notice of objections with his pleas, he had to obtain leave to plead *de novo*. (*Losh* v. *Hague*, 1 Web. P. C. 203 (n.).) It was not sufficient to state an objection in the notice of objections unless there was a plea to which it could apply. (*Gillett* v. *Wilby*, 1 Web. P. C. 270.) And the notice of objections was required to be drawn with reference to the pleas, or notice given of the pleas to which the objections were to be applied (*Walton* v. *Bateman*, 1 Web. P. C. 616): and were not allowed to go beyond them, or stand in their place. (*Macnamara* v. *Hulse*, 2 Web. P. C. 128 (n.).) They were required to point out the defence with greater particularity than the record (*Jones* v. *Berger*, 1 Web. P. C. 544; *Betts* v. *Walker*, 14 Q. B. 363; *Bulnois* v. *Mackenzie*, 1 Web. P. C. 263), of which they formed no part (*Reg.* v. *Mill*, 10 C. B. 379), unless the objections are completely and fully explained in the pleadings. (*Neilson* v. *Harford*, 1 Web. P. C. pp. 331, 370.) And further, the plaintiff's particulars of breaches could not be called in aid of defective particulars of objections. (*Palmer* v. *Cooper*, 23 L. J., Exch. 82.)

The 5th section of the 5 & 6 Will. 4 was supplemented by the 41st section of the 15 & 16 Vict. c. 83, but the former section was not repealed.

This section provided that "in any action in any of Her Majesty's Superior Courts of Record at Westminster or in Dublin for the infringement of letters patent, ... the defendant in pleading thereto, shall deliver with his pleas . . . . particulars of any objections on which he means to rely at the trial in support of the pleas in the said action . . . . ; and at the trial of such action no evidence shall be allowed to be given in support of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid: Provided

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always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at Chambers to allow such defendant to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit."

From the similarity of the wording of the two sections above set out the decision of the Courts upon notices given under the first are applicable to those given under the second statute.

The requirements of the 5 & 6 Will. 4, c. 83, and the 15 & 16 Vict. c. 83, as to notices by the defendant, were confined to notices affecting the validity of the patent; and the defendant might therefore object to the want of registration of an assignment of the patent to the plaintiff, although it was not specially mentioned in his notices of objection. (*Chollet* v. *Hoffman*, 26 L. J., Q. B. 449.)

This seems to be altered by subs. (2) of the present section, which deals with objections which do not affect the validity of the patent sued upon.

Both under the old statutes and the present Act the defendant is required to give a notice of the objections on which he relies by way of defence, and therefore, subject to what is said hereafter, the decided cases are still useful as pointing out what these particulars should be.

The reported cases upon the sufficiency of notices of objections may be conveniently collected under the following heads:—

(1.) *As to the first and true inventor.*

It was held that notice of objections delivered under the 5th section of the 5 & 6 Will. 4, c. 83, need not state *who* was the first inventor, or under what circumstances the invention had been previously used. (*Russell* v. *Ledsam*, 12 L. J., Exch. 439.)

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(2.) *As to prior user.*

By the Act of 1852 the particulars were required to state "the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent." Under the present Act they are required to state "*the time and place* of the previous publication or user alleged." So that now the *time and place* of prior user or publication must be given, but nothing is said of the *manner in which* the invention has been used or published. And an order for particulars ought to follow the words of the section. (*Flower* v. *Lloyd*, 45 L. J., Ch. 746.) This will somewhat change the practice, but a review of the cases under the old statutes is still useful as pointing out what particulars should be delivered.

The cases decided under the 5th section of the 5 & 6 Will. 4, c. 83, are conflicting.

In *Bulnois* v. *Mackenzie* (4 Bing. N. C. 132) the Court thought it doubtful whether it could require the defendant to furnish the names of those who are alleged to have used the plaintiff's invention, and refused to make the order, as it might prejudice the defendant. A similar application on *scire facias* to repeal a patent was refused. (*Reg.* v. *Walton*, 2 Q. B. 969.) And see *Carpenter* v. *Walker* (1 Web. P. C. 268 (n.).) But *Coltman*, J., ordered names, addresses, and descriptions to be given. (*Galloway* v. *Bleaden*, 1 Web. P. C. 268 (n.).)

The Court ordered the words "and divers other people" to be struck out of the notice of objections in *Fisher* v. *Dewick* (1 Web. P. C. 551 (n.)), *Galloway* v. *Bleaden* (1 Web. P. C. 268 (n.)); but refused to do so in *Bentley* v. *Keighley* (13 L. J., C. P. 167) and *Carpenter* v. *Walker* (1 Web. P. C. 268 (n.).) And the defendant was permitted to preface his statement of specific instances of alleged prior user with the words "amongst other instances" in the case of *Penn* v. *Bibby* (L. R., 1 Eq. 548) and *Curtis* v. *Platt* (8 L. T. Rep., N. S. 657). A notice delivered under this statute was held sufficient if it

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limited the inquiry to a particular species and class of persons, who were using it in a particular trade. (*Jones* v. *Berger*, 1 Web. P. C. 550.) But the words "and elsewhere" were struck out. (*Ibid.*) It was not a sufficient notice of an objection to say that the invention was wholly or in part used before, but it ought to point out what portions were previously in use. (*Heath* v. *Unwin*, 1 Web. P. C. 551; *Russell* v. *Ledsam*, 12 L. J., Exch. 439.)

But in a more recent case the defendant, who had given a general notice that the invention was not new, was allowed to show that one of two inventions described in the specification was old, and that therefore the patent was bad. (*Sugg* v. *Silber*, 2 Q. B. D. 493.)

It was not generally sufficient to give the name of the *town* where the invention has been used (*Flower* v. *Lloyd*, Solicitors' Journal, 1876, p. 860; *Holland* v. *Fox*, 1 W. R. 448); but the plaintiff ought to be put in possession of all the defendant himself knows, and to have such information as would enable him to make the necessary inquiries at the places named, and identify the instances alleged (*Palmer* v. *Cooper*, *per* Parke, B., 9 Exch. 236; *Curtis* v. *Platt*, 8 L. T. Rep., N. S. 657), unless the defendant relied upon a *general* user by all manufacturers at the place named. (*Palmer* v. *Wagstaffe*, 22 L. J., Exch. 295.) But *Field*, J., refused to follow this case (*Flower* v. *Lloyd*, Solicitors' Journal, 1876, p. 860), which seems inconsistent with *Morgan* v. *Fuller* (L. R., 2 Eq. 297), where particulars alleging that the patented invention had been, before the date of the patent, "commonly used by carriage builders generally throughout Great Britain," and by "various carriage builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain," were held insufficient. The Court, however, intimated that where the objection points to the public use of a particular *preparation*, the words "by various makers in or near London" might be sufficient; and that if the defendant could not give the names of the

carriage builders *in or near London*, &c., he would be required to specify the class or classes of carriages with respect to which the alleged prior user had taken place, and that might have been held sufficient. S. 29.

The decisions as to what particulars of prior user had to be given under the 41st section of the 15 & 16 Vict. c. 83, are also conflicting.

In *Penn* v. *Bibby* (L. R., 1 Eq. 548) the defendant was ordered to amend his particulars of objections by specifying "the persons by whom, the places where, the dates at, and the manner in which" there had been user prior to the date of the plaintiff's patent. And see *Palmer* v. *Cooper* (23 L. J., Exch. 82) and *Grover and Baker Sewing Machine Co.* v. *Wilson* (W. N. 1870, p. 78).

On the other hand, it was held in *Palmer* v. *Wagstaffe* (22 L. J., Exch. 295), that where the defendant relied upon a general user of the supposed invention, it is sufficient to state that the invention was used by manufacturers generally at a particular place, without naming any person or specifying any manufactory. And see *Bentley* v. *Keighley* (13 L. J., C. P. 167) and *Bulnois* v. *Mackenzie* (4 Bing. N. C. 127).

The practice was, however, settled by the Court of Appeal in the case of *Flower* v. *Lloyd* (45 L. J., Ch. 746; Seton on Decrees, p. 349), where it was decided that the order for further and better particulars should follow the words of section 41 of the Act of 1852, and require the defendant to state in his particulars merely "the place or places at, or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the patent," and this order was followed in *Plimpton* v. *Spiller* (20 Solicitors' Journal, 1876, p. 860).

But under this order the defendant was bound to furnish full and sufficient particulars, and *Field*, J., where the defendant had furnished in his particulars the names and addresses of three persons, and stated that the patented process had also been used by "other persons in *London* and

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Birmingham," ordered the words in inverted commas to be struck out, unless the defendant gave more specific information; his Lordship, however, adding, "I do not say that they need give the name and address of every such person, but they must give fair information." (*Plimpton* v. *Spiller*, Solicitors' Journal, 1876, p. 860.)

So in *Crossley* v. *Tomey* (2 Ch. D. 533), the defendant was ordered, in answer to interrogatories, to set out the names of some of the persons who were alleged by him to have used the invention prior to the date of the patent. *Chitty*, J., has also held that the plaintiff is entitled to the names and addresses of the persons by whom prior user is alleged to have been made as well as the places where the prior user has taken place. Also that, if the plaintiff or defendant makes out a proper case, the Court has jurisdiction to order interrogatories, with reference to those matters which may be covered by the particulars, to be answered. (*Birch* v. *Mather*, 22 Ch. D. 629.)

(3.) *As to prior publication.*

Notices delivered under the 5th section of the 5 & 6 Will. 4, c. 83, were required to specify all the books or publications intended to be relied on (*Jones* v. *Berger*, 1 Web. P. C. 548), and it was not sufficient to say, in certain magazines or journals (specifying them), "and also in other books and writings." (*Bentley* v. *Keighley*, 13 L. J., C. P. 167.)

Particulars delivered under the 41st section of the Act of 1852 alleged that, "before the date of the alleged letters patent the alleged invention had been published in England in the *Commissioners' Patents Journal* of the 6th of July, 1863, and in the *Scientific American* of the 25th January, 1863, and in *sketches and drawings deposited in the Patent Office Library in July*, 1865:—*Held*, that the defendant must give better particulars, stating the pages of the publications mentioned in the above objections, but not the lines, and identifying the drawings in writing, whether contained in

books or not. (*Plimpton* v. *Spiller*, 20 Solicitors' Journal, 1876, p. 860.) S. 29.

Where the defendant had given notice to admit a large number of specifications, and among them all specifications of the plaintiff, a judge at Chambers made an order on the defendant either to give the names and dates of the specifications of the plaintiff intended to be used, or that they should be excluded. The defendant then gave notice for all the plaintiff's specifications between 1840 and 1850, and contended at the trial that this was a compliance with the judge's order. *Erle*, J., at the trial ruled that it was not, on the ground that such an indefinite notice tended to embarrass the opposite party, and to deprive him of the means of preparation intended by the statute, it being admitted that the plaintiff had several other patents for various inventions in that interval. This view was adopted by the Court in a considered judgment. (*Lister* v. *Leather*, 8 Ell. & B. 1029, and 3 Jur., N. S. 816.) In a recent case (*The London and Leicester Hosiery Co.* v. *Higham*, not reported) in which the plaintiff sought to recover damages for the infringement of a complicated machine, and the defendant set out a large number of specifications in his particulars of objections to prove prior publication, the Court made an order in the following form, viz.: That the defendant do deliver further and better particulars of objections, by stating what portions of the specifications in the particulars already delivered referred to, are alleged to anticipate the plaintiff's inventions, with references to pages and lines of such specifications, and also what portions of the plaintiff's inventions are alleged to have been published or used prior to the dates of the several letters patent therefore, with references to the claiming clauses of the specifications of such letters patent.

(4.) *As to the specification.*

All the reported cases relate to decisions prior to the

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passing of the Act of 1852. The following notices were held sufficient: "that the invention is not properly set forth in the specification" (*Heath* v. *Unwin*, 12 L. J., Exch. 48; *Leaf* v. *Topham*, 14 L. J., Exch. 231); that the plaintiff's specification does not "sufficiently distinguish between what was old and what was new" (*Jones* v. *Berger*, 5 M. & G. 208); that the plaintiff did not state in his specification "the most beneficial method with which he was then acquainted of practising his said invention." (*Ibid.*) A notice "that the specification is calculated to deceive" would seem to be sufficient to let in evidence as to any particular passage in the specification being false (*Neilson* v. *Harford*, 1 Web. P. C. 324 (n.)); and where the notice of objection simply stated the specification to be insufficient, if the plaintiff was content to take that as notice, it was held that any objection as to the sufficiency of the specification was admissible at the trial. (*Ibid.* 332.) The objection "that the invention for which the said letters patent were granted is more extensive than, and did not correspond with, the invention described in the specification," was held insufficient, as the attention of the plaintiff should be called to the particular part or parts of the specification. (*Fisher* v. *Dewick*, 1 Web. P. C. 551 (n.).)

A notice that the plaintiff has not caused any specification sufficiently describing the nature of the supposed invention to be duly enrolled in Chancery was held to be too obscure, as it might mean either that there is no specification existing among the rolls of the Court, or that the specification enrolled is defective in not sufficiently describing the invention. (*Leaf* v, *Topham*, 14 L. J., Exch. 231.)

(5.) *As to fraud and misrepresentation.*

Where the defendant pleaded that the report of the Judicial Committee of the Privy Council, and the letters patent thereon, were procured by fraud, covin, and misrepresentation, the notice of objections ought to state the

species of fraud, covin, and misrepresentation by which the patent was procured, on which the defendant intends to rely. (*Russell* v. *Ledsam*, 11 M. & W. 647.) S. 29.

Further and better particulars.

If the particulars of breaches or of objections are too general, or tend to embarrass, application should be made to a judge at Chambers, by the defendant in the former, and the plaintiff in the latter case, for further and better particulars. If this is not done, evidence of any act of infringement, or of prior user, which come within the literal meaning of the words in the particulars, however large and general they may be, is admissible at the trial. (*Sykes* v. *Howarth*, 12 Ch. D. 826; *Hull* v. *Bolland*, 25 L. J., Exch. 304; *Neilson* v. *Harford*, 1 Web. P. C. 331.) Where the admission of such evidence is likely to create surprise or introduce a new point, the opposite party will probably be allowed to bring forward fresh evidence. (*Sykes* v. *Howarth*, *supra*.)

The judge at Chambers had no power to introduce into an order for further and better particulars, any terms relative to the admissibility of evidence at the trial which are inconsistent with the provisions of the 41st section of the Act of 1852. (*Palmer* v. *Cooper*, 23 L. J., Exch. 82.)

The judge at Chambers had power under the 41st section of the 15 & 16 Vict. c. 83, to allow the plaintiff to amend his particulars of breaches, and the defendant to amend his notice of objections, but such leave was only granted as to instances coming to the knowledge of the plaintiff or defendant subsequent to the notice delivered or the answer put in, and on payment of costs. (*Penn* v. *Bibby*, L. R., 1 Eq. 548; *Finnegan* v. *James*, L. R., 19 Eq. 73; *Curtis* v. *Platt*, 8 L. T. Rep., N. S. 657.) And this may be done after the action has been set down for trial. (*Wilson* v. *Gann*, 23 W. R. 546.) But in such cases the Court will place the plaintiff in the same position as to discontinuing the action, or disclaiming a portion of his

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invention, as he would have been in if the original particulars of objection had contained the new instances of prior publication proposed to be introduced by amendment; and accordingly all costs incurred by the plaintiff subsequently to the delivery of the original particulars of objection will be ordered to be paid to him by the defendant in case he elects, within a time fixed by the order, to discontinue his action. (*Edison Telephone Co.* v. *India Rubber Co.*, 17 Ch. D. 137; following *Baird* v. *Moule's Patent Earth Closet*, Ib. 139, (n.), which see for form of order; and *Aveling* v. *McLaren*, Ib. p. 139 (n.).)

The judge has in some cases amended the notice of objection during the course of the trial. (*Renard* v. *Levinstein*, 11 L. T. Rep., N. S. 505: *Daw* v. *Eley*, L. R., 1 Eq. 38.)

And where the defendants do not confine themselves to meeting the case opened by the plaintiff, but open and call evidence to prove an entirely different case, the plaintiff was entitled to call evidence in reply; and, notwithstanding the 41st section of 15 & 16 Vict. c. 83, to give instances of infringement not included in his particulars of breaches delivered in the action. (*Adair* v. *Young*, W. N. 1879, p. 8.)

Where a new trial was ordered, the defendant was allowed to give notice of acts of prior user that had come to his knowledge since the first trial. (*Bovill* v. *Goodier*, 36 L. J., Ch. 360.)

The defendant was held entitled to his costs of notice of objections, and of the evidence in support of them, when the plaintiff abandoned his action before trial. (*Greaves* v. *The Eastern Counties Railway Co.*, 28 L. J., Q. B. 290.)

When, at the trial of an action, the Court was of opinion that there had been an infringement by the defendant, but held on a legal ground that the patent was void, a certificate under sect. 43 of the Act of 1852 (which corresponds with this section, subsect. 6), that breach of the patent by the defendant had been proved, was refused. (*United Telephone Co.* v. *Harrison*, 21 Ch. D. 720.) The certificate of the judge under the 43rd section of the Act, 1852, was a condition

precedent to the right of a defendant to costs in respect of particulars. (*Honiball* v. *Bloomer*, 24 L. J., Exch. 11; and see *Losh* v. *Hague*, 5 M. & W. 387; and *Batley* v. *Kynock*, L. R., 20 Eq. 632.) S. 29.

S. 30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit. Order for inspection, &c., in action.

This is in effect a re-enactment of the provisions of the 42nd section of the Act of 1852, and cases decided under that section are equally explanatory and illustrative of this. All the powers conferred upon the Court or a judge by this section are already possessed by them under other Acts of Parliament and rules of practice. The subject is best considered under the following heads:

1. *Injunction.*

The injunction here spoken of is either interlocutory or final. A Court of Chancery always had power to grant injunctions, such jurisdiction arising from the imperfection and inadequacy of legal remedies.

Power was given to the Courts of law by ss. 79 to 82 of the C. L. P. A., 1854 (17 & 18 Vict. c. 125), as amended by ss. 32 & 33 of the C. L. P. A., 1860 (23 & 24 Vict. c. 126), to grant writs of injunction to parties injured who had brought actions. In future, however, no writ of injunction shall issue. (Rules of the Supreme Court, Order L., rule 11.) Under these Acts, as under the 42nd section of the Patent Law Amendment Act of 1852, and under this section of the present Act, the injunction can only be granted after an action has been brought for an infringement.

By the 24th section (subsection 8) of the Judicature Act,

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1873, however, an injunction may be granted by an interlocutory order *in all cases* in which it shall appear to the Court to be just or convenient that such order should be made. This section is a general supplement to all Acts of Parliament. (*Cooper* v. *Whittingham*, 15 Ch. D. 507.) In proper cases the order will be granted although no action has been commenced.

The practice under this section is regulated by Rules of the Supreme Court, Order L., rules 6 and 12. In cases of emergency the order will be made *ex parte*, either on the application of the plaintiff (*Melhuish* v. *Milton*, 24 W. R. 679; *Hennessey* v. *Bohmann*, W. N. 1877, p. 14), or on the application of any other party, where the Court or a judge are satisfied that to proceed on notice might entail irreparable or serious mischief. (Order LII., rule 3.)

Where notice of motion has been given, an interlocutory injunction will not be made *ex parte*, even though pressure of public business prevents the motion being brought on. (*Graham* v. *Campbell*, 7 Ch. D. 490.)

When an interlocutory injunction is granted, the plaintiff is required to give an undertaking to abide any order the Court may make as to the payment of damages by him to the defendant in respect of injury sustained by reason of the injunction (*Wakefield* v. *Duke of Buccleuch*, 11 Jur., N. S. 523; *Plimpton* v. *Spiller*, 4 Ch. D. 286), even where the order is made in favour of the Crown. (*Secretary for War* v. *Chubb*, W. N. 1880, p. 128.)

An interlocutory injunction may be granted to restrain an infringement where the patentee has had a reasonably long and uninterrupted enjoyment of it, notwithstanding that there may be some doubt as to its validity, or where its validity has been determined in another action, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent; or where the

patentee would otherwise have to bring a multitude of actions against the purchasers of the patented articles sold by the defendant. (*Kay* v. *Marshall*, 2 Web. P. C. 39; *Stevens* v. *Keating*, 2 Web. P. C. 177; *Harmer* v. *Playne*, 14 Ves. 130; *Dudgeon* v. *Thomson*, 30 L. T. Rep., N. S. 244; *The Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 706; *Renard* v. *Levinstein*, 10 L. T. Rep., N. S. 94, affirmed p. 177; *Losh* v. *Hague*, 1 Web. P. C. 200; *Plimpton* v. *Spiller*, 4 Ch. D. 286; *Bovill* v. *Goodier*, L. R., 2 Eq. 195; *Curtis* v. *Cutts*, 8 L. J., Ch. 184; *Hill* v. *Thompson*, 1 Web. P. C. 229.) S. 30.

Illustrations.

(A.) Interlocutory injunctions were granted:

(1.) Where the patent had been enjoyed for thirteen years, and its validity had been established once at law and once in Chancery. (*Davenport* v. *Goldberg*, 2 H. & M. 282.)

(2.) Where the patent was thirteen years old notwithstanding that the title was doubtful. (*Harmer* v. *Playne*, 14 Ves. 130.)

(3.) Where the patent was twelve years old and successful proceedings had been taken against four previous infringers, notwithstanding that a fresh fact tending to impeach the novelty of the invention was brought forward. (*Newall* v. *Wilson*, 2 De G. M. & G. 282; and see *Stevens* v. *Keating*, 2 Web. P. C. 175, 176.)

(4.) Where the patent had been enjoyed for eleven years. (*Muntz* v. *Foster*, 2 Web. P. C. 93.)

(5.) Where the patent was eight years old, but the defendant had neglected a prior opportunity of contesting the validity of the patent. (*Betts* v. *Menzies*, 3 Jur., N. S. 357.)

(6.) Where the patent had been enjoyed for six years, notwithstanding objections taken to the specification. (*Bickford* v. *Skewes*, 1 Web. P. C. 213; 211.)

(7.) Where the plaintiff establishes his legal title, even though the patent has been granted only for a year or less. (*Gardner* v. *Broadbent*, 2 Jur., N. S. 1041; and see *Neilson* v. *Harford*, 1 Web. P. C. 373; *Russell* v. *Cowley*, 2 Coop., C. C. 59 (n).)

(8.) Where facts proved, such as the conduct of the defendant, justify it, even though the patent is less than a year old, and its validity has not been established. (*Clark* v. *Fergusson*, 1 Giff. 184; and see *Muntz* v. *Greenfell*, 2 Coop. 61 (n).)

(9.) Where an interdict was granted against the defendant by the

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Court of Sessions in 1873, the patent being granted in 1866. (*Dudgeon* v. *Thomson*, 30 L. T. Rep., N. S. 244.

(10.) Where the Court were equally divided as to the validity of a patent, injunction continued until a fresh action was brought. (*Boulton* v. *Bull*, 3 Ves. 140.)

(11.) Against the master of a ship, who was not a part owner, to restrain him from using patented pumps, which had been fitted up on board the ship before he had taken command of her, and had never been worked in British waters, on the ground that he intended to use the patented invention. (*Adair* v. *Young*, 12 Ch. D. 13.)

(B.) Interlocutory injunctions refused in the following cases:

(1.) Where the plaintiff failed to prove that there has been an *active user* of the invention, even where the patent has been in force for eight years. (*Plimpton* v. *Malcolmson*, 44 L. J., Ch. 257.)

(2.) Where the patented improvements had been put in practice by the patentee for ten years, but had only been enjoyed by him without the licence of a prior patentee for about one year. (*Heugh* v. *Magill*, W. N., 1877, p. 62.)

(3.) Where two parties had obtained patents for the same invention, Kindersley, V.C., would not interfere by injunction, but left them to try the legal right by *scire facias*. (*Copeland* v. *Webb*, 11 W. R. 134.)

(4.) Where an undertaking by the defendant to keep an account afforded the Court the means of doing justice. (*Jones* v. *Pearce*, 2 Coop. 58; *Mitchell* v. *Barker*, 39 Lond. Jour. 531; but see *Renard* v. *Levinstein*, 2 Hem. & M. 628.)

An interlocutory injunction will not be granted unless asked for at an early period, or where the patentee has been guilty of delay, or has acquiesced in the infringements. (*Bridson* v. *Benecke*, 12 Beav. 1; *Bovill* v. *Crate*, L. R., 1 Eq. 388; *Smith* v. *London and South Western Railway Co.*, Kay, 408.)

Illustrations.

(1.) Where plaintiff knew of infringement in August, wrote letters of complaint in November, and commenced suit following July, an interlocutory injunction refused. (*Bovill* v. *Crate*, L. R., 1 Eq. 388.)

(2.) Knowledge of infringement in August, 1835, application for injunction, 1839, refused. (*Bacon* v. *Jones*, 4 My. & Cr. 433.)

(3.) Infringement discovered in January, bill filed following De-

cember. Injunction refused, although the patent had been established against another defendant. (*Bridson* v. *Benecke*, 12 Beav. 1.)

(4.) Patent granted 1846, infringement 1847, bill filed 1849. Injunction refused. (*Baxter* v. *Combe*, 1 Ir. Ch. R. 284.)

(5.) Information of infringement in March, application for injunction July, inquiries and correspondence having taken place in the interval. *Held*, that the plaintiff had come in time. (*Losh* v. *Hague*, 1 Web. P. C. 200.)

(6.) Omission to proceed by *scire facias* to set aside a patent granted for part of an invention already protected is no evidence of *acquiescence*, unless the subsequent patent is used. (*Newall* v. *Wilson*, 2 De G. M. & G. 282.)

(7.) Where there are several infringers of a patent, and an action is brought against one only, distinct notice ought to be given by the patentee to the other infringers, if injunctions and damages are intended ultimately against them. (*Smith* v. *The London and South Western Railway Co.*, Kay, 408; *Hancock* v. *Moulton*, M. Dig. 506.)

Before the Court will grant an interlocutory injunction the patentee must establish a *primâ facie* case of infringement. (*Neilson* v. *Betts*, L. R., 5 H. L. 1; *The Electric Telegraph Co.* v. *Nott*, 2 Coop. 41; *Hancock* v. *Moulton*, M. Dig. 506; *Heath* v. *Unwin*, 16 L. J., Ch. 283; *Collard* v. *Allison*, 4 M. & C. 487); or of threatened infringement (*Frearson* v. *Loe*, 9 Ch. D. 48.)

Illustrations.

(1.) Positive evidence having been given by a workman that he had seen the patented article manufactured in the manufactory when he was working by a process not distinguishable from that patented, if uncontradicted, is sufficient to establish a *primâ facie* case. (*Neilson* v. *Betts*, L. R., 5 H. L. 1.)

(2.) Where the alleged infringement consists of the sale of a patented article, the plaintiff must prove not only the sale but also that the article was not made by himself or his agent. (*Betts* v. *Willmott*, L. R., 6. Ch. 239.)

The plaintiff must proceed with his action with due promptness, otherwise the injunction will be discharged (*Bickford* v. *Skewes*, 4 My. & Cr. 498.)

An injunction will not be suspended pending an appeal. (*Flower* v. *Lloyd*, 36 L. T. Rep., N. S. 444.)

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Or because the defendant has entered into contracts for the supply of the article alleged to be an infringemet. (*Ibid.*)

An injunction may be granted to restrain the sale both before and after the expiration of a patent of articles made by an infringer (*Crossley* v. *Beverley*, 1 Web. P. C. 119), even though the patent has expired at the date of the application for the injunction (*Crossley* v. *The Derby Gas Light Co.*, 4 L. J., Ch. 25); but in this case it must be established that such articles are actually in existence. (*Price's Patent Candle Company* v. *Bauwen's Patent Candle Company*, 4 K. & J., 727.)

2. *Inspection.*

The inspection mentioned in the 42nd section of the Act of 1852, and in this section, is an inspection of the instrument manufactured or machinery or process used by the parties, with a view to evidence of infringement, and does not refer to an inspection of books. (*Vidi* v. *Smith*, 23 L. J., Q. B. 342; *Bovill* v. *Moore*, 2 Coop. C. C. 56.)

Where, as in ordinary cases, the duty of establishing that the patented thing has been pirated lies on the patentee, limited orders of inspection for the purpose of enabling him to discharge that duty, are granted. But such order cannot be granted where the piracy alleged has taken place abroad. (*Neilson* v. *Betts*, L. R., 5 H. L. 1.)

It must, however, be shown that the inspection is material for the purpose of proving the plaintiff's case. (*Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. Rep., N. S. 46; *Amies* v. *Kelsey*, 22 L. J., Q. B. 84; *Batley* v. *Kynock*, L. R., 19 Eq. 90.)

Where the plaintiff and defendant are competitors in trade, an order to inspect the defendant's works should be confined to scientific men, and not be made to include the plaintiff himself. (*Flower* v. *Lloyd*, W. N. 1876, pp. 169, 230.)

The order for inspection may be made notwithstanding that the defendant carries on his manufacture in secret, and would disclose important trade secrets. (*Bovill* v. *Moore*, 2

Coop. C. C. 56 (n.); *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. Rep., N. S. 46; *Russell* v. *Crichton*, 15 Dec. of Court of Sess. 1270.) S. 30.

The order may direct that machinery inspected be put to work during the inspection. (*Davenport* v. *Jepson*, 1 N. R. 307; *Russell* v. *Crichton*, 15 Dec. of Court of Sess. 1270.)

Samples of the goods manufactured may also be ordered to be taken (*Davenport* v. *Jepson*, 1 N. R. 307); as also samples for the purpose of chemical analysis (*Patent Type Founding Co.* v. *Walter*, John. 727; but see same case, 5 H. & N. 192.)

An order of inspection may also be obtained to inspect machines made by the defendant in an action brought by a patentee against his licensee. (*Jones* v. *Lees*, 25 L. J., Exch. 241.)

An application to inspect can be made as soon as the action is commenced, and before statement of claim is delivered. (*Amies* v. *Kelsey*, 22 L. J., Q. B. 84.)

As to the affidavit necessary to support the application see *Shaw* v. *The Bank of England*, 22 L. J., Exch. 26; *Meadows* v. *Kirkman*, 29 L. J., Exch. 205.

In the case of *Russell* v. *Cowley* (1 Web. P. C. 458) the Court not only ordered that the plaintiff's witnesses should inspect the defendant's machinery at work, but that defendant's witnesses should inspect the plaintiff's patented machinery at work, pending an action for infringement, the object of the Court being to enable the parties to give the best evidence as to whether the defendant had been guilty of infringement or not.

Where the defendant dealt in machines which were, as was alleged by the plaintiff, an infringement of his patent, the defendant was not ordered to allow the plaintiff to inspect all the machines in his stock; but was directed to verify on affidavit the several kinds of machines that he had sold or exposed for sale, and to produce one machine of each class for inspection. (*The Singer Sewing Machine Co.* v. *Wilson*, 5 N. R. 505; and see *Morgan* v. *Seaward*, 1 Web. P. C. 169.)

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3. *Account or Damages.*

In addition to the jurisdiction given by this section of the Act the Courts have power under *Sir Hugh Cairns' Act* (21 & 22 Vict. c. 27) to order an account of profits or an inquiry into damages. A patentee is not, however, entitled to both, but must elect which form of relief he will adopt. (*De Vitre* v. *Betts*, L. R., 6 H. L. 319; *Neilson* v. *Betts*, L. R., 5 H. L. 1; *Hills* v. *Evans*, 8 Jur., N. S. 531.)

Sir Hugh Cairns' Act, remains in force notwithstanding the passing of the Jud. Acts, and still is of importance in its provisions, as it enables the Court to grant damages in substitution for an injunction, and so to compensate the plaintiff for infringement of his patent, not only up to the date of the issue of the writ, but up to the hearing of the action, or the expiration of the patent if that shall have happened first. (*Fritz* v. *Hobson*, 14 Ch. D. 542.)

Where a bill prayed in the alternative an inquiry as to damages, or an account of profits, but no issue as to damages was submitted to the jury, the Court refused to refer an inquiry to assess damages to Chambers, but granted the alternative. (*Needham* v. *Oxley*, 8 L. T. Rep., N. S. 604.)

Where the patent has expired during the litigation, but the plaintiff succeeds in showing that at the time of instituting proceedings for an injunction he was entitled to that relief, the Court may, under *Sir H. Cairns' Act*, grant him an inquiry as to damages (*Davenport* v. *Rylands*, L. R., 1 Eq. 302), or an account of profits (*Fox* v. *Dellestable*, 15 W. R. 194), but will not do so if such proceedings were taken so immediately before the expiration of the patent as to render it impossible to obtain an interlocutory injunction (*Betts* v. *Gallais*, L. R., 10 Eq. 392).

The right to a decree for an account of the profits made by the manufacture and use of articles in infringement of a patent, is incident to the right to an injunction to restrain future infringements; and where no case is made for the

injunction, the account will not be decreed. (*Smith* v. *The London and South Western Railway Co.*, Kay, 408; *Bailey* v. *Taylor*, 1 R. & M. 73.) S. 30.

This rule applies notwithstanding that it may appear at the hearing that, since an interim injunction was moved for, the defendants have sold articles which, had the facts and law been then sufficiently ascertained, the Court would have restrained them from selling. (*Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 4 K. & J. 727.)

For illustrations of the practice of the Courts in ordering an account of profits, or an inquiry into damages against infringers, see *Edwards* v. *Normandy*, 12 W. R. 548; *Kernot* v. *Potter*, 3 De G. F. & J. 447; *George* v. *Beaumont*, 27 Rep. Arts, 2nd Series, 252; *Bacon* v. *Spottiswoode*, 1 Beav. 382; *Crossley* v. *Derby Gas Light Co.*, 3 M. & Cr. 428; *Holland* v. *Fox*, 23 L. J., Q. B. 357; against a licensee, *Hadden* v. *Smith*, 17 L. J., Ch. 43; against a person manufacturing patented machines under an agreement, *Moxon* v. *Bright*, L. R., 4 Ch. 292; as to costs where the defendant submits, *Nunn* v. *D'Albuquerque*, 34 Beav. 595. For form of order see *Betts* v. *De Vitre*, 12 L. T. Rep., N. S. 51; L. R., 6 H. L. 319.

Proceedings under an order, directing an account of profits, will, on appeal, be stayed till the hearing of the appeal (which ought to be advanced), where the discovery given by the account would enable the plaintiff to take proceedings against the customers of the defendants, and the defendants, supposing them to be ultimately successful, would thus sustain irreparable injury in their business. (*Adair* v. *Young*, 11 Ch. D. 136; but see *Saxby* v. *Easterbrook*, L. R., 7 Exch. 207.)

The amount of compensation to which a plaintiff is entitled for the infringement of his patent should be calculated by reference to the rate at which he has been in the habit of granting licenses, and he is not entitled to any additional sum in respect of contracts which he has missed by reason of the defendant's piracy. (*Penn* v. *Jack*, L. R., 5 Eq. 81.)

A patentee is entitled to compensation both from the

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person who manufactures in infringement of his patent, and also from the person who uses the article so manufactured (*Penn* v. *Bibby*, 3 Eq. 308). But where the user of an unlicensed machine has paid royalty to the patentee no further royalty is payable by the manufacturer. (Ibid. L. R., 5 Eq. 81.)

As to the form of order that should be made, see *Davenport* v. *Rylands*, in which Wood, V.-C., said: "The inquiry will be in the form, 'what damage the plaintiff has sustained,' and not 'what damage, if any,' he has sustained, as it would be in the case of a trade-mark. There is this difference between the case of a trade-mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without license of a patented article must be a damage to the patentee." (L. R., 1 Eq. 308; cited *per James*, V.-C., *Betts* v. *Gallais*, L. R., 10 Eq. 393.)

The inquiry is limited to six years prior to the commencement of the proceedings (*Davenport* v. *Rylands*, L. R., 1 Eq. 308; *Crossley* v. *Derby Gas Light Co.*, 1 Web. P. C. 119); or in the case of the assignee of a patent to the date of such assignment. (*Ellwood* v. *Christy*, 5 N. R. 312.)

A defendant, against whom an inquiry as to damages has been granted, must make an affidavit as to the number of the patented machines sold by him, and the names and addresses of the purchasers. (*Murray* v. *Clayton*, L. R., 15 Eq. 115.)

Certificate of validity questioned and costs thereon.

S. 31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement,

the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same. s. 31.

The subject-matter of this section was formerly dealt with by the provisions of s. 3 of the 5 & 6 Will. 4, c. 83, and s. 43 of the 15 & 16 Vict. c. 83, and cases decided under both these statutes are useful to the interpretation of the present section. It is to be observed that the "full costs, charges, and expenses" here spoken of are only those in any subsequent "action for infringement," and do not apply to a proceeding by way of revocation, or other litigation. Moreover, the section would seem not to come into operation unless there has been a *trial*. See *Greaves* v. *The Eastern Counties Railway Co.* (28 L. J., Q. B. 290) and *Penn* v. *Bibby* (L. R., 3 Eq. 308).

The words "that the validity of the patent came in question" appear in all three statutes, and constitute a condition precedent to the grant of the certificate.

The validity of the patent comes in question under a plea that the alleged improvements are not new. (*Gillett* v. *Wilby*, 1 Web. P. C. 270.)

Although the pleas may be sufficient to raise the question of the validity of the patent, yet, per *Erskine*, J., the certificate ought not to be granted where the defendant consents to a verdict, without any evidence being given, as such certificate affects third parties, and the verdict by consent might be the result of collusion between the parties. (*Stocker* v. *Rodgers*, 1 C. & K. 99; and see per *Wood*, V.-C., in *Davenport* v. *Rylands*, L. R., 1 Eq. 308; *Betts* v. *De Vitre*, 11 Jur., N. S. 9.)

Where the Court considers the plaintiff entitled to full costs as between solicitor and client, the order should contain an express direction that the costs be so taxed notwithstanding the provision that he shall have such full costs, unless the

S. 31. judge shall certify that he ought not to have them. (*Lister* v. *Leather*, 4 K. & J. 425.) After taxation the judge has no power to grant a certificate. (*Gillett* v. *Green*, 7 M. & W. 347.)

A certificate under this section is not a "usual certificate," and consequently the plaintiff is not entitled to it on the ground that defendant has settled the action by agreeing to pay certain damages and costs, with all "usual certificates." (*Bovill* v. *Hadley*, 17 C. B., N. S. 435.)

The certificate does not apply to the action in which it is obtained (*Penn* v. *Bibby*, L. R., 3 Eq. 308), but to all subsequent actions whether the validity of the patent is questioned or not. (*Davenport* v. *Rylands*, L. R., 1 Eq. 302.)

It is unnecessary now, as formerly, to put the certificate in evidence in any subsequent action.

Remedy in case of groundless threats of legal proceedings.

S. 32. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent. (*a*)

(*a*) The object of this section would seem to be to ensure that the issue, in actions of this kind, shall be whether infringement in fact is being committed. To justify threats of legal proceedings such as are here spoken of the person

making them must be possessed of a valid patent, and the person threatened must be guilty of infringing his rights under such patent, or, he must with due diligence commence and prosecute an action for infringement of his patent. The defendant in the action must, to have a good defence, be in a position to maintain an action for the infringement of which he complains. S. 32.

This is an important change in the law.

Prior to the passing of this section an action such as is therein referred to would lie if the plaintiff affirmatively proved that the defendant's claim was not a *bonâ fide* claim in support of a right which, with or without cause, he fancied he had, but a *malâ fide* and malicious attempt to injure the plaintiff by asserting a claim of right against his own knowledge that it was without any foundation. (*Wren* v. *Weild*, L. R., 4 Q. B. 730.)

An injunction, however, could be obtained if the plaintiff made out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement by the plaintiff was untrue, quite irrespective to any question of *mala fides*. Moreover, a patentee who issued circulars alleging infringement of his patent, was not bound to follow up such circulars by taking legal proceedings. (*Halsey* v. *Brotherhood*, 15 Ch. D. 514, and comments upon *Rollins* v. *Hinks*, L. R., 13 Eq. 355, and *Axmann* v. *Lund*, L. R., 18 Eq. 330.)

Infringement.

As the issue of infringement will be raised in these actions, as well as in actions directly charging that wrong, the substantive law upon the subject is given here in a concise form.

An infringement has been defined as the doing any of the acts specified in the prohibitory clauses of the letters patent. (*Walton* v. *Bateman*, 1 Web. P. C. 616.)

The form of letters patent given in the schedule to the present Act contains the following prohibition:—"We do by

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these presents, for us our heirs and successors, strictly command all our subjects whatsoever within our kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent of the patentee."

It is quite immaterial with what *intent* the acts are done (*Stead* v. *Anderson*, 2 Web. P. C. 156; *Heath* v. *Unwin*, 25 L. J., C. P. 19; per *Shadwell*, V.C., 15 Sim. p. 553; *Wright* v. *Hitchcock*, L. R., 5 Exch. 37), but if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose or under a claim of right, ought not to be considered within the prohibition. (Per *Jessel*, M.R., in *Frearson* v. *Loe*, 9 Ch. D. 66; *Muntz* v. *Foster*, 2 Web. P. C. 101; *Higgs* v. *Godwin*, Ell. Bl. & Ell. 529; *Betts* v. *Willmott*, L. R., 6 Ch. 239; *Jones* v. *Pearce*, 1 Web. P. C. 125.)

The question of infringement is a mixed question of law and fact. (*Curtis* v. *Platt*, 35 L. J., Ch. 852.) Where a question of infringement depends merely on the construction of the specification, it is entirely for the judge; but where it depends upon other circumstances, such as the degree of difference or of similitude between two machines, it is a mixed question of law and fact; what the jury find to have been done is the matter of fact, but the judge must apply that fact according to the rules of law, and is entitled and bound to say whether what has been done amounts to an infringement. (*Seed* v. *Higgins*, 8 H. L. Cas. 550; *De la Rue* v. *Dickinson*, 7 Ell. & Bl. p. 755.)

An action of infringement cannot be maintained for acts done on a British ship on the high seas. (*Newall* v. *Elliott*, 4 N. R. 429.)

Letters patent may be infringed, S. 32.

A. By directly or indirectly putting in practice the patented invention.

Illustrations.

(1.) An English patent for the manufacture of a substance to be applied as capsules to cover the mouths of bottles, is infringed by a person who purchases such capsules from a foreign manufacturer, fixes them upon bottles outside the limits of the patent, but sends such bottles, with the capsules affixed, to his agent in England for transhipment and exportation. (*Neilson* v. *Betts*, L. R., 5 H. L. Cas. 1; see also *Nobel's Explosives Company* v. *Jones, Scott & Co.*, 17 Ch. D. 721, 48 L. T. Rep., N. S. 490; *Caldwell* v. *Vanvlissengen*, 21 L. J., Ch. 97; and *Vavasseur* v. *Krupp*, 9 Ch. D. 351.)

(2.) A patent consisted of the application of cards or strips of leather covered with wire to rollers at "wide distances." A person who contracted to clothe rollers, and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only and did not include the nailer's work. *Semble*, the conclusion would have been the other way if he had merely supplied the cards without making the nailer his agent. (*Sykes* v. *Howarth*, 12 Ch. D. 826.)

B. By directly or indirectly putting in practice a new and material part of the patented invention.

Illustrations.

(1.) A patent for a combination of A. B. and C. *may* be infringed by using a combination of A. and B., or A. and C., or B. and C. But whether such user is an infringement or not can only be determined by considering the nature of the invention, by ascertaining what A. B. and C. are, how they contribute to the object of the invention, and what relation they bear to each other; and by seeing that the subordinate combinations are sufficiently claimed by the specification. (*Lister* v. *Leather*, 8 Ell. & B. 1031; *Clark* v. *Adie* (first app.), 10 Ch. 674; 2 App. Cas. 335; *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 578, 593; *White* v. *Fenn*, 15 W. R. 348; *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; *Smith* v. *London and North Western Railway Co.*, 2 Ell. & B. 69; *Sellers* v. *Dickinson*, 5 Exch. 312; *Newton* v. *Grand Junction Railway Co.*, 5 Exch. 331.)

(2.) A specification claimed the application of centrifugal force by

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the use of "a weight." A machine similar in many respects, but, though using weight, or pressure occasioned by weight, as a force, did not use "*a* weight." *Held*, no infringement. (*Seed* v. *Higgins*, 8 H. L. Cas. 550.)

(3.) The use of a part of a patented combination, when that part is not itself patentable, is not an infringement of the combination. (*Parkes* v. *Stevens*, L. R., 8 Eq. 358; 5 Ch. 36.)

(4.) Though the manufacture in this country of the several parts of a patented machine, and the exportation of those parts, may not be an infringement of a patent for a new combination of machinery, when the parts exported are old, it is otherwise where the parts exported are new, and are claimed as new. (*Goucher* v. *Clayton*, 11 Jur., N. S. 462.)

(5.) In a patent for a combination of processes altogether new, leading to one end, any use made of any of the ingredients singly, or any use made of such ingredients in partial combination, some of them being omitted, or any use of all or some of such ingredients in proportion essentially different from those specified, and yet producing a result equally beneficial with the result obtained by the proportions specified, will not constitute an infringement. (*Hill* v. *Thompson*, 8 Taunt. 391.)

(6.) A patent for a new combination of a blast and an exhaust in connection with a mill, in which only the *lower* stone rotates, is infringed by the use of the same combination in connection with a mill in which the *upper* stone rotates. (*Bovill* v. *Keyworth*, 7 Ell. & B. 725.)

(7.) A patent for a reaping machine, the several parts of which are not claimed, is not infringed by the manufacture of the blade or cutter similar to that described in the specification, which does not of itself constitute a machine; but the patent may be infringed by a person who subsequently makes the cutter into a machine which is identical with, or an imitation of, the patented machine. (*M'Cormick* v. *Gray*, 31 L. J., Exch. 42.)

C. By the purchase and sale or offering for sale a patented article.

Illustrations.

(1.) The manufacture of a patent article for the purpose of sale, and offering it for sale, although no sale is actually effected, is an infringement. (*Oxley* v. *Holden*, 8 C. B., N. S. 666: *Wright* v. *Hitchcock*, 39 L. J., Exch. 97; *Muntz* v. *Foster*, 2 Web. P. C. 101; *Gibson* v. *Brand*, 1 Web. P. C. 630; *Minter* v. *Williams*, 1 Web. P. C. 137.)

(2.) The importation into this country, and sale here, of goods manufactured abroad, by a process patented in this country, is an

infringement) *Von Heyden* v. *Neustadt*, 14 Ch. D. 230; *Elmslie* v. *Boursier*, L. R., 9 Eq. 217; *Walton* v. *Lavater*, 29 L. J., C. P. 275); provided it is clear that the goods were not made and sold by the patentee or his agents. (*Betts* v. *Willmott*, L. R., 6 Ch. 239.)

(3.) A license to A. to manufacture a patent article is an authority to his vendees to sell it without the consent of the patentee. (*Thomas* v. *Hunt*, 17 C. B., N. S. 183.)

(4.) A. does not infringe a patent for the use of well-known chemical substances, in a specified manner, to obtain a particular result, by selling such well-known chemical substances to B., with knowledge that B. intends to use them in infringement of the patent, the validity of which he disputes.

If A. sells the known chemical substances to B., not only with knowledge that B. intends to use them in infringement of the patent, but also, in consideration of such purchase, indemnifies B. from all consequences of such purchase and use, both A. and B. knowing the patent to be valid, the agreement for indemnity is invalid as against public policy, but A. is not guilty of infringement.

If, under the same circumstances, the patent is disputed or likely to be disputed, the indemnity is valid, but A. is not guilty of infringement. (*Townsend* v. *Haworth*, 12 Ch. D. 831 (n.).)

D. By putting in practice a colourable imitation of the patented invention, by the use of mechanical or chemical equivalents, or in any other way. (*Dudgeon* v. *Thomson*, 3 App. Cas. 34.)

The principle which protects a patentee against the use by others of mechanical equivalents is inapplicable in a case where the whole invention depends on the peculiar machinery by means of which a well-known object is attained. (*Curtis* v. *Platt*, 35 L. J., Ch. 852; *Bovill* v. *Pimm*, 11 Exch. 718; *Barker* v. *Grace*, 17 L. J., Exch. 122; *Flower* v. *Lloyd*, W. N. 1877, p. 132; *Saxby* v. *Clunes*, 43 L. J., Exch. 228; *Murray* v. *Clayton*, L. R., 10 Ch. 675 (n.).)

Illustrations.

(1.) A.'s invention consisted in stoppering bottles containing aërated water, by means of a cylinder or plug of hard wood, having a *greater* specific gravity than water. B.'s invention consisted in having internal stoppers of *less* specific gravity than the liquid contained in the bottle, the stoppering being effected by means of a weight or closed device

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arranged to be temporarliy applied to the stopper, so that the specific gravity of the stopper and closing device combined, exceeded the specific gravity of the liquid contained in the bottle. *Held*, a colourable imitation. (*Barrett* v. *Vernon*, 45 L. T. Rep., N. S. 755, and see *Thorn* v. *Worthing Skating Rink Co.*, 6 Ch. D. 417.)

(2.) A. obtained a patent for improvements in giving signals and sounding alarums in distant places, by means of electric currents transmitted through *metallic circuits*. B. obtained the same result by employing the earth for the transmission of the return circuit:—*Held* an infringement; for although B.'s circuit was not *wholly metallic*, it was so in that part which formed the substance of A.'s patent, viz.: that part which gave the signal. (*The Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; see also *Walton* v. *Potter*, 1 Web. P. C. 585; *United Telephone Co.* v. *Harrison*, 21 Ch. D. 720.)

(3.) A patent, for welding iron in the manufacture of tubes by circular pressure through dies or holes, is infringed by welding produced by passing the iron through grooved rollers, although the result obtained is not so perfect. (*Russell* v. *Cowley*, 1 Web. P. C. 463.)

(4.) A. invented an apparatus for the manufacture of sulphate of soda, consisting of two iron retorts connected together, the essence of the invention consisting of the use of two chambers which could be kept at different temperatures. B. for the same purpose used two chambers, one of iron, and one of brick, connected together and heated by separate furnaces:—*Held*, an infringement. (*Gamble* v. *Kurtz*, 3 C. B. 425.)

(5.) A. patented the use of carburet of manganese in the process for the conversion of iron into cast steel. B. manufactured cast steel by the use of oxide of manganese and carbonaceous matter, which during the process formed carburet of manganese, and produced the same effect, at a cheaper rate:—*Held*, a new invention, and no infringement. (*Unwin* v. *Heath*, 5 H. L. Cas. 505.)

(6.) A. obtained a patent for the improved manufacture of metal plates for sheathing the bottoms of ships. B., who was alleged to have infringed, claimed to be working under a prior patent obtained by C. The following points were characteristic in A.'s process:—

(*a.*) An alloy of 60 per cent. of copper and 40 per cent. of zinc.

(*b.*) Both metals were to be of the best quality, and pure.

C.'s patent directed:—

(*a.*) An alloy of 55½ per cent. of copper and 44⅓ per cent. of zinc.

(*b.*) Other metals could be used with the alloy of copper and zinc.

The metal sheathing manufactured by B. was found to consist of pure zinc and copper in the proportion of 3 to 2.

Held, an infringement. If the metals had been originally combined

in a pure state, the infringement was plain and direct, if purified in the course of the process, it was a colourable evasion. (*Muntz* v. *Foster*, 2 Web. P. C. 93, 96.) S. 32.

(7.) A patent was granted for an invention for the purification of gas by means of precipitated or hydrated oxides of iron. The specification was held to include such precipitated or hydrated oxides only as were obtained by artificial means. The use of a natural substance, such as bog ochre, containing precipitated oxide of iron, so long as it was used in its native condition, was held not to be an infringement of the patent; but upon this substance being re-oxidized or renovated in the manner described in the specification, or in any other manner, it was brought into the condition of being one of the plaintiff's patented purifying materials, that is, a hydrated or precipitated oxide artificially obtained, the use of which became an infringement. (*Hills* v. *Liverpool Gas Co.*, 32 L. J., Ch. 28.)

(8.) A patent for manufacturing type in the proportion of 75 per cent. of tin, and 25 per cent. of antimony, is infringed by the employment of different proportions of those metals if, in the opinion of the jury, such variations amount only to a colourable evasion of the patent. (*Patent Type Founding Co.* v. *Richards*, Johns. 381.)

Miscellaneous.

Patent for one invention only.

S. 33. Every patent may be in the form in the first Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. (*a*)

(*a*) The provision that every patent shall be granted for "one invention only" is new. The Act contains no direct provision that the examiner shall report whether the application and specification are confined to one invention, and no direct provision that the comptroller may require an amendment in such a case. By the 86th section, p. 165, the comptroller has power to refuse to grant a patent for an invention of which *the use* would be contrary to law. This, however, does not justify a refusal on the ground that the specifica-