IN THE HOUSE OF LORDS.

Present:—THE LORD CHANCELLOR, LORD WATSON, LORD HERSCHELL, and LORD MORRIS.

March 7th and 11th, 1890.

MORGAN AND CO. *v.* WINDOVER AND CO.

Infringement of patent.—Application of known article in analogous manner.—Subject-matter.—Anticipation.—Experimental user.

The assignees of a patent for supporting the front of a four-wheel carriage by C *springs brought an action for infringement thereof against* W. & Co. *The main defences relied on were* (*a*) *want of novelty in the patented invention, inasmuch as it consisted in the applying of a known article to an analogous purpose;* (*b*) *prior user of the invention by* Faithfull.

Held (*a*) *that the invention was novel and good subject-matter;* (*b*) *that the user by* Faithfull *was experimental;* (*c*) *that the Paintiffs were entitled to succeed.—The Defendants appealed.*

Held on appeal (1) *(by the entire Court) that the invention was subject-matter for a patent;* (2) *(by Lords Justices* Cotton *and* Bowen*) that the user by* Faithfull *was experimental;* (3) *(by the Lord Chief Justice) that anticipation by* Faithfull *was proved.—The appeal was dismissed with costs.*

Held on appeal to the House of Lords that the invention was not subject-matter for a patent, being only the application of a known article to an analogous purpose without any ingenuity, and that the judgment appealed for must be reversed with costs of the appeal and below on the higher scale.

If a known article is applied to an analogous purpose, the application is not patentable simply because it produces advantages not produced before.

In 1876 a patent (No. 4216 of 1876) was granted to *George Henry Morgan*, of Long Acre, in the County of Middlesex, for "Improvements in Carriages."

The Complete Specification was as follows: "The invention has for its object "improvements in carriages and relates to that description of carriage in which "the body is supported by C springs at both the front and back thereof. "Heretofore in such description of carriage the lower parts of the front "C springs have been fixed to the top 'beds' of the 'under carriage' and "elliptic springs have been fixed to the axle to support the 'under carriage' "whilst a 'perch' was necessary to hold the front under carriage and the hind "under carriage together. This arrangement of parts was expensive, cumbrous, "and inconvenient. Now, according to my invention, I am enabled to dispense "with the 'perch' and with the front elliptic springs, whilst I obtain a 'full "lock' to the under carriage and produce a cheaper, more elegant, more "compact, and otherwise convenient form of carriage. For this purpose I fix "the lower parts of the front C springs to the axle and I give support to the "tails of such springs by connecting them to a cross spring fixed at its centre to "a stay or stays fixed to the 'framing pieces' of the 'bottom bed' or I connect "the tails of such C springs to 'half springs' fixed to the 'bottom bed.' The "bows of the C springs are connected by links or loops to bearings fixed to "the 'bottom bed' of the 'under carriage,' and the body of the carriage is "bolted to the 'top beds' of the under carriage as has been the usual practice "when common elliptic springs have been used to carry the body. And in "order that my said invention may be more clearly understood and readily "carried into effect I will proceed, aided by the accompanying drawings, more "fully to describe the same.

"DESCRIPTION OF THE DRAWINGS.

"Figure 1 is an elevation and Figure 2 is a plan of parts of a carriage with "my invention applied thereto and showing the tails of the front C springs "supported by a cross spring, and Figures 3 and 4 are respectively an elevation "and plan of parts of a carriage having my invention applied thereto but

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"showing the tails of the C springs at both the front and back supported by "'half springs.' Like parts are marked with similar letters of reference in all "the figures. *a* is the body of the carriage. *b* are the front C springs and *c* "are the back C springs. According to my invention I dispense with the "'perch' heretofore employed in carriages having the body supported by "C springs at both the front and back thereof, and I fix the lower parts of the "C front springs *b* to the axle *d*, and according to the arrangement shown at "Figures 1 and 2 I support the tails b^1 of such springs *b* by connecting "them to a cross spring *e* which is fixed at its centre to a stay or stays f^1 fixed "to the framing pieces f^2 of the bottom bed *f*, or according to the modification "shown at Figures 3 and 4 I support the tails b^1 of the front C springs *b* by "connecting them to half springs *g* fixed to the 'bottom bed,' and in this last "arrangement I have shown the tails c^1 of the back C springs *c* supported by "half springs *h* fixed to the 'pump handles' *i*. The bows of the front "C springs are, according to my invention, connected by links or loops *j* to "bearings f^3 fixed to the 'bottom bed' *f* of the under carriage, and the body "of the carriage is bolted to the 'top beds' *k* of the under carriage as has been "the usual practice when common elliptic springs have been used to support "the carriage body. The links or loops *j* I also form of leather as has heretofore "been the case, but I prevent the stretching thereof by connecting thereto or "covering the same on one side and the two ends with a plate j^1 as shown more "clearly at Figure 5. According to my invention in 'locking,' the front "C springs pass under the 'boot' of the carriage, and in addition to the advan- "tages before mentioned I obviate the lateral motion of the carriage body, "which is inseparable from the former mode of using C springs for both the "front and back thereof. Having thus described the nature of my said "invention, and the mode in which I carry the same into effect, I would have "it understood that what I claim is:—First. The mode herein described of "supporting the front of a carriage by C springs having their lower parts fixed "to the axle and their bows connected by links or loops to bearings fixed to "the bottom bed of the under carriage substantially as and for the purposes "herein shown and described. And Secondly. I claim giving support to the "tails of the front C springs by connecting them to a cross spring fixed at its "centre to a stay or stays fixed to the framing pieces of the bottom bed in "manner and for the purpose substantially as herein shown and described."

Figures 1 and 3 will be found reproduced between pp. 296 and 297 of 5 R.P.C.

The patentee, on the 16th July 1884, commenced an action against Mr. *Charles S. Windover* for infringement of the patent; on this action coming on for trial it was, pursuant to a notice previously given to the Defendant, dismissed with costs on the Plaintiff's application.

The patent having become vested in *Morgan & Co.* (Limited), they, on the 16th April 1886, commenced another action for infringement against *Charles S. Windover & Co.*, claiming the usual relief. The breaches complained of were the exposure for sale by the Defendant Company between the 12th and 16th of April 1886, of divers carriages made substantially according to the first claim in the Specification of the patent, *i.e.*, according to Figure 3.

The Defendants, by their defence, denied infringement, and put in issue the novelty and utility of the invention, and the sufficiency of the Specification, and they alleged disconformity between the Provisional and Complete Specifications, and the invalidity of the patent. By their particulars of objections they gave, as an instance of prior user, the following:—"The said alleged invention was "used in or about the year 1848 by *Richard Faithfull*, now of Spencer Street, "Leamington, in the County of Warwick, at his works in George Street, "Manchester Square, London, in the construction of a carriage for *William Horne*, coach builder, of Long Acre, London."

The front portion of Defendants' carriage of which the Plaintiffs complained in this action was hung upon compound springs, substantially similar to those shewn in Fig. 3, except that the upper parts consisted of whole elliptic springs (instead of halves with iron stays attached thereto), and that the two ends of the

springs were connected in front by india-rubber shackles (instead of by links or loops of leather).

The front springs of the carriage complained of in the first action were similar to those complained of in the second action, but they were placed with the bow end downwards instead of with the bow end upwards.

At the trial the Judge held that the patent was valid, and gave judgment for the Plaintiffs.*

The Defendants appealed. The appeal was heard by the Lord Chief Justice and Lords Justices *Cotton* and *Bowen*.

Lord Justice *Cotton*, delivering the judgment himself and Lord Justice *Bowen*, held that the appeal failed, that the alleged invention was good subject-matter for a patent, and that the proper conclusion to draw from the evidence was that the carriage made by *Faithfull* for *Horn* was an experiment which failed, and was, therefore, not an anticipation of the patented invention. The Lord Chief Justice agreed with this judgment in other respects, but he thought that the proper inference to draw from the evidence was that the carriage made by *Faithfull* for *Horn* ran its life like other carriages, and such carriage was used by the person for whom it was constructed, and, therefore, anticipated the patent.†

The Defendants appealed to the House of Lords, and on the hearing of the appeal were represented by *Moulton*, Q.C., and *John Cutler* (instructed by *Peacock and Goddard*, as agents for *Jennings, Son, and Burton*, of Burton-on-Trent) appeared for the Appellants, and the Respondents were represented by *Sir R. Webster*, A.G., *Aston*, Q.C., and *Chadwyck Healey* (instructed by *Adam Burn, and Son*).

Moulton, Q.C., and *John Cutler* for the Appellants.—There was no invention in taking springs which had been put at the back of a carriage, and putting them in the front of a carriage. It was immaterial what was the effect of putting them in the front, if, in fact, there was no invention in so putting them. They relied on *Harwood* v. *G.N.R.* (11 House of Lords' Cases, 654). It having been proved that *Faithfull* constructed a carriage for *Horn* like the Plaintiffs' in the ordinary course of business, it was immaterial what became of it, and the Courts below were wrong in holding that it was not an anticipation of the Plaintiffs' patent.

The *Attorney-General* and *Aston*, Q.C., for the Respondents.—The proper inference was drawn that *Faithfull's* carriage was an unsuccessful experiment.—[THE LORD CHANCELLOR.—It was not a case of experimental carriage building here.] [Lord WATSON.—The carriage was made in the ordinary course of business.] There was no proof of actual user, and it would be a serious thing if anticipation were held to be proved by such evidence as that given in this instance. They relied upon *Jones* v. *Pearce* (1 Webster), *Edison* v. *Holland* (6 R.P.C., 243), and what was said by Lord *Lyndhurst* in *Household Company* v. *Neilson* (1 Webster, 713). [Lord HERSCHELL.—Those were *obiter dicta*; the decision was that user need not be continued, and there had been a misdirection to the Jury.] The patentee produced a new article which was cheaper than the old perch carriage and better than the old elliptic carriage, and the adaptation to the front of the spring which had been used on the back was not obvious as there had been attempts in that direction before; therefore the invention was good subject-matter.

No reply was called for.

LORD HALSBURY, *C.*—My Lords, the result of an examination of this case, as so often happens in a case of this sort, is that it is found really not to turn upon any question of law, for there has hardly been any doubt at the bar, and certainly there has been no doubt in any of your Lordships' minds as to what the law to be applied to a case of this sort is. It is conceded on the part of

* Reported Vol. IV., p. 417.

† *See* Report, 5 R.P.C., 295.

those who insist upon this patent that there must be invention. Whether that invention is to be ascertained by considering something originally discovered or by considering a combination producing a new result, still it cannot but be certain that the Statute of Monopolies and the whole branch of the law founded on that statute make it an absolute condition to the validity of a patent that there should be what may properly be called invention; and the application of well-known things to a new analogous use is not properly the subject of a patent.

My Lords, those being the principles on which this case must be decided, the question of fact (and it is in truth, when one comes to analyse it, a question of fact) to be ascertained in the present case is whether the Patentee here has brought himself within the two principles to which I have adverted.

Now, I think the question is best expounded by looking at the claim which the Patentee himself has made in his patent for what his invention is. He states that he claims:—"First, the mode herein described of supporting the "front of a carriage by C-springs having their lower parts fixed to the axle and "their bows connected by links or loops to bearings fixed to the bottom bed "of the under carriage substantially as and for the purposes herein shown and "described. And, secondly, I claim giving support to the tails of the front "C-springs by connecting them to a cross spring fixed at its centre to a stay "or stays fixed to the framing pieces of the bottom bed in manner and for the "purpose substantially as herein shown and described." When one comes to ascertain what is the subject-matter to which those words are to be applied it comes to this, and it was candidly admitted by the Attorney-General that it did come to this, that the very thing described was accurately represented in the mechanical contrivance already applied to the back of a carriage, and that the invention, although drowned in a great many words, consisted in turning those springs which had been at the back of the carriage and inverting those springs which had been at the back of the carriage and putting them at the front of the carriage, in such a manner, however, as not to interfere with the fore wheels and their motion in turning the carriage.

Now, the statement of that as being the invention seems to me to dispose of this case. Is it impossible to say that that is not applying old and well-known contrivances to an analogous use when the wheels of the same carriage and the springs of the very same carriage are put to the front instead of to the back? My Lords, I confess I am to some extent amazed at the period of time for which we have been able to discuss that question when the proposition so stated appears to me to speak for itself.

I am, therefore, of opinion, speaking of it as a question of fact as I believe it to be, that there is no invention in this supposed patent that the man has simply seen the hinder part of the carriage with those springs, which are not C-springs properly so called, but are C-springs with a well-known modification, themselves never patented at all, and has applied them to the front of the carriage. When so applied it may very well be, for aught I know to the contrary (indeed, I will assume in favour of the patentee that it is so), that they have the useful effect which is attributed to them in giving greater ease and comfort in the motion of the carriage; but if it is simply the application of well-known and well-understood things to an analogous use, although it may be true that it is accompanied by advantages not thought of or practised before, that will not save him from the fatal objection that there is no invention; because it is then simply the application of well-known things to an analogous use, of which a great many instances might be given. If this patent and the ground upon which this patent is supported could stand, it would be very difficulty indeed to say what would not be an invention, provided there was any additional advantages gained by the application of any known thing to an analogous use. It is well known and acted upon and must now be considered to be the law, that that does not constitute invention within the meaning of the Patent Laws. Therefore, I am of opinion that on that ground this judgment cannot be supported.

My Lords, with reference to anticipation, I can only say this:—Assuming everything in favour of the objection that mere experiment will not suffice to make a patent invalid, treating again this which is purely a question of fact as a question of fact, I am unable to concur in the inferences which the Court below thought themselves justified in drawing from the evidence which was before them. Whether or not any presumption beyond the mere facts which are in proof can properly be drawn, and whether the state of the evidence does not leave things in this condition, that the person who has to prove anticipation has failed in fully satisfying the burden which the law places upon him in that respect, I will not at present say. In fact it is not proper for us to decide that question if we decide the preliminary question that this alleged invention is not patentable for the reasons which I have given. I will, therefore, do no more than say upon that part of the subject that I am unable to concur in the reasoning which enables you to draw an inference from the fact that it was forty years ago, and that the man was speaking after a recollection which might or might not have been refreshed, that the thing was an experiment. The evidence is what it is, and I am unable to draw such inferences as would dispose and get rid of that evidence if the evidence is in itself sufficient to prove anticipation. Whether it is or is not sufficient to prove anticipation I say it is unnecessary to determine, and I desire therefore to give no opinion whatever upon that subject.

Under these circumstances, my Lords, I move that the judgment of the Court below be reversed, and that the Respondents do pay to the Appellants the costs both here and below.

LORD WATSON.—My Lords, whether the Letters Patent and Specification upon which the Respondents found disclose a patentable invention, is the main, and if answered in the negative the only question in this appeal. The facts which give rise to it are simple, and are not in dispute.

At the date of the patent there were in common use three different arrangements of springs for supporting the body of a four-wheeled carriage. In one of these the body was suspended from the upper extremities of four C-shaped springs, the lower ends of the two front springs being secured to a platform or framework termed a perch, having a rigid connection with the fore-axle. In another, the body rested directly upon four elliptical springs, two being in rigid connection with each axle. In the third arrangement the front of the body rested upon two elliptical springs, precisely similar in shape and adjustment to those used in the preceding class; whilst the back part rested upon two composite springs, which were for about half their length elliptical, and for the other half C-shaped. These composite springs rested upon, and were fastened to the axle, in the same manner as elliptical springs, their elliptical ends being placed below the body of the carriage. The sole object of employing springs is to prevent or mitigate jolting and thereby promote the comfort of persons occupying the interior of the vehicle. The advantage which C-shaped springs, properly so-called, possess over elliptical is that when the carriage is shaken, from any cause, they allow the body to sway horizontally as well as vertically, whereas elliptical springs only permit of vertical play. The witnesses appear to be agreed that composite springs such as I have described do permit some degree of horizontal play in all directions, and are so calculated to produce easier motion than elliptical springs. One feature was common to the second and third of these arrangements. In both a "full-lock"—which implies the capability of turning the fore wheels either to the right or to the left until they are nearly at right angles to the line of the body—can be obtained without using a perch, which is indispensible in the case of genuine C-spring carriages, and adds greatly to the weight of the machine.

In 1876, some years after these composite springs came into use for supporting the back part of a carriage, Mr. *Morgan* took out a patent for the "improvements in carriages" which the Respondents claim as his invention. The leading claim in the Specification is for "the mode herein described of

"supporting the front of a carriage by C-springs having their lower parts "fixed to the axle and their bows connected by links or loops to bearings "fixed to the bottom bed of the under carriage substantially as and for the "purposes herein shown and described." On referring to the letterpress and drawings, it becomes apparent that the invention substantially consists in the substitution of composite for elliptical springs in the fore part of the carriage, so as to make the whole body rest upon four composite springs, instead of resting upon four elliptical, or upon two elliptical and two composite springs. For that purpose the Patentee employs the same composite springs which were previously in use, and attaches them to the fore axle in the same manner in which they were previously attached to the hind axle—with this immaterial difference, that the C-end of the spring is turned forward, so that its elliptical end may be placed below the body of the carriage, as in the case of the hindmost springs. Mr. *Imray*, one of the Respondents' leading witnesses, candidly admitted—what is sufficiently apparent without any admission—that a workman of ordinary skill, if told to substitute a composite for an elliptical spring upon the fore axle, could carry out the order without farther instructions.

I am quite ready to assume that the improvement effected by the substitution of composite for elliptical springs in the front of a carriage was "useful" in the sense in which that word is used in patent law, and that it has proved to be a commercial success.

Lord Justice *Cotton*, with whom Lord *Coleridge* and Lord Justice *Bowen* agreed upon this point, seems to have been of opinion that, apart from any question of prior use, the utility of Mr. *Morgan's* new arrangement was in itself sufficient to impart to it the character of a patentable invention. The learned judges do not appear to me to have sufficiently considered the principle enunciated by Lord *Westbury*, and accepted by this House, in *Harwood* v. *Great Northern Railway Company*, to the effect that there cannot be a patent "for a well-known "mechanical contrivance merely when it is applied in a manner and to a "purpose which is not quite the same but is analogous to the manner or the "purpose in or to which it has hitherto been notoriously applied." Your Lordships had recent occasion to consider that principle in *Thomson* v. *American Braided Wire Company* (6 R.P.C, p. 518). In that case, although your Lordships were not agreed in result, there was no difference of opinion as to the soundness of the rule which formed the ground of judgment in *Harwood's* case. The majority, of whom I happened to be one, rested their judgment upon the fact, which they held to be established, that the particular forms of "dress "improvers" specified and claimed were not *mere* applications of wire braid to an analogous purpose, but that the Patentee, in his peculiar modes of adapting the old material to its new, though analogous use, had exercised and exhibited a degree of inventive ingenuity just sufficient to protect him from the incidence of the rule. It was for that reason only that the patent was sustained.

To return to the subject-matter of the patent in this case; the springs described in the Specification differ in no respect from carriage springs then in common use. The purpose to which they are applied is not only analogous to, but might fairly be described as identical with, the purpose which they previously served, viz.: that of giving support to the body of a carriage. These circumstances are, in my opinion, fatal to the validity of the patent, unless it has been shown that inventive faculty has been displayed in the adaptation of composite springs to their new position in the front of the vehicle. But nothing of that sort has been shown. No mechanical contrivance or adjustment is specified or required in order to make the substituted springs fit into their new position, or to render them efficient when they are placed there. On these grounds I am of opinion that the Specification does not disclose a patentable invention. One important question has been discussed at the bar, concerning an alleged anticipation by prior user. Upon that point it has become unnecessary to express any opinion beyond saying this, that I should not have been inclined to dissent from the inference of fact which was drawn by the majority of the Court below.

I accordingly concur in the judgment which has been moved by the *Lord Chancellor*.

Lord HERSCHELL.—My Lords, I am of the same opinion. I should be extremely unwilling to limit, by too narrow a construction, the rights which have been conferred upon those who benefit the public by disclosing to them a new invention; but at the same time it would be wrong to depart from settled principles of law, and to hold that that was a new invention which came within a category which has been judicially determined by the highest tribunal to be excluded from a proper application of those terms.

The law has not been disputed that the mere adaptation to a new purpose of a known material or appliance, if that purpose be analogous to a purpose to which it has already been applied, and if the mode of application be also analogous so that no inventive faculty is required and no invention is displayed in the manner in which it is applied, is not the subject-matter of a patent. That I take to be well settled. It was recognised by all your Lordships who took part in the judgment of this House in *Thomson* v. *The American Braided Wire Company* and has not been, as indeed it could not be, contested by the learned counsel who have ably argued this case on behalf of the Respondents. The only difficulty arises in the application of that general rule to the facts of the particular case, which is so often the difficulty that has to be encountered in determining by what principles one ought to be guided in determining the rights of the parties.

My Lords, I cannot help thinking that a good deal of the confusion which has, I think, existed in this case, has arisen from the form of the Specification of the patent taken out by Mr. *Morgan*. The Specification appears to be a Specification for an improvement in C-spring carriages, the improvement being the retention of the C-spring together with the absence of the perch which used to accompany it and to be considered a necessary incident in the case of a C-spring carriage. I think anybody reading the patent would imagine that Mr. *Morgan* had found out a means by which he could keep the old C-spring and give you all the advantages of it without the disadvantages of the perch. But when one comes to examine the nature of Mr. *Morgan's* invention one finds that it really was this, not the devising a C-spring carriage in which you could have the C-springs and dispense with the perch, but an improvement upon a carriage already in use in which the springs were either elliptical or partly elliptical and partly C. It may well be that this composite spring has come to be spoken of recently in the trade as a "C" spring; it is not a C-spring, and the carriage devised by Mr. *Morgan* is not a C-spring carriage without the perch, but it is a carriage precisely similar to the elliptical spring carriage, but with the advantage, which I think is proved to be an advantage, of these composite springs in place of the elliptical springs. That was really the nature of the invention; and it was only an invention to this extent, in so far as it extended to the front part of the carriage that substitution of composite springs for elliptical springs which had already been applied to the hind part of the carriage. The invention amounted to that, and absolutely to nothing more than that, so that the idea even of substituting a composite spring for an elliptical spring was not new. That idea had been anticipated and applied to the hind part of the carriage, and the only invention claimed is to carry that idea so much further as to extend the substitution to the front part of the carriage as well as to the hind part of the carriage. The question is, is that a new invention?

Now, my Lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had heretofore been used in the hind part of a carriage to the front part of a carriage, so that it was not the mere substitution in front in substantially the same way as the substitution had taken place at the back, but that it needed some skill and ingenuity to adapt to the front part of the carriage that which had been applied to the back, I should have thought that there was sufficient subject-matter and that the patent could have stood. But when once it is admitted that all that can be claimed as new is the idea of putting it in the front instead of at the back, and that when once that idea was

entertained, any workman told to do it would, without any instructions or any special mechanical skill, be able at once to do it, it seems to me that that really concludes the case against the Respondents, because if their contention be well founded it would certainly be somewhat extensive in its consequences.

It is said that it needed invention to make this substitution, and that this is obvious, because whereas for some period of time the substitution at the back of the carriage had been known, nobody thought of making the substitution at the front of the carriage, though, when made, people have found out its advantages; and a suggestion was made that this really was the attaining an end at which many people had been striving—namely, improving a C-spring carriage so as to do away with the perch. Here, again, I think the same confusion of idea comes in; it was not really the achieving that at which men had been aiming who were seeking to improve the C-spring; it was an act of a different nature altogether. It did not achieve the end at which they were aiming; it was not an adaptation of the C-spring in the sense in which that word is used in relation to many of these efforts at all events; it was the applying to a carriage something which possessed some of the advantages which the C-spring had possessed.

Now, my Lords, if it were held that that was enough to constitute a new invention, just consider what consequences would follow. It is common knowledge that when a new mechanical contrivance, such as a new spring (and many other illustrations might be given) is first invented it is often a very considerable time before its advantages are seen and realised. Men are slow to try experiments, however successful they may turn out to be when once tried. But if the argument of the Respondents were well founded, then if there was an invention of a new spring, let us say, for railway engines or carriages, and for some years no one had taken advantage of it in a particular part of an engine or carriage in which a spring was used until some one thought he would use it in that place, the first person who used it in that place could take out a patent for so using it and protect himself against all the rest of the world, and acquire a monopoly if it turned out that there were advantages in its use in that particular place which had not occurred to anyone before. It seems to me, my Lords, that that would be extending the rights which are conferred upon patentees of new inventions beyond anything which preceding cases will justify.

My Lords, for these reasons I have come to the same conclusion of fact as my noble and learned friends, that this patent cannot be supported.

I do not think we are differing from the law in its terms as laid down by Mr. Justice *Kekewich*. I am well satisfied with his statement of the law; but where I cannot help differing from him is on the question of fact whether there is here a distinct method of application requiring the exercise of the inventive faculties. It appears to me that there is not, and when Lord Justice *Cotton* speaks of Mr. *Morgan's* invention as being the selecting the proper spring for his purpose, and adapting it in the proper way to the carriage, if that adaptation had required any skill or ingenuity or inventive faculty, then I should have agreed with him in the result; but it is because I fail to see that that I am unable to arrive at the same conclusion as he has done.

My Lords, with regard to the alleged anticipation I will only say this. It is not necessary to express any opinion upon it in the view which your Lordships have taken; but I must not be understood as expressing a view differing in its result at all from that which has been expressed by the majority of the learned Judges in the Court below.

Lord MORRIS.—My Lords, I also concur in the judgment which has been moved by the *Lord Chancellor*, and in the judgments which have been pronounced by my noble and learned friends who have preceded me.

It appears to me that this is not a patentable invention which can be protected, as it was protected, by the Order of the learned Judge of the Court below, Mr. Justice *Kekewich*. It has been admitted that in order to make it a patent-

able invention, which could be protected, it was necessary that there should be invention. It does not appear to me that there is any invention here which can be recognised by having a patent. On the facts of the case it appears to me to be plain that there was nothing done by Mr. *Morgan* in this case, except the application to the fore part of a carriage of a spring which was in existence and in use at the hind part of the carriage. That of itself can scarcely be contended to be a matter of invention, because it was only the application to an analogous purpose, namely, to the fore part of the carriage, of what had been in use in the hind part; and it appears to me it would be difficult to conceive a case, in which the application was more analogous than that of applying the use of a spring which existed in one portion of a carriage to the front of the carriage.

Then was there any invention, in what has been called the adaptation of it to the fore part of the carriage? That appears to me to be a question of fact, and a question of evidence free from any consideration of a question of law. If there was invention in it, it should be protected; if there was not invention it should not. What is the invention? It has been proved by one of the witnesses that any workman called in to do it could perform the duty. It has not been suggested on the part of the Respondents here, what the inventive portion of the adaptability of the spring from the hinder part to the front consisted of, except that it must be done properly, which cannot of course be the subject of an invention if it was nothing more than a proper performance of the work.

On these grounds, my Lords, I fully concur in the judgment on the main point.

On the second question which has been raised as regards anticipation, I can only say that it becomes unnecessary to decide it; but I think it right to say that, as at present advised, if Mr. *Morgan* were able to sustain his patent otherwise, I should require to hear better reasons than I have heard as yet urged for not protecting him, and for holding that there was such an anticipation by user as would deprive him of his patented invention, if he had a patentable invention.

IN THE HIGH COURT OF JUSTICE—CHANCERY DIVISION.

Before MR. JUSTICE KAY.—February 7th and 14th, 1890.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES COTTON, LINDLEY, AND LOPES.

March 5th, 12th, and 20th, 1890.

GARRARD *v.* EDGE.

Patent.—Action for infringement.—Infringement not found.—No certificate for Particulars of Objections.—Application by unsuccessful Plaintiff for costs occasioned to him by objections, as being improper, vexatious, or unnecessary proceedings refused.—R.S.C. 1883, *O.* 65, *r.* 27 (20).—*Patents &c. Act*, 1883, *S.* 29.—*Security for costs of Appeal.—Preliminary application to Appellant for security.*

A Patentee brought an action for infringement. The Defendant denied infringement, and alleged that the patent was invalid on grounds set out in his objections. The Judge, at the trial, and the Court of Appeal held, without going into the rest of the case, that no infringement had been proved, and the action was dismissed with costs. No certificate was given that the objections were reasonable and proper. On taxation, the Taxing Master disallowed the costs of the objections on the ground that there was no certificate. The Plaintiff then carried in a bill of costs which he alleged had been caused to him by the objections.