

## THE CLAIMING CLAUSES OF PATENT SPECIFICATIONS.

By the Honourable MR. JUSTICE DEAN of the  
Supreme Court of Victoria.

The general principles of patent law are imperfectly understood by the average practitioner, yet it is a very important practical branch of our law. A manufacturing business, in particular, may at any time desire to invoke the law to enforce its patents, or may have to defend itself against claims based on patents owned by others. No apology is needed, therefore, for the present article.

A patentee who desires to enforce a patent against an alleged infringer has many hurdles to surmount. His patent must be valid. This means firstly, that it must possess "subject-matter," i.e., it must constitute a real inventive step as distinct from being a mere improvement upon known practice of a kind which any competent person setting out to solve the same problem could by the exercise of his skill and knowledge accomplish. It must also be novel, i.e., it must not have been previously published or used in this country. It must also be free of any of the fatal defects now conveniently set out in section 25 of the British *Patent Act* 1907-1939. Much legal ingenuity has been expended in establishing invalidity of patents upon one or more of the grounds there stated.

Two grounds of objection directly related to the claiming clauses are (a) uncertainty or ambiguity in the definition of the monopoly claimed, and (b) that the claims are wider than warranted by the disclosure made by the specification.<sup>1</sup> It is not proposed to deal with these questions here.

The relation of the claims to the rest of the specification is frequently the source of controversy. Claims are to be read in the light of the specification so as to claim, if that be fairly open, the invention described, but a patentee is not allowed to use wide language in his claim and then to seek to restrict such language by introducing limitations from the body of the specification. However, the basic rule is that claims are part of a specification and must be construed as such and not as if they were contained in an independent document.

But even if the patent be upheld as valid, there still remains the task, often formidable, of making out that it has been infringed. It is to this topic, and in particular, to the importance and proper construction of claiming clauses, that this article is devoted. The history of claiming clauses, or, more shortly, claims, has been clearly stated by a very great patent lawyer, Lord Moulton, when, as Moulton L.J., he delivered judgment in *British United Shoe Machinery Co. v. A. Fussell & Sons Ltd.*<sup>2</sup> Originally, claims were optional. But patentees found it convenient to introduce at the end of specifications describing their inventions and how they best could be carried out, a separate part whereby they defined the monopoly claimed. By the British Act of 1883, it was provided that a specification must end with a distinct statement of the invention claimed—see now Commonwealth *Patents Act* 1903-1946 section 36. In the formulation of his claim an inventor, or his patent attorney, must be

1. See as to (b) *The Mullard Radio Valve Co. v. Philco Radio Corporation*, (1936) 53 R.P.C. 323 (H.L.).

2. (1908) 25 R.P.C. 631, at p. 651.

very astute. If he claims too wide a monopoly, he is in danger of it being held invalid as he may include some construction or some matter which was not novel—or not useful or which otherwise invalidates the claim. If he claims too restricted a monopoly by confining himself closely to his own particular form of construction, or statement of proportions of ingredients, for example, he may render it easy for another person to take his novel idea but to avoid infringement by simply substituting some mechanism or proportions differing in no essential respects from that claimed, yet falling outside the literal words of the claim. This brings me to the crux of the present article. When is a claim infringed? What degree of departure from the literal words of the claim will be sufficient to avoid infringement?

In the earlier cases, claims were not very closely examined. The Courts were ready enough to protect what they called "the pith and marrow" of the invention. Thus in *Clark v. Adie*, Lord Cairns L.C. said,<sup>3</sup> ". . . it might well be, that if the instrument patented consisted of twelve different steps, . . . an infringer who took eight or nine or ten of these steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four or five steps which he might not actually have taken . . ." Again, Wills J. has said<sup>4</sup>—"It is seldom that the infringer does the thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits, and the only protection the patentee has in such a case lies . . . in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated." As will appear later, patentees may well feel that "good sense" has proved a much less secure protection than Wills J. could have anticipated.

For some time another doctrine flourished. Patents, it was said, were of two kinds. Those which were for something "wholly novel" and which were for inventions which marked out some important new departure, were treated more generously than those which merely introduced improvements into some known apparatus or process. Those in the former class were referred to as the *Curtis v. Platt*<sup>5</sup> type, those in the latter as the *Proctor v. Bennis* type<sup>6,7</sup>. No recent case has been decided on this broad distinction, but in each case the degree of novelty has been relevant in considering what departure from the claims constitutes infringement. In the case of a patent for a new departure (sometimes called a "master patent"), the substitution of some different integer for some integer specified in the claims is less likely to escape liability for infringement than a similar substitution in a patent for a mere improvement in detail of an existing machine or process.

An illustration of the "liberal" method of interpreting claims will be found in the case of *Aktiebolaget Separator v. The Dairy Outfit Co.*<sup>8</sup> decided in 1898. The patent related to a new type of separator, the

3. (1877) 2 A.C. 315, at p. 320.

4. *The Incandescent Gas Light Co. v. The De Mare Incandescent Gas Light System*, (1896) 13 R.P.C. 301, at p. 330.

5. 3 Ch. D. 136n.

6. (1887) 4 R.P.C. 333.

7. See *Walker v. Alemite Corporation*, (1933) 49 C.L.R. 643, per Rich J., at pp. 649-650.

8. 15 R.P.C. 327.

machine described in the specification being of an entirely new kind. The patentee attached inside the cylinder a number of plates so arranged as to form channels for the passage of fluid. He had only one claim which read: "In centrifugal separators . . . the combination of the conical plates *c* with the rotating drum or bowl *a* substantially as described." Defendant copied the plaintiff's machine but instead of employing conical plates he used a solid core of metal in which inclined passages were cut. He thus provided for channels which served the same purpose as plaintiff's channels, but he did not use "conical plates." The question was whether plaintiff, having in his claim expressly referred to "conical plates *c*" could claim a monopoly wide enough to include machines which did not employ plates at all. Wright J. thought plaintiff had limited his invention to machines employing such plates, but the Court of Appeal held that there was an infringement. Some reliance was placed in the fact that the machine was entirely new, and therefore within the *Proctor v. Bennis* cases, and this justified a wide construction. But it is probable that at the present day it would be held that the patentee had by his claim made the use of conical plates essential to his monopoly.

Another doctrine was that infringement was not avoided where the defendant took all that was essential in the claim but substituted for some non-essential part some mechanical equivalent of such part, e.g., a screw for a nail as a means of attachment. But this doctrine was qualified by the rule that there could be no infringement by the use of a mechanical equivalent where the part replaced was "essential to the invention."

But the real question in all cases must be, what is it which the inventor, upon the true construction of his claim, has really defined as his monopoly? This must be ascertained as a matter of construction, and the same construction must be applied in determining whether it is valid and whether it is infringed. Modern cases have accordingly come to attach much more importance than was formerly the case to the language of the claim. The inventor may claim broadly or narrowly as he chooses, and he cannot complain of the result. It is his language and he will be held to the actual monopoly he has himself asserted by his claims, both for the purposes of validity and for purposes of infringement. Of the many statements to be found in the cases as to the importance of claims, I select that by Maugham J.<sup>9</sup>:—"I do not propose in any way to quarrel with the well known metaphor . . . about taking 'the pith and marrow of the invention'; but I must observe that the phrase involves the idea that the pith and marrow is within the claim. If I may put the matter in my own language I would say that it is not sufficient for the inventor to discover his gold mine—he must also peg out his claim. Outside the pegs, the gold, if it be there, is free to all." The same thing has been said somewhat differently in *Fellows v. Lench*<sup>10</sup>:—"a claiming clause operates as a disclaimer of what is not specifically claimed, and for such disclaimer there may be reasons known to the inventor but not to the Court." Many other cases of recent years have proceeded upon the same view that it is only the invention claimed which is protected, and when a

9. *Marconi's Wireless Telegraph Co. v. Phillips Lamps Ltd.*, (1933) 50 R.P.C. 287, at p. 303.

10. (1917) 34 R.P.C. 45, at p. 55, *per* Lord Parker.

claim introduces specific features it makes them "cardinal" and leaves no room for the doctrine of mechanical equivalents—see *Walker v. Alemite Corporation (supra)* per Dixon J. at p. 657.

The position thus reached may appear logical and reasonable, but inventors have frequently found that the lawyer, as often is the case, is far more concerned with the literal language used than with the merit of the invention and the fact that the defendant has taken its meritorious features but omitted its details. Thus in *Shave v. H. V. McKay Massey-Harris Pty. Ltd.*,<sup>11</sup> the plaintiff was the inventor of a novel and highly useful plough of the disc type, capable of riding over stumps and obstructions, and of being reversed so as to cut on either side. It was a new departure from ploughs previously in use and of great practical utility. Unfortunately, he was so alive to the importance of his claims that he penned them himself. Defendant made a plough having all the qualities of the patented plough and constructed on the same principle, but with a number of variations and improvements. It was held that there was no infringement.

On the other hand, in *Radiation Ltd. v. Galliers & Klaerr Pty. Ltd.*<sup>12</sup> it was held that defendant's stove was an infringement of the plaintiff's patent, notwithstanding some degree of departure from the claims by the defendant. Dixon J. said,<sup>13</sup> ". . . on a question of infringement, the issue is not whether the words of the claim can be applied with verbal accuracy or felicity to the article or device alleged to infringe. It is whether the substantial idea disclosed by the specification and made the subject of a definite claim has been taken and embodied in the infringing thing." But the problem still remains; when has the "substantial idea" been "made the subject of a definite claim," and it is round this problem that controversy rages. How far are the specific features referred to in the claim essential to the monopoly defined? It is in the solution of this problem that legal ingenuity tends to force into the background the reality of the case as seen by the inventor. He says, in effect, "defendant has stolen my idea; it was new and patentable. Why can't I stop him?" Patents are of poor value and patent litigation a waste of time if patent actions centre round words instead of ideas and matters of substance.

Peter Meinhardt, in *Inventions Patents and Monopoly*,<sup>14</sup> complains of the modern tendency of tying down a patentee strictly to each individual word used in the claims. He urges a return to the "old liberal method" of interpretation and that effect be given to "the rule that a patent should be construed in the most beneficial sense for the advantage of the patentee." These words are part of the form of grant set out in the Schedule to the *Patents Act*. But what does this mean? Lord Atkin applied it to justify a construction for which the patentee contended, and which was wider than the construction adopted by the majority of the House of Lords.<sup>15</sup> Lord Russell dissented. His Lordship thought that whatever effect they might have upon interpreting the grant which contained these words, they could not affect the construction of the

11. (1935) 52 C.L.R. 701.

12. (1938) 60 C.L.R. 36.

13. at p. 51.

14. at pp. 302-3.

15. In *Electric and Musical Industries Ltd. v. Lissen Ltd.*, [1938] All E.R. 221 (H.L.).

specification. In some cases it might be to the patentee's advantage to adopt a wide construction, for the purpose of infringement; in other cases it might be to his advantage to adopt a narrow construction, for purposes of validity. Would the so-called rule operate to produce a different result in each case?

The injustice to patentees from the present attitude of the Courts is easily illustrated from the decided cases, such as *Shave's Case* (*supra*) and from general experience. It is impossible for the draftsman to foresee all the ingenious evasions which an imitator may conceive. He is usually a patent attorney with a sound knowledge of the principles of the invention but, unless old enough to have learnt by bitter experience, no match for the lawyer in verbal disputation and ingenuity. Further, specifications lodged here are frequently drafted by overseas patent agents or lawyers and lodged here under legislation giving effect to an international convention whereby an application made here is to be given the same priority date as an application made in a foreign country. But the invention applied for here must be for the same invention as that applied for abroad; otherwise the Australian patent is void for "convention disconformity."<sup>16</sup> The claims are primarily drawn to define the invention in the foreign country where principles of interpretation may vary widely from our own. Either the patentee must frame his claims so as to satisfy our law as to interpretation (in which case he risks invalidity because of disconformity with the foreign application) or he must leave his claims identical with those used abroad (in which case he must submit to the ruling of our courts as to their scope and effect in his own country).

One practical attempt to solve the patentee's dilemma has been evolved. It has become common for patentees to provide a number of claims. The first is widely drawn, and omits all detail. Each successive claim then incorporates all preceding claims by reference and adds one or more details. The claims thus proceed by stages from the widest definition of the invention to the narrowest, the patentee hoping that somewhere along the line he may find a claim sufficiently narrow to be valid and sufficiently wide to catch an infringer. This method of claiming also possesses the advantage, of doubtful propriety, that the patentee can threaten competitors with action under his widest claims and so secure a practical monopoly to which he is not entitled. It looks like an abuse of the right to have as many claims as are desired, and is more popular with patentees than with courts. Judges, however, cannot complain of an expedient designed to overcome the judicial tendency towards literal interpretation.

Another device commonly availed of is to insert in the specification immediately before the claims a statement in the following, or some similar terms:—"It will be understood that the invention is not limited to the actual construction hereinbefore described as the invention may be carried out by the use of other forms without departing from the spirit of the invention." But such statements are only a source of uncertainty and add nothing to the true construction of the claims. Since the condemnation of this practice by the Court of Appeal<sup>17</sup> this device should gradually disappear. The courts, having created the difficulty

16. See *Electric and Musical Industries Ltd. v. Lissen Ltd.* (*supra*).

17. *R. W. Crabtree & Sons Ltd. v. R. Hoe & Co. Ltd.*, [1936] 2 All E.R. 1639.

by adherence to literal interpretation, continue to discourage all attempts to meet the difficulty so created.

Something should be said about what are frequently called "omnibus claims." It is now the almost invariable practice to conclude with a claim in some such terms as "apparatus substantially as herein described and as illustrated in the accompanying drawings." Such a claim may be void for ambiguity or uncertainty where the specification has described and illustrated a number of alternative constructions.<sup>18</sup> The words "substantially as described and illustrated" have a limiting effect and confine the patentee fairly closely to his description and drawings. But they must be read in conjunction with the whole specification. In a recent case in the House of Lords such a claim proved valuable as all other claims were held invalid, and it was held that the omnibus claim was valid and was infringed.<sup>19</sup> The value of such claims must vary in each case. Meinhardt<sup>20</sup> refers to a proposal put forward by an English patent lawyer, Shelley, whereby a patentee should be allowed to amend or redraft his claims at any time and in any way provided that the new claims could have been included in the original specification. Meinhardt supports the proposal, but adds that it "was heartily acclaimed by some patent agents and barristers and severely condemned by others." The present power to amend is very restricted. The amendment must not be one whereby the claims are substantially larger than or substantially different from the claims before amendment. There is reason for this limitation. Other persons might be led to incur expense and to undertake manufacture according to some method falling outside the claims. It would be unjust to them if a patentee could subsequently amend his claims so as to involve them in liability and loss. Meinhardt agrees that "important safeguards" to protect the public and competitors are necessary. It would be worth while endeavouring to arrive at a compromise along these lines.

The solution to these problems must depend on the general attitude towards the patentee. Is he a monopolist whose monopoly must be closely confined in the public interest, or is he a public benefactor to be rewarded by liberal protection? There can be no doubt that the patent laws have been abused by powerful foreign corporations which have obtained numerous patents of doubtful validity which they are prepared to enforce against competitors of slender resources by means of protracted litigation. There can also be no doubt that the small inventor is often a benefactor and often loses his just reward. But some general rule must be found applicable to all types of inventions and to all kinds of inventors. Perfect justice cannot be achieved by any legislation which aims at a compromise between public welfare and private rights. But those who draft claims should study carefully the nature of the invention and its relation to prior knowledge and should endeavour to set out fairly, succinctly and clearly, in as few claims as possible, the real substance of the invention. Claims so drawn are more likely to obtain a fair and just interpretation than those which begin by wide and covinous claims and gradually narrow down to particular constructions or formulae.

18. See *Kauzal v. Lee*, (1936) 58 C.L.R. 670, at p. 688.

19. *Raleigh Cycle Co. v. H. Miller & Co.*, [1948] 1 All E.R. 308.

20. at p. 296.