

THE REPLACEMENT OF THE DOCTRINE OF PITH AND MARROW BY
THE CATNIC TEST IN ENGLISH PATENT LAW: A HISTORICAL
EVALUATION

by

RAYMOND MNYAMEZELI MLUNGISI ZONDO

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SUMMARY OF DISSERTATION

This dissertation is a historical evaluation of the movement of the English courts from the doctrine of pith and marrow to the Catnic test in the determination of non-textual infringement of patents. It considers how and why the doctrine was replaced with the Catnic test. It concludes that this movement occurred as a result of the adoption by a group of judges of literalism in the construction of patents while another group dissented and maintained the correct application of the doctrine. Although the Court of Appeal and the House of Lords initially approved the literalist approach, they, after realising its untenability, adopted the dissenters' approach, but, ultimately, adopted the Catnic test in which features of the dissenters' approach were included. The dissertation concludes that the doctrine of pith and marrow, correctly applied, should have been retained as the Catnic test creates uncertainty and confusion.

KEY TERMS

Doctrine of pith and marrow; *Catnic*; Catnic test; patent; infringement of patents; Upjohn LJ; Lord Upjohn; Lord Reid; Upjohn LJ approach; Lord Reid approach; Lord Pearce; no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention; the rule on immaterial variations; *Clark v Adie*; *C Van Der Lely v Bamfords Limited*; *Marconi v British Radios Telegraphs and Telephone Co Ltd*; *EMS v Boonton Research Corp Ltd*; *Birmingham Sound Reproducers Ltd v Collaro Ltd*; Lloyd-Jacob, J; *Rodi's case*; *Beecham*; Lord Diplock; non-textual infringement of patents; English patent law.

DECLARATION

I declare that “THE REPLACEMENT OF THE DOCTRINE OF PITH AND MARROW BY THE *CATMIC* TEST IN ENGLISH PATENT LAW: A HISTORICAL EVALUATION” is my own work and that all the sources that I have used or quoted have been indicated and acknowledged by means of complete references.

RMM Zondo

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TABLE OF CONTENTS

	PAGE
CHAPTER 1	
1 INTRODUCTION	1
1.1 The First Period: 1875 – 1960	5
1.2 The Second Period: 1960 – 1978	5
1.3 Third Period: 1978 – 1980 and After	9
1.4 Explanation of the Doctrine of Pith and Marrow	11
1.5 Explanation of the <i>Catnic</i> Test	13
CHAPTER 2	
2 THE PERIOD OF THE CORRECT APPROACH TO THE DETERMINATION OF LIABILITY FOR NON-TEXTUAL INFRINGEMENT OF PATENTS AND THE DOCTRINE OF PITH AND MARROW 1875-1960	15
2.1 <i>Clark v Adie</i>	15
2.2 <i>Clark v Adie</i> in the House of Lords	17
2.3 <i>The Incandescent Gas Light Company Ld v the De Mare Incandescent Gas Light System Ld and Others</i>	18
2.4 <i>Marconi v British Radios Telegraph and Telephone Company Ltd</i>	22
2.5 <i>Electric and Musical Industries Ltd and Boonton Research Corporation v Lissen Ltd</i>	26
2.6 <i>Birmingham Sound Reproducers Ld v Collaro Ld and Collaro Ld v Birmingham Sound Reproducers Ld</i>	32
CHAPTER 3	
3 THE ERA OF THE UPJOHN LJ APPROACH	39
3.1 <i>Van der Lely</i> in the Court of First Instance: 1960 – 1978	39
3.2 <i>C Van der Lely</i> in the Court of Appeal: <i>Van Der Lely v Bamfords Limited</i>	42
3.3 The Majority Judgment of Upjohn LJ and Pearson LJ In <i>Van der Lely</i> in the Court of Appeal	43
3.4 Lord Evershed MR’s Dissent in <i>Van der Lely</i> in the Court of Appeal	46
3.5 <i>Van der Lely v Bamfords</i> in the House of Lords	48
3.6 Lord Reid’s Dissent in <i>Van der Lely</i> in the House of Lords	50

3.7	Lord Jenkins' Judgment	61
3.8	Viscount Radcliffe's Judgment	64
3.9	Lord Hodson's Judgment	68
3.10	Act of Rebellion: Lloyd-Jacob J Joins the Dissenters: <i>Rodi</i> in the Court of First Instance	72
3.11	Lloyd-Jacob J in the Court of First Instance in <i>Rodi</i>	74
3.12	Comparison of Lloyd-Jacob J's Judgment in <i>Rodi</i> with Lord Evershed MR'S Dissenting Judgment in the Court of Appeal in <i>Van der Lely</i>	78
3.13	Comparison of Lloyd-Jacob J's Judgment in <i>Rodi</i> with Lord Reid's Dissenting Judgment in the House of Lords in <i>Van der Lely</i>	79
3.14	The Court of Appeal Sticks to its Guns: <i>Rodi</i> in the Court of Appeal	81
3.15	Harman LJ's Judgment	81
3.16	Diplock LJ's Judgment	87
3.17	Winn LJ's Judgment	91
3.18	Special Observations on the Judgments of the Three Judges in the Court of Appeal in <i>Rodi</i>	93
3.19	More Cracks on the Walls of the House of Lords: The <i>Rodi</i> Matter in the House of Lords	94
3.20	Lord Morris' Judgment	95
3.21	Lord Hodson's Judgment	100
3.22	Lord Pearce's Speech in the House of Lords in <i>Rodi</i>	103
3.23	Lord Upjohn's Judgment	109
3.24	Lord Reid's Speech in the <i>Rodi</i> Matter in the House of Lords	111
3.25	Comparison of Lloyd-Jacob J's Judgment in <i>Rodi</i> with those of Lord Reid in <i>Van der Lely</i> and <i>Rodi</i> and that of Lord Pearce in <i>Rodi</i>	117

CHAPTER 4

4	SPECIAL OBSERVATIONS ABOUT THE PERIOD FROM LLOYD-JACOB J'S JUDGMENT IN <i>VAN DER LELY</i> TO THE DECISION OF THE HOUSE OF LORDS IN <i>RODI</i>	120-127
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CHAPTER 5

5	THE PERIOD AFTER <i>RODI</i> 1978-1980 AND THEREAFTER: <i>BEECHAM</i> IN THE COURT OF FIRST INSTANCE	128
5.1	Falconer QC's Judgment	129

5.2	The Court of Appeal Turns its Back on the Upjohn LJ Approach: <i>Beecham</i> in the Court of Appeal	132
5.3	The House of Lords Turns its Back on the Upjohn LJ Approach and Embraces the Dissenters' Approach: <i>Beecham</i> in the House of Lords	134
5.4	<i>Catnic</i> in the Court of First Instance	139
5.5	Whitford J's Judgment: Whitford J Applies the Lord Reid Approach to the Doctrine of Pith and Marrow and not the Upjohn LJ Approach	141
5.6	<i>Catnic</i> in the Court of Appeal	144
5.7	Buckley LJ's Judgment: Buckley LJ Applies the Upjohn LJ Approach	144
5.8	Waller LJ's Judgment	154
5.9	Sir David Cairns' Judgment	156
5.10	General Comments on the Approach to the Determination of Non- Textual Infringement and to the Doctrine of Pith and Marrow Adopted in the Cases Discussed Above	160
CHAPTER 6		
6	1980: THE HOUSE OF LORDS SAVES FACE! <i>CATNIC</i> IN THE HOUSE OF LORDS	165-181
CHAPTER 7		
7	SPECIAL COMMENTARY ON THE <i>CATNIC</i> DECISION	182-195
CHAPTER 8		
8	HOW THE <i>CATNIC</i> TEST CAME TO REPLACE THE DOCTRINE OF PITH AND MALLOW IN ENGLISH PATENT LAW	196-204
CHAPTER 9		
9	SPECIAL FEATURES OF CERTAIN JUDGMENTS OF THE DISSENTERS AND LORD DIPLOCK'S SPEECHES IN <i>BEECHAM</i> AND <i>CATNIC</i>	205
9.1	Special Features of Lord Evershed MR's Dissent in the Court of Appeal in <i>Van der Lely</i>	205
9.2	Special Features of Lord Reid's Speech in <i>Van der Lely</i> in the House of Lords	205
9.3	Special Features of Lord Reid's Speech in <i>Rodi</i> in the House of Lords	208

9.4	Special Features of Lord Pearce's Speech in <i>Rodi</i> in the House of Lords	209
9.5	Special Features of Lord Diplock's Speech in <i>Beecham</i>	210
9.6	Special Features of Lord Diplock's Speech in <i>Catnic</i>	213
CHAPTER 10		
10	COMPARISON OF LORD DIPLOCK'S JUDGMENTS IN <i>BEECHAM</i> AND <i>CATNIC</i> TO LORD REID'S JUDGMENTS IN <i>VAN DER LELY</i> AND IN <i>RODI</i> AND LORD PEARCE'S JUDGMENT IN <i>RODI</i>	219
10.1	The <i>Beecham</i> Case	219
10.2	The <i>Catnic</i> Case	221
10.3	Features Common to the Lord Reid Approach and Lord Diplock's Speeches in <i>Beecham</i> and <i>Catnic</i>	230
CHAPTER 11		
11	FIVE JUDGES WHO PLAYED SPECIAL ROLES IN THE EVOLUTION OF THE ENGLISH PATENT LAW JURISPRUDENCE FROM <i>VAN DER LELY</i> TO <i>CATNIC</i>	232-234
CHAPTER 12		
12	CONCLUSION	235
12.1	Is the <i>Catnic</i> Test for Determining the Essential Features of a Patent?	235
12.2	Did <i>Catnic</i> Bring About Any Change in the Law?	236
12.3	Was the Introduction of the <i>Catnic</i> Test Necessary?	241
12.4	Conclusion	245
13	BIBLIOGRAPHY	247
14	TABLE OF CASES	249

CHAPTER 1

1 INTRODUCTION

[1] The determination of liability for the textual infringement¹ of a patent has never been difficult.² However, when it comes to the determination of liability for non-textual infringement³ of a patent, the situation is different. The difficulties associated with the determination of liability for non-textual infringement of patents arise from the fact that the alleged infringer so often varies, adds or omits from the patentee's invention to try and benefit from such invention as if it were his own without suffering the

¹ Textual infringement of a patent in the terms found in the relevant claim in the specification. It means that the device, product or process that is accused of infringing a patent fits exactly the description of the claim in a specification. For a further explanation of textual infringement as well as of non-textual infringement, see footnote 3 below.

² The reason for this may be that, as Wills J put it way back in 1896 in *The Incandescent Gas Light System Ltd and Others v The De Mare Incandescent Gas Light System Ltd and Others* (1896) 13 RPC 301 (Queens Bench) at 330:

“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...”

In 1950 the Supreme Court of the USA said through Mr Justice Jackson in the landmark case of *Graver Tank and Manufacturing Co Inc et al v Linde Co* 339 US 605 (1950) at page 2:

“Outright and forthright duplication is a dull and very rare type of infringement”.

Mr Justice Jackson continued thus in the same case at p.2:

“One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play may be expected to introduce minor variations to conceal and shelter the piracy.”

³ The best way to explain textual and non-textual infringement of a patent claim is to invoke the words of two Cairns who provided the explanations about 100 years or so apart. First, Lord Cairns LC had the following to say in *Clark v Adie* (1877) 2 App Cas 315 (HL) at 320 about what in effect was an explanation of textual and non-textual infringement:

“One mode of infringement would be a very simple and clear one; the infringer would take the whole infringement from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question arises. The second mode would be one which might occasion difficulty. The infringer might not take the whole of the instrument here described but he might take a certain number of parts of the instrument described; he might make an instrument which in many respects would resemble the patent instrument, but would not resemble it in all its parts.”

The type of infringement to which Lord Cairns LC referred first in the quoted passage is what is called textual infringement, whereas the second type of infringement to which he referred is non-textual infringement. It was by Lord Cairns LC in the *Adie* case that the phrase “pith and marrow” was used for the first time in English law to refer to the infringement of a patent specification by the taking of the substance of a patent or to refer to non-textual infringement. About 100 years later, another Cairns, Sir David Cairns had the following to say in this regard in *Catnic Components Ltd and Another v Hill and Smith Ltd* (1982) RPC 183 (HL) at 234-235.

“1 There are two types of infringement, textual infringement and infringement of the pith and marrow (*Van der Lely*, p 75 lines 35-9, per Lord Reid; p 77 line 45, per Lord Radcliffe; p 79 lines 48-9, per Lord Jenkins; p 80 lines 15-21, per Lord Hodson. *Rodi*, p 380 lines 21-36, per Lord Morris of Borth-y-Gest; p 384 line 6, per Lord Upjohn; p 385 line 1, per Lord Hodson).

2 Textual infringement occurs when the defendant's product contains all the features of the plaintiff's claim, interpreted literally (*Van der Lely*, p 75 line 35 per Lord Reid; p 80 per Lord Hodson. *Rodi*, p 380 lines 21-5 per Lord Morris; p 385 line 1, per Lord Hodson).

3 Infringement of the pith and marrow occurs when the defendant's product contains all the essential features of the plaintiff's claim despite some variation in unessential features (*Van der Lely* p 75 lines 45-50, per Lord Reid; p 79 lines 43-47, per Lord Jenkins; p 80 lines 15-19, per Lord Hodson. *Rodi*, p 380 lines 38 to p 381 line 3, per Lord Morris; p 384 lines 18-21, per Lord Hodson; p 388 lines 8-15, per Lord Pearce; p 391 lines 14-20, per Lord Upjohn).

consequences of infringement. In English patent law two of the cases that are critical in any discussion of how the problem of the determination of non-textual infringement of patents has been dealt with from the late 19th century to about the end of the 20th century are *Clark v Adie*⁴ and *Catnic Components Limited and Another v Hill and Smith Limited*⁵ (“*Catnic*” or “the *Catnic* decision”). The purpose of this dissertation is a critical evaluation of the movement of the English courts from the use of the doctrine of pith and marrow in the determination of non-textual infringement of patents to the adoption of the *Catnic* test. It examines a number of important decisions handed down from about 1875 to 1980 by the English courts which influenced not only the direction of that movement, but also the twists and turns which occurred along the way between 1960 and 1980 when the *Catnic* test was adopted.

- [2] Part of the significance of the two cases is that the former gave the doctrine of infringement by taking the substance of a patented invention the name of the “pith and marrow” doctrine whereas the latter case brought the use of the doctrine of “pith and marrow” in the determination of liability for non-textual infringement of patents in English patent law to an end and introduced the “*Catnic* test” in its stead.⁶ The gap between the two cases is just over 100 years. During that period the doctrine of pith and marrow was used to determine non-textual infringement of patents but, after the *Catnic* decision, the doctrine of pith and marrow ceased to be used and the *Catnic* test was used. Prior to *Catnic* the English law influence regarding the use of the doctrine of pith and marrow to determine liability for the non-textual infringement of patents had spread to many countries. Such countries included South Africa and Canada.⁷ The influence of the *Catnic* decision of the House of Lords also spread to other countries including South Africa, Canada, Korea, Australia and New Zealand whose courts also adopted or, at least, purported to adopt, the *Catnic* test in the determination of the infringement of patents.⁸ The question which arises, following upon the *Catnic*

⁴ (1877) 2 App Cas 315 (HL). In the Court of first instance this case was reported as *Clark v Adie* (1875) LR Ch 667. The judge in this case was James LJ.

⁵ [1982] RPC 183 (HL).

⁶ The phrase “*Catnic* Test” is obviously taken from *Catnic Components Limited*, one of the parties to the *Catnic* case.

⁷ According to Cameron and Renault, in Canada textual infringement and substantive infringement or the taking of the pith and substance was recognised by the Canadian Supreme Court in *Smith Incubator Co v Seiling* (1936) SCR 259 (SCC) (see Donald M Cameron and Ogilury Renault at 7).

⁸ See Binnie J’s judgment in *Free World Trust v Electro Lante* [2000] 2 SCR 1024 par 39. See also *Whirlpool v Camco* [2000] 2 SCR 1067. While the Supreme Court of Canada has said that the Federal Court of Australia

decision of the House of Lords, is how and why English patent law abandoned the doctrine of pith and marrow and replaced it with the *Catnic* test.

- [3] The purpose of this dissertation is to provide a historical evaluation of the replacement of the doctrine of pith and marrow by the *Catnic* test in English patent law. In the process of such evaluation an explanation of how and why English patent law abandoned the doctrine of pith and marrow and adopted in its stead the *Catnic* test will be provided. A proper explanation of how and why this happened can only be given after an analysis of English patent law jurisprudence relating to the determination of non-textual infringement of patents and the doctrine of pith and marrow over a period of about 100 years before *Catnic* and the *Catnic* decision itself. Such an analysis is provided in this dissertation and the conclusion that is reached is that what led to the abandonment of the doctrine of pith and marrow and its replacement by the *Catnic* test in English patent law was a repeated disregard by the Court of Appeal and the House of Lords of an important rule of patent law applicable to the determination of non-textual infringement of patents which caused a judicial crisis about the determination of similar cases in future and the House of Lords' desire to save its face in resolving this judicial quagmire.
- [4] The proposition that the *Catnic* test replaced the doctrine of pith and marrow and that the doctrine of pith and marrow did not apply after the *Catnic* test is not universally accepted as correct.⁹ L Bently and B Sherman refer to the replacement of the literal mode of interpretation by purposive style of interpretation.¹⁰ It is suggested that what these authors refer to as the literal mode of interpretation is that approach to the construction of patents and the doctrine of pith and marrow that is referred to in this dissertation as the Upjohn LJ approach as reflected in the majority decisions of the

approved purposive construction in *Populin v HB Nominees (Populin)* (1982) 4 ALR 471, Pendleton has made contradictory statements on whether or not the Federal Court of Australia approved purposive construction in that case (see Pendleton Michael "The Purposive Approach to Patent Construction" (2000-2001) *Intellectual Property Journal* (2000-2001) 75 at 76, 81 and 88).

⁹ However, Cameron probably shares the view that *Catnic* replaced the doctrine of pith and marrow because he says that in *Catnic* Lord Diplock attempted to put an end to the pith and substance infringement test and replace it with a supposedly more simpler test of claim construction and purposive construction (Cameron at 13). Fox says that the English Courts have accepted that the strict literalism of the past and the limited application of the doctrine of pith and marrow have been superseded by the "purposive" approach to claim construction, where the scope of protection extends beyond its literal meaning to encompass variants of a claimed invention Fox Nicholas "Divided by a Common Language: A Comparison of Patent Claim Interpretation in the English and American Courts" (2004) EIPR 528 (at 530).

¹⁰ Bentley L and Sherman B *Intellectual Property Law* (2011) (2nd ed) at 535.

Court of Appeal and the House of Lords in both *Van der Lely NV v Bamfords Ltd*¹¹ and *Rodi and Wienenberger AG v Henry Showell Ltd*¹² cases. If this is correct, the statement by Bently and Sherman would mean that these authors also take the view that the *Catnic* test or purposive construction replaced the literalist approach which was used before *Catnic*. Annand supports the proposition that *Catnic* did not change the prior law. She says that this is borne out by the subsequent case of *Cordes Corporation v Racal-Mulgo Ltd*.¹³ She quotes a passage in that case but does not include any analysis of the law before and the law after.¹⁴ Some have expressed the view that *Catnic* did not bring about any change in the law and that *Catnic* did not abolish the doctrine of pith and marrow. Prominent among those who seem to take this latter view are the Supreme Court of Canada¹⁵ and the Supreme Court of Appeal of South Africa.¹⁶ In fact the Supreme Court of Canada, through Mr Justice Binnie, went to the extent of saying that in *Catnic* Lord Diplock could be said to have “poured some whiskies into a new bottle, skilfully refined the blend, brought fresh clarity to the result, added a directive label, and voila ‘purposive construction’”.¹⁷ A proper answer to these questions can only be found if one understands the developments which occurred over a long period prior to *Catnic* and led to the introduction of the *Catnic* test.

- [5] The discussion spans the period from 1875, which is the year of the reported judgment of James LJ in *Clark v Adie* to 1980 which is the year of the decision of the House of Lords in *Catnic* which was reported in 1982 and thereafter. The period is divided into three periods marked by important developments. The first period runs

¹¹ It is convenient to give the citations of the *Van der Lely* decisions at all three levels, namely, the Chancery Division, the Court of Appeal and the House of Lords. They are: *Van der Lely NV v Bamfords Ltd* [1960] RPC 169 (Ch); *Van der Lely NV v Bamfords Ltd* [1961] RPC 296 (CA); *Van der Lely (C) NV v Bamfords Ltd* [1963] RPC (HL).

¹² It is convenient to give the citations for all the decisions in the *Rodi* case at all three levels, namely, the Chancery Division, the Court of Appeal and the House of Lords. They are *Rodi and Wienenberger AG v Henry Showell Ltd* [1966] RPC 441 (Ch); *Rodi and Wienenberger AG v Henry Showell Ltd* [1966] RPC 460 (CA); *Rodi and Wienenberger AG v Henry Showell Ltd* [1969] RPC 367 (HL).

¹³ (1983) RPC 369.

¹⁴ Annand Ruth E “Infringement of Patents ” is ‘*Catnic*’ the Correct Approach for Determining the Scope of a Patent Monopoly under the Patents Act 1977” (1992) *Anglo American Law Review* 39 at 46.

¹⁵ See *Camco Inc and General Electric Company v Whirlpool Corporation and Inglis Ltd* 2000 SCC or [200] 2 SCR 1067 par 48.

¹⁶ See *Vari-Deals 101 (Pty) Ltd t/a Vari-Deals v Sunsmart Products (Pty) Ltd* 2008 (3) SA 447 (SCA) at par 11 where Hurt AJA, writing for a unanimous Supreme Court of Appeal of South Africa, *inter alia* said that “... *Catnic* did not change the law relating to construction ...”.

¹⁷ See the *Whirlpool* case at par 48.

from 1875 to 1960. The second period runs from 1960 to 1978. The third runs from 1978 to 1980 and thereafter.

1.1 The First Period: 1875 – 1960

[6] During the first period, ie 1875 to 1960, whenever the English courts considered whether to invoke the doctrine of pith and marrow in the determination of non-textual infringement of patents, they took into account:

- (a) what the purpose or reason for the alleged infringer’s introduction of a difference to the patented invention was;
- (b) the value, if any, which such difference added to the patented invention or the practical significance of the difference introduced by the alleged infringer, and
- (c) the rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention (the “rule on immaterial variations”).

A consideration of these factors plus the language of the relevant claim characterised the use of the doctrine of pith and marrow in the determination of non-textual infringement of patents during this period.

1.2 The Second Period: 1960 – 1978

[7] The year 1960 marked the beginning of a change in English patent law relating to the determination of non-textual infringement. This was reflected in the judgment of Lloyd-Jacob J in the Chancery Division in the case of *Van der Lely NV v Bamfords Ltd*¹⁸ (“*Van der Lely*” or “the *Van der Lely* case”). In his judgment Lloyd-Jacob J placed form above substance and decided the case purely on the basis of the language used by the patentee in formulating his claims. He had no regard to the rule on

¹⁸ *Van der Lely NV v Bamfords Ltd* [1960] RPC 169 (Ch).

immaterial variations nor did he ask the question whether the alleged infringer had a reason for introducing the difference that he had introduced into his device or whether he had simply done so for no plausible reason. He found that there was no infringement. Lloyd-Jacob J's judgment and approach were subsequently approved by both the Court of Appeal and the House of Lords, albeit with dissents in both the Court of Appeal and the House of Lords.

[8] In the Court of Appeal there were two judgments. The one, which was the judgment of the Court, was the judgment of Upjohn LJ and Pearson LJ. The other one, which was a dissent, was the judgment of Lord Evershed MR. Lord Evershed MR rejected the Upjohn LJ approach. The approach to the determination of non-textual infringement and to the doctrine of pith and marrow which was adopted, first by Lloyd-Jacob J and later by Upjohn LJ and Pearson LJ, was later approved by the House of Lords in the *Van der Lely* case. Although between Lloyd-Jacob J and Upjohn LJ, Lloyd-Jacob J was the first to adopt this approach to the determination of non-textual infringement and the doctrine of pith and marrow and Upjohn LJ used it after Lloyd-Jacob J, it will, for convenience, be referred to in this dissertation as the "Upjohn LJ approach" because Upjohn LJ ultimately played a much more prominent role in the promotion of the approach than Lloyd-Jacob J. More will be said later about this approach.

[9] In the House of Lords in *Van der Lely*, the various Law Lords wrote separate judgments. Four of them approved the approach adopted by Lloyd-Jacob J in the Chancery Division and by Upjohn LJ and Pearson LJ in the Court of Appeal. In other words they approved, adopted and applied the Upjohn LJ approach to the determination of non-textual infringement of patents and to the doctrine of pith and marrow. Lord Reid rejected the approach adopted by the Court of Appeal and the majority in the House of Lords. He in effect followed the approach adopted by Lord Evershed MR in the Court of Appeal in *Van der Lely*. For convenience the approach that was adopted by Lord Evershed MR in the Court of Appeal and Lord Reid in *Van der Lely* in the House of Lords will hereinafter be referred to as "the Lord Reid approach". Although Lord Evershed MR used the approach earlier than Lord Reid, the approach is referred to in this dissertation as the "Lord Reid approach" because ultimately Lord Reid played a much more prominent role in the promotion of that

approach than Lord Evershed MR. The Lord Reid approach had regard not only to the language of the claims but also to the reason for the difference introduced by the alleged infringer and to the question of what value the difference added to the device or what practical significance the difference made to the product or device.

[10] In the subsequent case of *Rodi*¹⁹ in the Chancery Division Lloyd-Jacob J turned his back on the Upjohn LJ approach that he had initiated in *Van der Lely* in the Chancery Division which had also received the approval of both the Court of Appeal and the House of Lords in that case. Lloyd-Jacob J then embraced the Lord Reid approach in the *Rodi* case in the Chancery Division. He found that EXCALIBUR 59 infringed the patent. In a subsequent appeal to the Court of Appeal that Court stuck to the Upjohn LJ approach in deciding the *Rodi* appeal. In a further appeal to the House of Lords, the House of Lords once again applied the Upjohn LJ approach when they had to decide the *Rodi* appeal. Although there was no dissent in the Court of Appeal in *Rodi*, the House of Lords was divided 3:2. Lord Reid and Lord Pearce applied the Lord Reid approach. The rest of the Law Lords applied the Upjohn LJ approach.

[11] On the whole the Upjohn LJ approach to the determination of non-textual infringement of patents and the doctrine of pith and marrow as reflected in the decisions of the Court of Appeal and the House of Lords in both *Van der Lely* and *Rodi* focused almost exclusively on the language employed by the patentee in his claims to describe his invention and disregarded other relevant considerations. In terms of this approach no regard was had to the question of what value the difference introduced by the alleged infringer added to the patented invention or to the accused device nor was the purpose or reason for the introduction of the difference considered. Indeed, in terms of this approach the rule on immaterial variations was almost completely disregarded. The approach was a literalist approach.

[12] The Upjohn LJ approach made it very difficult to find a case in which it could be said that the doctrine of pith and marrow applied. It was bound to lead to serious difficulties in determining liability for non-textual infringement in the future. It will be suggested that the decisions of the Court of Appeal and the House of Lords in *Van*

¹⁹ *Rodi and Wieneberger AG v Henry Showell Limited* [1966] RPC 441 (Ch).

der Lely and *Rodi* constituted aberrations in the application of the doctrine of pith and marrow by the English courts. They had serious adverse consequences for the future. It will further be suggested that after *Rodi* the House of Lords realised the untenability of the Upjohn LJ approach and turned its back on it and embraced the Lord Reid approach. In this way the House of Lords averted the disastrous consequences that were likely to have followed if it had continued to apply the Upjohn LJ approach.

[13] During this period there were those who dissented from the Upjohn LJ approach. The first dissenter was Lord Evershed MR in the Court of Appeal in *Van der Lely* – but the dissenter who played the most prominent role in the rejection of the Upjohn LJ approach was Lord Reid who was the sole dissenter in a panel of five in the *Van der Lely* case in the House of Lords and one of two dissenters with Lord Pearce in the *Rodi* matter. The dissenters applied the correct approach to the determination of non-textual infringement and to the doctrine of pith and marrow. Central to the dissenters’ approach to the determination of non-textual infringement of patents was a consideration of:

- (a) what value, if any, the difference introduced by the alleged infringer added to the patented invention or the device or whether the difference was of any practical significance;
- (b) the reason, if any, advanced by the alleged infringer for introducing the difference he introduced to the device, product or process;
- (c) the rule on immaterial variations that related to the question whether the difference did not add any value or was of no practical significance or of whether the alleged infringer failed to show any reason for introducing the difference; if the difference was found to be immaterial, then almost inevitably infringement would be found. This did not necessarily entail an express mention of the rule on immaterial variations in each and every case;
- (d) the view that, unlike in the case of the Upjohn LJ approach, the mere fact that an integer was mentioned in a claim did not on its own mean that the patentee necessarily intended such integer to be an essential integer.

1.3 Third Period: 1978 – 1980

- [14] Although in *Rodi*, Lloyd-Jacob J turned his back on the Upjohn LJ approach and embraced the Lord Reid approach, neither the Court of Appeal nor the House of Lords followed his lead. However, in the House of Lords the number of the Law Lords embracing the Lord Reid approach increased from 1 to 2. The year 1978 is the year when the House of Lords did an about turn on the determination of non-textual infringement and its approach to the doctrine of pith and marrow. This was in the *Beecham Group Ltd v Bristol Laboratories and Others* (“*Beecham*” or “*the Beecham case*”)²⁰ which came after the *Rodi* decision of the House of Lords. In *Beecham* Falconer QC, who was the Deputy Judge who heard the matter in the Chancery Division, though referring to the rule on immaterial variations, continued to apply the Upjohn LJ approach. In fairness to him, he was bound to use that approach in the light of the decisions of the House of Lords and the Court of Appeal in *Van der Lely* and *Rodi*. He found that there was no infringement in *Beecham*. When the *Beecham* matter went on appeal to the Court of Appeal, the Court of Appeal gained the courage to follow Lloyd-Jacob J’s lead, disregarded its previous decisions in *Van der Lely* and *Rodi* and embraced the Lord Reid approach. When the *Beecham* matter went to the House of Lords, the House of Lords, through Lord Diplock’s judgment, abandoned the Upjohn LJ approach and embraced the Lord Reid approach. The House of Lords found that there was infringement in *Beecham*.
- [15] In due course the *Catnic* case came before the Chancery Division. Whitford J applied the Lord Reid approach. Of course, he had no choice in the light of the decision of the House of Lords in *Beecham*. He found that there was infringement of the patent. In an appeal to the Court of Appeal, the majority found that there was no infringement. That was the judgment of Buckley LJ in which Waller LJ concurred. In his dissent Sir David Cairns found that there was infringement.
- [16] In November 1980 came the *Catnic* decision of the House of Lords in which the House of Lords adopted the *Catnic* test. Although Lord Diplock, who wrote for a unanimous House of Lords, called his approach to the construction of patent claims

²⁰ *Beecham Group Ltd v Bristol Laboratories and Others* (1978) RPC 192 (HL).

the “purposive construction”, there can also be no doubt that the approach to the determination of non-textual infringement and the doctrine of pith and marrow which had been adopted by the dissenters in the *Van der Lely* and *Rodi* cases was very much purpose-driven. That is why it entailed an enquiry into what value, if any, the difference introduced by an alleged infringer into the patented invention added or an inquiry into the practical significance of the difference introduced by the alleged infringer or an inquiry into the reason advanced by the alleged infringer for introducing the difference he did to the patented invention. It would not be a misnomer to refer to the Lord Reid approach as the purposive approach to the determination of non-textual infringement and to the doctrine of pith and marrow. In both *Beecham* and *Catnic* Lord Diplock adopted a significant amount of the Lord Reid approach, though he neither said so nor credited Lord Reid or Lord Pearce for any influence on his approach in *Catnic*.

- [17] Through its *Catnic* decision the House of Lords changed the test for the determination of infringement of patents. Although the House of Lords incorporated some of the features of the doctrine of pith and marrow as articulated by Lord Reid and Lord Pearce into the *Catnic* test, it effectively abolished the doctrine of pith and marrow in English patent law and replaced it with the *Catnic* test.
- [18] It must have been difficult for the House of Lords to live with the fact that its decision in *Beecham* represented their about turn from *Van der Lely* and *Rodi* and was an unarticulated admission by itself that it had been wrong in approving the Upjohn LJ approach and rejecting the Lord Reid approach. It cannot be said that the learned Law Lords did not appreciate these implications of their decision in *Beecham*.
- [19] In *Catnic* the House of Lords took advantage of the movement away from literalism in the interpretation of patents and other legal documents and of the calls for the adoption of purposive interpretation in its stead in English law at the time the House of Lords saved its face by adopting the *Catnic* test in *Catnic*. In this way its decision in *Beecham* would be forgotten in due course and the *Catnic* decision would be the focal point for the future. To show that this is how English patent law got the *Catnic* test will require, as already pointed out, a discussion and analysis of a number of decisions of the English courts on the determination of liability for non-textual

infringement of patents and on the doctrine of pith and marrow prior to *Catnic* and the *Catnic* decision itself. However, before that discussion, it is necessary to explain briefly the doctrine of pith and marrow and the *Catnic* test.

1.4 Explanation of the Doctrine of Pith and Marrow

[20] The doctrine of pith and marrow is the same as the doctrine of infringement by taking the substance of a patented invention. Indeed, prior to Lord Cairns LC's speech in the House of Lords in the case of *Adie* the doctrine was not known as the doctrine of pith and marrow. It was known as the doctrine of infringement by taking the substance of a patented invention. The doctrine of pith and marrow is the doctrine that was applied in English patent law for over a century before the *Catnic* decision of the House of Lords in November 1980 to determine whether there had been infringement of a patent where the product or process or device or apparatus alleged to constitute an infringement did not precisely or exactly fall within the text of the relevant claim in the specification of a patented invention. Obviously, where the accused product or device or process exactly fell within the literal meaning of the relevant claim in a specification, there could be no doubt that there was infringement. Where, however, it did not exactly fall within the literal meaning of the relevant claim, the determination whether or not there was infringement had to be made with the use of the doctrine of pith and marrow.

[21] Under the doctrine of pith and marrow the question that had to be asked to determine whether there was non-textual infringement was formulated by Parker J in *Marconi*²¹ as the following:

“From this point of view, the question is whether the infringing apparatus is substantially the same as the apparatus said to have been infringed”.²²

²¹ *Marconi v British Radios Telegraph and Telephone Company* 1911 (28) 181 (Ch). Annand states that in the UK the doctrine of pith and marrow owes its origin to Parker J's judgment in *Marconi v British Radio Telegraph and Telephone Company Ltd* (1911) 28 RPC 181 (Annand Ruth E “Infringement of Patents” is ‘*Catnic*’ the Correct Approach for Determining the Scope of a Patent Monopoly under the Patents Act 1977” (1992) *Anglo-American Law Review* 39 at 42) This is not true. The doctrine of pith and marrow existed long before the *Marconi* case. Initially it was referred to as the infringement by taking the substance of a patented invention. In *Clark v Adie*, Lord Cairns used the term “pith and marrow” for the first time to refer to the doctrine of taking the substance of the invention and this is how the doctrine got the name “pith and marrow”.

²² Parker J in *Marconi* at 217.

Subsequently in *Birmingham*²³ Lord Evershed MR had this to say with regard to the question for the determination of non-textual infringement:

“For the purposes of the present case we are content to treat the question as being in the words of Parker J as he then was, in *Marconi v British Radio etc* (1911) 28 RPC 181 at 217:

‘Whether the infringing apparatus is substantially the same as the apparatus said to have been infringed’.

In the question thus formulated we take the apparatus ‘said to have been infringed’ as being the apparatus claimed as the invention in the claiming clause of the specification; and ‘substantially the same’ as meaning ‘in all essential respects the same’.”²⁴

It is suggested that this question is the same in substance and effect as the question articulated by both James LJ in *Adie* and the question articulated by Lord Cairn LC in the House of Lords in *Adie*. In *Adie* James LJ formulated the question as being:

“Whether the alleged piracy is the same in substance and effect or is a substantially new or different combination”.²⁵

Lord Cairns LC formulated the question in *Adie* as being:

“...whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented”.²⁶

[22] The doctrine of pith and marrow could only be invoked when the accused product or process took all the essential integers of the patented invention irrespective of whether or not it omitted, varied or added, some inessential feature. If the accused product or process left out an essential feature, the doctrine of pith and marrow had no application. For this reason it was always of paramount importance to determine whether the integer that was omitted or added or the variant had any practical value or significance to the successful operation of the patented invention. If it did not have

²³ *Birmingham Sound Reproducers Ltd v Collaro* (1956) RPC 232 (CA).

²⁴ Lord Evershed MR in *Birmingham* at 244 line 51 to 245 line 3.

²⁵ James LJ in *Clark v Adie* at 675.

²⁶ Lord Cairns in *Clark v Adie* in the House of Lords at 320.

any practical value or significance, the proper approach was then to invoke a well-known rule of patent law on immaterial variations. If it was found in a case that the variation introduced by the alleged infringer was material, it would follow that there was no infringement. However, if it was found that the variation or omission or addition was immaterial, then almost inevitably a finding of infringement would be made.

1.5 Explanation of the *Catnic* Test

[23] The *Catnic* test is the test used for the determination of infringement of patents introduced into English patent law by the House of Lords in 1980 through its decision in *Catnic*.²⁷ Lord Diplock wrote the speech in which the rest of the Law Lords concurred. In terms of that decision the question to be asked to determine the infringement of a patent is:

“... whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked”.²⁸

There are situations in which it is said that this question does not arise but those will be discussed later in the course of an analysis of the *Catnic* decision of the House of Lords.

[24] Under the *Catnic* test the determination of infringement is taken as a question of construction and not as a question of fact which was the case with the doctrine of pith and marrow in English patent law prior to *Catnic*. Against this understanding of the essence of the doctrine of pith and marrow and of the *Catnic* test, it is appropriate to begin a consideration of the cases.

[25] In all the cases that will be the subject of the analysis herein there was a discussion of whether or not the doctrine of pith and marrow was applicable. In some of them it was

²⁷ *Catnic Components Ltd and Another v Hill & Smith Ltd* [1982] RPC 183 (HL)

²⁸ Lord Diplock in *Catnic* at 243 lines 5-11.

decided that it applied. In others it was held that it did not apply. It is necessary to examine the cases and analyse the reasons why it was decided that the doctrine was applicable or was not applicable. Thereafter the decision which introduced the *Catnic* test will be examined with a view to showing that it and one or two others that were decided on the basis of the *Catnic* test soon after *Catnic* could easily and satisfactorily have been decided using the doctrine of pith and marrow and that the introduction of the *Catnic* test as a replacement of the doctrine of pith and marrow in the determination of non-textual infringement of patents was unnecessary. It is convenient to deal with the cases in the sequence in which the judgments were handed down so that the developments leading to the adoption of the *Catnic* test can be seen in their proper perspective.

Against the above background it is now necessary to turn to a discussion of the first period to be considered, namely, the period from 1875-1960. The first case to discuss is the *Adie* case.

CHAPTER 2

2 THE PERIOD OF THE CORRECT APPROACH TO THE DETERMINATION OF LIABILITY FOR NON-TEXTUAL INFRINGEMENT OF PATENTS AND THE DOCTRINE OF PITH AND MARROW 1875-1960

2.1 *Clark v Adie*¹

[1] In this case Clark instituted an action to restrain Adie from manufacturing and using or dealing in certain machines that were exact and avowed imitations of Clark's machine. Clark had, however, not made his new machine the subject of a patent. The two machines were for clipping or shearing horses and other animals. There had previously been other machines for doing the same thing as Clark's machine. Different people had taken patents for various such machines but Clark's machine was without any doubt better than any previous machine known up to that time including some which Adie had manufactured before. Clark was going to take out a patent for his advanced machine but abandoned that idea when he discovered that his ideas had been anticipated by one Grayson, who had taken out a patent. He then took an assignment of Grayson's patent from his trustee in bankruptcy. Clark sued as an assignee of Grayson's patent. His action was based on an alleged violation of Grayson's patent. The Court found in effect that Adie's machine did not take the substance of Grayson's machine because Adie's machine was in effect a much better machine than the machine described in Grayson's specification.

[2] Based on the above facts there could be no infringement of Grayson's patent. The doctrine of pith and marrow could not apply because that doctrine applied only where the allegedly infringing product or process or apparatus could be said to have taken the substance of the patented invention. In his judgment James LJ made no reference to how persons to whom the specification was addressed would have understood the patentee's intention to have been in regard to which integers were essential and which ones were not. James LJ made certain statements in his judgment which reflected

¹ (1875) LR Ch 667. Hitchman and MacOdrum point out that while *Clark v Adie* is generally cited for the principle of infringement in substance, there is little discussion of the principle and no application of it in that case Hitchman Carol VE and MacOdrum D H "Don't Fence Me In: Infringement in substance" (1990) *Intellectual Property Review* 167 at 169.)

some of the principles applicable to the determination of non-textual infringement of patent specifications. James LJ *inter alia* said:

“A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact every, or almost every, patent is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.”²

James LJ referred to another case, namely *Murray v Clayton*³ – no citation appears in the judgment – where he said that they – by which he must have meant himself and Vice-Chancellor Baron with whom he sat in the *Adie* case – had held in that case that, although the patent was for a combination, infringement had been made out by showing that the alteration was colourable only, and that the defendant’s machine was in substance and truth the same thing as the invention of the plaintiff.⁴ He also referred to another case where, as he put it, the defendant’s machine left out a material part of the invention, and they therefore held that a machine which left out that part was not an infringement.⁵ It is significant that James LJ referred in this regard to a material part which must mean that it was a part that the Court regarded as material as opposed to a part that may have been intended by the patentee to be material but may not necessarily have been objectively material nor a part that would have been understood by the notional addressee to have been intended by the patentee to be material.⁶ Accordingly, James LJ seems to have meant that the objective materiality of an integer was important. James LJ stated the principle in these terms:

“The principle is really very plain as it seems to us. A combination or accumulation of three improvements is a totally distinct thing from a combination or accumulation of two of them – as distinct as a partnership of A, B and C is from a partnership of A and B. And if a man really wants to patent not only the whole of what he calls a new arrangement, construction and combination of parts, he must clearly show that he

² James LJ in *Clark v Adie* at 675.

³ *Murray v Clayton* Law Rep 7 Ch 570

⁴ James LJ in *Clark v Adie* at 675.

⁵ James LJ in *Clark v Adie* at 676.

⁶ These observations seek to contrast that part of James LJ’s judgment that dealt with the materiality of an omission or variant under the doctrine of pith and marrow and the approach that the *Catnic* test advocates in regard to the materiality of an omission from or variation of or addition to, a patented invention.

claims that something less – of course periling his patent if that something less is not a novelty.”⁷

2.2 *Clark v Adie* in the House of Lords⁸

[3] *Clark v Adie* went on appeal to the House of Lords. After explaining the different modes of infringement of a patent, Lord Cairns LC articulated the question to be asked in order to determine non-textual infringement of a patent. Lord Cairns LC, *inter alia*, said in relation to non-textual infringement:

“... the question would be, either for a jury or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, an infringer who took eight or nine of those 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 and represented upon his machine.”⁹

It was in this passage that Lord Cairns LC coined the phrase “pith and marrow” to refer to the infringement by the taking of the substance of a patent claim. Thereafter the doctrine of infringement by the taking of the substance of a patented invention became known as the doctrine of pith and marrow.

[4] The important features of the above passage in Lord Cairns LC’s speech in the House of Lords in *Adie*’s case are the following:

- (a) that the question to be asked to determine liability for non-textual infringement was whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented and whether in what he had done he had not really taken and adopted the substance of the instrument patented.

⁷ James LJ in *Clark v Adie* at 676-677.

⁸ (1877) 2 App Cas 315(HL).

⁹ Lord Cairns LC in *Clark v Adie* in the House of Lords at 320.

- (b) that it was the tribunal judging of the facts which had to decide whether or not the alleged infringer had taken the substance of the patented invention; this is important in the sense that the House of Lords did not say that the notional addressee of the specification had a role to play in this regard – something that resides at the centre of the *Catnic* test as decided by the same House over 100 years later in the *Catnic* case
- (c) that the question whether or not the alleged infringer in what he had done had not taken and adopted the substance of the instrument patented was a question of fact to be decided by the tribunal judging of the facts.

2.3 *The Incandescent Gas Light Company Ltd v the De Mare Incandescent Gas Light System Ltd And Others*¹⁰

- [5] In *The Incandescent Gas Lamp* case patents had been granted to one Carl Auer von Welsbach and were for the manufacture of an illuminant appliance for gas and other burners. The plaintiffs complained that the defendants were planning to infringe those patents. The defendants denied that what they were planning to do would infringe the patents. Welsbach had discovered a practical and simple method of arranging oxides to be rendered incandescent in a shape which made it possible to use them in burners and also discovered that a class of substances referred to as “rare earths” would, when blended with Zirconia, afford at once the necessary illumination and the necessary coherence.
- [6] The defendants intended to construct or sell in England plumes for incandescent lamps in a manner described by one De Mare with reference to two patents which De Mare had taken out and in an application for a patent on the 11th April 1895. It would seem that the difference between what the specification described and what the defendants were likely to do was the defendants’ omission of ammoniation, omission of lanthana and the variation in the form of the illuminant appliance.¹¹
- [7] Wills J, who was the trial Judge, articulated the test as being that, if the process which the defendants had held out that they were going to use was substantially identical to

¹⁰ (1896) 13 RPC 301 (QBD).

¹¹ *The Incandescent Gas Lamp* case at 329 lines 25-26.

the process of the plaintiffs' or of Welsbachs', they were liable in that action but that, if it was not so, they were entitled to his judgment.¹² No reason was given for the omission of lanthanum. The trial Judge said that this omission undoubtedly involved some loss of the light-giving power of the plume; and generally no advantage had been suggested was obtained by any variation there may have been between Welsbach's or De Mare's proportions of the oxides or salts. With regard to the non-ammoniation, evidence given by an expert called by the defendants was to the effect that ammoniation was, in his opinion, not necessary to arrive at the result proposed by the patentee. This meant that ammoniation was not an essential integer of the plaintiffs' patented invention. It seemed that dropping ammoniation only had the effect that the defendants got the same result by one step as could be achieved by two steps if there was ammoniation of the fabric. The trial Judge said that that was strictly the use of a chemical equivalent perfectly well known at the date of the patent, and could have no bearing upon the question of infringement.¹³

- [8] Wills J then embarked upon an extensive discussion of the principles relating to infringement. In dealing with the question of construction, he said he had carefully avoided any reference to the relative importance of different parts of the invention but that in dealing with the question of infringement, it was impossible not to consider them.¹⁴

This was a reference to the objective importance of the various parts of the invention irrespective of the patentee's own view of such importance. Wills J continued after the last sentence of the passage quoted above and said:

“Infringement is a question of fact for the jury if there be one; and the question is not whether the substantial part of the process said to be an infringement has been taken from the specification, but the very different one, whether what is done or proposed to be done takes from the patentee the substance of his invention. A process might be wholly gathered from a specification and nowhere else, and yet be no infringement, if it did not take substantially the thing invented. What the thing invented is must be gathered from the specification alone, and the Patentee cannot escape from the thing he has claimed as the standard, and the only standard with which to compare the

¹² Wills J in *The Incandescent Gas Lamp* case at 321 line 55 to 322 line 2.

¹³ *The Incandescent Gas Lamp* case at 330 lines 3-4.

¹⁴ *The Incandescent Gas Lamp* case at 330 lines 16-19.

alleged infringement so as to see if it constitutes substantially the appropriation of the thing claimed.”¹⁵

Four of the points made by Wills J in the passage quoted above are that:

- (a) the relative importance of the various parts of the invention must be considered in determining whether there has been an infringement;
- (b) what the thing invented is must be gathered from the specification alone and from nowhere else;
- (c) the patentee must be judged by the specification.
- (d) the question for determining whether or not there had been infringement was whether what is done or proposed to be done takes from the patentee the substance of his invention.

The point made in (a) relates to the materiality or essentiality of the various parts of the inventions including the variants.

[9] An oft-quoted statement by Wills J in his judgment appears in a paragraph that follows the paragraph just quoted above. As will be recalled, in the last sentence of the paragraph last quoted above, Wills J referred to a comparison of the alleged infringement to the specification to see if the alleged infringement constitutes substantially the appropriation of the thing claimed. In the next paragraph Wills J then said:

“When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied? 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, as has been often pointed out by every Court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated.”¹⁶

¹⁵ Wills J in *Incandescent Gas Lamp* case at 330 lines 19-29.

¹⁶ Wills J in *The Incandescent Gas Lamp* at 330 lines 30-37.

Part of what Wills J said in this passage relates to the materiality of the variant or the integer that is varied or omitted or added. In this passage Wills J repeated the statement about the importance of the magnitude and value of the things taken and of those left or varied. He then said that it was the tribunal which had to decide whether the substance of the invention had been taken and that the tribunal had to use its good sense to make this decision. In this regard what Wills J said in *The Incandescent* case about what the question was for determining whether there had been infringement and about who had to decide whether the substance of the patentee's invention had been taken was in line with the judgments of both James LJ and Lord Cairns in *Adie*.

[10] In *The Incandescent Gas* case an argument was advanced that which parts of the invention were important and which ones were of subsidiary consequence could only be gathered from the specification itself. Wills J rejected this contention saying he was satisfied that that neither was nor could be the law.¹⁷ Wills J then said:

“There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention. In the case of a patent for a combination, or for a series of operations, the Specification very often contains no clue to the inventor's own view of the relative importance of the different elements in the combination. If he says nothing on the subject you must conclude that, as far as the Specification goes, they are all presented as of equal importance, and all as essential parts of the combined whole, and yet there may be no infringement notwithstanding slight variations’ (Cotton LJ in *Proctor v Bennis* 36 Ch D 740-754). So, again says Cotton LJ at page 756, ‘omissions and additions may be very material in considering whether, in fact, the ‘machine of the Defendant is an infringement of the combination which the Plaintiff claims. Omissions and additions may even be improvements but that fact ‘does not enable you’ says Bowen LJ, ‘to take the substance of the Plaintiff's patent’.”¹⁸

Wills J found that what the defendants planned to do would take the substance of the plaintiff's invention and that there would be infringement. In this passage Wills J unequivocally said that you could not ascertain whether an invention had been taken when there were additions or subtractions except by seeing what they are worth as compared with the things which have been taken bodily from the invention.¹⁹

¹⁷ Wills J at 330 lines 38-40.

¹⁸ Wills J in *The Incandescent Gas Light* at 330-331.

¹⁹ Wills J in *The Incandescent Gas Light* at 330.

[11] It is clear that Wills J did not decide the essentiality or otherwise of the relevant parts of the patented invention omitted or varied only according to what the patentee said in the specification but also considered the objective importance and value thereof. That is the materiality of the parts. He certainly did not over-emphasise what the patentee had intended more than the objective importance and value of the relevant parts of the invention.

[12] *Adie's case* and *The Incandescent Gas case* were decided towards the end of the 19th century. The first case of significance in the 20th century that needs to be discussed is *Marconi's case*.

2.4 *Marconi v British Radios Telegraph and Telephone Company Ltd*²⁰

[13] The *Marconi* matter came before Parker J in the Chancery Division. It concerned an alleged infringement of a patent relating to an invention of improvements in an apparatus for wireless telegraphy. The defendant's apparatus contained all the essential features of the plaintiff's apparatus. That would suggest that the defendant's apparatus obviously infringed the plaintiff's patent. However, in this case the defendant, nevertheless, maintained that it did not infringe the plaintiff's patent. The basis of the defendant's defence was, in the main, that, whereas in the plaintiff's apparatus the plaintiff used a transformer that was a transformer in the ordinary sense which had two coils and that was the type of transformer that the specification referred to, the defendant had used an instrument which was a single-coil instrument. The defendant's case was that the instrument used in the place of the plaintiff's transformer was not, in ordinary parlance, a transformer at all but was what was known as an auto-transformer. The defendants said that their instrument did not act as a transformer acts, entirely by mutual induction, but partly by mutual induction and partly by what was called inductive shunt and they could perfectly easily eliminate the mutual induction altogether and make their instrument act entirely by inductive shunt.

²⁰ *Marconi v British Radios Telegraph and Telephone Company Ltd* 1911(28) RPC 181 (Ch).

[14] The effect of the defendant's defence was that there was a sufficient difference between its apparatus and that of the plaintiff to justify a conclusion that there was no infringement. After analysing the technical evidence at some length Parker J expressed satisfaction that, if at the date of *Marconi's* 1900 Patent, a competent electrical engineer, conversant with wireless telegraphy, had had Marconi's invention explained to him, and had been asked whether you could substitute for Marconi's two-coil transformers auto-transformers, whether arranged "1 to 1", or otherwise, he would unhesitatingly have answered in the affirmative. Parker J then said that, if this was so, the use of the aircore autotransformer, even if arranged "1 to 1" in Marconi's system could never have afforded subject matter for a new patent or be called a new discovery.²¹ Parker J concluded that the reference to a transformer in Marconi's specification was a reference to an ordinary transformer, and that was, he continued, a two-coil transformer. He said that if, therefore, a two-coil transformer was an essential feature of Marconi's system, the action would have to fail. However, he went on to say that he did not think that a two-coil transformer was an essential feature of Marconi's system. He said that Marconi had taken, and he thought most engineers would have taken, the most obvious means of securing this linkage, namely, a two-coil transformer. He said it was, however, a matter of indifference, so far as the essence of that invention was concerned, whether a transformer or an auto-transformer be used.²²

[15] When Parker J looked at Marconi's first, second, third and fourth claims, he said that there could be no doubt that anyone reading the body of Marconi's specification, and then his claims, would conclude that the instrument, to which he referred in the claims as a transformer, was an instrument with two coils, though the words of the claims, taken alone, might include auto-transformers. He pointed out that, if, therefore the use of an instrument with two coils were an essential feature, the action would fail. In his opinion, however, the use of a two coil instrument was not an essential feature of Marconi's invention at all.²³

²¹ Parker J in *Marconi's* case at 216.

²² Parker J in *Marconi's* case at 217 lines 27-30.

²³ Parker J in *Marconi* at 217 lines 10-17.

[16] Later on Parker J expressed the view that Marconi had taken the most obvious means of securing some form of inductive linkage, namely a two-coil transformer. Parker J said he thought that most engineers would have done the same. He then said:

“It is, however, a matter of indifference, so far as the essence of this invention is concerned, whether a transformer or an auto-transformer be used. Looking at the first Claim of the Specification, it is a claim for a transmitter involving a combination of parts, and, among others, two tuned circuits and a transformer the latter supplying the necessary linkage. In the second and third claims the transformer has the same function. The fourth Claim is for apparatus substantially as described in the Specification and illustrated in the Drawings.”²⁴

Parker J went on to say in the *Marconi* case that he could not doubt that a jury would say that the defendant’s apparatus was substantially the same as that covered by Marconi’s 1900 patent. Then he pointed out that, where the patent is for a combination of parts or a process, and the combination or process, besides itself being new, produces new and useful results, everyone who produces the same results by using the essential parts of the combination or process is an infringer, even though he has, in fact, altered the combination or process by omitting some unessential part or step and substituting another part or step, which is, in fact, equivalent to the part or step he has omitted. Parker J took the view that the question here, again, was a question of the essential features of the invention said to have been infringed. Parker J said that, if that part of the combination, or that step in the process for which an equivalent has been substituted, be the essential feature, or one of the essential features, then there is no room for the doctrine of equivalents, and to ascertain the essential features of an invention, the Specification must be read and interpreted by the light of what was generally known at the date of the patent.²⁵

[17] Fox draws attention to a statement by Romer LJ in Marconi’s case to the effect that the essence of an invention is a matter to be determined on an examination of the language used by the patentee in formulating his claims and points out that there is considerable doubt as to the correctness of this statement.²⁶ In this regard Fox refers

²⁴ Parker J in *Marconi* at 217-218 line 4.

²⁵ Parker J in *Marconi* at 217 lines 46 to 218 line 4.

²⁶ Fox at 379.

to the judgment of Thorson P in *McPhar Engineering*²⁷ but fails to provide a citation for that case, Fox states that in that case Thorson P rejected this statement by Romer LJ and pointed out that the proper approach to the ascertainment of the essential features of an invention was stated by Parker J in *Marconi's* case 1911 28 RPC 181 at 218 as being that the specification must be read and interpreted by the light of what was generally known at the date of the patent.²⁸ Of course, the approach contemplated in Romer LJ's statement is the same approach that was applied by Lloyd-Jacob J, Upjohn LJ, and Pearson LJ as well as the majority in the House of Lords in *Van der Lely* and by the Court of Appeal and the majority in the House of Lords in *Rodi* which resulted in a crisis in English patent law early in the second half of the 20th century. Fox goes on to say that Thorson P pointed out that, once the claim defining the invention has been construed, the ascertainment of whether the invention has been infringed is a different matter than the construction of the claims. He said that the distinction is of the utmost importance because infringement is a question of fact. As pointed out elsewhere in this dissertation it is suggested that infringement may not be a question of fact in all cases but the distinction is important. Fox says²⁹ that, since there is infringement if the substance of the invention is taken, it becomes necessary to ascertain what the substance of the invention is and said that that question is a question of fact.

- [18] Parker J also referred to *Benno's case*³⁰ and said that that case was a good instance of the application of the doctrine of equivalents. In that case a centrifugal machine was both specified and claimed and the process was new and led to a new and useful result. The defendant used the whole process but omitted the centrifugal machine which he replaced with a settling tank to do what the centrifugal machine had been intended to do. It was held that the centrifugal machine had not been an essential feature of the process and that the defendant was an infringer. In the *Marconi* case the Court rejected an argument to the effect that no room existed for the application of the doctrine of equivalents where the equivalent used was unknown at the date of the patent. Parker J concluded in *Marconi's* case that the defendants had taken all the essential parts of Marconi's invention and were, therefore, infringers notwithstanding

²⁷ *McPhar Engineering Co v Sharpe Instruments Ltd* (1960) [1956-60] Ex CR 467.

²⁸ Fox at 379; *Benno Jaffé und Darmstaedter Lanolin Fabrik v John Richardson and Co* (11 RPC 93, 261).

²⁹ Fox at 379.

³⁰ Parker J in *Marconi* at 217 lines 46 to 218 line 4.

that they had substituted an auto-transformer for a transformer in the combination claimed and notwithstanding that the use of an auto-transformer with an air-core for any such purpose as that for which Marconi has used the transformer may have been new.³¹ Accordingly, the plaintiff's claim succeeded.

[19] It is interesting to note that in the *Marconi* case reference was made to what a competent electrical engineer conversant with wireless telegraphy would have said about the substitutability of auto-transformers for Marconi's two-coil transformers if he had been asked after getting an explanation of Marconi's transformers. Parker J said that such engineer would no doubt have answered in favour of their substitutability. In the *Clark v Adie* and in *The Incandescent Gas* cases no reference seems to have ever been made to the role of the views of persons to whom a patent is addressed. In *Marconi's* case the doctrine of pith and marrow was applied. What is most significant about *Marconi's* case is not only that Parker J took into account the question whether or not the variant affected the result of the invention but also that, when he concluded that it did not, he immediately referred to the rule of patent law that no one who borrows the substance of a patented invention may escape the consequences of infringement by making immaterial variations. Accordingly, in *Marconi's* case it was after Parker J had both considered the value of the variant as well as this rule of patent law that he concluded that the substance of the patentee's invention had been taken and that, therefore, infringement had been established.

2.5 *Electric and Musical Industries Ltd and Boonton Research Corporation v Lissen Ltd*³²

[20] Another case that needs to be referred to is that of *Electric and Musical Industries Ltd and Boonton Research Corporation v Lissen Ltd* ("the EMI case"). It is not considered necessary to set out or discuss the facts of this case. It suffices to only refer to some statements that were made in the speeches of some of their Lordships in the House of Lords relating to the subject of the construction of specifications or of patent claims. This case concerned among other things a claim by *Electric and Musical Industries Ltd and Boonton Research Corporation* that *Lissen Ltd and Another* had infringed

³¹ Parker J in *Marconi* at 218.

³² 56 RPC 23; 1938 All ER 221 (HL).

claims 1 and 2 of a patent that had been granted to them in respect of Improvements in Electric Wave Amplifying Apparatus. There were two consolidated actions. They came before Luxmoore J who held the patent to be valid and found that claims 1 and 2 had been infringed. There was an appeal to the Court of Appeal against the judgment of Luxmoore J. The Court of Appeal upheld the appeal. The plaintiffs then appealed to the House of Lords.

[21] Before the House of Lords the appeal was heard by Lords Atkin, Russel, MacMillan, Wright and Porter. The House of Lords was divided. Lords Atkin and Porter would allow the appeal but Lords Russel, MacMillan and Wright dismissed the appeal. Accordingly, the decision of the House of Lords was to dismiss the appeal. However, Lord MacMillan's reasons for the decision to dismiss the appeal did not entail his agreement with Lord Russell on the issue of infringement. He was of the view that the patent failed for want of subject-matter. In the light of his conclusion on the defence of disconformity, it was not necessary for Lord Wright to deal with the issue of the construction of patent claims. Nevertheless, he did go on to express his view briefly on that question. On the applicable principles of construction, Lord Wright stated that he agreed with the enunciation of the true principles of construction made by Lord Romer in delivering the judgment of the Court of Appeal and the statement to the same effect by Lord Russell in the same matter.³³

[22] In the judgments of Lord Atkin and Lord Porter one cannot find much by way of a discussion of the principles of construction other than that, in the case of Lord Porter, he affirmed in his judgment the principle that "if the claims have a plain meaning in themselves, then advantage cannot be taken of the language used in the body of the specification to make them mean something different".³⁴ Lord Parker went on to say in that case that he was unable "to construe the claims with certainty without the explanatory matter contained in the body of the specification...".³⁵ He read certain words into claim 1.

³³ Lord Wright in *Electric and Musical Industries* case at 52 lines 22-25.

³⁴ Lord Porter in the *EMI* case at 57 lines 45-48.

³⁵ Lord Porter in the *EMI* case at 57 lines 49 to 58 line 2.

[23] It is now opportune to refer to the judgment of Lord Russell of Killowen. However, in discussing those aspects of that judgment that relate to the construction of patent claims and infringement, it must be borne in mind that only one other Judge in the matter expressed agreement with his enunciation of the principles of construction. That is Lord Wright. Lord Russell of Killowen made a number of important statements in this regard some of which were subsequently quoted with approval in numerous cases both in England and South Africa many decades after he had made them.³⁶

[24] The first statement Lord Russell made in this regard on the construction of patents was that he agreed with the Court of Appeal's statement in the same case that:

- (a) no special rules were applicable to the construction of a specification;
- (b) a specification must be read as a whole and in the light of surrounding circumstances;
- (c) it may be gathered from the specification that particular words bear an unusual meaning, and,
- (d) if possible, a specification should be construed so as not to lead to a foolish result or one which could not have contemplated.

Leger views Lord Russell's statement that, if possible, a specification should be construed so as not to lead to a foolish result or one which the patentee could not have contemplated as being in conformity with the concept of purposive construction.³⁷ It is suggested that, although Leger is right in this regard, this may equally also fall within the qualification of the golden rule of interpretation, which is part of literalism, which is that words must be given their ordinary meaning unless that would lead to an absurdity.

[25] Having expressed his agreement with every word that the Court of Appeal had said on the construction of a specification, and on the function of claims, Lord Russell

³⁶ Some of the important statements relating to the construction of patent claims appear at 39 lines 17-39.

³⁷ Jacques Leger in Henderson G (ed) *Patent Law of Canada* (1994) Carswell at 198.

expressed a desire to add something further in regard to the claim in a specification.³⁸

What Lord Russell then said in the following paragraph has been repeated umpteen times in subsequent cases. He said:

“The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims. As Lord Cairns said, there is no such thing as infringement of the equity of a patent (*Dudgeon v Thompson* LR 3 App Cas 34).”³⁹

To a very large extent this passage has been used in support of the literalist approach to the construction of patent claims. This does not, however, mean that it has not been used for any purpose other than in support of the literalist approach.⁴⁰

[26] Lord Russell also made further statements.⁴¹ He started off with an implied suggestion that words in a claim may bear a special or unusual meaning by reason either of a dictionary found elsewhere in the specification or of technical knowledge possessed by persons skilled in the art. He went further and said that the *prima facie* meaning of words used in a claim may not be their true meaning when read in the light of such a dictionary or of such a technical knowledge and that in those circumstances a claim, when so construed, may bear a meaning different from that which it would have borne

³⁸ Lord Russell of Killowen in *EMI* at 39 lines 24-26

³⁹ Lord Russell in *EMI* at 39 lines 26-39.

⁴⁰ It is interesting to note that, whereas Lord Russell made a statement in the last sentence of the passage quoted above that “there is no such thing as infringement of the equity of a patent” and referred to *Dudgeon v Thompson* LR 3 App Cas 34, in South Africa Froneman DJP said in *Buffalo Signs Co Ltd and Others v De Castro and Another* (1999) 20 ILJ 1501 (LAC) at 1508 par 22 that under the now repealed Labour Relations Act, 1956 (Act 28 of 1956) “... liability for the commission of an unfair labour practice extends only to an employer as defined in the Act and there is no employer in equity”. However, he said in the next sentence: “But that, in my view, does not mean that in every case there can only be one employer, or that equitable policy considerations do not come into play when determining who an employer is under the Act”.

⁴¹ Lord Russell at 41 lines 20-47.

had no such assisting light been available.⁴² Lord Russell pointed out that that was construing a document in accordance with the recognised canons of construction.⁴³

[27] What Lord Russell said as reflected in the preceding paragraph suggests that as at that time the construction of specifications and claims was governed by the same canons of construction that were applicable to the construction of documents. A little later Lord Russell made two points. The first one was that he knew of “no canon or principle which will justify one in departing from the unambiguous and grammatical meaning of a claim and narrowing or extending its scope by reading into it words which are not in it”.⁴⁴ The second point was that he knew of no canon or principle of construction “which will justify one in using stray phrases in the body of a Specification for the purpose of narrowing or widening the boundaries of the monopoly fixed by the plain words of a claim”.⁴⁵

[28] Lord Russell concluded by saying:

“A claim is a portion of a specification which fulfils a separate and distinct function. It and it alone defines the monopoly; and the patentee is under a statutory obligation to state in the claims clearly and distinctly what is the invention which he desires to protect. As Lord Chelmsford said in this House many years ago: ‘The office of a claim is to define and limit with precision ‘what it is which is claimed to have been invented and therefore patented’ (*Harrison v Anderson Foundry Co* LR 1 App 574). If the patentee has done this in a claim the language of which is plain and unambiguous, it is not open to your Lordships to restrict or expand or qualify its scope by reference to the body of the specification. Lord Loreburn emphasised this when he said: ‘The idea of allowing a patentee to use perfectly general language in the claim and subsequently to restrict or expand or qualify what is therein expressed by borrowing this or that gloss from other parts of the specification is wholly inadmissible’ (*Ingersoll Sergeant Drill Co v Consolidated Pneumatic Tool Co* 25 Report of Patent cases, page 61 at page 83).”⁴⁶

Two observations emerge from this passage. Firstly, as a general rule, a patentee’s monopoly must be found within the four corners of the claims. Secondly, an

⁴² Lord Russell in *EMI* at 41 lines 23-27.

⁴³ Lord Russell in *EMI* at 41 lines 27-28.

⁴⁴ Lord Russell in *EMI* at 41 line 28.

⁴⁵ Lord Russell in *EMI* at 41 lines 28-33.

⁴⁶ Lord Russell in *EMI* 41 lines 34 to 42 line 48. For a history of the evolution of English patent claims, see DJ Brennan: “The evolution of English patent claims as property definers” (2005) 4 *IPQ* 361-399.

exception to that general rule is where the language of the claims is unclear and ambiguous. In such a case recourse can be had to the body of the specification. Lord Russell then quoted Sir Mark Romer who, he said, had expressed a similar view in *British Hatford*.⁴⁷ Lord Russell quoted Sir Mark Romer as having expressed himself thus in that case:

“One may and one ought to refer to the body of the specification for the purpose of ascertaining the meaning of words and phrases in the claims, or for the purpose of resolving difficulties of construction occasioned by the claims when read by themselves. But where the construction of a claim when read by itself is plain, it is not, in my opinion, legitimate to diminish the ambit of the monopoly claimed merely because in the body of the specification the patentee has described his invention in more restricted terms than in the claim itself.”⁴⁸

[29] Fox says there appears to be a conflict between a statement in the judgment of Lord Russell of Killowen in *EMI* and another statement made by Parker J in *Marconi*'s case. In this regard Fox quoted the statement where Lord Russell said that “a claim is a portion of the specification which fulfils a separate and distinct function. It and it alone defines the monopoly and the patentee is under a statutory obligation to state clearly and distinctly what is the invention which he desires to protect.”⁴⁹ Fox then quotes the statement made by Parker J, in *Marconi* where Parker said that it was a well known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations.⁵⁰ Fox refers⁵¹ to Lloyd-Jacob J's judgment in *Parks-Cramer Co v Thornton and Sons Ltd*⁵² for an explanation of these two statements. It is suggested that one explanation for the two statements would be found in another statement which Lord Russell made in *EMI*. That is a statement which, it is suggested, qualified the one which Fox says is in conflict with the statement of Parker J. That statement by Lord Russell was that “if possible, a specification should be construed so as not to lead to a foolish result or one which the patentee could not have contemplated”.⁵³ This statement would, it is suggested, accommodate the rule referred to by Parker J to

⁴⁷ *British Hatford-Fairmont Syndicate Ltd v Jackson Bros (Knottingley) Ltd* 49 RPC 495 at 556.

⁴⁸ Lord Russell in *EMI* at 41 lines 49 to 42 line 7.

⁴⁹ *Electrical and Musical Industries Ltd v Lissen Ltd* (1939) 56 RPC 23 at 41.

⁵⁰ See *Marconi*'s case at (1911) 28 RPC 181 at 217; see also Fox at 364.

⁵¹ Fox at 364.

⁵² (1966) RPC 99 at 128.

⁵³ Lord Russell of Killowen in *EMI* at 39 lines 17-22.

which Fox also refers. It would be an exception to Lord Russell's statement said to be in conflict with Parker J's statement.

[30] Lord Russell also referred in *EMI* to the fact that much stress was laid upon the fact that the body of the specification contained references to strong and weak signals, to modulation – distortion, and to the experiments made and the results obtained and illustrated in figures 1, 2, 3 and 4.⁵⁴ He said that it was those references, experiments and information which were relied upon as a justification for departing from the plain language of Claim 1. Lord Russell then said that in his opinion those references, experiments and information thus imparted furnished no such justification. He said that they were included in the body of the specification because they indicated the advantages (ascertained by experimenting with valves which had the special design of tube electrodes) which would accrue from using the claimed method of adjusting the transmission. Lord Russell said that that was the proper place for them to occupy. He said that they should not be read into Claim 1 and had no place there, because they formed no part of the invention. He emphasised that their advantages accrued from using it.⁵⁵ Lord Russell concluded that he would dismiss the appeal with costs.

2.6 *Birmingham Sound Reproducers Ltd v Collaro Ltd and Collaro Ltd v Birmingham Sound Reproducers Ltd*⁵⁶

[31] In this case the patent related to an apparatus for the automatic changing by a gramophone or other sound reproducer of a number of disc records placed upon it for successive playing, notwithstanding that such records could have been of different diameters. Prior to the patented invention gramophone disc records had at all material times been, and at the time of the judgment in this case, were still, made and marketed in three sizes. The smallest, which previously had been 9 inch diameter, was then 7 inch diameter, the next bigger size 10 inch diameter and the largest size 12 inch diameter.

[32] Automatic devices for changing records required a mechanism which would cause the tone arm or pick-up at the end of the playing of a record to be raised from the record

⁵⁴ Lord Russell at 42 lines 17-21.

⁵⁵ Lord Russell in *EMI* at 42 lines 23-30.

⁵⁶ (1956) RPC 232 (CA).

and carried outward or laterally beyond the rim of the turntable and of the played record, the dropping of the next record to be played from the stack on to the turntable and then the movement of the tone-arm or pick-up back as far as the outermost groove of the new record to be played and its depression so that the needle would make contact with that record upon its outside groove and play the record in the ordinary way. It would seem that this mechanism worked when the records being dropped on to the turn-table from the stack were of the same size but not when they were of different sizes. To achieve the object of adapting the mechanism to be able to drop records of different sizes from the stack on to the turntable, the mechanism had to be such that the swinging inwards of the tone-arm or pick-up to the outermost groove of the new record to be played had to be adjusted to the size of the record.

[33] The essential features of the earlier types of mechanism were that the falling record, other than a record of the smallest diameter, by depressing the blade, caused a corresponding lift of a rod; that the lifting of the rod in turn through a “bell-crank” lever caused a lateral movement of a horizontal member under the turntable to which was attached a projecting piece having in it an angled slot; that another member, called a stop member, being free to rotate about a fixed pivot, and having a peg engaged in the slot in the abovementioned slotted member, was caused by the lateral movement of the latter to rotate to a distance determined by the extent of the movements previously described; that the stop member was held in the position to which it had been moved by the action of another spring and rotating member called “detent” which operated in the manner of a ratchet upon an appropriate notch or tooth on the stop member, and that, finally, another member co-operating with the tone-arm was by a knob or peg brought to rest or halted against a part of another surface of the stop member corresponding to the notch or tooth held by the detent.

[34] Lord Evershed MR, who delivered the unanimous judgment of the Court, made the following observations:

“From the description which we have attempted, it will be appreciated that the extent of the depression of the blade was, indirectly or by a series of mechanical parts, communicated to a moving stop member which was held in the achieved position by a detent and that such position controlled, through the stop member itself, the extent of the in-swing of the tone-arms. It will further be appreciated that the work of moving

all the mechanism was done directly by the record itself, that is, by its own weight and movement. The outward movement of the tone arm at the end of the playing of a record operated to restore the whole mechanism to its original position.”⁵⁷

[35] According to Lord Evershed MR, in the essential features of the appellants’ device as described and illustrated in their Letters Patent were found the essential pieces of the mechanism, the stop member and the detent. However, Lord Evershed MR pointed out that there were two marked differences between the earlier type of mechanism and the mechanism described in the appellants’ Letters Patent. The one was that in the appellant’s mechanism the blade was attached to the “detent”. The other was that the stop member was attached to the vertical part of the apparatus to which were “pivoted” also the blade and the detent. The stop member was free to move to a certain extent upwards or downwards but by reason of the use of a spring its tendency or “bias” was to move upwards. In the position of the mechanism produced by the outward swing of the tone-arm, the narrow “toe” of the detent rested upon the topmost of three steps at the top of the stop member. In this position the blade was horizontal. A record of the smallest size would not touch the blade. This part of the mechanism remained in this original position for the playing of such a record.

[36] Lord Evershed MR pointed⁵⁸ out that the use in the respondents’ RC 54, which represented the respondents’ apparatus, of the bell-crank lever plus the sliding metal strip in lieu of the single stop member in the appellants’ device, gave rise to certain distinctions in design between the two devices, namely:

- (1) instead of the three steps or notches at the top of the appellants’ stop member, one or other of which engaged with what he called the toe of the detent, there were found in RC 54(a) in the bell-crank a notch (liable to engage with a hook at the top of the detent) and peg (liable to engage with one or other of the two cam surfaces on the detent) and (b), the two last mentioned cam surfaces’;
- (2) instead of the single stop member in the appellants device “biased” to move vertically upwards, there were found in RC 54 two belt-cranks, biased to

⁵⁷ Lord Evershed in *Birmingham* at 236 lines 1-8.

⁵⁸ Lloyd-Jacob J in *Birmingham* at 237.

rotate clockwise, and the metal strip connected with the bell-crank and thereby “biased” to move vertically downwards; and

- (3) Instead of the three bottom steps or notches on the single stop member in the appellants’ device, in RC 54 the corresponding three notches or steps were on the metal strip which itself had no other steps or notches.

[37] The entire case of infringement related to claim 1 of the specification. The heading to the specification was: *IMPROVEMENTS TO AND RELATING TO SOUND REPRODUCING APPARATUS*. The specification referred to the kind of apparatus in which “the extent of the inward movement imparted to the reproducer by traversal of the plane of the turn-table, as a preliminary to the engagement of the stylus with the record to be played is made to correspond with the radius of that record by settable means adopted to function as a temporary stop for the inwardly moving reproducer, setting of said means being determined by the engagement of non-engagement therewith of the edge of the record as it moves from the lower end of the stack to the playing position on the turntable”.⁵⁹ Thereafter followed a paragraph to the effect that the object of the invention was to provide an improved and simplified form of apparatus of this kind suitable for use with two but more particularly with a number in excess of two different sizes of disc records.⁶⁰ Dealing with the invention with which the case was concerned, Lord Evershed MR. made the following points, namely:

- that the invention consisted of the selection of particular known chemical members and their arrangement in a particular way so as to provide a simple, compact, cheap and positive method of carrying out a known mechanical operation.
- that the individual parts of the apparatus were not claimed as inventions and could not be so claimed.
- that the basic idea which the invention carried out, that is to say, the stopping of the tone-arm at a point appropriate to the commencement of the

⁵⁹ At 238 lines 14-20.

⁶⁰ At 238 lines 22-24.

playing of a given record, which point was determined or selected by the degree of defection of the blade brought about by that record as it dropped from stack to turntable, was not and could not be claimed as an invention as it was not new.

- that the essence of the invention resided wholly in the selection and arrangement of the parts and the manner in which they interacted when arranged in accordance with the invention and that it was therefore essential to the invention that it should consist of the particular parts described in the claim arranged and acting upon each other in the way described in the claim.⁶¹

[38] Lord Evershed discussed the principles applicable to non-textual infringement.⁶² He discussed all the prominent cases dealing with the principles applicable to the determination of non-textual infringement of patent claims between 1870 and 1956.⁶³ Quite importantly, Lord Evershed MR said:

“For the purposes of the present case we are content to treat the question as being in the words of Parker J, as he then was, in *Marconi v British Radio etc* (1911) 28 RPC 181 at 217:

‘Whether the infringing apparatus is substantially the same as the apparatus said to have been infringed’.

In the question thus formulated we take the apparatus ‘said to have been infringed’ as being the apparatus claimed as the invention in the claiming clause of the specification; and ‘substantially the same’ as meaning ‘in all essential respects the same’.⁶⁴

[39] In the next two paragraphs⁶⁵ Lord Evershed MR dealt with the question of how a court would determine whether the infringing apparatus was substantially the same as the apparatus said to have been infringed. He *inter alia* said:

⁶¹ At 245 lines 15-28.

⁶² From 242 line 5 to 245 line 14.

⁶³ These cases included *Clark v Adie* (LR 10 ch 667, the House of Lords’ decision in *Clark v Adie* (1877) 2 App Cas 315 (HL); *The Incandescent Gas* case, the *Marconi* case; *BHT v Metropolitan Vickers Electrical Coy* (1928) 45 RPC 24; *RCA Photophone Ltd v Gaumont Picture Corporation* (1936) 53 RPC 167 and *Multiform Displays Ltd v Whitmarleys Displays Ltd* (1956) RPC 143.

⁶⁴ Lord Evershed at 244 line 51 to 245 line 3.

⁶⁵ Lord Evershed at 245 lines 4-15.

“In order to resolve this question it is necessary to determine what are the essentials of the particular invention claimed in any given case. We agree with Sir Lionel that generally speaking this must be ascertained by reference to the claim and to the claim alone. In *RCA Photophone v Gaumont British etc (supra)* at p 197 immediately after the passage already quoted, Romer LJ went on to say: ‘But it is not the province of the court to query what is or what is not the essence of the invention; that is a matter to be determined on an examination of the language used by the patentee in formulating his claims’.”⁶⁶

This last sentence might have been in conflict with the approach of the House of Lords as found in the speech of Lord Cairnes LC in the *Adie* case. In the next paragraph Lord Evershed sought to dispel any notion that what he had just said meant that he did not think that that question was a question of fact. He said:

“We do not however, exclude the possibility that, after the nature, scope and essential features of a given invention have been ascertained by construing the relevant claim, the question whether the alleged infringement is essentially or substantially the same as or different from the invention as claimed may become a question of fact and degree”.⁶⁷

[40] Lord Evershed also said that the question therefore was whether the allegedly infringing apparatus consisted of substantially the same parts acting upon each other in substantially the same way as the apparatus claimed as constituting the invention. He said it was not enough to find that the parts comprised in the Respondents’ apparatus individually or collectively perform substantially similar functions to those performed individually or collectively by the parts comprised in the apparatus claimed as the appellants’ invention that the respondents’ apparatus produced the same result as the appellants’ apparatus. It must be shown, continued Lord Evershed, that the respondents’ selection and arrangement of parts is substantially the same as the appellants’ selection and arrangement of parts because it would be in such selection and arrangement that the appellants’ invention resided.⁶⁸ The Court then went on to hold that the respondents’ apparatus, namely, RC 54, was substantially different from the appellants’ apparatus as claimed in the claiming clause. The Court said:

⁶⁶ Lord Evershed at 245 lines 4-10.

⁶⁷ Lord Evershed at 245 lines 11-14.

⁶⁸ Lord Evershed at 245 lines 29-38.

“As compared with the Plaintiffs’ invention as claimed, the Defendants’ construction introduced several new features. We note in particular the bell-crank lever biased for clockwise movement, the peg in its head, the two ‘cam surfaces’ (or, as we think they may properly be called, spaced abutment surfaces) on the detent, and the co-operation of the peg in the head of the bell-crank with the spaced abutment surfaces on the detent when the blade is depressed so as to produce the required degree of downward movement on the part of the stop-member through its connection to the extremity of the horizontal arm of the bell-crank. We note also the method of holding the stop-member in the starting position by means of the engagement of the hook at the top of the detent and the notch in the head of bell-crank.”⁶⁹

The Court found that there was no infringement. It is suggested that in the *Birmingham* case it was correctly found that the doctrine of pith and marrow was not applicable because the differences in the two devices were, at least in part, in respect of essential features. It is now necessary to turn to a discussion of the period: 1960 – 1978.

⁶⁹ Lord Evershed at 245 lines 39-49.

CHAPTER 3

3 THE ERA OF THE UPJOHN LJ APPROACH: 1960 – 1978

3.1 *Van der Lely* in the Court of First Instance¹

[1] In this case the appellants owned a patent for a hay rake, patent NO 680, 537. The respondent claimed to have invented a hay rake as well. For present purposes it can be accepted that the only difference between the two hay rakes was that, whereas the appellant's specification was to the effect that the hindmost wheels were dismountable, with the defendants' rake it was the foremost wheels that were dismountable. The appellants complained that the respondents' rake was an infringement of their patent relating to their rake. In the Chancery Division the trial Judge was Lloyd-Jacob J. Lloyd-Jacob J's judgment did not include any serious discussion of the principles relating to the determination of non-textual infringement of patents.

[2] Lloyd-Jacob J found that the accused apparatus did not correspond to the textual requirements of the relevant claim. He then turned to the question whether the accused apparatus could be said to infringe the substance of the patented invention. In this regard he said that, although it was true that the accused apparatus secured the result which the claimed device was adapted to produce, if a finding of infringement was to be justified, it was not the identity of result only but substantial identity of means whereby that result was secured that had to be established. In other words Lloyd-Jacob J saw the test as being whether the same result was secured by means that were substantially identical to the means contemplated in the claims.² Lloyd-Jacob J pointed out that, if the patentee had in fact appreciated that a vehicular frame could be devised which permitted conversion from side raking to swath turning by retention in position of the hindmost rake wheels of the original row, it would have been inconceivable that he would have framed the relevant claim in a language which expressly called for their removal.³

¹ C *Van der Lely NV v Bamfords Ltd* [1960] RPC 169 (Ch).

² Lloyd-Jacob J in *Van der Lely* at 197 lines 13-16.

³ Lloyd-Jacob J in *Van der Lely* at 197 lines 12-20.

[3] Lloyd-Jacob J thereafter referred to dicta in Sir Mark Romer’s judgment in *British-Hartford*⁴ and in Lord Russell of Killowen’s judgment in *EMI*. The one dictum was to the effect that, when the construction of a claim when read by itself was plain, it was not legitimate to diminish its ambit of the monopoly claimed merely because in the body of the specification the patentee had described his invention in more restricted terms than in the claims. The other dictum was to the effect that there was no rule or principle which would justify a departure from the unambiguous and grammatical meaning of a claim and narrowing or extending its scope by reading into it words which were not in it or which would justify one in using stray phrases in the body of the specification for the purpose of narrowing or widening the boundaries of the monopoly fixed by the plain words of the claim.

[4] In the *Van der Lely* case in the Court of first instance Lloyd-Jacob J found that the defendants’ apparatus did not infringe the plaintiffs’ patent. He set out the thrust of his reasons for his conclusion in these terms:

“In the present case, no passage in the specification can be found to support the suggestion that removal of any but the hindmost wheels was ever within the contemplation of the inventor. Save for the ingenuity of the Defendants in producing their device, it is unlikely that any reader of the specification would have appreciated that the transposition in claim 11 of the words ‘hindmost’ and ‘foremost’ would be required to identify the useful conversion of a particular raking device, still less to suppose that the Patentee so intended. For the reasons stated, infringement of Claim 11 has not been proved.”⁵

[5] What is noteworthy in Lloyd-Jacob J’s judgment is also the absence of any reference to the rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention. Indeed, he also made no reference to the question whether the variant added any value to the invention. It was Lloyd-Jacob J’s judgment in this case that marked the emergence of an approach to the determination of infringement of patents and the doctrine of pith and marrow which was later followed by the Court of Appeal and the House of Lords which is referred to elsewhere herein

⁴ *British-Hartford Fairmont Syndicate Ltd v Jackson Bros (Knottingly) Ltd* (1932) 49 RPC at 556.

⁵ Lloyd-Jacob J in *Van der Lely* in the Court of first instance at 197 lines 34-42.

as the “Upjohn LJ” approach. There was an appeal to the Court of Appeal. The judgment of the Court of Appeal is next for discussion. Lloyd-Jacob J’s approach was entirely based on the literal meaning of the claims.

[6] Lloyd-Jacob J’s approach was to ask whether or not there was any passage in the specification to support the suggestion that removal of any but the hindmost wheels was ever within the contemplation of the invention.⁶ He then said that save for the ingenuity of the defendants in producing their device, it was unlikely that any reader of the specification would have appreciated that the transposition in claim 11 of the words “hindmost” and “foremost” would be required to identify the useful conversion of a particular raking device, still less to suppose the patentee so intended.⁷ He then concluded that for these reasons the infringement of claim 11 had not been established.

[7] From the above it is clear that Lloyd-Jacob J adopted a very literalist approach to the construction of claim 11 by asking the question whether or not the specification had a passage which suggested the removal of any wheels other than the hindmost wheels. This approach left no room for a consideration of whether or not the difference introduced by the alleged infringer was introduced for no reason other than to disguise the theft of the patentee's invention. Indeed, Lloyd-Jacob J paid no attention to the rule on immaterial variations at all nor did he have regard to the question whether the difference was in form only and not in substance. Lloyd-Jacob J had no regard to the question whether or not the dismounting of the foremost wheels instead of the hindmost wheels as contemplated in the claim added any value to the invention or whether the difference was of any practical significance. If, therefore, one applied Lloyd-Jacob J’s approach to determine whether there was infringement in substance, one would simply have to ask the question whether or not there was a passage in the claims which covered the variant of the alleged infringer. This seems to require a literal “covering” of such variant. If the variant was not literally covered by the claims, then there was no infringement. That is in line with the approach that was later taken by the majority in the Court of Appeal and in the House of Lords in the same case. It is suggested that, if this approach were the correct approach, there would have

⁶ Lloyd-Jacob J in *Van der Lely* at 197 lines 35-37.

⁷ Lloyd-Jacob J in *Van der Lely* at 197 lines 35-43.

been no room for the application of the doctrine of pith and marrow in patent infringement cases. Lloyd-Jacob J also made no reference to the role of the national addressee.

[8] Lloyd-Jacob J's judgment on infringement in *Van der Lely* began what later became a very critical period of twenty years in English patent law. Lloyd-Jacob J's judgment was later followed and approved by both the Court of Appeal and the House of Lords. Lloyd-Jacob J also failed to refer to any of the important decisions. Finally, Lloyd-Jacob J did not even refer to the doctrine of pith and marrow or any of the well-known cases in which the doctrine had previously been dealt with authoritatively. Lloyd-Jacob J's approach was completely literalist. There was an appeal to the Court of Appeal. It is the decision of the Court of Appeal that falls to be discussed next.

3.2 *C Van der Lely in the Court of Appeal: Van der Lely v Bamfords Limited*⁸

[9] In the Court of Appeal the panel of Judges who heard the appeal comprised Lord Evershed MR, Upjohn LJ and Pearson LJ. Upjohn LJ and Pearson LJ gave a joint judgment in which they upheld the judgment of the trial Judge and found that the respondents' devices did not infringe the appellants' patent claims. For convenience Upjohn LJ's and Pearson LJ's joint judgment is referred to herein as Upjohn LJ's judgment. Lord Evershed MR dissented and found that there was infringement. One important difference between the two judgments was that in considering the issue of infringement, Upjohn LJ did not consider, nor, did he refer to, the rule on immaterial variations whereas Lord Evershed MR not only referred to that rule but he also took it into account. He also considered the practical significance or materiality of the variant before deciding on infringement. Upjohn LJ also did not consider the practical significance or materiality of the variant before deciding on infringement. It is convenient to discuss the judgment of Upjohn LJ, which was the judgment of the Court, first and, thereafter, that of the Master of the Rolls.

⁸ [1961] RPC 296 (CA).

3.3 The Majority Judgment of Upjohn LJ and Pearson LJ in *Van der Lely* in the Court of Appeal

[10] Although the majority judgment in the Court of Appeal in the matter of *Van der Lely* was a joint judgment of Upjohn LJ and Pearson LJ, for convenience only Upjohn LJ may sometimes be referred to in the discussion of the judgment in this dissertation. In dealing with the appeal in the Court of Appeal Upjohn LJ and Pearson LJ, *inter alia*, said:

“Now it is obvious that in fact the respondents have avoided textual infringement by the simple device of so arranging the parallel beam to carry the wheels for swath turning that it is necessary to move the foremost wheels backwards rather than the hindmost wheels forward. Put in another way, if the respondents’ machine was used by towing it in the opposite direction to its designed direction of travel (making suitable known mechanical adjustments) you would achieve a machine precisely within claims 11 and 12. *To that extent the respondent may be said to have taken the substance of the appellants’ invention. But that, in our opinion, does not dispose of the point, for it is clearly settled law that to infringe the patent it must be shown that the invention, as claimed in the relevant claim, has been infringed in all essential respects, essential that is to say, upon the true construction of the claim.*”⁹

Upjohn and Pearson LLJ went on to say:

“As a matter of construction of claim 11, it seems to us clear that the appellants have deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable and, as we have pointed out, the foremost wheels need not be. Why they so confined the claim it is not for us to speculate. The claim could presumably have safely been drawn to cover dismountability of either group (see for example claim 7 in the respondents’ later patent 753,478); but as the learned judge pointed out, apparently the appellants did not appreciate this possibility. We have come to the conclusion that there is no escape from the learned judge’s conclusion upon this point, and upon principle and authority we are bound to construe the words of the claim according to their clear and unambiguous meaning and to hold that claims 11 and 12 are not infringed.”¹⁰

[11] The fundamental basis for Upjohn LJ’s and Pearson LJ’s conclusion of non-infringement was the finding that “(a) as a matter of construction of claim 11, it seems to us that the appellants have deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable and, as we have already pointed

⁹ Upjohn LJ in the Court of Appeal in *Van der Lely* at 313 lines 4-15 (author’s emphasis).

¹⁰ Upjohn LJ in *Van der Lely* at 313 lines 16-26. Compare with Gordon Harris: “Trends in UK patent litigation: The age of reason?” (1999) 21/5 *EIPR* 254-263 at 255.

out, the foremost wheels need not be. Why they so concluded to confine their claim is not for us to speculate”. Upjohn LJ and Pearson LJ did not give any reasons for their finding that the patentees had “deliberately chosen” to make the dismountability of the hindmost wheels an essential feature. It was the same kind of approach as the one that had been adopted by Lloyd-Jacob J in the same case in the Chancery Division who had asked the question whether or not there was a passage in the relevant claims which suggested the dismountability of any wheels other than the hindmost wheels and decided the case on the basis simply of the answer to that question.

[12] It is suggested that the conclusion reached by Upjohn and Pearson LLJ that there was no infringement was erroneous. It followed upon their conclusion that the appellants had deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable and the foremost wheels need not be.¹¹ The fundamental error with this finding made by Upjohn LJ and Pearson LJ is that they seem to have regarded the mere fact that the appellants had mentioned detachability in relation to the hindmost wheels as enough to make the detachability of the hindmost wheels an essential feature of the patented invention. The mere mention of a feature is not and cannot without more be sufficient to make a feature essential. A claim in a specification will mention both essential and unessential features. If it were not so (and if the mere mention of a feature in a claim was sufficient to make the feature essential), the question for the determination of the essentiality of a feature would be whether or not it is mentioned in the claim.

[13] Another error made by Upjohn LJ in his judgment in coming to the conclusion that there was no infringement was that he had no regard to whether or not the detachability of the foremost wheels in the respondents’ apparatus as opposed to the hindmost wheels in the patentee’s invention added any value to the invention or whether there was any reason for the defendants’ decision to make the foremost wheels detachable as opposed to the hindmost wheels. This, it is suggested, was an important factor because, where the feature, objectively speaking, does not add any value in that it is immaterial to the operation of the invention, it is not going to be easy to conclude that the patentee has chosen to make such feature an essential feature

¹¹ Upjohn LJ in *Van der Lely* at 313 lines 16-26.

of his invention. Another factor is that Upjohn LJ overlooked the well-known rule of patent law that no one who borrows a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention. If Upjohn LJ had taken this rule into account, he would have reached the opposite conclusion to the one that he reached.

[14] Finally, Upjohn LJ said that to some extent the respondent could be said to have taken the substance of the appellants' invention.¹² When regard is had to what the law was at the stage of the *Van der Lely* case in the Court of Appeal in English patent law on the determination of the non-textual infringement of patent claims, this statement should inevitably have driven Upjohn LJ to the conclusion that there had been infringement. In this regard a reference to *Adie, Birmingham* and *Marconi* cases both of which were binding on Upjohn LJ would have reminded him that in terms of those decisions the question was whether or not the respondents had taken the substance of the appellants' invention. It is also to be noted that in his judgment Upjohn LJ made no reference whatsoever to any authorities, including *Clark v Adie, Birmingham* and *Marconi* which contained the relevant principles. If he had, he might have reached a different conclusion.

[15] Upjohn LJ's approach to or understanding of, the doctrine of pith and marrow was the same as the one reflected in Lloyd-Jacob J's judgment in the court of first instance. It was an approach that disregarded the rule of patent law on immaterial variations. It did not inquire into whether or not the difference introduced by the alleged infringer to the invention added any value or was of any practical significance to the operation of the invention. The approach which, for convenience, is referred to herein as the "Upjohn LJ" approach to the determination of infringement of patents and the doctrine of pith and marrow, uses almost exclusively the language employed by the patentee in framing his claim to determine whether an integer is essential or inessential and, therefore, whether the doctrine of pith and marrow applied or not and, therefore, whether there is infringement. The Upjohn LJ approach seems to in effect have taken the mere mention of an integer in a claim as evidence that the patentee intended it to be an essential feature of his invention in which case there would be no infringement.

¹² Upjohn LJ at 313 lines 10-15.

3.4 Lord Evershed MR's Dissent in *Van der Lely* in the Court of Appeal

[16] Lord Evershed MR disagreed with Upjohn LJ and Pearson LJ that there was no infringement. His view was that there was infringement. He wrote a dissenting judgment. Lord Evershed MR, *inter alia*, said:

“If attention must exclusively be directed to the strict language of the claim then the charge of infringement may well be said to be repelled because, in the respondents’ machine, the wheels which are dismountable are not the wheels ‘situated hindmost in the direction of motion of the vehicular frame’ but the foremost. So it is said, and this answer has appealed to my brethren, that the appellants having, for reasons best known to themselves, confined by its language the scope of their 11th claim to dismounting the hindmost (only) of the wheels, cannot complain of the device wherein not the hindmost but the foremost of the wheels are alone dismounted: and it is further said, and said truly, that it is the function of the claim to state precisely the scope of that for which the inventor desires protection. As Lord Russell of Killowen said in the *EMI* case (*EMI Ltd v Lissen Ltd* (1938) 56 RPC 23 at 41): It and it alone defines the monopoly; and the patentee is under a statutory obligation to state in the claim what is the invention which he desires to protect.”¹³

[17] Lord Evershed MR pointed that it was not always a defence to a claim of infringement for the alleged infringer to say that his device or process or apparatus did not exactly and in every respect fall within the precise language of the patentee’s claim.¹⁴ Lord Evershed MR thereafter said:

“Authorities of long standing and binding upon this court establish that infringement may occur if that which is done or proposed to be done ‘takes from the patentee’, in the language of Wills J, affirmed by this court in the case of *The Incandescent Gas Light Co. Ltd v The de Mare Incandescent Gas Light System Ltd* (1896) 13 RPC 301, ‘the substance of the invention’: if, in Lord Cairns’ classic phrase, the infringer has taken the ‘pith and marrow’ of the patentee’s claim.”¹⁵

A little later Lord Evershed MR said:

“True it is that the question of infringement ‘in substance’ normally arises where the patented device consists – as is very commonly the case – of a number of combined integers and where the device alleged to constitute infringement embodies some but not all of them; so that the question is resolved to this: whether the integers omitted or

¹³ At 318 lines 21.

¹⁴ At 318 lines 35-37.

¹⁵ Lord Evershed MR, in *Van der Lely* at 318 lines 37-43.

varied are ‘unessential’ characteristics of the claim properly construed as a whole. But in my judgment the principle involved is not, and cannot on principle be confined precisely to that class of case. The principle invoked remains where the device alleged to infringe only departs from the invention comprehended in the claim, properly construed, in respects which are, upon its true interpretation, not essential to the scope of the claim.”¹⁶

[18] Against the background of the fact that claim 11 referred to the dismounting of wheels situated hindmost in the direction of motion of the vehicular frame, Lord Evershed MR pointed out that, as he read the claims, “it was no essential part of the invention that the machine should move in direction, that is upwards as you look at the Figure rather than in the opposite direction.¹⁷ The direction is indicated, but only indicated by the small arrow near to the Figure itself. For the purposes of construing and appreciating the claims such direction is assumed. Nor is more light thrown upon the matter in the body of the specification. True, the line of the wheels must be oblique to the direction of movement; but this essential feature would be achieved whether the vehicle moved upwards or downwards on the sheet of Figures. The only reference to the fact or assumption that the direction is upwards is by reference to the Figures themselves ...”.¹⁸ Lord Evershed MR then turned to the question of how the defendants had sought to avoid the infringement of claim 11. He said that they had done this by merely reversing the direction of the machine. He continued:

“If the appellants’ machine and that of the respondents were placed side by side upon the ground without any indication of the direction of the traction, then those of the wheels to be displaced and remounted would be in both cases the same three. So in each case would the transition from side raking to swath turning be identically achieved. The result in each case would be that the six wheels would become disposed in the required position, ‘adjacent and parallel’. For my own part I would therefore hold that the appellants’ claimed device had in substance been infringed. Regarding the machines as pieces of mechanism the same three wheels of each are to be displaced and remounted; but because the directions in use are reversed, the three wheels are called hindmost in the one and foremost in the other.”¹⁹

[19] Lord Evershed MR also referred to James LJ’s well-known statement in the same court many years before where James LJ said in part:

¹⁶ At 318 line 50 to 319 line 10.

¹⁷ Lord Evershed at 319 lines 21-22.

¹⁸ At 319 lines 21-30.

¹⁹ Lord Evershed MR at 319 lines 33-44.

“The patent is for the entire combination but there is or may be an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect or is a substantially new or different combination.”²⁰

Lord Evershed MR endorsed Lord Cairns LC’s judgment in *Adie v Clark* in the House of Lords to the effect that the question would be “whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented and whether in what he had done he had not really taken and adopted the substance of the instrument patented”.²¹

[20] Lord Evershed MR then said:

“I add one citation from the speech of Lord Duredin in the case of *BTH v Metropolitan Vickers Electrical Co* (1928) 45 RPC 1 at 25: ‘The question for the court is not that of detecting absolute similarity but is that of seeing whether the pith and marrow of the combination, to use Lord Cairns phrase, has been taken and if that has been done, there is an infringement in spite of any combination.’²²

He also said that the question was a question of fact.²³ Lord Evershed MR’s judgment was an affirmation of the correct approach to the determination of non-textual infringement and the doctrine of pith and marrow, ie, the Lord Reid approach. Lord Evershed MR’s judgment became the first judgment in the Court of Appeal not to follow the Upjohn LJ approach. Lord Reid was to later build upon this judgment in his dissent in *Van der Lely* in the House of Lords. There was an appeal from the decision of the Court of Appeal to the House of Lords.

3.5 *Van der Lely v Bamfords* in the House of Lords²⁴

[21] The panel of Judges who heard the appeal in the House of Lords comprised Lord Reid, Viscount Radcliffe, Lord Jenkins, Lord Hodson and Lord Devlin. On the issue of whether the relevant claim, namely, claim 11, had been infringed, there had been a

²⁰ Lord Evershed at 319 quoting James LJ in *Clark v Adie* (1875) LR 10 (Ch) App 667 at 675.

²¹ Lord Evershed MR at 320 quoting from James LJ at 675.

²² Lord Evershed MR at 320 line 4.

²³ At 320 line 17.

²⁴ *C Van der Lely NV v Bamford Ld* (1963) RPC 61 (HL).

difference of judicial opinion in the Court of Appeal. There occurred a difference of judicial opinion in the House of Lords as well. In the House of Lords, Lord Reid found that there was infringement whereas the rest of the members of the panel found that there was no infringement. In deciding the issue of infringement in this case the majority was rigid and seemed to think that they were required to hold the patentee strictly to the terms of his claims irrespective of the results thereof whereas the minority was prepared to invoke the doctrine of pith and marrow to decide the matter.

[22] Lord Reid thought that the doctrine of pith and marrow was applicable and could be invoked in this case whereas the majority thought that this was not a case where that doctrine was applicable. In fact Viscount Radcliffe pointed out that a patentee had a basic duty to state clearly what his invention was for which he sought protection.²⁵ He also pointed out that “one must be very careful when one speaks of theft or piracy of another’s invention or when the principle of pith and marrow is invoked to support such accusation to see that the inventor has not by the actual form of his claim left open to the world the appropriation of just that property that he says has been filched from him by piracy or theft”.²⁶

[23] None of the Judges who found that there was no infringement inquired into whether or not the variant in the *Van der Lely* case added any practical value to the functioning of the invention. Viscount Radcliffe actually refrained from inquiring into the question whether or not the dismountability of the hindmost wheels was an essential.²⁷ This was because he took the view that the patentee had himself “told us by the way that he has drawn up claim 11 that this dismountability of the hindmost wheels is the very element of his idea that makes it an invention”.²⁸ None of the Judges who found that there was no infringement ever considered what the interpretation was that a person skilled in the art would have attached to claim 11. Nor, indeed, did they ask the question whether it would have been obvious to a person skilled in the art that dismounting the foremost wheels would have made any material difference. The majority gave their own interpretation to claim 11 and concluded that the patentee had effectively said in the claim that the dismountability of the hindmost

²⁵ Viscount Radcliffe at 78.

²⁶ Viscount Radcliffe at 78 lines 23-28.

²⁷ Viscount Radcliffe at 78 lines 23-28.

²⁸ Viscount Radcliffe at 78 lines 25-28.

wheels was the very element of his invention. The majority, therefore, held that there was no infringement of the patent and upheld Upjohn LJ's judgment in the Court of Appeal.

[24] One of the observations that can be made about the judgments of the judges who found no infringement is that those Judges all failed to deal with the reasons upon which Lord Reid relied to find that there was infringement. It is suggested that they were obliged to have considered Lord Reid's reasons for his dissent and to have dealt with them and, if they did not find them persuasive, to have given reasons why they found those reasons unpersuasive. It is now necessary to deal with the minority judgment of Lord Reid who found that there was infringement.

3.6 Lord Reid's Dissent in *Van der Lely* in the House of Lords

[25] One of the appellants' complaints was that the respondents had infringed claim 15. Claim 15 was in the following terms:

“A device as claimed in any one of the preceding claims wherein the rear ground wheel of the vehicular frame is adjustable in a horizontal direction and can be fixed in any desired position with respect to the longitudinal axis of the device”.²⁹

The respondents' defence to the claim of infringement of claim 15 was that “any desired position in claim 15 meant any position which may be desired by the farmer when he came to use the machine”. Lord Reid then said: “They had incorporated the device in a way that there were only four positions in which rear wheels can be fixed and they say that this is not within the claim because the farmer cannot put the wheel in some other position if he desired to do so. To my mind there is no substance in this point. The specification is addressed to the man who is making the machine and it says to him: you may arrange to fix the wheel in any positions you may desire and the machine will work in all of them. No doubt the manufacturer is concerned to choose positions which are likely to suit the needs of his customers, but that is not the concern

²⁹ At 302 in *Van der Lely* in Upjohn LJ's judgment.

of the patentee. He is giving directions to the manufacturer. I am therefore of the opinion that this claim has been infringed, and that the cross-appeal fails.”³⁰

[26] Another important question for decision in the *Van der Lely* matter was whether the respondent had infringed claim 11. Lord Reid regarded this issue as the most difficult in the case.³¹ He described the scenario with regard to claim 11 thus:

“On that question there was a difference of opinion in the Court of Appeal, Lord Evershed holding that there had been infringement. The respondents have copied the appellants’ method of conversion of the machine to a swath turner with one difference. The appellants dismount the three hindmost wheels of the row of six and remount them separately in accordance with claim 11. The respondents do exactly the same except that they dismount and remount the three foremost wheels. They cannot point to any mechanical reason for doing this or to any advantage resulting from it. It is simply done to try to evade the claim, and the respondents’ method is the exact mechanical equivalent of the appellants’ method. But they do avoid textual infringement of claim 11 because claim 11 refers to dismounting ‘rake wheels situated hindmost in the direction of motion.’”³²

It is important to point out that in this passage Lord Reid, *inter alia*, directed his attention to why the respondents had decided to dismount the foremost wheels and not the hindmost wheels as well as whether introducing such difference to the invention affected in anyway the functioning of the apparatus. These were important issues to consider in seeking to determine liability for non-textual infringement of a patent.

[27] Lord Reid dealt³³ with the question whether the respondents had infringed claim 11 of the appellants’ patent by dismounting the three foremost wheels whereas claim 11 referred to the dismounting of the three hindmost wheels. Lord Reid said:

“Copying an invention by taking its ‘pith and marrow’ without textual infringement of the patent is an old and familiar abuse which the law has never been powerless to prevent. It may be that in doing so there is some illogicality, but our law has always preferred good sense to strict logic. The illogicality arises in this way. On the one hand the patentee is tied strictly to the invention which he claims and the mode of

³⁰ Lord Reid at 75 lines 14-23.

³¹ Lord Reid at 75 line 24.

³² Lord Reid at 74 lines 25-36.

³³ Lord Reid at 75 lines 25-36.

effecting an improvement which he says is his invention. Logically it would seem to follow that if another person is ingenious enough to effect that improvement by a slightly different method he will not infringe. But it has long been recognised that there ‘may be an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination’ (Per James LJ, in *Clark v Adie* (1873) LR 10 Ch 667). It was in *Clark v Adie* that Lord Cairns used the expression ‘pith and marrow’ of the invention: (1877) 2 App Case 315 at 320.”⁹³

Leger, after quoting this passage from Lord Reid’s judgment in *Van der Lely*, says³⁴ Lord Reid’s comments in that judgment have been applied to the evolution of the law of infringement in substance in Canada. This is interesting to note because Lord Reid’s judgment was a minority judgment and dissent and not that of the majority. The approach adopted by Lord Reid in *Van der Lely* on patent copycats and patent pirates seems to have subsequently been echoed by Mr Justice Binnie of the Supreme Court of Canada in the *Free World* case where he said:

“It would be unfair to allow a patent monopoly to be breached with impunity by a copycat device that simply switched bells and whistles, to escape the literal claims of the patent”.³⁵

[28] A reading of the specification in general and claim 11 in particular in the *Van der Lely* case would reveal that there was no mention that the foremost wheels could not be dismounted in order to achieve the same result. That alone should not necessarily mean that a person who then produced the same apparatus or device but substituted the dismounting of the foremost wheels for the dismounting of the hindmost wheels necessarily did not infringe. It is suggested that the inquiry should not be such a shallow one. One further issue that should have been considered was whether or not there was a special reason underpinning the choice of dismounting the foremost wheels. Put differently, the further question should have been asked whether dismounting the foremost wheels instead of the hindmost wheels as was envisaged in the claim of the patented invention added any value to the invention or its functioning. If it did, that would have been a basis to conclude that the accused apparatus or device did not constitute an infringement. If, however, the answer was that the dismounting

³⁴ Leger at 230.

³⁵ Binnie J at par 55 in *Free World*.

of the foremost wheels was not based on any particular reason or did not really add any value to the apparatus or device, it is suggested that that should have led to the conclusion that an infringement of the patented invention had been established because it would constitute an immaterial variation. In this regard the rule on immaterial variations would have come into operation. The majority in both the Court of Appeal and the House of Lords in the *Van der Lely* case completely overlooked this principle.

[29] One reason why the passage appearing at 75 lines 38 to 52 of Lord Reid’s speech in *Van der Lely* is significant is the statement he quoted from the judgment of James LJ, in *Adie*. That is the statement that “... invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact *whether the alleged piracy is the same in substance and effect*, or is a substantially new or different combination”.³⁶ Lord Reid went on to say: “I cannot imagine any more obvious equivalent than substituting the foremost for the hindmost wheels in this machine. So the question is whether selecting the hindmost wheels in claim 11 makes them an essential or an unessential integer.”³⁷ Lord Reid pointed out that he would agree that, if there were only one novel integer in a particular claim, the patentee could not be heard to say that it was unessential.³⁸ He continued and said that, “(if) the specification of the hindmost wheels were the important part of claim 11 or the only novel feature in it I cannot imagine how it could be held that claim 11 was valid or involved in any inventive step”.³⁹ He then pointed out in the next sentence that “(n)othing could be less inventive than selecting the hindmost as against the foremost wheels when the selection makes no practical difference as regards efficiency”.⁴⁰

[30] It is clear from Lord Reid’s speech that he sought to establish why the defendant had decided upon the variant. Lord Reid asked whether there was any mechanical reason for the variant or any advantage resulting from the variant.⁴¹ Lord Reid also stated that “nothing could be less inventive than selecting the hindmost as against the

³⁶ Lord Reid at 76 lines 10-13 (author’s emphasis).

³⁷ Lord Reid at 76 line 14.

³⁸ Lord Reid at 76 lines 13-22.

³⁹ Lord Reid in *Van der Lely* at 76 lines 18-21.

⁴⁰ Lord Reid in *Van der Lely* at 76 lines 21-23.

⁴¹ Lord Reid in *Van der Lely* at 75 lines 31-33.

foremost wheels when the selection makes no practical difference as regards efficiency”.⁴²

[31] It is convenient to pause here and make some important point that should be made now rather than later. A few paragraphs earlier there is a statement within a passage quoted from Lord Reid’s speech to the effect that the respondents had copied the appellants’ apparatus in every respect except that the wheels that were dismantled in the apparatus were the three foremost wheels instead of the three hindmost wheels in the case of the apparatus of the appellants and in accordance with the terms of claim 11. Lord Reid also made the point – and the point was common cause – that the respondents could not point to any mechanical reason for dismantling the three foremost wheels instead of the three hindmost ones nor could they advance any advantage resulting from it.

[32] It is suggested that Lord Reid could well have stopped the inquiry at that stage. It is suggested that the rule should be that, where the only difference between the patentee’s invention and the alleged infringer’s apparatus is one for which the alleged infringer can advance no mechanical reason nor advantage, that should be the end of the inquiry where the two devices or processes are otherwise the same. It is difficult to understand how the other Judges reached a different conclusion in a case where the respondents could not justify the only difference they had made to the invention. It ought to have been crystal clear to all concerned that the sole reason for the respondents’ decision to dismantle the foremost wheels in their apparatus instead of the hindmost wheels as specified in the patentee’s claim was to disguise their “theft” of the appellant’s invention.

[33] In the Court of Appeal Lord Evershed MR dealt specifically in his dissent with how the respondents had sought to avoid infringement of the appellants’ claim. He wrote that so far as relevant to the claim then under consideration, the respondents had done no more than reverse the direction of the machine. He said that, if the appellants’ machine and that of the respondents were placed side by side upon the ground without any indication of traction, then those of the wheels to be displaced and remounted

⁴² Lord Reid in *Van der Lely* at 76 lines 21-24.

would be in both cases the same three. So, said Lord Evershed MR, in each case would the transition from side raking to swath turning be identically achieved. He said that the result in each case would be that the six wheels would become disposed in the required position, adjacent and parallel.⁴³ A line or two later Lord Evershed said:

“Regarding the machines as pieces of mechanism the same three of the wheels of each are to be displaced and remounted but, because the directions are reversed, the three wheels are called hindmost in the one and foremost in the other”.⁴⁴

[34] Lord Reid discussed how the Court determined what is and what is not an essential integer. He said that the authorities revealed a difference of opinion. He stated that sometimes it was said that it was a question of construction of the specification and sometimes it was said that you must have regard to all the facts.⁴⁵ The impression that the two approaches created was that it was the Court that determined what was and what was not an essential integer. This is highlighted herein in contrast to an approach that is based on the intention of the patentee as is the case with the *Catnic* test.

[35] Fox says⁴⁶ that the question whether a particular feature for which a mechanical equivalent has been substituted is essential to the invention is one of fact and the answer to the question whether a particular feature is essential must depend on the facts of each case and by considering the magnitude and value of the things taken and of those left or varied. In support of this last part of the statement, Fox relies on *Van der Lely NV v Bamfords Ltd* (1963) RPC 61 at 76 and *Rodi and Wienenberg AG v Henry Showell Ltd* (1966) RPC 441 at 467. Fox’s reliance on both the *Van der Lely* and *Rodi* cases for support for the last part of his statement is, with respect, not supported by what was said in the pages of the judgments which he has cited in respect of both cases. In fact support for the last part of his statement is to be found not in *Van der Lely* or *Rodi* but in Wills J’s judgment in *The Incandescent Gas Light case*.⁴⁷ Talking about making a comparison of the alleged infringement to the specification to see if the alleged infringement constitutes substantially the appropriation of the thing claimed, Wills J, *inter alia*, said:

⁴³ At 319.

⁴⁴ At 319.

⁴⁵ Lord Reid in *Van der Lely* at 76 lines 27-28.

⁴⁶ Fox at 579.

⁴⁷ See (1896) 13 RPC 301(QBD) at 330 lines 30-37.

“When however, you come to make that comparison, how can you escape from that considering the relative magnitude and value of the things taken and those left or varied?”⁴⁸

[36] Soon after stating the two approaches relating to how to determine what is and what is not an essential integer, Lord Reid stated that he doubted whether there was much difference between the two approaches. He continued:

“If the specification makes it clear that the patentee regards a particular integer as essential, then it must be treated as essential, but otherwise even if the question is one of construction of the specification I cannot see why one should shut one’s eyes to facts of which the patentee must have been aware when framing the specification”.⁴⁹

[37] The first part of the passage just quoted from Lord Reid’s speech suggests that, as long as the specification makes it clear that the patentee intended a particular integer to be essential, then it is essential. However, the second part of the same passage seems to qualify that and seems to suggest that the Court may hold an integer to be essential even if there is nothing in the specification to suggest that the patentee had intended it to be treated as an essential integer. That is why Lord Reid said that he could not see why the Court would have to shut its eyes to facts of which the patentee must have been aware at the time of framing his specification. In the next paragraph of his speech Lord Reid seemed to make this clear. He had this to say:

“I think that Lloyd-Jacob J and Upjohn LJ, delivering the judgment of himself and Pearson LJ, have taken too narrow a view of this matter. It must be true, as Lloyd-Jacob J, says, that in framing their specification the appellants did not appreciate that the same result could be achieved by moving the foremost wheels, for otherwise they would have made their claim wide enough to cover this. But surely the same must be true of most if not all cases where there is an attempt to avoid infringement by the substitution of a mechanical equivalent: if the patentee had foreseen that possibility he would have made his claim cover it. If that were a good reason for refusing protection to the patentee against a person who later thinks of and adopts the mechanical equivalent, it seems to me that there would be very little left of this principle. Upjohn LJ, said that the appellants ‘have deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable. If by that he meant that there is something in the specification to show that they deliberately refrained from including the foremost wheels or went out of their way to make the hindmost wheels an essential feature I cannot find anything on which to base such a conclusion. But I do not think that he meant that, because he went on to agree with Lloyd-Jacob J that apparently the appellants did not appreciate the possibility that the foremost wheels might be moved. So I think that he must have meant that the mere fact that they only mentioned the hindmost wheels was sufficient to

⁴⁸ Wills J in *The Incandescent Gas Light* at 330 lines 30-37.

⁴⁹ Lord Reid at 76 lines 29-33.

make the limitation to the hindmost wheels an essential feature of the claim. But if that were right, then I cannot see how there could ever be an unessential feature or how this principle could ever operate. And I think that the principle is very necessary to prevent sharp practice.”⁵⁰

[38] Special attention should be drawn to Lord Reid’s statement in the above passage that Lloyd-Jacob J, Upjohn LJ and Pearson LJ took a narrow view of the matter. The narrow view to which he is referring is the view they took to the determination of non-textual infringement and the doctrine of pith and marrow. He demonstrates that narrow view by referring to the fact the Lloyd-Jacobs J said (and this is what Upjohn and Pearson LLJ also approved on appeal in the Court of appeal) that in framing their specification in *Van der Lely* the appellants had not appreciated that the same result could be achieved by moving the foremost wheels instead of the hindmost wheels for otherwise they would have made their claim wide enough to cover it. Lord Reid says that, although this must have been true, it did not necessarily mean that the doctrine of pith and marrow did not apply because of this. He said the same was true of most if not all cases where an attempt has been made to avoid infringement by the substitution of a mechanical equivalent. Lord Reid was in effect saying that the approach adopted by the three Judges would make it impossible to find a case where the doctrine of pith and marrow would apply.

[39] In making the statement that the mere mention of a feature in a patent claim is not itself sufficient to justify the conclusion that such a feature was intended by the patentee to be an essential integer, Lord Reid echoed a point which had previously been made by Thorson P in Canada in the case of *McPhar v Sharpe*.⁵¹ What emerges from the passage is that Lord Reid held that the mere fact that a patentee did not foresee that the same result could be achieved by a different combination did not necessarily mean that there was no infringement.

[40] Lord Reid used his own judgment to determine whether an integer or a feature was essential. He said:

⁵⁰ Lord Reid at 76 lines 34 to 77 lines 4.

⁵¹ See *Hitchmann and McOdrum* at 187 point no 9; *McPhar Engineering Co v Sharpe Instruments Ltd* (1960) [1956-60] Ex CR 467.

“in my judgment taking the way in which the specification is framed and the nature of the mechanism in respect of which this claim is made, the reference to the hindmost wheels is of minor importance and is an unessential integer. The respondent’s substitution of the foremost wheels is merely a mechanical equivalent and therefore they must be held to have infringed this claim.”⁵²

[41] After referring to what he called the illogicality which he said arose from the fact that, on the one hand, the patentee “is tied strictly to the invention which he claims and the mode of effecting an improvement which he says is his invention and therefore, that it should follow that, if another person is ingenious enough to effect that improvement by a slightly different method, he will not infringe”, Lord Reid pointed out that it had “long been recognised that ‘there may be an essence or substance of the invention underlying the mere accident of form; and that invention like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination’ (per James LJ in *Clark v Adie* (1873) LR 10 Ch 667. It was in *Clark v Adie* that Lord Cairns used the expression ‘pith and marrow of the invention’ (1877 2 App Cas 315 at 320).”⁵³

[42] A careful study of Lord Reid’s speech in *Van der Lely* reveals that he did not refer to the rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations. However, what is clear from that speech is that Lord Reid did place a lot of emphasis on whether the variant was material or immaterial which inquiry precedes the application of that rule. It is also clear from Lord Reid’s speech that, once he found that the variant was immaterial, he proceeded to conclude that there was infringement. That approach is an application of that rule. Accordingly, although Lord Reid made no express reference to that rule, he did consider the materiality of the variant and effectively applied that rule without expressly referring to it.

[43] Support for the last mentioned proposition is derived from the fact that Lord Reid asked himself the question of what practical difference the defendants’ choice of the foremost instead of the hindmost wheels was. When he found that that selection made

⁵² Lord Reid in *Van der Lely* at 77 lines 5-9.

⁵³ Lord Reid in *Van der Lely* at 75 lines 40-52.

no practical difference, he concluded that the defendants' selection of the foremost instead of the hindmost wheels was an obvious equivalent and that, therefore, the defendants' apparatus infringed the plaintiffs' patent. He said:

"I cannot imagine any more obvious equivalent than substituting the foremost for the hindmost wheels in this machine".⁵⁴

Later Lord Reid said:

"Nothing could be less inventive than selecting the hindmost as against the foremost wheels when the selection makes no practical difference as regards efficiency".⁵⁵

Lord Reid went on to say:

"How then are we to determine what is and what is not an essential integer? The authorities show an apparent difference of opinion. Sometimes it is said that it is a question of construction of the specification and sometimes it is said that you must have regard to all the facts. I doubt if there is much difference between these points of view. If the specification makes it clear that the patentee regards a particular integer as essential, then it must be treated as essential, but otherwise, even if the question is one of construction of the specification I cannot see why one should shut one's eyes to facts of which the patentee must have been aware when framing the specification."⁵⁶

[44] Lord Reid later pointed out that the mere fact that an integer had been mentioned in a claim was not by itself enough to justify the conclusion that it was an essential integer or that it was intended by the patentee to be an essential integer. The Appellate Division of the Supreme Court of South Africa seems to have been in agreement with Lord Reid on this point. In *Frank and Hirsch (Pty) Ltd v Rodi and Weinenberger Aktiengesellschaft* Schreiner JA said:

"Whether a feature can actually be claimed, as opposed to being merely mentioned, without being an essential of the claim seems to be largely a matter of terminology. If a feature is claimed it may on one view be said to have been thereby made an essential, or one may say that, though claimed, it must still be examined in the light of its apparent importance, having regard to the language of the claim, to see whether it is essential or not. The latter usage seems preferable, as avoiding verbalistic inquiries

⁵⁴ Lord Reid in *Van der Lely* at 76 lines 10-11.

⁵⁵ Lord Reid in *Van der Lely* at 76 lines 21-24.

⁵⁶ Lord Reid in *Van der Lely* at 77 lines 5-9.

as to whether a feature mentioned in a claim is actually claimed. The question of substance is whether a feature is essential to the invention or not.”⁵⁷

[45] Lord Reid then concluded the discussion of the issue of infringement by pointing out that in his judgment, taking the way in which the specification was framed and the nature of the mechanism in respect of which the claim was made, the reference to the hindmost wheels was merely a mechanical equivalent and therefore the alleged infringers had to be held to have infringed the claim.⁵⁸ From this passage it is clear that Lord Reid used his own judgment to determine whether or not the relevant integer was essential but also had regard not only to the specification but also to the nature of the mechanism in respect of which the claim had been made. Annand suggests that in *Van der Lely* Lord Reid was looking to the essence or equity of the plaintiff’s invention and not to its formal expression in the claim.⁵⁹ This accords with the suggestion made elsewhere in this dissertation that the approach of the majority in *Van der Lely* both in the Court of Appeal and in the House of Lords was one which elevated form above substance. It was too formalistic.

[46] Finally, special attention needs to be drawn to a feature of Lord Reid’s speech that, it seems, was to later influence Lord Diplock’s approach to the construction of patent claims in his *Catnic* decision that will be dealt with in due course. That is whether or not it would have been obvious to the patentee at the time of the publication of the specification that the variant would affect the way that the invention works. Lord Reid said: “... You cannot avoid infringement by substituting *an obvious equivalent* for an unessential integer”.⁶⁰ Lord Reid continued and said that “[n]othing could be less inventive than selecting the hindmost as against the foremost wheels when the selection makes *no practical* difference as regards efficiency”.⁶¹ Lord Reid said that he would dismiss the appeal except in regard to the infringement of claim 11 in respect of which he would allow the appeal. He said that he would dismiss the cross-appeal.

⁵⁷ Schreiner JA in *Frank and Hirsch (Pty) Ltd v Rodi and Weinenberger Aktiengesellschaft* 1960 (3) SA 747 (A) at 762H-763A.

⁵⁸ Lord Reid in *Van der Lely* at 77 lines 5-9. Fox has expressed the view that the determination of the exact nature of what constitutes the substance of invention is often a matter of considerable difficulty depending largely upon due construction of the specification. See Fox at 357.

⁵⁹ Annand (1992) *Anglo American Law Review* 39 at 43.

⁶⁰ Lord Reid in *Van der Lely* at 76 lines 6-7 (author’s emphasis).

⁶¹ Lord Reid in *Van der Lely* at 76 lines 21-24 (author’s emphasis).

[47] It is very surprising that in their discussion of the *Van der Lely* case Hitchman and McOdrum⁶² have said absolutely nothing about the important dissent of Lord Reid and the significance of his approach. However, they do say that the *Van der Lely* decision of the House of Lords held that, although the doctrine of infringement in substance was not dead, the form of claim might well prevent the patentee from relying upon that doctrine.⁶³ It is also suggested that these authors' statement about the majority decision of the House of Lords lends credence to the suggestion made elsewhere in this dissertation that the decision elevated form above substance.⁶⁴

[48] Leger states that the *Van der Lely* case, which he says had been the source of inspiration for the doctrine of infringement in substance in Canada,⁶⁵ was also the source of inspiration for the doctrine of purposive construction in the *Catnic* case.⁶⁶ Leger must be referring to Lord Reid's judgment in *Van der Lely*. If so, his view in regard to Lord Reid's judgment in *Van der Lely* being a source of inspiration for the doctrine of purposive construction in *Catnic*, would not be inconsistent with the view expressed in this dissertation that in *Catnic*, Lord Diplock borrowed some of the features of the Lord Reid approach to the construction of patents, the determination of patent infringement and the doctrine of pith and marrow.

3.7 Lord Jenkins' Judgment

[49] In the *Van der Lely* case Viscount Radcliff, Lord Jenkins, Lord Hodson and Lord Devlin concurred in all the views expressed by Lord Reid in his speech except on the issue of whether or not the respondents had infringed claim 11. On the latter point Lord Jenkins expressed a different view and the rest of the Court agreed with him. It is convenient to first discuss Lord Jenkins' speech before a discussion of Viscount Radcliff's speech. Lord Jenkins expressed agreement with the conclusion of the Judges of the Court of Appeal and Lloyd-Jacob J, who had dealt with the matter at first instance. He quoted a passage from the majority judgment of Upjohn LJ and

⁶² Hitchman and McOdrum (1990) 167 at 169.

⁶³ Hitchman and MacOdrum at 175.

⁶⁴ Hitchman and MacOdrum at 169.

⁶⁵ Although Leger did not make a reference to Canada in making this point at 237, the context of the discussion is such that he must have meant Canada. He referred to the importation into Canada of the law of "good sense" of Lord Reid as contained in his speech in *Van der Lely* (Leger at 237).

⁶⁶ Leger at 237.

Pearson LJ in the Court of Appeal which, he held, correctly reflected the legal position.⁶⁷

[50] What can be distilled from the passage from Upjohn LJ's judgment referred to above is that a patentee would be held to what was taken to be his choice of what he claimed to be essential integers and what he did not claim was disclaimed. Furthermore, the passage is to the effect that, if the meaning of the claim or the specification was clear and unambiguous, there was no need not to give effect thereto. Lord Jenkins approved the finding of the majority in the Court of Appeal that the appellants had deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable and the foremost wheels did not need to be.⁶⁸ In that passage the Court of Appeal did not state the basis for its conclusion.

[51] In the *Van der Lely* case Lord Jenkins also quoted, with approval, another passage from Upjohn LJ's judgment in the Court of Appeal. In that passage Upjohn LJ quoted a statement by Sir Mark Romer in *British Hartford* to the effect that, when the construction of a claim, read by itself, was plain, it was not legitimate to diminish the ambit of the monopoly claimed merely because in the body of the specification the patentee had described his invention in more restricted terms than in the claim itself.⁶⁹ There, Sir Mark Romer had also quoted a statement from Lord Russell of Killowen in *EMI*. Lord Russell's statement was to the effect that he knew of no canon or principle which would justify one in using stray phrases in the body of the specification for the purposes of narrowing or widening the boundaries of the monopoly fixed by the plain words of the claim.⁷⁰

[52] Lord Jenkins went on to describe what the difference was between the hay rake of the appellant and that of the respondents. He pointed out that the argument in support of the charge of infringement was based on the doctrine of pith and marrow and that Claim 11 required, in the course of the operation described, the dismounting and

⁶⁷ Upjohn LJ and Pearson LJ in *Van der Lely* in the Court of Appeal as quoted by Lord Jenkins in *Van der Lely* at 79 lines 9-19. The passage that Lord Jenkins quoted from the judgment of Upjohn LJ and Pearson LJ is at 313 lines 16-26

⁶⁸ Here Lord Jenkins was quoting a passage from the judgment of Upjohn LJ in the Court of Appeal in *Van der Lely*.

⁶⁹ (1932) 49 RPC 495 at 556.

⁷⁰ (1939) 56 RPC 23 at 41.

remounting of the three hindmost wheels, and the appellants' machine as operated complied with that requirement. Lord Jenkins further observed that, on the other hand, the respondents dismounted and remounted the three foremost wheels of their apparatus, making, he understood, no other change. He pointed out that in these circumstances the doctrine of pith and marrow was called in aid and it was claimed that the respondents' use of the foremost wheels was a mere colourable device, designed to enable the respondents to take the substance of the appellants' invention, under cover of a wholly unessential and superfluous feature in the shape of the substitution of the foremost for the hindmost wheels.⁷¹

[83] Lord Jenkins stated that he could not agree that *Van der Lely* was a proper case for the application of the pith and marrow principle. He said that each case had to be decided on its own facts. Then he said that in that case, whatever the reason, the appellants had deliberately framed claim 11 so as to exclude the use of the foremost wheels. That, in his opinion, left it open to the respondents to arrange their wheels in any way they chose provided they did not interfere with the appellants' arrangement. Lord Jenkins did not think that the doctrine of pith and marrow applied in the case. He said that it should be noted that the appellants themselves wanted for some reason or other the arrangement of wheels which was said to have led to the infringement of claim 11. He thought it would be unfair and oppressive to hold the respondents guilty of infringement of claim 11 merely because they did what the language of claim 11 in effect allowed them to do.⁷² If this last sentence does not reflect a literalist approach in the extreme on the part of Lord Jenkins, then literalism does not exist. In that sentence Lord Jenkins revealed a misunderstanding of the doctrine of pith and marrow. He implied that the doctrine of pith and marrow did not apply where the alleged infringer did what the language of the patentee's claim allowed him to do or did not prevent him from doing. The fact of the matter is that all cases in which the doctrine of pith and marrow is invoked are cases where the device or apparatus of the alleged infringer falls outside the strict language of the patent claim. Where such apparatus or device falls within the textual language of the claim, textual infringement occurs and the doctrine of pith and marrow does not apply.

⁷¹ Lord Jenkins in *Van der Lely* at 79 lines 37-47.

⁷² Lord Jenkins in *Van der Lely* at 80 lines 1-10.

[54] Lord Jenkins' judgment to the effect that there was no infringement of claim 11 is unpersuasive. It is simply an upholding of literalism in the construction of patent specifications and of documents generally which held sway in English law for a long time prior to the 1980's. Lord Jenkins' approach did not look beyond the literal meaning of words used in a patent claim or specification, no matter what the consequences were. He said that *Van der Lely* was not a case in which the pith and marrow principle applied but did not explain what it would take for a case to attract the application of that principle. He held the appellants to the literal meaning of the claim despite the fact that the respondents could not explain why they used the foremost wheels instead of the hindmost wheels, even when it was accepted that the use of the foremost wheels was a superfluity. It is suggested that Lord Reid's judgment to the effect that the respondents' device infringed claim 11 is a much sounder judgment, is persuasive, full of common sense and advanced the battle against patent piracy. Lord Jenkins' approach promoted the cause of patent pirates. Finally, it needs to be noted that Lord Jenkins did not have regard to whether or not the variant in this case had any practical significance to the functioning of the hay rake nor did he refer to or have regard to the rule on immaterial variations. This resulted in him wrongly concluding that the doctrine of pith and marrow did not apply.

3.8 Viscount Radcliffe's Judgment

[55] Viscount Radcliffe, Lord Hodson and Lord Devline concurred in Lord Jenkins' judgment on the issue of the infringement of claim 11. Viscount Radcliff stated that the "pith and marrow" principle "is from first to last directed to the prevention of abuse of patent rights by colourable evasion; it is not a special or 'benevolent' method of construing an uncertain claim: and I think that [Counsel for the respondents] is right to remind us that the basic duty of the patentee to state clearly what is the invention for which he seeks protection and the modern practice of building up patent claims by a meticulous accumulation of separate or combined elements has left a good deal less room for a patentee to complain of abuse, where there is no textual infringement, than may have been allowed to him at some periods in the past."⁷³

⁷³ Viscount Radcliffe in *Van der Lely* at 78 lines 1-9.

[56] Viscount Radcliffe went on to caution that when one speaks of theft or piracy of another's invention or says that it has been "taken" by an alleged infringer and the "pith and marrow" principle is invoked to support the accusation, one must be very careful to see that the inventor has not by the actual form of his claim left open to the world the appropriation of just that property that he says has been filched from him by piracy or theft. This statement by Viscount Radcliffe suggests that in his view the actual form of a patentee's claim could be such that it allowed someone else to in effect take the substance of the patentee's invention. He then said: "After all, it is he who has committed himself to the unequivocal description of what he claims to have invented, and he must submit in the first place to be judged by his own action and words".⁷⁴ The rest of what Viscount Radcliffe said in his judgment says nothing more than the following two points:

- (a) the patentees could not complain if the respondent dismounted the foremost wheels;
- (b) the appellants had, according to Viscount Radcliffe, in effect said in claim 11 that their invention lay in its application to the hindmost wheels.⁷⁵

[57] In his separate judgment in *Van der Lely*, Viscount Radcliffe said that he could not "embark upon an enquiry whether the dismountability of the hindmost wheels is an essential or unessential element of the invention claimed, because it seems to me that the patentee himself has told us by the way that he has drawn up claim 11 that this dismountability of the hindmost wheels is the very element of his idea that makes it an invention".⁷⁶ He went on to say that "(w)hen one says, then, as has been said by the majority of the Court of Appeal, that the appellants have deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable', what one means is not merely that the wording of this claim has been carefully selected, as has all the rest of the patent document, to put the appellants in a strong position as their expert advisers thought attainable or desirable, but also that the appellants have stated clearly and without equivocation that the point of their

⁷⁴ Viscount Radcliffe at 78 lines 10-15.

⁷⁵ Viscount Radcliffe at 78 lines 15-17.

⁷⁶ Viscount Radcliffe at 78 lines 32-35.

invention lies in its application to the hindmost wheels.”⁷⁷ Viscount Radcliffe did not refer to any provision of the claim to support the conclusion that the appellants had made it clear that the point of their invention lay in its application to the hindmost wheels. In *O’Hara*⁷⁸ the Federal Court of Appeal, through Pratte JA, *inter alia*, said: “When an inventor has clearly stated in the claims that he considered a requirement as essential to his invention, a court cannot decide otherwise for the sole reason that he was mistaken”.⁷⁹ There was nothing in the specification of the appellants in *Van der Lely* to support the proposition that the inventor considered the selection of the hindmost wheels to be an essential integer and none was pointed out by any of the judges who reached that conclusion from the Court of first instance up to the House of Lords.

[58] One of the factors which Lord Reid took into account in reaching the conclusion that he reached on claim 11 which is the opposite of the conclusion reached by Lord Jenkins, Viscount Radcliffe and Lord Hudson was that the respondents were not able to point to any mechanical reason for their choice to dismount the foremost wheels instead of the hindmost wheels nor were they able to point to any advantage which resulted there from. Lord Jenkins, Viscount Radcliffe and Lord Hodson did not take this factor into account before rejecting the opposite conclusion reached by Lord Reid. It is suggested that this is a very important factor pointing in the direction that the respondents made a minor and unessential variation to the appellants’ invention. In Canadian patent law parlance what happened to the patentee in *Van der Lely* as seen through the eyes of the majority in both the Court of Appeal and the House of Lords would have been regarded as a self-inflicted wound⁸⁰ but it is suggested that in truth it is not.

[59] The failure of the respondents to point to any mechanical advantage or reason for their choice of dismounting the foremost rather than the hindmost wheels should have led the majority to a finding of infringement based on the doctrine of ‘pith and marrow’. In the *Van der Lely* case the majority in both the Court of Appeal and the majority in the House of Lords effectively approved the theft of an invention in a disguised form.

⁷⁷ Viscount Radcliffe in *Van der Lely* at 78 lines 24-28.

⁷⁸ *Eli Lily and Co v O’Hara Manufacturing Ltd* (1989) 26 CPR (3 d) 1 (Fed CA).

⁷⁹ Viscount Radcliffe in *Van der Lely* at 78 lines 28-35.

⁸⁰ See *Binnie J in Free World* par 51.

They also went against the well-known principle of patent law that, if you borrow the substance of patented invention, you cannot escape the consequences of infringement by making immaterial variations to the patented invention. It is suggested that the failure of the majority to take into account the fact that the defendants could not point to any advantage arising from their making the foremost instead of the hindmost wheels dismountable and their disregard of this well-known rule of patent law constituted a serious misdirection on their part which must have contributed considerably to their reaching the conclusion of non-infringement. The majority appears to have been excessively preoccupied with the language of the claims to the detriment of other relevant factors such as, it is suggested, whether the variation added any value to the apparatus or its efficiency or not. James LJ must have had cases such as *Van der Lely* in mind when he said in *Clark v Adie* that “there is or may be an essence or substance of the invention underlying the accident of form; and that invention like every other invention, may be pirated by a theft in a disguised or mutilated form”.⁸¹ In *Van der Lely*’s case making the foremost wheels as opposed to the hindmost wheels dismountable added absolutely no value and, as Lord Reid said, was only done in order to disguise the piracy of the appellant’s invention. Lord Jenkins simply recorded the argument that this was a wholly unessential and superfluous feature but went on to say that the appellants had deliberately framed claim 11 so as to exclude the use of the foremost wheels and that that left it open for the appellant to arrange their wheels in any way they chose provided that they did not interfere with the appellants’ arrangement.

[60] It seems that the majority’s approach was to look at the terms of the claim concerned and, if the terms of the claim did not refer to the variation effected by the alleged infringer which made his apparatus slightly different from the patentee’s invention or apparatus, the majority found that the patentee had deliberately chosen not to cover the variant and that, for that reason, there could be no infringement. It is suggested

⁸¹ In par 51 of his judgment in the *Free World* case, Mr Justice Binnie of the Supreme Court of Canada points out that the involvement of the skilled addressee in claim construction holds out to the patentee the comfort that the claims will be read in light of the knowledge provided to the Court by expert evidence on the technical meaning of the terms. He further points out in part that, although the concepts used in the claims and “words chosen by the inventor will be read in the sense the inventor is presumed to have intended and in a way that is sympathetic to accomplishment of the inventor’s purpose expressed or implicit in the test of the claim”, if the inventor has misspoken or otherwise has created an unnecessary or troublesome limitation in the claims, it is a self-inflicted wound. The public is entitled to rely on the words used provided the words used are interpreted fairly and knowledgeably.

that this approach adopted by the majority in *Van der Lely* was literalism of the extreme order. In fact one wonders what the majority would have wanted to see in a claim other than that the variant was textually covered by the claim before they could find infringement on the basis of the pith and marrow doctrine. The pith and marrow doctrine does not apply to a case where the apparatus of the alleged infringer falls within the textual terms of the claims of a specification. That being so, it would appear that the case in which the majority in the *Van der Lely* case could apply the pith and marrow principle would be as difficult to find as it is difficult to find water in a desert. It is suggested that the majority judgment of the House of Lords in *Van der Lely*'s case on claim 11 was a travesty of justice and the main reason why this travesty of justice occurred was that both the majority in the Court of Appeal and the majority in the House of Lords failed to take into account the question of whether the dismounting of the foremost wheels added any practical value to the invention and disregarded the rule of patent law that no one who borrows the substance of a patented invention escapes the consequences of infringement by making immaterial variations to the invention.

3.9 Lord Hodson's Judgment

[61] In his judgment Lord Hodson revealed that he understood that the appellants' complaint was that the substance of their invention had been taken under cover of an unessential change in that the foremost had been substituted by them for the hindmost wheels.⁸²

[62] Lord Hodson said that he agreed with Lord Jenkins that "the pith and marrow" doctrine was not applicable to this case. He went on to say: "Where the appellants have drawn their claim so as to include specifically the hindmost wheels, thereby excluding the foremost, it would, I think, be oppressive to hold the respondents guilty of infringement of claim 11 because they have made those wheels detachable which were deliberately excluded from the language of the plaintiffs' claim".⁸³ Lord Hodson also pointed out that he agreed with Lloyd-Jacob J that no passage in the specification could be found to support the suggestion that the removal of any but the hindmost

⁸² James LJ in *Clark v Adie* at 657.

⁸³ Lord Hodson at 80 lines 17-19.

wheels was ever within the patentee's contemplation.⁸⁴ Lord Hodson found that there was no infringement of the patentee's invention.

[63] It has been pointed out above that the majority in the *Van der Lely* case did not take into account Lord Reid's reasons for his conclusion in his minority judgment on the infringement of claim 11 that the change introduced by the respondents to the appellants' invention added no value to the invention. Another reason which the majority also failed to take into account (and did not deal with) upon which Lord Reid relied was that the mere fact that a patentee mentioned a certain feature in a claim did not necessarily mean that he intended to make that feature an essential feature of his invention. He effectively said that the mere mention of a feature in the claims is no sufficient basis to conclude that it was intended by the patentee to be an essential feature. Lord Reid said that, if it was enough, there would be very little left of the doctrine of pith and marrow. In none of the judgments of members of the majority in the *Van der Lely* case can one find an answer to this argument. The majority was not entitled to go ahead and give a judgment going against Lord Reid's judgment without dealing with his reasons for his conclusion in this regard.

[64] Earlier on when discussing Wills J's judgment in *The Incandescent Gas* case attention was drawn to a statement that Wills J made in his judgment to the effect that, when a patentee did not reveal any clue in his specification as to his own view of the relative importance of the different features of his invention, that meant that the patentee intended to treat all of the features of the invention as equally important and as essentials of the invention. It was pointed out that that approach made it easy for the conclusion of non-infringement to be reached in a case. It is suggested that the approach taken by the majority in both the Court of Appeal and the House of Lords in the *Van der Lely* case was in effect an implementation of the wrong approach advocated by Wills J in *The Incandescent Gas Lamp* case in this regard. That approach of Wills J ensures that every feature is taken as essential and this means that, if an alleged infringer omits only one feature, he would not be said to have infringed the patent because omitting an essential feature results in there being no infringement.

⁸⁴ Lord Hodson at 80 lines 26-31.

- [65] When the *Van der Lely* matter came before the House of Lords, Viscount Radcliffe, who gave the main judgment and, for all intents and purposes, the judgment of the House of Lords, took Upjohn LJ's judgment in the Court of Appeal which made no reference to the rule on immaterial variations as correctly setting out the principles on infringement. Accordingly, he, too, fell into the same error into which Upjohn and Pearson LJ had fallen in the Court of Appeal, namely, that of not considering the rule on immaterial variations. The other Law Lords who came to the same conclusion also did not refer to the rule. This means that the rule was in effect overlooked by both the Court of Appeal and by the House of Lords.
- [66] When one reads all the speeches of Viscount Radcliffe, Lords Jenkins, Hodson and Devlin, it is quite clear that they decided the matter purely on the basis of the fact that the appellants had mentioned dismountability only in respect of the hindmost wheels and in respect of no other wheels. They took this to be evidence that the appellants deliberately chose the dismountability of the hindmost wheels as an essential feature of their claim. They allowed form to prevail over substance. In fact Viscount Radcliffe even said in his speech that, when one seeks to invoke the pith and marrow principle to support an accusation that the substance of someone's invention has been taken, one should "be careful to see that the inventor has not by the actual form of his claim left open to the world the appropriation of just that property that he says has been filched from him by piracy or theft".⁸⁵ It is suggested that what Viscount Radcliffe was saying here was that, if in form the inventors' claim does not cover the alleged infringer's device or process, there is no infringement. It is suggested that there cannot be a worse way of elevating form above substance than this. This is conclusive proof that the Upjohn LJ approach elevated form above substance.
- [67] Based on the judgments which found that there was no infringement of the appellants' claims 11 and 12, it can be said with confidence that the rule of patent law on immaterial variations and the doctrine of pith and marrow were effectively discarded by the judgments of the Court of Appeal and the House of Lords in *Van der Lely*. For all intents and purposes it would not have been easy for anyone in the future to successfully sue for the non-textual infringement of patents and invoke the

⁸⁵ Lord Hodson at 80 lines 32-34.

doctrine of pith and marrow. This was a disaster for the future. Very strangely, as already stated elsewhere in this dissertation, in *Van der Lely* the English courts from the Chancery Division to the House of Lords, all the judges who found that there was no infringement of claims 11 and 12 failed to take into account the rule of patent law on immaterial variations, failed to consider whether the alleged infringer had a reason for introducing the difference that it introduced nor did they consider whether or not such difference added any value. Indeed they failed to consider whether or not the difference introduced by the alleged infringer had any practical significance. They also did not refer to or consider some of the important decisions relevant to the doctrine of pith and marrow.

[68] A reading of the decision of the House of Lords in *Van der Lely* reveals the following about that decision:

- (a) the House of Lords decided the question whether or not there was non-textual infringement without dealing with the rule on immaterial variations;
- (b) the House of Lords regarded the fact that the patentee had made mention of the dismountability of one set of wheels without mentioning any other set as sufficient to justify the conclusion that the patentee had intended the dismountability of the mentioned set of wheels as essential;
- (c) the House of Lords did not inquire into the materiality, or otherwise, of the dismountability of one set of wheels as opposed to another set of wheels in the functioning of the device;
- (d) the House of Lords did not inquire into the alleged infringer's reasons for choosing to dismount the one set of wheels which he chose as opposed to the set of wheels to which the claims referred in regard to dismountability.
- (e) the House of Lords did not deal with Lord Evershed MR's reasons for his dissent and Lord Reid's reasons for his dissent to indicate whether it found those reasons unpersuasive and, if not, to say why not;

- (f) the House of Lords decided the issue of infringement purely on the basis of the language used by the patentee in formulating his claims;
- (g) the House of Lords' approach was too literalistic;
- (h) the House of Lords' approach placed form above substance;
- (i) the House of Lords' approach to the determination of liability for non-textual infringement and to the doctrine of pith and marrow made it impossible for any litigant to succeed in a non-textual infringement claim and, in effect, sounded the death-knell to the doctrine of pith and marrow.⁸⁶

3.10 Act of Rebellion: Lloyd-Jacob J Joins the Dissenters: *Rodi* in the Court of First Instance⁸⁷

[69] This case was probably one of the first reported cases, if not the first reported case, to come before the courts after the *Van der Lely* decision of the House of Lords in which the claim was based on non-textual infringement. In this case, the *Rodi* case, the plaintiffs invented a new method of making extensible wrist watch bracelets. The plaintiffs' bracelet was made up of only three components, namely, hollow sleeves, connecting links and spring plates with a novel method of articulation so that it could be assembled without any soldering or riveting. In the plaintiffs' bracelet there were two layers of sleeves which were arranged in such a way that each sleeve in the top layer overlapped two sleeves in the bottom layer.

[70] At each end of each sleeve there were inserted two connecting links. Those on the one side also went into one of the sleeves which overlapped in the lower layer and those on the other side also went into the other sleeve in the lower layer which was overlapped. When the bracelet was not extended, the sleeves in each layer touched each other but adjoining sleeves in each layer were not connected and the links could pivot. When the ends of the bracelet were pulled, the pivoting of the links allowed the sleeves to slide and separate slightly thus making the bracelet extensible.

⁸⁶ Viscount Radcliffe in *Van der Lely* at 78 lines 10-17.

⁸⁷ *Rodi and Wienenburger AG v Henry Showell Ltd* [1966] RPC 441 (Ch).

[71] There was a spring plate in each sleeve so arranged that, when the connecting links pivoted, they compressed the springs. When the pull extending the bracelet was released, the springs caused the bracelet to contract again to its original length.

[72] The defendants made two models of bracelets known as EXCALIBUR 59 and EXCALIBUR 60. EXCALIBUR 59 was made in exactly the same way as the plaintiffs' bracelet with one alteration or variation. Whereas in the plaintiffs' bracelet as described in the specification the connecting links at one end of each sleeve were separate from those at the other end and each was roughly in the shape of a capital U, with the upright parts of the U going into different sleeves and the curved part forming a bridge or connection between them, in the defendants' EXCALIBUR 59 one limb of the U was extended and joined to the corresponding limb of the corresponding U at the other end of the sleeve, thus making a double link in the shape of an elongated letter C.

[73] Only claim 1 was in issue. It read as follows:

“Claim 1:

An extensible chain band, more particularly a wrist watch bracelet, made of hollow links, which connect the hollow links in an articulated manner and so that they can be pulled apart and which pivot against spring action, characterised by this that the hollow links are constituted by two layers of cylindrical sleeves (10, 11) of any desired section which are arranged transversely to and relatively staggered in, the longitudinal direction of the chain band, and the connecting links are constituted by U-shaped connecting bows (14) arranged in the longitudinal edges of the chain, which bows are inserted in pairs with one of the limbs (15) of each in the open end of a sleeve (10) of the one layer and with the other limb (16) in one of the adjacent sleeves (11) of the other layer which are in a staggered position, in that a leaf spring comprising a bent spring plate (12) is provided in each sleeve and acts by spring action against their pivoting when the chain is stretched or bent.”

The plaintiffs alleged that the defendants' EXCALIBUR 59 was an infringement of claim 1 of its patent. The defendants sought a declaratory order that their EXCALIBUR 60 did not infringe.

3.11 Lloyd-Jacob J in the Court of First Instance in *Rodi*

[74] Lloyd-Jacob J was the trial judge in the *Rodi* matter in the Chancery Division. Lloyd-Jacob J found that the defendants' device known as EXCALIBUR 59 infringed the patentees' invention. What is very remarkable in Lloyd-Jacob J's judgment is that one of the issues upon which he focused was whether such differences as there were between the patentees' claim and the defendants' device were differences which added value or which had any practical significance to the operation of the device. That is, as is suggested throughout herein, the correct approach in the determination of non-textual infringement of patents. Once it has been found that the differences do not add any value or are not of any practical significance in the operation of the device or apparatus, the patent rule on immaterial variations comes into operation and this will almost inevitably lead to the conclusion that there is infringement.

[75] Although Lloyd-Jacob J did not refer to this rule of patent law in his judgment, he, nevertheless, came to the correct conclusion. It is interesting to note that in this case Lloyd-Jacob J did take into account the question of whether or not the differences added any value or had any practical significance because he was the judge who had also tried the *Van der Lely* case in the court of first instance and in that case he did not take this factor into account in determining whether non-textual infringement had been proved and in that case he came to the conclusion, quite incorrectly it is suggested, that there was no infringement. It is suggested that, had he taken this factor into account in *Van der Lely* and had he also applied the rule on immaterial variations, he would have come to the conclusion that there was infringement in the *Van der Lely* case which would have been the correct conclusion.

[76] Lloyd-Jacob J pointed out that the resemblances between the two bracelets were so marked that it was not reasonable to infer that the design of EXCALIBUR 59 was arrived at in ignorance of the patented invention. He said:

“Both are assemblages wherein two relatively staggered layers of hollow sleeves arranged transversely to the longitudinal direction of the band are united by connectors held firmly in place by bent spring plates, which connectors tilt when tensioned to permit articulation between adjacent sleeves. The first and main differentiation concerns these connectors, for, in lieu of each pair of U-shaped bows

disposed at opposite edges of a sleeve, the defendants employ one integral C-shaped member the two ends of which function as U-bows but which, because of the union between one limb of each U, requires to be introduced into the sleeve otherwise than from the edges. This necessitates the presence of a slot in the lower face of each of the upper sleeves of a width just exceeding the width of the two inserted C-members.”⁸⁸

[77] Lloyd-Jacob J pointed out that the defendants relied upon a number of differences between their bracelet and claim 1 (upon which the plaintiffs relied in regard to infringement) which they contended were adequate to disprove infringement. Five differences were relied upon by the defendants. These were that:

- (1) the sleeves are of rectangular section and thus not cylindrically shaped
- (2) the gap in every upper link member denies possession of the sleeve characteristic;
- (3) no U-shaped connecting bows are used;
- (4) the C-shaped connector is incapable of insertion within the sleeves it is required to conjoin; and
- (5) no spring plate was required to retain each C-member within its sleeves.⁸⁹

Lloyd-Jacob J pointed out that the first two and the last two of the differences were of “no real substance”. This meant that the only difference that deserved to be considered was the one mentioned in (3) above. That is that in EXCALIBUR 59 there were no U-shaped connecting bows used whereas claim 1 contemplated a device in which U-shaped connecting bows were used. Lloyd-Jacob J pointed out that this left for estimation of the real significance the requirement that pairs of U-shaped connecting bows as inserts in the longitudinal edge of the chain were to constitute the connecting links.⁹⁰

[78] Lloyd-Jacob J thoroughly considered the advantages which the defendants argued their bracelet had over the plaintiffs’ bracelet but came to the conclusion that the

⁸⁸ Lloyd-Jacob J in *Rodi* at 454 lines 42 to 445 line 3.

⁸⁹ Lloyd-Jacob J in *Rodi* at 455 lines 25-35.

⁸⁹ Lloyd-Jacob J at 457 lines 45-47.

differences were of no practical significance. This meant that the differences introduced by the defendants to the patented invention to produce their bracelet added no material value.⁹¹ That Lloyd-Jacob J considered the allegedly infringing device thoroughly can be seen from what follows below.

[79] After dealing with the differences between the defendants' bracelet and the plaintiffs' claim, Lloyd-Jacob J pointed out that the question to be answered was whether the defendants' bracelet consisted of substantially the same parts acting in relation to each other in substantially the same way as the claim required.⁹² Lloyd-Jacob J then said that in many of the decided cases the omission of a non-essential feature of a patent claim or the substitution of a mechanical equivalent in the operation of a patented device had been held insufficient to avoid infringement. But, he continued and pointed out that, the principle of safeguarding a patentee against the evasion of his rights by colourable evasion was not restricted to such types of infringement.⁹³

[80] In considering the question of infringement, Lloyd-Jacob J did consider the question whether or not the differences between the plaintiffs' bracelet and the defendants' bracelet were of any "real substance".⁹⁴ He also inquired into the "real significance" of the requirement "that pairs of U-shaped connecting bows as inserts in the longitudinal edges of the chain are to constitute the connecting links".⁹⁵ He also pointed out that, although some of the differences relied upon by the defendants could have importance from a commercial point of view, for the purpose of deciding on infringement, they required examination "to see to what extent, if any, their existence is inconsistent with any of the representations contained in the specification so as to constitute all or any of the genuine distinctions as opposed to merely colourable differences from the patentee's invention".⁹⁶

[81] Lloyd-Jacob J referred to the fact that the interposition of an integral spacing member between oppositely disposed limbs of a pair of U-bows such as was involved in their conversion to a C-shaped member denied to the combined member the complete

⁹⁰ Lloyd-Jacob J at 456 lines 31-35 to 457 lines 2-3 and 11-15.

⁹¹ Lloyd-Jacob J at 457 lines 45-47.

⁹² Lloyd-Jacob J at 457 lines 47 to p.458 line 3.

⁹³ Lloyd-Jacob J in *Rodi* at 455 lines 36-37.

⁹⁴ Lloyd-Jacob J in *Rodi* at 455 lines 46-48.

⁹⁵ Lloyd-Jacob J in *Rodi* at 456 lines 12-18.

freedom of action possessed by separate U-bows in relation to transverse extensibility.⁹⁷ He pointed out that in practice the teaching of the specification in suit that the limbs of the bows should lie with play in the sleeves, when applied to a C-member, enabled sufficient transverse flexibility to be available to meet all reasonable requirements in this respect.⁹⁸ Lloyd-Jacob J then concluded in the next sentence:

“This introduction of a slight degree of rigidity is not of any practical significance, as can be observed by manipulation of the exhibited EXCALIBUR 59”.⁹⁹

[82] Lloyd-Jacob also referred to some thickness upon which the defendants had also relied as one of the differences between the plaintiffs’ bracelet and their bracelet. He found that this imported “no practical difference”.¹⁰⁰ Lloyd-Jacob J concluded that it was possible that a finding of strict mechanical equivalence was not justified but said that this was not necessarily adverse to an affirmative conclusion on the issue of infringement “for the question to be answered is whether the defendants’ bracelet consists of substantially the same parts acting in relation to each other in substantially the same way as the claim requires”.¹⁰¹

[83] A little later Lloyd-Jacob J concluded in regard to the issue of infringement:

“The difference between a pair of U-bows and a C-shaped member is for the connecting purpose devised by the patentee of *no genuine significance*, for the interaction between the associated parts is in all *material respects* identical. Each C-member comprises in *reality* a pair of U-bows, and this, although obscured, is not removed by the integral arm interposed between them. This arm serves *no purpose necessary* for the successful operation, its presence does not deny the substantial attainment of the patentee’s result, and no reason for its adoption other than as a disguise is established. In fairness it should be disregarded as a colourable distinction introducing an apparent but not an actual difference from the invention claimed, and, so considered, a finding of infringement must follow.”¹⁰²

[84] Thus, Lloyd-Jacob J concluded that the defendants’ bracelet infringed the plaintiffs’ patent. This last passage quoted from Lloyd-Jacob J’s judgment was, it is suggested,

⁹⁶ Lloyd-Jacob J at 456 lines 45-49.

⁹⁷ Lloyd-Jacob J in *Rodi* at 456 lines 49 to 457 line 2.

⁹⁸ Lloyd-Jacob J in *Rodi* at 457 lines 2-4.

⁹⁹ Lloyd-Jacob J in *Rodi* at 457 lines 5-15.

¹⁰⁰ Lloyd-Jacob J in *Rodi* at 457 lines 40-47.

¹⁰² Lloyd-Jacob J in *Rodi* at 458 lines 3-13 (author’s emphasis).

based upon the same kind of reasoning and factors that Lord Reid used to reach the conclusion of infringement in his dissent in *Van der Lely*. In this regard reference can be made to the fact that Lloyd-Jacob J asked himself the question: what purpose does the difference or variant serve? He also took into account the fact that the defendants had not advanced any reason for introducing the difference. It, therefore, seemed to him that the difference had been introduced as a disguise for the theft of the patentee's invention. Although Lloyd-Jacob J did not refer to the rule on immaterial variations referred to earlier herein, it is quite clear from some of the passages quoted above from his judgment that in effect he applied that rule without expressly mentioning it. As already stated above, Lloyd-Jacob J also considered the question of what practical significance the differences introduced by the defendant to the patented invention were. This drove him to the correct conclusion on infringement. In reaching this conclusion Lloyd Jacob J invoked the doctrine of pith and marrow.

[85] Although Lloyd-Jacob J did not in his judgment refer to the rule on immaterial variations, there can be no doubt that he in effect applied that rule after establishing that the variations introduced by the defendants were not material or were not of any practical significance. Lloyd-Jacob J's judgment in *Rodi* represents his abandonment of the Upjohn LJ approach and an adoption of the Lord Reid approach. It marked a turning point in the entire saga of the Upjohn LJ approach and the Lord Reid approach. Lloyd-Jacob J was the one who had initiated the Upjohn LJ approach through his judgment in *Van der Lely* in the Chancery Division and his approach in that case had been approved by both the Court of Appeal and the House of Lords and yet he now turned his back on that approach and joined the dissenters in using the Lord Reid approach. There was an appeal to the Court of Appeal against Lloyd-Jacob's judgment.

3.12 Comparison of Lloyd-Jacob J's Judgment in *Rodi* with Lord Evershed MR's Dissenting Judgment in the Court of Appeal in *Van der Lely*

[86] A reading of Lloyd-Jacob J's judgment in *Rodi* and his judgment in *Van der Lely* in the Chancery Division reveals a striking contrast between the approaches employed in the two judgments to the determination of non-textual infringement of patent claims and the doctrine of pith and marrow. In *Van der Lely* Lloyd-Jacob J elevated from

above substance in determining whether there was an infringement of the patent in that case but in *Rodi* he focussed more on substance than on form in determining whether or not the patent had been infringed. After Lloyd-Jacob J's judgment in *Van der Lely*, Lord Evershed MR gave his dissenting judgment in the same case in the Court of Appeal. A reading of Lord Evershed MR's judgment also reveals that he had also focused on substance rather than on form in determining whether or not there was infringement in *Van der Lely*. Lord Evershed referred to the doctrine of pith and marrow and asked himself the question whether or not the substance or pith and marrow of the invention had been taken. That was the correct approach. Lloyd-Jacob J's judgment in *Rodi* reflected the same approach. It is suggested that this must have been because Lord Evershed MR's dissent probably influenced Lloyd-Jacob J in his judgment in *Rodi*.

3.13 Comparison of Lloyd-Jacob J's Judgment in *Rodi* with Lord Reid's Dissenting Judgment in the House of Lords in *Van der Lely*

[87] A reading of the judgment of Lloyd-Jacob J in *Rodi* and Lord Reid's dissenting judgment in the House of Lords in *Van der Lely* reveals that there are interesting features common in both judgments. It is suggested that the reason for the presence of these features in the two judgments is that, when Lloyd-Jacob J wrote his judgment in *Rodi*, he had already read Lord Reid's judgment and had become convinced that the Upjohn LJ approach that he had applied in *Van der Lely* and which had been approved by both the Court of Appeal and the House of Lords was wrong and that the correct approach was the Lord Reid approach. The common features in the two judgments are the following:

(a) In *Van der Lely* Lord Reid adopted an approach that focused on substance rather than form in determining whether there was an infringement of the patent; in support of this, reference can be made to the statement in *Van der Lely* where Lord Reid said:

“... it has long been recognized that there ‘may be an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the

alleged piracy is the same in substance and effect, or is a substantially new or different combination”¹⁰³.

In *Rodi* Lloyd-Jacob J also adopted an approach that focused on substance rather than form. In support of this proposition, reference can be made to the fact that, when he considered the differences between the allegedly infringing bracelets and the patentees’ relevant claim 1, Lloyd-Jacob J said that the differences were of “no real substance”¹⁰⁴.

- (b) In *Van der Lely* Lord Reid did not refer in terms to the rule on immaterial variations even though he, in effect, applied that rule in determining infringement of the patent. In *Rodi* Lloyd-Jacob J also did not refer in terms to that rule even though he applied it in determining infringement.
- (c) In *Van der Lely* Lord Reid asked himself the question whether the alleged infringer’s choice to dismount and remount the foremost wheels instead of the hindmost wheels as provided for in the patentee’s claim 11 made any practical difference.¹⁰⁵ In *Rodi* Lloyd-Jacob J effectively said the same. He said:

“This introduction of slight rigidity is not of any practical significance, as can readily be absorbed by manipulation of the exhibited EXCALIBUR 59”¹⁰⁶.

Lloyd-Jacob J also rejected a distinction in respect of the thickness of the bracelets as making “no practical difference”¹⁰⁷.

- (d) In *Van der Lely* Lord Reid also inquired into the reason for or the purpose served by, the difference introduced by the alleged infringer. In the *Van der Lely* case this refers to the fact that he inquired into the reason why the respondents had chosen to dismount the foremost wheels instead of the hindmost wheels as provided for in the patentees’ claim 11. Lord Reid

¹⁰⁶ Lord Reid in *Van der Lely* at 75 lines 30-36 quoting James LJ in *Clark v Adie* (1873) LR 10 Ch. 667.

¹⁰⁷ See Lloyd-Jacob J in *Rodi* at 455 lines 25-35.

¹⁰⁸ See Lord Reid in *Van der Lely* at 76.

¹⁰⁹ See Lloyd-Jacob, J in *Rodi* at 457 lines 2-3.

¹⁰⁷ See Lloyd-Jacob J in *Rodi* at 457 lines 10-15.

found that the respondents had no reason for making that choice other than to try and disguise their infringement of the appellants' patent. He said:

“The appellants dismount the three hindmost wheels of the row of six and remount them separately in accordance with claim 11. The respondents do exactly the same except that they dismount and remount the three foremost wheels. They cannot point to any mechanical reason for doing this or to any advantage resulting from it. It is simply done to try to evade the claim and the respondents' method is the exact mechanical equivalent of the appellant's method.”¹⁰⁸

In *Rodi* Lloyd-Jacob J said:

“The difference between a pair of U-bows and a C-shaped member is for the connecting purpose devised by the patentee of no genuine significance for the interaction between the associated parts is in all material respects identical. This arms serves no purpose necessary for successful operation, its presence does not deny the substantial attainment of the patentee's result.”¹⁰⁹

There was an appeal to the Court of Appeal against the judgment of Lloyd-Jacob J.

3.14 The Court of Appeal Sticks to its Guns: *Rodi* in the Court of Appeal¹¹⁰

[88] In the Court of Appeal the appeal was heard by Harman LJ, Diplock LJ and Winn LJ. All three Lord Justices upheld the appeal against the finding of infringement and held that there had been no infringement in respect of both EXCALIBUR 59 and EXCALIBUR 60. Each of them gave a separate judgment giving reasons for his conclusion. Their respective judgments require some discussion.

3.15 Harman LJ's Judgment

[89] The plaintiffs' invention was described in the specification in part in the following terms:

¹⁰⁸ See Lord Reid in *Van der Lely* at 74 lines 30-36.

¹⁰⁹ See Lloyd-Jacob J in *Rodi* at 458 lines 3-13.

¹¹⁰ *Rodi and Wienenburger AG v Henry Showell Ltd* [1966] RPC 460 (CA).

“This invention relates to an extensible chain band, more particularly a wrist watch bracelet, which consists of hollow links and links connecting the same together in an articulated manner and so that they can be stretched apart, which connecting links can pivot against spring action. Moreover, the chain band is composed of only three different parts, namely the sleeves, the connecting bows and the spring plates, whereby its construction and assembly is extremely simple and its manufacture very economical, especially as the parts can be inserted within one another without soldering or reverting.”¹¹¹

Harman LJ referred to certain passages in the judgment of the trial Judge. He said that the trial judge had described the plaintiffs’ invention in this case in the following terms:

“The invention the subject of the letters patent in suit is concerned with extensible chain bands, more particularly for wrist watch bracelets of the type wherein a succession of hollow links are united by interposed members which permit articulation and stretching of composite band to take place”.¹¹²

[90] Harman LJ also quoted a passage from the trial judge’s judgment dealing with two concepts on which the trial Judge thought the plaintiffs’ invention stood. The passage reads as follows:

“Stated as a matter of broad generality, the patentee’s construction of bracelet incorporated two basic concepts, both of which were novel at the priority date. The first was that an arrangement of link members in two layers arranged transversely to and relatively staggered in the longitudinal direction of the chain would if they could be satisfactorily articulated present a closed appearance throughout all reasonably required extensions. The second concerned the articulation, and this was that connectors capable of pivotal action would, if located within opposed ends of each pair of upper and lower links, permit relative movement between them on extension, and if spring controlled allow recovery when tension is released. Figures 1 and 2 are illustrative of these two concepts. In embodying these two concepts in a bracelet the patentees chose to place a practical limitation upon each of them. For the first (and this was necessitated by the requirement of the second that the connectors should be located within the links) hollow links were specified and these are expressed to be cylindrical sleeves of any desired cross-section.”¹¹³

Harman LJ then quoted another passage from the judgment of the trial Judge where the latter said:

¹¹¹ At 462 lines 3-12.

¹¹² Quoted by Harman LJ in his judgment in the Court of Appeal at 462 lines 41-45.

¹¹³ At 463 lines 3-17.

“For the second, the connection between adjacent upper and lower sleeves was to be provided by what are termed U-shaped connecting bows and their spring control by a leaf spring of the bent spring plate type suitably located within each sleeve. This spring holds the connectors firmly in the sleeve and, whilst permitting pivoting of the connectors when tension is applied, operates to restore them to their original position when tension is released.”¹¹⁴

[91] The first claim in the specification, which was the only claim said to have been infringed by the defendants, has been quoted earlier on. Accordingly, it is not necessary to quote it again. In two paragraphs Harman LJ described the similarities and differences between the plaintiffs’ patented invention and the defendants’ apparatus or device that was said to have infringed the plaintiffs’ patent claim. He did so in these terms:

“There seems to me no doubt that the defendants’ bracelet here in suite, which they call EXCALIBUR 59, exhibits these two concepts referred to by the judge. The appearance of the defendant’s bracelet is much the same as that of the plaintiffs’. It consists of two rows of hollow sleeves, staggered one above the other, within which are located leaf springs and a means of connecting the upper with the lower row by pairs of connectors of which one prong is placed in a lower sleeve, which the upper prong is placed in the adjacent sleeve in the upper row. The so-called pairs of U-bows in the patented invention consist of two parallel prongs joined at the base and of a length less than half of the length of the sleeves. In the defendants’ bracelet each opposed pair of these is replaced by a single double-ended piece like a ‘C’ on its side. These, of course, cannot be put into position by pushing them into the ends of the sleeves: they are inserted by means of a slot in each sleeve which can be subsequently closed. There is moreover another difference namely that in the patented device the U-bows are held in position and prevented from falling out by the two leaf springs, one in the upper and one in the lower sleeve; whereas in the EXCALIBUR 59, the ‘C’ pieces would not fall out in the absence of the springs, though no doubt they might rattle about. In both instruments the leaf springs provide the retracting force which brings the sleeves together again when released from stretch.”¹¹⁵

[82] Harman LJ began his consideration of the appeal by making an observation to the effect that the trial Judge had decided the case upon the footing that the so-called “C” pieces were in effect two U-pieces joined so as to give a pretended difference. He then said:

¹¹⁴ At 463 lines 20-25

¹¹⁵ At 463 lines 28-46.

“As to this it is the law, and the judge expressly recognises it, that you cannot patent a concept. Your monopoly is to be found in your claim and in so far as the claim limits your means of performing or carrying out the concept to a certain method, your patent will not be infringed by someone who carries it out in another. This is analogous to the law of copyright. There is none in ideas: it is their embodiment in physical or tangible form that the law protects.”¹¹⁶

Harman LJ then continued and pointed out that the starting point for the court was to construe the claim and decide what the essential features were. He said that, having done that, the Court should find whether the essential features had been taken by the infringer. “If there are unessential elements”, said Harman LJ, “and there is a departure from these there will nevertheless be infringement but if the so-called infringer, in bringing about the same result, has employed really different means, he will not infringe”.¹¹⁷ Harman LJ pointed out that “the so-called doctrine of mechanical equivalents only applies, I think, to unessential features. If there are genuine differences between the elements of one machine and the other, there will be no infringement.”¹¹⁸ It is to be noted that Harman LJ referred to “genuine differences” and not to material differences.

[93] Harman LJ pointed out that there was no difference between the parties as to the principles involved in the determination of infringement. He said that those principles were well set out in *Birmingham* and he thought he did not need to “rehearse the authorities”.¹¹⁹ In the next sentence Harman LJ set out what the decisive question was. He said:

“The question is whether the mechanism said to infringe consists of substantially (that is to say in essentials) the same parts operating in substantially the same way as in the patented invention”.¹²⁰

He then said that it was, as usual, in the application of the principle involved that the difficulty arose.¹²¹ Harman LJ examined the claim and set out what he believed were the features of the claim. With regard to the differences, he said:

¹¹⁶ At 463 lines 8-14.

¹¹⁷ At 464 lines 17-21.

¹¹⁸ At 464 lines 22-24.

¹¹⁹ At 464 lines 26-27.

¹²⁰ At 464 lines 28-31.

¹²¹ The reference to page 52 and page 69 in the citation of the *Birmingham* case referred to by Harman LJ appears to be wrong.

“The difference comes where the plaintiffs speak of U-shaped connecting bows and describe them as ‘inserted in pairs’ in the open end of the sleeves. The defendants’ connectors are not in the shape of a ‘U’ and cannot be inserted in the end of a sleeve. Moreover, in the plaintiffs’ invention the spring in each sleeve is required to keep the U-bows in position, whereas in the defendants’ invention it is not needed for this purpose.”¹²²

Harman LJ then pointed out that the plaintiffs’ contention was that the differences pointed out above were only colourable differences and not differences in essentials. He said that the plaintiffs contended that the “C” pieces were only two U-bows joined together and that the join did not perform any function. He said that the plaintiffs argued that the “C” pieces were “inserted” in the sense of being found inside the sleeves and that it was unnecessary that they should be pushed in at the open ends. He said that, furthermore, the plaintiffs argued that the defendants’ “C” pieces did keep the connectors firmly in the sleeve in the sense that they prevented them from lying loosely within it and that this was all that the claim, on its true construction, meant.

[94] Harman LJ expressed sympathy with the plaintiffs. He said:

“I feel some sympathy with the plaintiffs whose broad notion does seem to me to have been imitated by the defendants; and it may be that in other times they could have succeeded on what was called the ‘pith and marrow’ doctrine as enunciated, for instance, by Lord Cairnes in *Clark v Adie* (1877) 2 App Cas 315 but as time has gone on inventors have gone into greater particulars about their claims and have not left the court to examine the substance and extract the essential details, and once you find that an essential element of the patented invention is not found in the rival machine, the latter does not infringe the former”.¹²³

Harman LJ then referred to the *Van der Lely* case and said that it was a “striking example of this”. He said:

“The change from displacing the hindmost wheels of the hay rake to that of displacing the foremost wheels seems to be a merely mechanical alteration, nevertheless the claim for infringement failed”.¹²⁴

¹²² At 464 lines 41-46.

¹²³ At 465 lines 6-13.

¹²⁴ Lloyd-Jacob J at 465 lines 15-17.

These statements by Harman LJ reveal an approach on his part in terms of which he found against the patentee not because of what the law was but because of what he regarded as a practice that had developed among patentees when they drew their specifications.

[95] It was in one paragraph that Harman LJ made the finding that there was no infringement in this case in respect of the defendants' EXCALIBUR 59 and gave his reasons upon which that finding was based.¹²⁵ His first reason was that it was impossible, in his opinion, to say that the so-called U-bows were not an essential part of the plaintiffs' invention. In support of this statement, Harman LJ said that the U-bows were one of the three different parts expressly mentioned in the specification as constituting the only parts of the chain band, and as having the result of making the construction simple and easily taken apart. Moreover, he thought that it was an essential feature that they should be pushed in at the open end of each sleeve and kept in the sleeve by means of the leaf springs.¹²⁶ The first reason cannot be sufficient for the conclusion that the U-bows were essential features of the patented invention. A mere mentioning of a feature in a claim is not per se sufficient for a finding that it is an essential feature. The second one is not another reason for the conclusion that the U-bows were essential features but another conclusion – a statement that it was an essential feature of the patented invention that the U-bows should be pushed in at the open end of each sleeve and kept in the sleeve by means of the leaf springs. Harman LJ then went on to say that such features were not present in the defendants' device and that the defendants' C-pieces were not the true equivalents of the U-bows in the patented invention and that they were not pushed in at the ends of the sleeves nor did they rely on the springs to prevent them from falling out. He then said that in the light of all this he could only conclude that there had been no infringement of the plaintiffs' invention by the defendants' EXCALIBUR 59.

[96] It is important to point out that in his reasons for the conclusion that the U-bows were essential features of the patented invention all that Harman LJ said, apart from the statement that they were mentioned in the specification, was that they were said to

¹²⁵ At 464 lines 18-27.

¹²⁶ At 465 lines 19-24.

have “the result of making the construction simple and easily taken apart”.¹²⁷ No other substantiation was given for this conclusion. It was also not pointed out why the simplicity of the construction was essential. No reference was made to the patent law rule on immaterial variations. Harman LJ did not deal with the plaintiffs’ contention that the join arising out of the “U” bows being joined together to make a “C” performed no function. There can be no doubt that Harman LJ applied the Upjohn LJ approach in determining whether there was infringement in the *Rodi* case.

[97] Harman LJ correctly found that EXCALIBUR 60 had not been infringed. It is important to observe that Harman LJ did not refer to the notional addressee in any way to determine essentiality but only determined it himself. It is now necessary to turn to Diplock LJ’s judgment.

3.16 Diplock LJ’s Judgment

[98] Diplock LJ also found that EXCALIBUR 59 and EXCALIBUR 60 did not infringe the patentees’ patent. He allowed the appeal in respect of both devices. In dealing with the matter Lord Diplock first considered the role played by the specification in the determination of liability for the non-textual infringement of patent claims. In this regard he said:

“By letters patent a patentee discloses to the world the new manner of manufacture which he claims to have invented. He thereby obtains if his patent is valid a monopoly for what in his specification he has claimed as being his invention. He obtains a monopoly for nothing else. When, as was formerly the practice, specifications were drafted in the form of a description of the invention, whether a process or an article, followed by a general claim to the process or article ‘substantial as described’, the problem of construction involved the court’s selecting from the descriptive matter what was intended by the patentee to be the substance as distinct from the unessential parts of his invention. Since specifications then as now were written for the information of persons interested in the process or article described who would know what was already known about the subject matter and could identify what was old and what was novel in the process or article described, the court in approaching the problem of construction had to try itself to understand the description as such persons would. Such persons would be able to say that the patentee could not have been intending to claim that the use of a particular component referred to in the description was essential to his invention if it were common knowledge to those versed in the

¹²⁷ Harman LJ at 465 lines 20-22.

subject matter that some other component would perform the same function (the ‘doctrine of equivalents’ cf *Marconi v British Radio etc* (1911) 28 RPC 181, and when the unessential had been thus identified, what remained, were the ‘essential features’ of the invention an expression which I find preferable to ‘substance’ or to the time-worn lispng metaphor ‘pith and marrow’ (cf *Clark v Adie* (1877) 2 App Cas 315 at 320).”¹²⁸

[99] In the above passage the important points that Diplock LJ made, apart from the historical background to specifications, are the following:

- (a) a patentee only obtains a monopoly for that which he has claimed in his specification as his invention and nothing else;
- (b) previously the problem of construction involved the court selecting from the descriptive matter in the specification what was intended by the patentee to be the substance of the invention as distinct from the unessential parts;
- (c) in approaching the problem of construction the Court had to try and understand the description of the invention as it would be understood by persons interested in the process or article; and
- (d) persons interested in the process or article would be able to say that the patentee could not have been intending to claim that the use of a particular component referred to in the description was essential to his invention if it were common knowledge to those versed in the subject matter that some or other component would perform the same function.

[100] Diplock LJ went on to deal with the position as it was in terms of the then modern practice. He said:

“Under the modern practice, however, the patentee does not leave the essential features of his invention to be identified by the reader from the general description of it in his specification. He himself specifies with particularity those elements or integers of his invention which he claims to be essential to it. In construing a modern specification, to speak of looking for the substance or the ‘pith and marrow’ of the invention, may lead one erroneously to suppose that the patentee, whatever be the precise language in which he has framed his claim, is entitled to a monopoly of the mechanical or other principle of which his invention makes use or of the result which

¹²⁸ Lord Diplock at 466 lines 27-48.

his invention achieves. This is not so. If the language which the patentee has used in the claims which follow the description upon its true construction specifies a number of elements or integers acting in a particular relation to one another as constituting the essential features of his claim, the monopoly which he obtains is for that specified combination of elements or integers so acting in relation to one another – and for nothing else. There is no infringement of his monopoly unless each and every one of such elements is present in the process or article which is alleged to infringe his patent and such elements also act in relation to one another in the manner claimed. The law as to the principles of construction of claims in specifications in the modern form seems to me so laid down clearly and authoritatively in the judgment of Upjohn LJ in *Van der Lely v Bamfords Ltd* [1961] RPC 296 at 312 which was approved by the majority of the House of Lords on appeal; [1963] RPC 61.”¹²⁹

The important points made by Diplock LJ in the above passage are the following:

- (a) under the then modern practice the patentee did not leave it to the reader to identify the essential features of his invention but “(h)e himself specified with particularity those elements or integers of his invention which he claims to be essential to it”;
- (b) if the language which the patentee has used in the claims, upon its true construction, specifies a number of elements or integers acting in a particular relation to one another as constituting the essential features of his invention, the monopoly which he obtains is for that specified combination of elements or integers so acting in relation to one another – and for nothing else. There is no infringement of his monopoly unless each and every one of such elements is present in the process or article which is alleged to infringe his patent and such elements also act in relation to one another in the manner claimed.
- (c) The law as to the principles of construction of claims in specifications in the then modern form was that laid down by Upjohn LJ in *Van der Lely* in the Court of Appeal which was approved by the majority of the House of Lords in a further appeal.

¹²⁹ Diplock LJ at 467 lines 1-21.

[101] Diplock LJ pointed out that, to resolve ambiguities, it was permissible to have resort to the remainder of the specification including the drawings.¹³⁰ He expressed the view that it was not an essential feature of the invention that the sleeves should be of circular section or devoid of any gap in their periphery. In substantiation of this view Diplock LJ referred to the drawings in the specification and said that they showed sleeves that were not circular in section and which had a gap in the lower surface of the upper sleeve and the upper surface of the lower sleeve. In further substantiation of his view – and more importantly – Diplock LJ referred to what would have been obvious to any reader versed in mechanics. He said:

“Secondly, to any reader versed in mechanics it is obvious that there is no need for the section of the hollow sleeve to be circular in order to enable it to perform its required function and that so long as the lower surface of the upper sleeve provides a firm bearing surface for the leaf spring, it makes no difference to the functioning of the bracelet that there is a gap between the parts of the lower surface on each side which bear the spring. Such a reader would realise that the patentee could not have been intending to claim as an essential feature of his invention that the sleeve must be of circular section or devoid of any gap in its periphery in the lower surface of the upper sleeve.”¹³¹

[102] In discussing the principles applicable to the determination of liability for infringement of patents, Diplock LJ made two very important omissions. First, he made no reference to whether or not any of the variations or omissions made by the defendants to the patentee’s inventions added any value to the invention nor does it appear that he paid any attention to the fact that the defendants did not give any reasons why they made such variations. That was a relevant factor to take into account because, once it was found that a particular variation added no material value to the invention, that should be a factor in favour of a finding of infringement. The second matter that Diplock LJ omitted to take into account was the rule on immaterial variations. It was imperative that Diplock LJ should have taken this rule into account and should have given effect to it. His failure to take these two matters into account led him to find that there was no infringement. Had he taken them into account, he would have concluded that there was infringement.

¹³⁰ Lord Diplock at 468 lines 29-31.

¹³¹ Diplock LJ at 468 lines 33-41.

[103] Diplock LJ decided the matter broadly on the basis of the language used by the patentees in their claim. Lord Diplock said:

“For the patentees it has been argued forcefully before us and successfully before the learned judge – that the description of the connecting links as ‘U-shaped bows’ does not make it an essential feature of the invention that the parallel limbs of the link should be open at one end. The only portions of the connecting link which perform an essential mechanical function in the bracelet are the base, which lies outside the hollow sleeves and at right angles to their axis, and those parts of the two limbs which lie within the hollow sleeves near to their open ends. As long as these portions of the connecting links can be fairly described as U-shaped, it matters not, the patentees contend, that one of the limbs of a connecting link at one side of the bracelet between the open ends of two adjacent sleeves is joined to the corresponding limb of the connecting link at the other side of the bracelet between the open ends of the same sleeves, so that two U-shaped links become one composite link roughly in the shape of an elongated approximately rectilinear letter ‘C’. If such a composite connecting link was intended to be covered by the claim it could hardly be described as having two ‘limbs’, and even if it could, such ‘limbs’ could not be ‘inserted’ in the open ends of adjacent sleeves if ‘inserted’ connotes the method of assembling the bracelet as distinct from the mere positional arrangement of its various component parts which is what the patentees are driven to contend it means.”¹³²

Diplock LJ’s approach to the doctrine of pith and marrow in *Rodi* was the same as that of Upjohn LJ in *Van der Lely* in the Court of Appeal.

3.17 Winn LJ’s Judgment

[104] Winn LJ, who gave a separate judgment, said that it was not open to doubt in his view either that the patented invention represented a marked and meritorious development in the art of constructing wrist watch bracelets or that Henry Showell Ltd, appreciating the significance and merits of this advance, set out to produce a competing article which would incorporate the advantages of the patented invention so far as this could be achieved without infringement.¹³³

[105] Winn LJ pointed out that to determine the essential question whether a patent monopoly had been infringed, the starting point of the inquiry was necessarily to

¹³² Diplock LJ at 469 lines 7-25.

¹³³ Winn LJ in *Rodi* at 471 lines 28-33.

ascertain what was the monopoly granted.¹³⁴ Two sentences thereafter he pointed out that in the modern form of specification the patentee “picked out by a series of claims in the characteristics of his invention” and thereby, in general, indicated the essential features which could be omitted or replaced without substantially altering the article for which he is claiming a patent. Winn LJ pointed out that, where a question of alleged infringement arose, it was clear from the judgment of Upjohn LJ in *Van der Lely* in the Court of Appeal¹³⁵ that “to infringe the patent it had to be shown that the invention, as claimed in the relevant claim, had been infringed in all essential respects essential, that is to say, upon the true construction of the claim”. Winn LJ then noted that this judgment was upheld expressly by the majority of the House of Lords.¹³⁶ Winn LJ expressed the view that Lord Evershed MR had defined the question in similar terms in *Birmingham*. In this regard Winn LJ quoted a passage from the judgment of Lord Evershed MR in *Birmingham* where Lord Evershed MR said:

“For the purposes of the present case we are content to treat the question as being in the words of Parker J in *Marconi v British Radio etc* (1911) 28 RPC 181 at 217 ‘whether the infringing apparatus is substantially the same as the apparatus said to have been infringed’. In the question thus formulated we take ‘the apparatus said to have been infringed’ as being the apparatus claimed as the invention in the claiming clause of the specification; and ‘substantially the same’ as meaning ‘in all essential respects the same’.”¹³⁷

Ultimately Winn LJ effectively decided the issue of infringement on the basis of the language used by the patentee in the claim. He said:

“Taking as a whole those portions of the text set out above under (a), (b) and (c) I am of the firm opinion that the claim states as an essential of the invention that into either end of each of the sleeve referred to there should be put from outside, inwards and arranged contiguous to each of those ends, one limb of a connector shaped in a general sense like a capital letter ‘U’ this postulate excludes the use of any connector with a continuous portion running throughout the length of the sleeve and within the sleeve, albeit possessing two ends shaped respectively like ‘U’ pieces”.¹³⁸

¹³⁴ Winn LJ in *Rodi* at 471 lines 38-41.

¹³⁵ At 313.

¹³⁶ Winn LJ at 471 line 44 to p.472 line 3.

¹³⁷ Winn LJ quotes this passage at 472 lines 6-12 of the *Rodi* case from *Birmingham*’s case at 471 line 472.

¹³⁸ Winn LJ in *Rodi* at 473 lines 23-30.

Winn LJ also pointed out that there was an advantage in practice, favouring lateral flexibility of the band, in securing that there be two limbs lying within any particular sleeve able to move independently of one another, as they could not do if joined together by a connecting piece.¹³⁹

[106] In considering the issue of infringement, Winn LJ neither considered what value the differences introduced by the defendants added to the invention or article nor did he at any stage refer to or consider the patent rule on immaterial variations. Winn LJ also concluded that the appeal should be allowed. He found that there was no infringement of the plaintiffs' patent by the defendants' device called EXCALIBUR 59 and the one called EXCALIBUR 60.

[107] The fact that Winn LJ also followed the Upjohn LJ approach in deciding the *Rodi* appeal means that all the three Judges in the Court of Appeal in *Rodi*'s case chose to stick to the Upjohn LJ approach. Unlike in *Van der Lely* in which the Court of Appeal followed the approach adopted by Lloyd-Jacob J in the Court of first instances, in this case it stuck to the approach that Lloyd-Jacob J had adopted in *Van der Lely* and not the one of Lord Reid that Lloyd-Jacob J chose to follow in *Rodi*. There is no indication in any of the three judgments produced in the Court of Appeal in *Rodi*'s case that anyone of the three Judges of the Court of Appeal appreciated the legal quagmire that the approval of the Upjohn LJ approach by both the Court of Appeal and the House of Lords had created for English patent law. There was an appeal against the judgment of the Court of Appeal to the House of Lords.

3.18 Special Observations on the Judgments of the Three Judges in the Court of Appeal in *Rodi*

[108] It is significant to note that that not a single one of the three Judges considered or even referred to the rule on immaterial variations. All three of them seemed to have focused on the language of the claim in the specification. They also did not have regard to, for example, whether the differences had any practical significance. In this regard it needs to be pointed out that Diplock LJ regarded Upjohn LJ's judgment in the Court of Appeal in *Van der Lely* as approved by the House of Lords in the same

¹³⁹ Winn LJ in *Rodi* at 473 lines 30-34.

case as having correctly stated the relevant principles.¹⁴⁰ Of course this was erroneous because both in Upjohn LJ's judgment in the Court of Appeal in *Van der Lely* and in Viscount Radcliff's speech in the same case in the House of Lords the rule on immaterial variations was not mentioned as part of the law on infringement and yet it was part of the law. Once Diplock LJ had taken this view on the law, it was inevitable that he would have no regard to the rule on immaterial variations in his consideration of the issue of infringement and would ultimately conclude that EXCALIBUR 59 did not infringe the patent. Winn LJ did the same.

3.19 More Cracks on the Walls of the House of Lords: The *Rodi* Matter in the House of Lords¹⁴¹

[109] In the House of Lords the matter came before Lord Reid, Lord Morris of Borth-Y-Gest, Lord Hodson, Lord Pearce and Lord Upjohn. The majority of this panel had been involved in the *Van der Lely* case at one level or another. Lord Reid and Lord Hodson were members of the panel which had heard the *Van der Lely* matter in the House of Lords. Lord Reid had given a dissent and Lord Hodson had concurred in the majority judgment of Viscount Radcliffe. Lord Upjohn had given the majority judgment in the *Van der Lely* case in the Court of Appeal. Lord Pearce and Lord Morris were the only Law Lords who had not had anything to do with the *Van der Lely* matter. In the light of this composition of the panel, one is tempted to wonder to what extent the prior involvement of the three members of the panel in different judgments in the *Van der Lely* case would influence the ultimate outcome of *Rodi* in the House of Lords. Two of the members of the panel in the *Rodi* matter in the House of Lords had followed the Upjohn LJ approach in the *Van der Lely* case and found the doctrine of "pith and marrow" not to be applicable whereas one had applied the Lord Reid approach and had found the doctrine of pith and marrow to have been applicable in that case.

[110] The House was divided 3:2 in favour of a finding that the EXCALIBUR 59 did not infringe the plaintiffs' patent. Lord Reid gave a minority judgment. He found that the defendants' bracelet known as EXALIBUR 59 infringed the plaintiff's patent but that

¹⁴⁰ See Diplock LJ at 467 lines 17-21.

¹⁴¹ *Rodi and Wienerberger AG v Henry Showell Ltd* [1969] RPC 367 (HL).

the defendants' bracelet known as EXCALIBUR 60 did not. Accordingly, he concluded that he would allow the appeal with regard to EXCALIBUR 59 but dismiss it with regard to EXCALIBUR 60. With regard to EXCALIBUR 60 Lord Reid was of the view that EXCALIBUR 60, in dispensing with separate spring plates found in the plaintiff's device by modifying the nature of the connecting links, was "essentially different from using substantially the same parts so that they act on each other in substantially the same way".¹⁴² Lord Pearce wrote a separate judgment agreeing with Lord Reid that EXCALIBUR 59 infringed but that EXCALIBUR 60 did not infringe. Accordingly, he too, would allow the appeal relating to EXCALIBUR 59 but dismiss the appeal in respect of EXCALIBUR 60. The other Law Lords concluded in three separate speeches that the appeal be dismissed in respect of both EXCALIBUR 59 and EXCALIBUR 60. It is necessary to discuss the different approaches adopted by the majority and the minority in their different speeches. It is convenient to start off with the majority.

3.20 Lord Morris' Judgment

[111] Lord Morris of Borth-y-Gest referred¹⁴³ to a part in *Van der Lely NV v Bamfords Ltd*¹⁴⁴ where it was said that the patentee is tied strictly to the invention which he claims and the mode of effecting an improvement which he says is his invention and also to a part in *Van der Lely* where it was said that "[i]t is he who has committed himself to the unequivocal description of what he claims to have invented, and he must submit in the first place to be judged by his own action and words".¹⁴⁵ Lord Morris pointed¹⁴⁶ out that this did not mean that an allegation of infringement could be answered by pointing out that a method had been adopted which in some unimportant respect was different from that described in a claim. He then quoted a passage from Lord Reid's speech in *Van der Lely* at 75 which, in turn, had quoted a passage from James LJ's judgment in *Clark v Adie* which was to the effect that there could be an essence or substance of the invention underlying the mere accident of form and that an invention could be pirated by a theft in a disguised or mutilated form

¹⁴² Lord Reid at 379 line 45 to 380 line 2.

¹⁴³ Lord Morris at 380.

¹⁴⁴ [1963] RPC 61 at 75.

¹⁴⁵ *Van der Lely*'s case at 75.

¹⁴⁶ *Rodi*'s case at 380 lines 26-32.

and that in every case it would be a question of fact whether the alleged piracy is the same in substance and effect or is a substantially new or different combination.¹⁴⁷

[112] Lord Morris said that when there is an allegation of infringement it becomes, therefore, a question of considering substance rather than mere form.¹⁴⁸ Lord Morris observed that it was pointed out in *Marconi* that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations.¹⁴⁹ He quoted another passage from the same judgment that, *inter alia*, said that everyone who produces the same result by using the essential parts of the combination or process is an infringer, even though he has, in fact, altered the combination or process by omitting some unessential part or step and substituting another part or step, which is, in fact, equivalent to the part or step he has omitted. It was said in the same judgment that the question here, again, was a question of the essential features of the invention said to have been infringed.¹⁵⁰

[113] Lord Morris also referred to a passage in *Birmingham*¹⁵¹ where it was, *inter alia*, said that “[t]he question therefore appears to be whether the allegedly infringing apparatus consists of substantially the same parts acting upon each other in substantially the same way as the apparatus claimed as constituting the invention”.¹⁵² However, Lord Morris also referred to the speech of Viscount Radcliffe in the *Van der Lely* matter in the House of Lords where Viscount Radcliff took a very rigid approach on tying the patentee to the strict terms of his claim. In the passage which Lord Morris quoted from Viscount Radcliff’s speech in *Van der Lely*, Viscount Radcliffe, *inter alia*, cautioned that when therefore one speaks of theft or piracy of another’s invention or says that it has been “taken” by an alleged infringer and the “pith and marrow” principle is invoked to support the accusation, one must be very careful to see that the inventor has not by the actual form of his claim left open to the world the

¹⁴⁷ Lord Morris at 380 lines 30-35.

¹⁴⁸ Lord Morris at 380 lines 38-39.

¹⁴⁹ Lord Morris at 380 lines 39-42.

¹⁵⁰ Lord Morris in *Marconi*’s case at 380 line 43 380 line 3 quoting from the judgment in *Marconi*’s case at 217.

¹⁵¹ *Birmingham Sound Reproducers v Collaro Ltd* [1956] RPC 232.

¹⁵² *Birmingham Sound Reproducers* case 245. Cole states that it is apparent from *Catnic* at page 244 lines 13-15 that the existence or absence of a plausible reason why a rational patentee would have wished to place a limitation on his invention forms part of the third part of the test since a patentee would not intentionally make his monopoly worthless for practical purposes. He also cautions that the third part of the *Catnic* test should not be used as a backdoor route to reintroduce the strict constructionist’s verbal analysis that was condemned in *Catnic*. (Cole Paul G “Purposeful Construction under English Law” (1994) *EIPR* at p5).

appropriation of just that property that he says has been filched from him by piracy or theft.¹⁵³

[114] The approach taken by Lord Morris after referring to the above authorities was to the effect that the Court should study the relevant claim and, if necessary, construe it and thereafter consider what the defendants have done.¹⁵⁴ Very importantly, Lord Morris asked the correct questions. He asked:

“Have they or have they not taken all the essential features or integers of the invention claimed? If there are variations, are they immaterial? If there are differences, are they differences in essential respects or in inessential respects?”¹⁵⁵

One can see from this passage that Lord Morris did have as one of the factors to be considered the question whether, if there were differences, such differences were material or immaterial or to put it differently, whether the differences related to essential or inessential respects. This approach was correct. The next question would be how he would determine the materiality or immateriality of the differences and what the consequences of such conclusion would be to the question whether there was infringement or not.

[115] Lord Morris said that, like Harman LJ in the Court of Appeal in the same matter he was approaching the matter, with some sympathy for the plaintiffs because not only did their invention have new and valuable features but its “broad notion” did seem to have been imitated by the defendants. However, he considered that claim 1 was clear. His view was that it was a claim requiring a combination of integers. He said that it was manifest that in what the defendants had produced there were differences and the question was whether or not the differences were in essential respects.¹⁵⁶

[116] Lord Morris thereafter sought to apply to the case the principles he believed to be applicable. Lord Morris set out the three features of the plaintiffs’ invention.¹⁵⁷ Those were the same features as those found by the Court of Appeal. They were:

¹⁵³ Lord Morris in *Rodi*’s case at 281 lines 20-26 quoting Viscount Radcliffe in *Van der Lely*’s case at 78.

¹⁵⁴ Lord Morris in *Rodi* at 381 lines 26-28.

¹⁵⁵ Lord Morris in *Rodi* at 381 lines 28-31.

¹⁵⁶ Lord Morris in *Rodi* at 381.

¹⁵⁷ At 381 lines 38-48.

- (a) that the connecting links between the staggered layers of sleeves were constituted by U-shaped connecting bows arranged in the longitudinal edges of the claim;
- (b) that those “bows” were inserted in pairs with one of the limbs of each in the open end of the sleeve of the one layer and with one of the limbs of each in the open end of the sleeve of the one layer and with the other limb in one of the adjacent sleeves of the other layer; and
- (c) that in each sleeve there was a leaf spring comprising a bent spring plate which spring plate kept the connecting bows firmly in the sleeve and acted by spring action against their pivoting when the chain was stretched or bent.¹⁵⁸

In the next sentence Lord Morris said that it seemed to him that these elements of the plaintiffs’ claim had to be regarded as essential ones¹⁵⁹ but he did not substantiate this conclusion.

[117] Lord Morris referred to certain differences between the plaintiffs’ invention and the defendants’ device and concluded that the defendants’ departures from the plaintiffs’ claim were in respect of essential elements and that, therefore, EXCALIBUR 59 was not an infringement. Lord Morris did not in reaching this conclusion refer to how a person skilled in the art would have understood the relevant claim nor did he refer to what such person would have understood to have been the patentee’s intention. Also of significance is the fact that Lord Morris did not refer to whether or not the variant had any practical effect on the functioning of the invention. He also did not consider the matter from the point of view of what the patentee intended to be the essential elements. He decided what elements were essential on the basis of his view in this regard. He concluded that EXCALIBUR 59 did not infringe nor did EXCALIBUR 60.

[118] Lord Morris referred to the plaintiffs’ contentions that the form of connecting links devised by the defendants in their EXCALIBUR 59 which the plaintiffs described as

¹⁵⁸ At 381 lines 44-45.

¹⁵⁹ He was referring to the three features given in (a)-(c) in the preceding paragraph.

“C-shaped” were no different from or were the equivalent of a pair of opposite U-shaped connecting bows and that because the defendants’ connecting links would be found in or would rest or lie in the hollow sleeves they were “inserted” in the way in which that word was used in claim 1. Lord Morris rejected these contentions as involving ignoring the plain meaning of the words in claim 1.¹⁶⁰ Lord Morris quoted a passage from the judgment of the judge of first instance in which that judge had described what, in his view, the plaintiffs’ device. The quotation focused on the language of the claim. Lord Morris then said:

“I can only regard such U-shaped connecting bows as being essential parts. The specification had stated that the feature of the chain band according to the invention is its ‘very great extensibility and flexibility’. The specification had also set out that the chain band was composed of only three different parts (the sleeves, the connecting bows and the spring plates) and that its construction and assembly was extremely simple and its manufacture very economical ‘especially as the parts can be inserted within one another without any soldering or riveting’.”¹⁶¹

[119] Lord Morris then turned to the defendants’ device. He said that the defendants’ connecting links were different and, in his view, were essentially different. He pointed out that within one sleeve it was not possible to identify four limbs unless limbs without any terminal points were to be counted. Furthermore, he said that it seemed to him that in their context the words “inserted in” could only mean, and were only intended to mean, that a U-shaped connecting bow was to be inserted by being pushed in at the end of a sleeve so that one of its limbs would be in the open end of a sleeve in one layer and the other limb in the open end of an adjacent sleeve in the other layer. He observed that the defendants’ fraction and method were such that their connecting links could not be pushed in the open ends of sleeve. His view was that the defendants’ construction involved departures in material respects from the essential features of the plaintiffs’ invention to which he had referred. Lord Morris pointed out that as a result of the differences the defendants did not achieve the flexibility which the plaintiffs claimed as one of the features of their chain band.¹⁶²

¹⁶⁰ Lord Morris in *Rodi* at 382 lines 6-7.

¹⁶¹ Lord Morris in *Rodi* at 382 lines 31-37.

¹⁶² Lord Morris in *Rodi* at 382 line 37 383 line 8.

[120] Despite the fact that Lord Morris recognised that the materiality of the differences between the patentee’s invention and the defendants’ device was important in the determination of non-textual infringement and actually referred also to the well-known patent rule on immaterial variations he failed to apply this to the determination of non-textual infringement in the *Rodi* case. This happened because he failed to ask the question whether the differences to be found in the defendants’ device were of any practical significance in the functioning of the device. He did note that the chain band in the defendants’ device did not achieve flexibility but that should not have been the end of the enquiry. He should have asked what value flexibility added. Flexibility that did not add any functional value was immaterial. Lord Morris found that there was no infringement in respect of both devices.

3.21 Lord Hodson’s Judgment

[121] Lord Hodson also gave a separate judgment. He, too, adopted the approach that the question was whether the infringing apparatus was substantially the same as the apparatus said to have been infringed.¹⁶³ In this regard he referred to Parker J’s judgment in *Marconi*’s case and to the judgment in *Birmingham* where it was, *inter alia*, said:

“The question therefore appears to be whether the allegedly infringing apparatus consists of substantially the same parts acting upon each other in substantially the same way the apparatus claimed as constituting the invention”¹⁶⁴

Lord Hodson reached the same conclusion as the Court of Appeal in terms of the essential elements of the relevant claim and on infringement. The observations made above about Lord Morris’ speech apply with equal force to Lord Hodson’s speech as well.

[122] In considering whether or not EXCALIBUR 59 had been infringed, Lord Hodson did not refer to the rule of patent law on immaterial variations. However, he did refer to a passage in Lord Evershed MR’s judgment in *Birmingham* where in relation to a case

¹⁶³ Lord Hodson at 383 lines 39-45.

¹⁶⁴ Lord Hodson at 383 quoting from *Birmingham* at 245.

where there was no textual or literal infringement but a combination, the Master of the Rolls said:

“The question therefore appears to be whether the allegedly infringing apparatus consists of substantially the same parts acting upon each other in substantially the same way as the apparatus claimed as constituting the invention. It is not enough to find that the parts comprised in the respondents’ apparatus produce the same result as the appellants’ apparatus. It must be shown that the respondents’ selection and arrangement of parts is substantially the same as the appellants’ selection and arrangement of parts, for it is in such selection and arrangement that the appellants’ invention resides.”¹⁶⁵

[123] Lord Hodson thereafter dealt with the question of what the claim in this case stated as essential. After quoting the claim, Lord Hodson dealt with the connecting bows. He said that, in his opinion, the connecting bows were claimed by the patentees as essential features. It is important to pause here and make the observation that in this regard Lord Hodson was not seeking to decide whether or not the connecting bows were, objectively speaking, essential features nor was he seeking to decide whether the notional addressee would have understood the patentee to have intended the connecting bows to be essential features. He sought only to decide what “the claim in this case state as essential”.¹⁶⁶ In this regard he decided this according to his opinion. He said:

“These are, in my opinion, claimed by the patentees as an essential”.¹⁶⁷

[124] In support of his opinion that the connecting bows were claimed by the patentees as essential features, Lord Hodson said:

- that the connecting bows were described as inserted in pairs with one of the limbs of each in the open end of a sleeve of the one layer and with the other limb in one of the adjacent sleeves of the other layer which were in a staggered position and it was said that this produced a result which featured very great extensibility and flexibility of the chain band.

¹⁶⁵ Lord Hodson in *Rodi* at 385 quoting Lord Evershed MR *Birmingham* at 245.

¹⁶⁶ Lord Hodson in *Rodi* at 385 line 17.

¹⁶⁷ Lord Hodson in *Rodi* at lines 23-30.

- that he could not regard the pieces of metal which the defendants used as connecting links as equivalent to the U- bows in the claim, he said that this was not simply a joining of one arm of each of two U-bows; he said that each performed the function of two U bows but in a different manner so that there was less flexibility than that which existed in the patent in suit. He said that “this member” could not be inserted in the ends of the sleeves by reason of its shape which in turn prevented it “falling out of either end of a sleeve”.

Lord Hodson also pointed out that simplicity of construction and assembly and economy of manufacture were advanced by the patentees as important features of their invention especially as the parts could be inserted within one another without any soldering or riveting. Lord Hodson expressed the view that the word “inserted” could only refer to the method of assembly. He pointed out that it was in this sense, that of being “put in”, that the word was used throughout the specification. He said that it would be odd if it were otherwise.¹⁶⁸ Lord Hodson expressed the view that the patentees had made the bows and their insertion in the open ends of the sleeves essential.¹⁶⁹

[125] Lord Hodson said that one other feature that was claimed by the plaintiffs as an essential integer was the “spring plate which keeps the connecting bows firmly in the sleeve”.¹⁷⁰ He pointed out that the plaintiffs’ argument was that the bows were prevented from lying loosely within the sleeve and that this had been taken by the defendants. Lord Hodson thought that this construction gave too limited a meaning to the word “firmly”. He was persuaded by the defendants’ construction that the phrase covered keeping in the sleeve so that the bows did not fall out.¹⁷¹ He said that, if read in this way, there was no infringement, for the defendants’ article was so constructed that there were no U-bows to keep from falling out because they had been replaced by a single C-shaped piece of metal which was so designed that it did not require a spring to prevent it from falling out. Lord Hodson then pointed out that this particular argument of the plaintiffs was virtually abandoned during the hearing in the House of

¹⁶⁸ Lord Hodson in *Rodi* at 385 lines 34-36.

¹⁶⁹ Lord Hodson in *Rodi* at 386 lines 2-3.

¹⁷⁰ Lord Hodson in *Rodi* at 386 lines 8-10.

¹⁷¹ Lord Hodson in *Rodi* at 386 lines 13-15.

Lords.¹⁷² Lord Hodson then agreed with the approach adopted by the Court of Appeal on the question of essentiality. He did not inquire into what the practical significance was of the C-shaped piece of metal nor did he refer to the patent law rule on immaterial variations.

3.22 Lord Pearce's Speech in the House of Lords in *Rodi*

[126] Lord Pearce also delivered a separate speech. His speech produced the same result as that of Lord Reid although he made no reference to Lord Reid's speech. Two matters need to be mentioned with regard to Lord Pearce's speech. The one is that, unlike Lord Morris and Lord Hodson, Lord Pearce pointed out that it was important that "in construing a patent one should seek to find what it means to the reasonable person who is reasonably versed in the matters of which it speaks – in this case mechanical".¹⁷³ Lord Pearce continued in the next three sentences:

"It is directed to the workshop and the market place rather than to the cloister. For that reason a plain straightforward construction is generally to be preferred to one that is strained or literally or tortuous. And meticulous niceties of construction of which are wholly appropriate to the legal document may seem to the practical man to have a flavour of pedantry if they so whittle away a patent that they enable a copyist to avoid its ambit by means that seem to be concerned with words rather than essentials."¹⁷⁴

Lord Pearce then referred to the question as formulated in *Birmingham's* case. He also referred to Marconi's case in support of the principle that, if you borrow the substance of a patented invention, you cannot escape the consequences of infringement by making immaterial variations to the patented invention.¹⁷⁵ It is also significant that Lord Pearce did have regard to the issue of a functional difference.¹⁷⁶

[127] Lord Pearce, like Lord Reid, found that EXCALIBUR 59 constituted a non-textual infringement of the plaintiffs' patent. Lord Pearce wrote with disapproval of an approach to the construction of patent claims which he described as "alphabetical" and "meticulous". Lord Pearce said:

¹⁷² Lord Hodson in *Rodi* at 386 lines 14-19.

¹⁷³ At 387 line 46 to 388 line 1.

¹⁷⁴ Lord Pearce at 388 lines 1-7.

¹⁷⁵ At 388 lines 10-15.

¹⁷⁶ At 387 lines 26-31.

“A mechanically minded person at first sight when reading the specification might wonder what could be said to be the essential difference between the plaintiffs’ and the defendants’ bracelets and why the defendants could be said not to have infringed the plaintiffs’ patent. The answer to the question, an answer which he might or might not find satisfactory is this. The defendants, instead of anchoring the connections at each end by the catching device in claim 2, anchored them by joining up one of the limbs of the connector at one end to one of the limbs of the connector at the opposite end of the sleeve. Thus two Us became one C. Since the claim refers to connectors as ‘U-shaped bows’ it is said that a C-shaped connector cannot be an infringement. Considerable stress is laid on the *alphabetical* approach. It is even argued that had the U-shaped connector had uneven limbs (*even though this produced no functional difference*) so that it had the appearance of a J rather than a U, this would have enabled a defendant, to escape infringement.”¹⁷⁷

In response to this construction Lord Pearce said:

“I do not find this *meticulous construction* attractive. Had the claim been a direction to a printer or a type-setter, the *alphabetical approach* would seem to me correct, since the alphabet would clearly be relevant and the identity and formation of a particular letter would probably be the essential ingredient of the integer described. But the essence of the connector to anybody thinking on *mechanical rather than literary lines* would be a bridge connecting two parallel limbs which would lie in adjacent sleeves. That quality would be fulfilled whether one described it as U-shaped bows or J-shaped links or goal posts.”¹⁷⁸

[128] Lord Pearce pointed out that, if one discarded “alphabetical niceties”, there remained “the more solid argument that here, instead of the two U-shaped bows, one has running all through the sleeve one continuous integer albeit having at each end (at the relevant point of interconnection) a link which performs the same function as a U-shaped link in that it acts as a bridge to join the adjacent sleeves and in that its limbs perform the pivotal action against the leaf springs”.¹⁷⁹

[129] Earlier on reference was made to a statement by Lord Pearce where he spoke against what he called “meticulous construction”.¹⁸⁰ He also implied his rejection of a construction that ran along “literary lines”.¹⁸¹ He also referred to this approach to

¹⁷⁷ Lord Pearce in *Rodi* at 387 lines 18-31 (author’s emphasis).

¹⁷⁸ Lord Pearce in *Rodi* at 387 lines 30-38 (author’s emphasis).

¹⁷⁹ Lord Pearce in *Rodi* at 387 lines 39-44.

¹⁸⁰ Lord Pearce in *Rodi* at 387 lines 30-31.

¹⁸¹ Lord Pearce in *Rodi* at 387 lines 35-36.

construction as “the alphabetical approach”.¹⁸² After revealing his disapproval of the “meticulous” construction or the literary approach or the alphabetical approach to the construction of specifications, Lord Pearce then gave his view of what the correct approach was to the construction of patent claims. In this regard he said:

“It is important that in construing a patent one should seek to find what it means to the reasonable person who is reasonably versed in the matters of which it speaks – in this case mechanical. It is directed to the workshop and the market place rather than to the cloister. For this reason a plain straight forward construction is generally to be preferred to one that is strained or literary or tortuous. And meticulous niceties of construction which are wholly appropriate to a legal document may seem to the practical man to have a flavour of pedantry if they so whittle away a patent that they enable a copyist to avoid its ambit by means that seem to be concerned with words rather than essentials.”¹⁸³

[130] With regard to what the real question was that had to be answered, Lord Pearce had this to say after setting out the correct approach for the construction of patent claims:

“The real question is whether one finds here substantially the same parts acting in substantially the same way so far as concerns essentials (see *Birmingham Sound Reproducers Ltd v Collaro* [1956] RPC 232 at 245). It is a well-known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations. From this point of view, the question is whether the infringing apparatus is substantially the same as the apparatus said to have been infringed. (Per Parker J in *Marconi v British Radio Telegraph and Telephone Co Ltd* (1911) 28 RPC 181 at 217.)”¹⁸⁴

Lord Pearce pointed out that the defendants had advanced three grounds upon which they had contended that there was no infringement. The first was that the connecting links in EXCALIBUR 59 consisted of the one C-shaped link in the place of the two connecting U-shaped bows. The second was that the C-shaped link was not capable of being inserted into the open ends of the sleeves in the process of assembly and it was the act of insertion which was protected. The third was that the spring plates in EXCALIBUR 59 did not perform the function of keeping the connecting bows firmly in the sleeves.

¹⁸² Lord Pearce in *Rodi* at 387 lines 31-34.

¹⁸³ Lord Pearce in *Rodi* at 387 lines 45 to 388 line 7. The thrust of the first two sentences of this passage seem to have been taken by Lord Diplock in *Catnic* when in his *Catnic* judgment he referred to the role of the notional addressee.

¹⁸⁴ Lord Pearce in *Rodi* at 388 lines 8-15.

[131] Lord Pearce quickly disposed of the third ground on the basis that there was nothing left of that ground in argument when it became apparent that in EXCALIBUR 59 the spring did perform the function of keeping the bows firmly in the sleeves. Lord Pearce continued and pointed out that, since the upper sleeves had wide gaps which were bridged only by the spring on which the outside ends of the C-shaped link were held, one had only to remove the spring and the C-shaped ends would then fall apart through the gap and the bracelet would at once come to pieces.¹⁸⁵ With regard to the other two grounds Lord Pearce had quite a lot to say. He rejected the proposition that “... inserted in pairs with one of the limbs of each in the open end of a sleeve and so forth necessarily connotes the method of assembly”.¹⁸⁶ It seemed to him “too strained and meticulous a construction of the claim”.¹⁸⁷ He said that “the more natural meaning” of the claim seemed to him to be that “inserted in pairs” was “a description of the completed article as it lies at the table”.¹⁸⁸

[132] Lord Pearce continued and made the following points in support of his construction:

- (a) that the earlier and later parts of the sentence confirmed his view; he said that the sentence dealt with the position in which the sleeves were “arranged”, meaning “the staggered arrangement which one finds in the constructed bracelet on the table without reference to the method by which the operator arranged the sleeves”.¹⁸⁹
- (b) that the sentence went on to deal with the general in which the connecting bows were arranged, namely, in the longitudinal edge of the chain.
- (c) that the next thing that the sentence dealt with was “the intricate explanation of the interlocking of the bows with the sleeves, ‘which bows are inserted in pairs with one of the limbs of each in the open ends of the sleeve’.”¹⁹⁰

¹⁸⁵ Lord Pearce in *Rodi* at 388 lines 24-29.

¹⁸⁶ Lord Pearce in *Rodi* at 388 lines 29-32.

¹⁸⁷ Lord Pearce in *Rodi* at 88 lines 32-33.

¹⁸⁸ Lord Pearce in *Rodi* at 388 lines 35-36.

¹⁸⁹ Lord Pearce in *Rodi* at 388 lines 38-39.

¹⁹⁰ Lord Pearce in *Rodi* at 388 lines 39-43.

[133] Lord Pearce then observed that the sentence did not say that the bows were “inserted into the ends of the sleeve”.¹⁹¹ He said that it was perfectly reasonable “to start a new clause (as it does) for this rather lengthy explanation”.¹⁹² Lord Pearce then made the following points:

- 1 Without the new clause the lengthy explanation would have to depend on the previous word “arranged” and would, “like a wounded snake, drag its slow length along”.
- 2 The new clause might have repeated the word “arranged” but “inserted in pairs” was a reasonable choice of words for the purpose and made the matter far more clear. To regard the words “inserted in pairs” as demonstrating that the clause was switching over from the arrangement of the completed bracelet to the actual method of constructing it and then switching back again in the concluding part of the sentence to what was plainly a description of the spring as it lay on the table after assembly seemed to him too strained an interpretation. He took the view that the “pairs” were clearly the pairs which lay side by side in each open end of a sleeve, not pairs of which one half was at one end and one half at the other. He thought that this was demonstrated by two things. First, the rational way of describing the interaction of the integers was to refer to the interlocking of three sleeves so as to give an idea of one completed sleeve end. Naturally, said Lord Pearce, the other end of the sleeve would be similarly furnished to make the thing work, but there was no need to describe both ends. Secondly, any ambiguity was made plain by the sentence into specification (page 2 line 80) beginning: “The connecting bows are inserted in pairs next to each other with their upper limbs in the open end of a sleeve of the upper layer”, and so forth. He said that the words in italics were consistent only with what he regarded as a more normal construction of the words “inserted in pairs”, namely, that the pairs were the two *Us* side by side whose limbs shared the occupancy of the open end of a sleeve.

¹⁹¹ Lord Pearce in *Rodi* at 388 lines 43-45.

¹⁹² Lord Pearce in *Rodi* at 388 lines 44-45.

3 Further, if one is going to be so literal and say that “inserted” (alone among the various directions) refers to a method of assembly, one should presumably limit the claim to bows “inserted in pairs, so that it would not cover operators who chose to insert them one at a time. Moreover, he doubted if it was possible for an operator, strictly speaking, to insert them in pairs in the small holes at the end of the sleeves. He said that it would take great ambidexterity. Thus, the addition of the words “in pairs” seemed to him to tell strongly against the suggestion that it was the method of construction and not the article as completed which was the objective of the clause. He observed that in the judgment in the courts below there were various references which were inserted in brackets after the relevant case. He said that he would not wish this observation to be taken as an assertion that the learned judges had either inserted the references after completing their judgments, which he said would be unusual, or that they had inserted the references into the brackets after first writing out the brackets, which he said would be eccentric.¹⁹³

[134] In conclusion on the issue of whether EXCALIBUR 59 was an infringement, Lord Pearce said that the real point of the case was whether the fact that two connectors were made into one was sufficient to avoid the infringement. He said that in his opinion it was not. He pointed out that it was not enough to say that the U-shaped bow was an essential integer and that the defendants had not got two U-shaped bows but only one C-shaped connector. Lord Pearce took the view that the question was whether the essential part of the essential integer was taken although the inessential parts of it had been omitted. Lord Pearce said that neither the individual U-shape (as opposed to any other alphabetical shape) nor its lack of attachment to the connector at the other end was its essential quality. He pointed out that its essential feature lay in that it connected two adjacent sleeves by a bridge between two parallel limbs that lay in the sleeves and pivoted on the spring. Lord Pearce observed that the C-shaped connector had this feature too, since it had at each end a U-shape which performed the functions of the plaintiffs’ U-shaped bows and it pivoted on the spring in precisely the same way. He said that in all essential respects, therefore, it was the same. He

¹⁹³ Lord Pearce in *Rodi* at 388 line 45 to 389 line 33.

concluded that the matters in which it differed were inessential.”¹⁹⁴ Lord Pearce found that EXCALIBUR 59 infringed the patent but not EXCALIBUR 60. It is to be noted that Lord Pearce did refer to and considered the rule of patent law on immaterial variations.

3.23 Lord Upjohn’s Judgment

[135] Lord Upjohn also delivered a separate speech. In dealing with the principles and the approach to the construction of patent claims and the determination of non-textual infringement thereof, Lord Upjohn made the following important points:¹⁹⁵

- (a) the question whether the relevant claim had been infringed was purely a question of construction of the claim read as a matter of ordinary language in the light of the complete specification taken as a whole;
- (b) a specification had to be construed without having in mind the alleged infringement;
- (c) what is not claimed is disclaimed;
- (d) the claim must be read through the eyes of the national addressee, the man who is going to carry out the invention described; he also said that “this document must be read through the eyes of the common man at his bench”;¹⁹⁶
- (e) in considering a claim, the Court must ascertain what are the essential integers of the claim;¹⁹⁷
- (f) the determination of what are the essential integers of a claim is a question of construction and no general principles can be laid down;

¹⁹⁴ Lord Pearce in *Rodi* at 389 line 34-41.

¹⁹⁵ At 391 lines 1-3.

¹⁹⁶ At 391 lines 5-9.

¹⁹⁷ At 391 lines 10-11.

- (g) once the essential integers have been determined, the infringing article must be considered and, to constitute infringement, the article must take each and everyone of the essential integers of the claim;
- (h) non-essential integers may be omitted or replaced by mechanical equivalents and there will still be infringement;
- (i) where the invention, as in the *Rodi* matter, resides in a new combination of known integers but also merely in a new arrangement and interaction of ordinary working parts it is not sufficient to show that the same result is reached; the working parts must act on one another in the way claimed in the claim of the patent. In this regard Lord Upjohn referred to a passage in Lord Evershed's judgment in *Birmingham's*¹⁹⁸ case;
- (j) if the patentee has in his specification limited the essential features of his claim in a manner that may appear to be unnecessary, it may be that the copier can escape infringement by adopting some simple mechanical equivalent so that it cannot be said that every essential integer of the claim has been taken;
- (k) it must not be forgotten that some claim may on a superficial reading appear to be unnecessarily circumscribed but those who have drafted them may have done so in the light of the prior art and have rightly been fearful of claiming too much with adverse effects upon the validity of the claim;
- (l) the argument "that per *incuriam* there has been some unnecessary limitation could only be accepted in cases where there can be shown to have been some slip of the pen";¹⁹⁹
- (m) Lord Upjohn, in the course of his consideration of the claim, referred to the notional reader as well as his own interpretation; and
- (n) Lord Upjohn mentioned that the "difference might seem to be utterly irrelevant to a wrist watch bracelet".²⁰⁰

¹⁹⁸ In *Birmingham's* case at 245.

¹⁹⁹ Lord Upjohn in *Rodi* at 392 lines 7-13.

²⁰⁰ At 394 lines 10-13.

[136] It is significant to highlight the point that in his speech Lord Upjohn did not refer to the rule of patent law on immaterial variations. That is the rule that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention. As to the principles on infringement Lord Upjohn referred to his own judgment in the Court of Appeal in *Van der Lely* (which was approved by the House of Lords) and to Winn LJ's judgment in the Court of Appeal. What is remarkable about all these judgments which guided Lord Upjohn with regard to the principles on infringement is the conspicuous absence of any reference to the rule on immaterial variations in each and everyone of them. Lord Upjohn concluded that EXCALIBUR 59 did not infringe the plaintiffs' claim 1. He also found that EXCALIBUR 60 also did not infringe. Lord Upjohn had no regard to the practical value of the variant nor did he have regard to the rule of patent law that, if you borrow the substance of a patented invention, you cannot escape the consequences of infringement by making immaterial variations. It is important to point out that by his own admission Lord Upjohn reached the conclusion that he reached in *Rodi* "upon the wording of the claim".²⁰¹ Lord Upjohn also indicated in terms that he was using "the literal words of the claim".²⁰² This supports the view that the Upjohn LJ approach was based on literalism. It is now necessary to deal with Lord Reid's speech.

3.24 Lord Reid's Speech in the *Rodi* Matter in the House of Lords

[137] It is necessary to deal briefly with how Lord Reid came to the conclusion that he came to on the issue of infringement. It is important to point out that, unlike his speech in the *Van der Lely* case, Lord Reid's judgment in *Rodi*'s case did not contain any discussion of the principles of construction and of the doctrine of pith and marrow. He simply set out the facts and applied to the facts the principles he believed to be applicable.

[138] One of the factors that Lord Reid took into account in considering infringement was what value the difference in the defendants' device added to the invention. He said that EXCALIBUR 59 was made in exactly the same way as the plaintiff's bracelet but

²⁰¹ See Lord Upjohn in *Rodi* in the House of Lords at 394 lines 1-5.

²⁰² See Lord Upjohn in *Rodi* in the House of Lords, second last paragraph at 393.

for one alteration. He explained that in the plaintiff's bracelet the connecting links at one end of each sleeve were separate from those at the other end. He said that each one of the connecting links was roughly in the shape of a capital U, with the upright parts of the U going into different sleeves and the curved part forming a bridge or connection between them. He said that in EXCALIBUR 59 one limb of the U was extended and joined to the corresponding limb of the corresponding U at the other end of the sleeve, thus making a double link of the shape of an elongated letter C. Lord Reid then pointed out that in his opinion functionally this made "no material difference". He said that it made the bracelet slightly less flexible if one tried to bend it in a way in which no one would normally try to do. He added:

"It makes the role of the spring plates slightly different – a matter to which I shall return. It makes no material difference to the ease with which the parts can be assembled, or the bracelet can be shortened by taking out one or more sleeves."²⁰³

Lord Reid went on to point out that it was said that "this small change takes EXCALIBUR 59 out of the ambit of the claim in the plaintiffs' specification".²⁰⁴

[139] Lord Reid pointed out that it was not disputed that "a very slight alteration" of the wording of the claim would make it quite clear that the claim was wide enough to cover C-shaped connecting links.²⁰⁵ "But", said Lord Reid, "it is said that the inventor has tied himself to words which are not wide enough to cover C-shaped links. It is not suggested that there was any possible reason for limiting the claim in this way. If it has been so limited it must have been per *incuriam*. No doubt, if the reader of a specification is astute enough to see that the patentee has framed his claim so narrowly as to leave it open to him by some small modification to use the invention without infringing the claim, he is quite entitled to do that. He cannot be accused of sharp practice. He is within his legal right."²⁰⁶

[140] It is not clear from the above passage what Lord Reid meant in the last three sentences in the above passage.²⁰⁷ Whether he is there expressing his views or whether he is

²⁰³ At 377 (last line) to 378 line 3.

²⁰⁴ At 378 lines 4-5.

²⁰⁵ At 378 lines 6-8.

²⁰⁶ At 378 lines 8-15.

²⁰⁷ This is at 378 lines 9-15.

simply recording what was being said in support of the proposition that the defendants' device did not infringe the plaintiff's invention is not clear. It is thought that he probably was recording what was being said in support of a no infringement finding. This has to be so because everything contained in those three sentences appears to be completely in conflict with Lord Reid's view of the legal position as set out in his minority judgment in the *Van der Lely* case as well as the way he came to the conclusion that EXCALIBUR 59 infringed the plaintiff's patent. It is, among others, in conflict with the trite principle of patent law that a person who borrows the substance of a patented invention cannot escape the consequences of infringement by making immaterial variations thereto. And that is the principle which formed the basis of his judgment in *Van der Lely* and of his conclusion with regard to the infringement of the plaintiff's invention by EXALIBUR 59.

[141] In the sentence following the three sentences referred to above in the passage, Lord Reid seemed to give an answer to what he said in those sentences was being said in support of a non-infringement finding. He said that claims are not addressed to conveyancers; they are addressed to practical men skilled in the prior art, and he did not think that they ought to be construed with that meticulousness which was once thought appropriate for conveyancing documents.²⁰⁸ It is suggested that in this sentence Lord Reid was rejecting the notion contained in the three sentences referred to above.

[142] Lord Reid then referred to the part of claim 1 which dealt with connecting links. That part of the claim read thus:

“... the connecting links are constituted by U-shaped connecting bows (14) arranged in the longitudinal edges of the chain, which bows are inserted in pairs with one of its limbs (15) of each in the open end of a sleeve (10) of the one layer and with the other limb (16) in one of the adjacent sleeves (11) of the other layer which are in a staggered position ...”²⁰⁹

²⁰⁸ At 378 lines 15-18.

²⁰⁹ At 378 lines 19-24.

Lord Reid pointed out that the crucial phrase in the relevant part of the specification dealing with connecting links was the phrase: “constituted by U- shaped connecting bows”. He then said:

“This cannot be taken quite literally. ‘Bow’ normally means or connotes a curve. But suppose the links consisted each of two straight parallel limbs joined by a straight piece at right angles to them. There would be no curve and the link would not be in the shape of any letter U ever used by a printer. Or suppose that one limb were made longer than the other so that the link had the shape of the letter J. Would any practical man listen for one moment to a contention that these were not ‘U-shaped bows’? Then suppose you join the longer limbs of two J’s together. Why do you cease to have U-shaped connecting links? That must surely depend on a construction of the claim as a whole read in the light of the rest of the specification. If this shows that there is any virtue in keeping the Us separate then this change would take the double link out of the ambit of the claim. But otherwise you still have two U-shaped connecting links, but they are joined together. The connecting link is, in my view, the part at the end of the sleeves which connects the two sleeves and it does not cease to be a U-shaped link because one limb has been joined to another link.”

[143] Thereafter Lord Reid then addressed that part of the claim where the claim proceeds “which bows are inserted in pairs”. Lord Reid said that, if “pairs” referred to the pairs of links which the defendants had joined together, that would be important. However, he said that, as he read the claim, those were clearly not the pairs referred to. He said that both ends of the pairs which had been joined together connected the same link in the one layer with the same link in the other layer. But, said Lord Reid, here the reference was to the pair of links at the same end of one of the hollow sleeves: he said that one limb of each was to be “in the open end of a sleeve” and the other limb “in one of the adjacent sleeves of the other layer”.

[144] Lord Reid pointed out that the whole point of this method of articulation was that the two links which each had one limb in the same sleeve would have their other limbs in different sleeves in the other layer. Lord Reid expressed the view that the defendants floundered on the word “inserted”. He pointed out that it was said that you could insert one limb of a U into a hollow tube but you could not insert a C into a tube. Lord Reid offered two answers to this. He pointed out that the defendants’ sleeves were not closed tubes: they had longitudinal openings. Furthermore, he continued “inserted” did not need to mean that one had to be able to put the link in after one had finished

making the sleeve. Lord Reid said that it was not a misuse of language to say that the apple is inserted in the dumpling.

Lord Reid then proceeded to consider that part of claim 1 which dealt with the spring plates. That part read as follows:

“... a leave spring comprising a bent spring plate (12) is provided in each sleeve, which spring plate keeps the connecting bow firmly in the sleeve and acts by spring action against their pivoting when the chain is stretched or bent”.

Lord Reid observed that the spring plate had two functions, namely, to keep the connecting bows firmly in the sleeves and to act against their pivoting. He said that EXCALIBUR 59 did have spring plates and, admittedly, they did have the second function. He said that it was argued that joining two U's to make a C rendered the first function unnecessary. Lord Reid did not think so. He said that no doubt the C-connecting link would come through the gap at the side of the sleeve and, in any case, the spring was necessary to prevent looseness.²¹⁰

[145] With regard to the value or practical significance of or difference made by, the variant, Lord Reid made the following points:

“EXCALIBUR 59 was made in exactly the same way but for one alteration. In the plaintiffs' bracelet as marketed and in the preferred embodiment described in their specification the connecting links at one end of each sleeve were separate from those at the other end. Each was roughly in the shape of a capital U, the upright parts of the U going into different sleeves and the curved part forming a bridge or connection between them. In EXCALIBUR 59 one limb of the U was extended and joined the corresponding limb of the corresponding U at the other end of the sleeve, thus making a double link of the shape of an elongated letter C.”

Lord Reid then said:

“Functionally this, in my opinion, makes no material difference. It makes the bracelet slightly less flexible if one tries to bend it in a way which no-one would normally try to do. It makes the role of the spring plates slightly different – a matter to which I shall return. It makes no material difference to the case with which the parts can be assembled, or the bracelet can be shortened by taking out one or more sleeves. But it

²¹⁰ At 378 line 31 379 line 29.

is said that nevertheless this small change takes EXCALIBUR 59 out of the ambit of the claim in the plaintiffs' specification."²¹¹

In the next paragraph Lord Reid said:

“It is not disputed that a very slight alteration of the wording of the claim would make it quite clear that the claim is wide enough to cover C-shaped connecting links. But it is said that the inventor has tied himself to words which are not wide enough to cover C-shaped links. It is not suggested that there was any possible reason for limiting the claim in this way. If it has been so limited it must have been per *incuriam*. No doubt, if the reader of a specification is astute enough to see that the patentee has framed his claim so narrowly as to leave it open to him by some small modification to use the invention without infringing the claim, he is entitled to do that. He cannot be accused of sharp practice. He is within his legal rights. But claims are not addressed to conveyancers: they are addressed to practical men skilled in the prior part, and I do not think that they ought to be construed with that meticulousness which was once thought appropriate for conveyancing documents.”²¹²

[146] Lord Reid also did not refer in terms to the rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations. However, as he did in his speech in *Van der Lely*, he did take into account whether the variant was material or was of any practical significance and, when he concluded that the variant was immaterial or was of no practical significance, he effectively applied the abovementioned rule without expressly mentioning it. This approach drove him to the correct conclusion that EXCALIBUR 59 constituted an infringement but that EXCALIBUR 60 did not.

[147] It is suggested that Lord Reid's judgment was correct and was in line with the rule that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial changes to the invention. The judgments of the other Law Lords that went against that of Lord Reid's were in breach of that well-known rule of patent law.

²¹¹ Lord Reid in *Rodi* at 377 lines 36 to 378 line 5.

²¹² Lord Reid in *Rodi* at 378 lines 19-24.

3.25 Comparison of Lloyd-Jacob J's Judgment in *Rodi* with those of Lord Reid in *Van der Lely* and *Rodi* and that of Lord Pearce in *Rodi*

[148] Lloyd-Jacob J's judgment in *Rodi*'s case is a remarkable contrast to his judgment in *Van der Lely* which was upheld by both the Court of Appeal and the House of Lords. In *Rodi* Lloyd-Jacob J abandoned the LJ approach and adopted the Lord Reid approach. Unlike his judgment in *Van der Lely*, which was upheld by the Court of Appeal and the House of Lords in subsequent appeals, to Lloyd-Jacob J's judgment in *Rodi* was overturned by both the Court of Appeal and House of Lords. His judgment in *Van der Lely* entirely focused on the language used by the patentee in the claim to determine whether or not a disputed integer was an essential or not. In *Rodi* his approach changed, so did the results. In *Van der Lely* he found that there was no infringement of the patent whereas in *Rodi* he found that there was infringement. In *Rodi* Lloyd-Jacob J's approach was not exclusively based on the language of the specification but also considered other factors which Lord Reid had considered in his dissent in *Van der Lely*. The result was that the conclusion he reached was the same conclusion that Lord Reid was to later also reach in the same matter in the House of Lords.

[149] The proposition that Lloyd-Jacob J changed his approach to the determination of non-textual infringement of patents and to the doctrine of pith and marrow in *Rodi*'s case is supported by various features of his judgment in *Rodi* which are nowhere to be found in his judgment in *Van der Lely*. The following are the features:

- although in his judgment in *Rodi*, Lloyd-Jacob J did not refer in terms to the patent rule on immaterial variations, it is clear from a reading of his judgment that he applied that rule. In *Van der Lely*, in the House of Lords Lord Reid had also not referred to that rule in terms but it is clear from a reading of his judgment that he applied the rule.
- dealing with certain differences between the two devices relied upon by the defendants in support of their contention that in *Rodi* there was no infringement, Lloyd-Jacob J said:

“For present purposes, they require examination to see to what extent, if any, their existence is inconsistent with any of the representations contained in the specifications so as to constitute all or any of the genuine distinctions as opposed to merely colourable differences from the patentees’ invention”.²¹³

He also said:

“This introduction of slight rigidity is not of any practical significance, as can readily be absorbed by manipulation of the exhibited EXCALIBUR 59”.²¹⁴

[150] Lloyd-Jacob J also rejected a distinction in respect of the thickness of the bracelets as being of “no practical difference”.²¹⁵

He further said:

“The difference between a pair of U-bows and a C-shaped member is for the connecting purpose devised by the patentee of no genuine significance, for the interaction between the associated parts is in all material respects identical. Each C-member comprises in reality a pair of U bows, and this, although obscured, is not removed by the integral arm interposed between them. This arm serves no purpose necessary for successful operation, its presence does not deny the substantial attainment of the patentee’s result. In fairness it should be disregarded as a colourable distinction introducing an apparent but not an actual difference from the invention claimed, and, so considered a finding of infringement must follow.”²¹⁶

These features reveal the same kind of reasoning that is to be found in Lord Reid’s judgment in both *Van der Lely* and *Rodi*.

[151] Lords Morris, Hodson and Upjohn found that there was no infringement. Lords Reid and Pearce found that there was infringement in respect of EXCALIBUR 59 but not in respect of EXCALIBUR 60. Therefore the result was that the House of Lords was split 3:2 in favour of those who found that there was no infringement. Once the split decision of the House of Lords in *Rodi* was handed down, it became clear that there were serious divisions in the Court of Appeal and the House of Lords on the approach to the determination of non-textual infringement and to the doctrine of pith and

²¹³ Lloyd-Jacob J in *Rodi* in the Chancery Division at 456 lines 14-18.

²¹⁴ Lloyd-Jacob J in *Rodi* at 457 lines 2-3.

²¹⁵ Lloyd-Jacob in *Rodi* in the Chancery Division at 457 lines 10-15.

²¹⁶ Lloyd-Jacob J in *Rodi* in the Chancery Division at 458 lines 3-13.

marrow. In the *Van der Lely* case in the Court of Appeal it was 2:1 in favour of the Upjohn LJ approach. In the House of Lords in the *Van der Lely* case the split was 4:1 in favour of the Upjohn LJ approach. Then in the *Rodi* matter the Judge of first instance had effectively followed the Lord Reid approach.

[152] Although in the Court of Appeal in *Rodi*, the Upjohn LJ approach prevailed, once the matter came to the House of Lords, the split was 3:2 in favour of the Upjohn LJ approach. Lord Reid increased his support in that Lord Pearce decided the matter on the basis of the Lord Reid approach. The dissents given by Lord Evershed MR, in the Court of Appeal in *Van der Lely*, Lord Reid in the House of Lords in both matters as well as Lord Pearce's dissent in *Rodi* were all very powerful and well-reasoned. The obvious question that would have dominated the minds of all concerned would have been what would happen if another case arose which related to the doctrine of pith and marrow because, if the Upjohn LJ approach were to be applied to determine non-textual infringement in such a case, the prospects of infringement being established would have been almost nil.

CHAPTER 4

4 SPECIAL OBSERVATIONS ABOUT THE PERIOD FROM LLOYD-JACOB J'S JUDGMENT IN *VAN DER LELY* TO THE DECISION OF THE HOUSE OF LORDS IN *RODI*¹

[1] The delivery of Lloyd-Jacob J's judgment in the Chancery Division in *Van der Lely* which was followed by that of Upjohn LJ's and Pearson LJ's joint judgment in the Court of Appeal in the *Van der Lely* matter marked the beginning of a special era in English jurisprudence with regard to the determination of non-textual infringement of patents and to the doctrine of pith and marrow. Upjohn LJ's and Pearson LJ's understanding of the doctrine of pith and marrow as reflected in their joint judgment in *Van der Lely* was one which was based on the Court looking almost exclusively at the language of the claim in the specification in order to decide whether or not the doctrine applied. Of course, the doctrine would be held to apply if it was found, having regard to the language used by the patentee in the claim, that he had made a particular integer an unessential feature of his invention. The doctrine would be held not to apply if it was found that the patentee had, by the language he chose to use in formulating his claim, made the integer essential.

[2] In seeking to determine non-textual infringement this approach adopted by Upjohn LJ and Peterson LJ did not involve asking the question whether the difference introduced by the alleged infringer added any value to the invention or was of any practical significance or had any material effect upon the way the invention functioned. Indeed, the Upjohn LJ approach to the doctrine of pith and marrow and towards the determination of non-textual infringement did not even seek to establish whether the

¹ In the 14th edition of *Terrel on the Law of Patents* by W Aldous and others, the authors say that in the 13th edition of the book they discuss the pre-*Catnic* cases dealing with the principles governing liability for patent infringement and will not discuss them in the 14th edition in view of the comments of the Court of Appeal in *Codex Racal Milgo* [1983] RPC 369 CA at 380. There the Court of Appeal said that it would henceforth be unnecessary and undesirable for counsel to take the Court through the previous decisions referred to in Lord Diplock's speech in *Catnic* and to which the Court's attention was drawn in detail (*Terrel on the Law of Patents* (1994) (14th ed) at 188). Such cases were *Van der Lely*, *Rodi* and *Beecham*. However, a reading of the 13th edition of *Terrel on the Law of Patent* reveals that the learned authors do not discuss the cases in any serious way, let alone, analyse them. In the main they simply provide quotations from some of the cases such as *Van der Lely*, *Rodi*, *Beecham* and *Marconi* with no analysis of those cases at all. Accordingly, a reading of that edition of this important work does not suggest that these learned authors appreciated the instability in the judicial handling of the English jurisprudence between 1960-1970 with regard to the determination of patent infringement (see Aldous *et al Terrel on the Law of Patents* (1982) (13th ed) at 172-178).

alleged infringer was able to advance a reason for introducing the difference so as to see whether the difference was introduced for a valid or genuine reason or whether it was only introduced to disguise the theft of the patented invention.

[3] The *Van der Lely* and *Rodi* decisions of the Court of Appeal and the House of Lords, in so far as they related to the approach that had to be taken by the English courts on the issue of the determination of liability for the non-textual infringement of patent claims and the doctrine of pith and marrow made it extremely difficult for the English courts in the future to uphold a complaint of non-textual infringement. If the decisions of the Court of Appeal and the House of Lords in *Van der Lely* and *Rodi* were anything to go by, the mere mention of an integer in a patent claim or in a specification was enough to justify the conclusion that the integer was an essential integer. That automatically meant that there was no infringement if another person produced a device or product that was exactly the same as the patentee's patented invention except that it omitted one integer that was mentioned in the claims and, was, for that reason, taken as an essential even though it in fact was not essential for the functioning of the invention. That is why writing about the Upjohn LJ approach in *Van der Lely*, Lord Reid said in *Van der Lely* that Upjohn LJ "must have meant that the mere fact that [the patentees] only mentioned the hindmost wheels [in their claims] was sufficient to make the limitations to the hindmost wheels an essential feature of the claim".² Lord Reid then said about Upjohn LJ's approach in this regard:

"But if that were right, then I cannot see how there could ever be an unessential feature or how this principle could ever operate. And I think the principle is very necessary to prevent sharp practice".³

[4] The difficulties with the Upjohn LJ approach were the following:

- (a) it regarded the mere mention of an integer in a claim in a specification as a sufficient basis to conclude that the patentee intended it to be an essential integer and that, therefore, the integer was an essential integer;

² At 76 line 51 to 77 line 2.

³ At 77 lines 2-4.

- (b) it paid excessive attention to the language employed by the patentee in the claim;
- (c) it paid either no attention or little attention to the question of what value the integer in question or the difference introduced by the alleged infringer added to the patented invention or what practical significance the difference introduced by the alleged infringer to the invention made to the functioning of the invention;
- (d) it disregarded the rule of patent law on immaterial variations; and
- (e) it was premised on the assumption that it was possible for a patentee to formulate his claims in such a way that they could cover all eventualities so as to prevent patent pirates from in any way “stealing their inventions”. That is something that no language is good enough to cover for all conceivable eventualities. Blanco-White says as much. He writes: “However carefully a claim may be drafted, there are bound to be borderline cases but this will not render the claim invalid for lack of definition”.⁴

[5] As a result of the deficiencies in the Upjohn LJ approach set out in the preceding paragraph, it was going to be almost impossible for any English court dealing with a case of alleged non-textual infringement to make a finding of infringement. In *Graver Tank and Manufacturing Co v Linde Air Products Co*,⁵ Justice Jackson, writing for the majority of the US Supreme Court, within the context of a discussion of the US doctrine of equivalents, said that:

“[t]o permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing . Such a limitation would leave room or indeed encourage the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence, outside the reach of law.”⁶

⁴ Blanco-White *Patents for Invention* (1974) (4th ed) at 75.

⁵ *Graver Tank and Manufacturing Co v Linde Air Products Co* 339 US 605.

⁶ USA Supreme Court through Justice Jackson in the *Graver Tank* case at 607.

It is suggested that the decisions of the Court of Appeal and the House of Lords in both *Van der Lely* and *Rodi* had the effect of, to use Justice Jackson's phrase, converting the protection of the English patent grant into "a hollow and useless thing".

[6] The other approach to or understanding of, the determination of non-textual infringement of patents and to the doctrine of pith and marrow which had emerged was the one that was reflected in the minority judgment of Lord Evershed MR in the Court of Appeal in *Van der Lely* which was followed by Lord Reid in his speech in the House of Lords in *Van der Lely* and persisted in by both Lord Reid and Lord Pearce in their separate speeches in the House of Lords in *Rodi*.

[7] The features or characteristics of the Lord Reid approach to the doctrine of pith and marrow were the following:

- (a) the mere mention of an integer in a claim in a specification was not by itself enough to justify the conclusion that the patentee intended the integer to be an essential feature of his monopoly; if the mere mention of an integer in a claim was enough, there would never be inessential integers in a claim and that could simply not be.
- (b) the primary focus was whether or not the difference introduced by the alleged infringer added any value or had any practical significance and, if it did not add any value or if it had no practical significance, it was simply regarded as a disguise for the theft of the patentee's invention.
- (c) the inquiry entailed asking what reason was advanced by the alleged infringer for introducing the difference; if no reason was advanced or if the alleged infringer could not point to any advantage derived from the difference introduced, the inference would be irresistible that it was introduced to disguise the theft of the patented invention.
- (d) if the patentee had in clear language specified that the integer was an essential feature of his invention, this would generally be accepted as meaning that the integer was essential but the Court would not shut its eyes

to facts that must have been known to the patentee at the time of framing his claim.

- (e) the Lord Reid approach advocated a construction of patents that was not literal and did not involve the meticulousness that was associated with the interpretation of conveyancing documents and other legal documents.
- (f) the Lord Reid approach required that patents be construed through the eyes of a reasonable person skilled in the relevant art.

It also needs to be pointed out that the Lord Reid approach made it difficult for copying and patent pirates to ‘steal’ a patented invention whereas the Upjohn LJ approach made it extremely easy to do so.

- [8] Highlighting that the two approaches to the doctrine of pith and marrow and setting out above their respective features, as has been done, will help in the understanding of the legal crisis that faced the House of Lords after its decisions in *Van der Lely* and *Rodi* which approved the Upjohn LJ approach. The crisis was that the House of Lords had twice approved an untenable approach to the doctrine of pith and marrow and to the determination of non-textual infringement. The Upjohn LJ approach was untenable because, literalist in its construction of patents as it was, and not inquiring into the practical significance of the difference introduced by an alleged infringer, it made it difficult for the courts in the future to find non-textual infringement of patents in many cases. Indeed, on the Upjohn LJ approach to the determination of non-textual infringement of the patents and to the doctrine of pith and marrow, there was no doctrine of pith and marrow left after the *Van der Lely* and *Rodi* decisions of the House of Lords.⁷

⁷ In the 12th edition of their work *Terrell on the Law of Patents*, published in 1971, Falconer *et al* submitted that “in view of the detailed nature of modern claims there can be little scope for [the application of the doctrine of pith and marrow] in practice nowadays”. It is suggested that this view is based on the assumption that it is possible to formulate claims in such a way as to cover every possible trick that patent pirates can effect in order to reap where they did not sow. This is humanly not possible just as it is not possible in labour law to have a definition of the word “employee” that will cover every conceivable loophole that may be exploited by those who seek to opt out of labour legislation that protects employees. For some of the cases in English law and South African law in which the courts have sought to deal with the problems arising out of the difficulty in formulating a precise definition of the word “employee”, see *Denel (Pty) Ltd v Gerber* (2005) 26 ILJ 1256 (LAC) and the cases discussed in that judgment. So big is the problem that in South Africa Parliament has even enacted section 200A of the Labour Relations Act, 1995 (Act no 66 of 1995) in terms of which a person is presumed to be an employee of another if one or more of eight factors set out therein is or are present. See also

- [9] The obvious question that must have arisen in the minds of those who appreciated⁸ the legal crisis that the Court of Appeal and the House of Lords had created by approving the Upjohn LJ approach must have been: what would the House of Lords do next time a case which required the determination of non-textual infringement came up? Would it apply the Upjohn LJ approach to the doctrine with all its consequences or would it apply the Lord Reid approach to the doctrine? It is suggested that, if it applied the Upjohn LJ approach to the doctrine, the consequences would be disastrous because that approach in effect rendered the doctrine of pith and marrow illusory. On the Upjohn LJ approach it would be difficult in the future to find a case where the doctrine of pith and marrow would be found to be applicable. If it applied the Lord Reid approach, how would it explain its decision not to follow its own approach as reflected in *Van der Lely* and *Rodi*? It would not be an easy matter for the House of Lords to turn around and say that it had been clearly wrong in its approach in the two cases and that Lord Reid's, Lord Evershed MR's and Lord Pearce's dissents were correct.
- [10] In his discussion of *Van der Lely* in the House of Lords, Blanco-White expresses the view that the difference of opinion between the majority and the minority in *Van der Lely* was a point of principle rather than one of approach to the facts. He says actually this applies to the division of opinion in *Rodi* as well.⁹ In his discussion of the division of judicial opinion in the *Rodi* case in the House of Lords, Blanco-White says the majority asked the question: Are the essential integers present? And answered it in the negative whereas Lord Pearce, in the minority, asked the question: Is the essential part of each essential integer present? And answered it in the affirmative.¹⁰ With regard to the division of judicial opinion in the House of Lords in *Van der Lely* Blanco-White

Bosch Craigh "Are Sexual Workers 'Employees'" (2007) 26 *ILJ* 804; Van Niekerk Andre "Personal Service Companies and Definition of 'Employee'" (2005) 26 *ILJ* 1904; Benjamin Paul "An Accident of History: Who is (and who should be) an employee under South African Labour Law (2004) 25 *ILJ* 787; Le Roux Rochelle "The Meaning of 'Workers' and the Road Towards Diversification: Reflecting on Discovery, Sita and 'Kylie'" (2009) 30 *ILJ* 49.

⁸ A reading of *Terrell on the Law of Patents*, 12th ed reveals that Falconer *et al*, as the authors of that edition of the well-known work which was published in 1971, seem not to have appreciated what was happening in English patent law jurisprudence in the *Van der Lely* and *Rodi* cases between 1960 and 1970. (Falconer *et al Terrell on the Law of Patents* (1971) (12th ed)). This is said because, although in their book, they discuss the doctrine of pith and marrow, the issue of infringement and the cases of *Van der Lely* and *Rodi*, they do not say anything about the effect of these two cases on the determination of non textual infringement in English patent law.

⁹ Blanco-White *Patents for Inventions* (4th ed) at 89.

¹⁰ Blanco-White (4th ed) at 89.

says in effect that the majority took the view that it was the movability of the front wheels that was an essential feature of the patentee's claim whereas the minority, ie, Lord Reid took the view that it was the movability of the wheels that was an essential feature of the claim and it was not essential that the wheels be the front wheels.¹¹ Blanco-White expresses the view that Lord Reid's approach in *Van der Lely* was actually the same as Lord Pearce's approach in *Rodi* "put the other way round".¹² Actually, since Lord Reid's judgment in the *Van der Lely* preceded Lord Pearce's judgment in *Rodi*, it is more accurate to say that Lord Pearce's approach in *Rodi* was actually the same as Lord Reid's approach in *Van der Lely*.

[11] By the time of the 4th edition of Blanco-White's work *Patent For Inventions*, which was published in 1974, all the decisions in *Van der Lely* and *Rodi* had been given. Blanco-White does discuss the House of Lords decisions in both cases but he does not discuss Lloyd Jacob J's judgment in *Rodi* and how it differed from the approach Lloyd Jacob J had taken in his judgment in the Chancery Division in *Van der Lely*. It seems that the learned author did not appreciate fully the extent or depth of the judicial controversy which had arisen with regard to the determination of liability for non-textual infringement and the doctrine of pith and marrow in English jurisprudence at the time. He did not realise that in effect Lloyd Jacob J turned his back on his own approach to be found in *Van der Lely* and on the decisions of the Court of Appeal and the House of Lords in *Van der Lely*.

[12] Blanco-White expresses¹³ the view that Lord Reid and Lord Pearce took the view they took in *Rodi* without apparently recognising that they were taking a different view of the law from that laid down in *Van der Lely* and *Deere v Harrison, McGregor and Guest*.¹⁴ This may arguably be so. If that is so, that may explain why in *Rodi* Lord Reid and Lord Pearce may not have felt bound by the approach that was adopted by the majority in the House of Lords in *Van der Lely*. That may also be the case with Lloyd-Jacob J's approach in *Rodi* in the Chancery Division. It may explain his conduct in feeling free to adopt the approach he adopted in *Rodi* and not to adopt the

¹¹ Blanco-White (4th ed) at 89.

¹² Blanco-White (4th ed) 89.

¹³ Blanco White (4th ed) at 90.

¹⁴ [1965] RPC 461(HL).

one he had adopted in *Van der Lely*, which had been approved by both the Court of Appeal and the House of Lords. The same explanation may also apply to the decisions of the Court of Appeal and the House of Lords in not following the Upjohn LJ approach and instead embracing the Lord Reid approach in *Beecham* which, it is suggested in this dissertation, was different from the Upjohn LJ approach adopted by both the Court of Appeal and the House of Lords in *Van der Lely* and *Rodi*.

- [13] The decision of the House of Lords in *Rodi* was delivered in 1968. It took a long time before another matter of importance relating to the doctrine of pith and marrow came before the House of Lords. That was the *Beecham* case.

CHAPTER 5

5 THE PERIOD AFTER *RODI* 1978-1980 AND THEREAFTER: *BEECHAM* IN THE COURT OF FIRST INSTANCE¹

- [1] Beecham Group Ltd² were the owners of four patents relating to a new class of semi-synthetic penicillins and to methods for their manufacture. One such penicillin was known as Ampicillin and proved to be a valuable antibiotic. Beecham Group Ltd also owned similar patents in the USA where the second defendants were their licensees. The first defendants, a wholly-owned subsidiary of the second defendants, imported and sold in UK an antibiotic known as Hetacillin which was an acetone derivative of Ampicillin. It was not disputed that the clinical effectiveness of Hetacillin was due entirely to the Ampicillin into which it reverted in the presence of water by a reversible chemical reaction whenever it was administered as an antibiotic. In response to this importation, Beecham Group Ltd sued the defendants for infringement of various claims of the four patents and by earlier proceedings had secured interim relief preventing further importation.
- [2] The starting point in the manufacture of Ampicillin was 6-amino penicillanic acid (6-APA). This substance was the subject of claim 1 of one of the patents in suit ('396). By acylation, 6-APA could be converted into Ampicillin which was a subject of product claims in Beecham Group Ltd's third and fourth patents ('049 and '703 respectively). The acylation process used by the second defendants in the USA was similar to that claimed in the principal process of Beecham Group Ltd's third UK patent, and claims in both the second and fourth patents also covered the preparative process. Hetacillin was manufactured by the reaction of Ampicillin produced by the primary manufacturing stages with acetone.
- [3] Beecham Group Ltd, *inter alia*, argued that infringement could be established on the basis of the doctrine of "pith and marrow". The defendants argued that, having regard to the requirement in the present statute for precise claiming, the "Saccharin doctrine" no longer applied and that for the same reason the doctrine of "pith and marrow" was

¹ *Beecham Group Limited v Bristol Laboratories Limited and others* [1978] RPC 153 (Ch).

² The facts of this case are taken from the summary thereof which appears in the law report.

obsolete. They further contended that, if *Beecham Group Ltd's* claims were construed sufficiently broadly so as to embrace Hetacillin, they were invalid for ambiguity.

- [4] The trial judge found all four patents to be valid and infringed, but found infringement only on the basis of the infringing importation and not on the basis of the “pith and marrow” doctrine.

5.1 Falconer QC’s Judgment

- [5] In *Beecham* at Court of first instance, Falconer QC, Deputy Judge in the Chancery Division, pointed out that hetacillin was formed by the chemical combination of ampicillin (formed as an intermediate acetone – a reaction which yielded hetacillin and water. He pointed out that, as could be seen from the formula of hetacillin, the acetone combined with the ampicillin by substituting for one hydrogen (H) atom in the 6-position in the penicillin nucleus and one hydrogen atom in the amino group in the alpha position, so that there was no longer a free amino group in that position [sentence formulation].³

Falconer QC pointed out that the reaction was a reversible reaction so that in appropriate conditions hetacillin in the presence of water would “hydrolyse” into ampicillin and acetone. He continued:

“The evidence establishes that hetacillin has no antibacterial activity of its own but that its value as an antibacterial agent arises by virtue of its property of converting by hydrolysis into ampicillin – conversion which takes place in the body when the drug is taken. Mr Gratwick submits, therefore, that hetacillin is merely ampicillin with an addition, namely, acetone – as he picturesquely put it, ‘ampicillin with a hat on’. He pointed out, as the evidence shows (if evidence be necessary to establish the fact) that drugs are often administered in a disguised form. Thus, he says, ampicillin may be administered in a capsule or in the form of a sodium or potassium salt or an ester of the drug.”⁴

Falconer QC then turned to the law on the doctrine of infringement by taking the substance of a patented invention or the doctrine of “pith and marrow”.

³ At 167.

⁴ At 167 lines 12-21.

[6] In dealing with the law relating to the doctrine of infringement by taking the substance of a patented invention, Falconer QC began by taking into account the rule that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations.⁵ Fowler QC was quoting a passage from the judgment of Parker J in *Marconi*. There Parker J, *inter alia*, said:

“It is a well-known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making [im]material variations. From this point of view, the question is whether the infringing apparatus is substantially the same as the apparatus said to have been infringed.”⁶

Falconer QC took the view⁷ that the scope of applicability of the doctrine of infringement by taking the substance of pith and marrow was to be found in three cases at that time, namely, *Birmingham*, *Van der Lely* and *Rodi*.

[7] Falconer QC, *inter alia*, referred⁸ to Lord Reid’s speech in *Van der Lely* where Lord Reid, *inter alia*, said:

“Copying an invention by taking its ‘pith and marrow’ without textual infringement of the patent is an old and familiar abuse which the law has never been powerless to prevent. It may be that in doing so there is some illogicality, but our law has always preferred good sense to strict logic. The illogicality arises in this way. On the one hand the patentee is tied strictly to the invention which he claims and the mode of effecting an improvement which he says is his invention. Logically it would seem to follow that if another person is ingenious enough to effect that improvement by a slightly different method he will not infringe. But it has long been recognised that there ‘may be an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination? (Per James LJ in *Clark v Adie* [1877] 2 App Cas 423)’. ”⁹

⁵ At 167 lines 36-38 quoting Parker J in *Marconi* at 217.

⁶ Parker in *Marconi*’s case at 217.

⁷ At 169 in *Beecham*.

⁸ Falconer QC at 170.

⁹ Lord Reid in *Van der Lely* at 75 as quoted by Falconer QC.

[8] The “illogicality” to which Lord Reid referred in the passage quoted by Falconer QC, is not, it is suggested, an illogicality at all. It is an exception to a general rule. All rules have an exception simply because nothing is absolute and there will always be some situation that was not thought of at the time of the formulation of the rule which strictly speaking, falls outside the rule but which would have been included within the rule had someone raised it at the time of the formulation of the rule. The general rule is that infringement happens when a product or process falls within the language of the patent claim of the patentee. However, if a product or process does not strictly fall within such language, you have to choose when to say there is no infringement and when to say there is infringement. In such a case if you say everything that does not fall strictly within the language of the patent claim is no infringement, you will render the rule ineffective, inoperative, nugatory and useless. You have to devise a way in which in the right cases you will say that, although the product or process falls outside the strict language of the claim, it, nevertheless, infringes the claim and there will have to be cases in which the product or process falls outside the strict language of the claim and you say there is no infringement.

[9] In terms of the doctrine of pith and marrow the position, it is suggested, is that if the variation or omission or addition does not add any value to the practical use of the invention or is immaterial and the rest of the product or process falls within the language of the claim, there is infringement. That is why there exists the rule to which Parker J referred in his 1911 judgment in *Marconi* that no one who borrows the substance of a patented invention may escape the consequences of infringement by making immaterial variations. The position is the same as the rule that “thou shall not kill”. It means that as a general rule you are not allowed to kill but you are allowed to kill in self-defence. Despite Falconer QC referring to all the correct dicta from various judgments relating to the doctrine and having regard to the well-known rule of patent law referred to by Parker J in *Marconi*, he concluded that the doctrine of pith and marrow did not apply. It was on the basis of another principle, namely, the Saccharian principle that he found that infringement had been proved. Falconer QC applied the Upjohn LJ approach. The defendants appealed to the Court of Appeal.

5.2 The Court of Appeal Turns its Back on the Upjohn LJ Approach: *Beecham in the Court of Appeal*¹⁰

[10] The judgment of the Court of first instance was taken on appeal to the Court of Appeal. The judgment of the Court of Appeal was written by Russell LJ. The other two Judges were Stamp LJ and Mr Justice Brightman. None of the three Judges had sat in *Van der Lely* or in *Rodi*. The Court of Appeal found in favour of the plaintiffs on the basis of a principle called the Saccharian principle as well as on the basis of the doctrine of pith and marrow.

[11] Russell LJ pointed out that it was agreed that on the construction of the ampicillin claim it was an essential feature or *sine qua non* of the chemical structure of the substance that “there is present the amino group NH in the alpha position”.¹¹ After this sentence Russell LJ had the following to say:

“It is agreed that this feature is not present in the substance hetacillin, the importation of which is the subject of complaint. There is ample authority which in terms requires that variations from the patented article in the article complained of be confined to features of the patented article that, though textually claimed, are non essential if the principle of infringement by taking the pith and marrow of an invention, or its essential substance is to be applied. It suffices to mention *Van der Lely v Bamfords* (*supra*) and *Rodi v Showell* (*supra*).”¹²

In this paragraph Russell LJ articulated the doctrine of pith and marrow. In the next two paragraphs of his judgment, Russell LJ referred to the arguments of the parties and sought to apply the doctrine of pith and marrow to the facts of the case. In the two paragraphs Russell LJ said:

“But it is argued that the peculiar features of the present case are such as to show that in truth, as a matter of substance and reality, the defendants’ hetacillin is ampicillin and the whole of ampicillin. It is ampicillin temporarily masked or disguised. It is simply ampicillin simply subjected to a reversible chemical reaction which is quite irrelevant to the function of hetacillin as an antibiotic. It is a *sine qua non* of hetacillin that it shall in due course become a mixture of ampicillin and separated out acetone, either before administration or in the body after administration. *As a matter of reality*, though not of chemical formularity, hetacillin is no less a mere carrier of ampicillin

¹⁰ (1978) RPC 181 (CA).

¹¹ At 186 lines 21-23.

¹² Russell LJ at 186 lines 21-30.

than would be a capsule of ampicillin, or a mere mixture of ampicillin and water or any other substance not involving any chemical reaction.

It is right to notice that it is not said that the producers of hetacillin set out deliberately to add a useless evanescent frill to ampicillin: it is accepted that some special value was hoped for in hetacillin, though on the evidence that hope was misplaced. But if the defendants can deny a pith and marrow infringement they could equally do so had their intentions been otherwise. In our judgment, hetacillin should also be held to infringe the claim to the substance ampicillin on the ground that *as a matter of reality* it is to be regarded as a reproduction of ampicillin. To take a substance and alter it in a manner which necessarily results, when relevantly applied, in the reconstitution of the substance, seems to us to be fairly described as reproduction of the substance, albeit temporarily masked.¹³

[12] It is clear from the part of Russell LJ's judgment dealing with the doctrine of pith and marrow that Russell LJ not only referred to the doctrine of pith and marrow but also that he had regard to the question of what value the variant added to the invention and that, although he did not in terms refer to the rule of patent law repeatedly referred to herein, he actually applied that rule to the facts of the case before him and concluded that there was infringement. The rule referred to is the rule that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention. Lastly, but very importantly, it is suggested that, when one carefully reads Lord Reid's dissent in the *Van der Lely* case and reads the passages quoted above from Russell LJ's judgment, the temptation to conclude that Russell LJ was, or, must have been, influenced by Lord Reid's reasoning and application of the doctrine of pith and marrow even though Lord Reid's judgment in *Van der Lely* was a minority judgment is irresistible. In fact Russell LJ specifically referred to the *Van der Lely* judgment. Although in referring to the *Van der Lely* judgment, Russell LJ made no mention of Lord Reid's judgment as such, the factors that Russell LJ referred to just before referring to the *Van der Lely* case and after referring to that case are factors that only Lord Reid discussed in that case and were not discussed or even referred to by the majority in their judgment.

[13] Russell LJ's judgment is yet another indication that, if the question of what value the defendant's variant added to the patented invention was taken into account in considering the application of the doctrine of pith and marrow, more often than not

¹³ At 186 line 31 to 187 line 6 (author's emphasis).

the correct conclusion on infringement was reached. Russell LJ applied the Lord Reid approach. In this case the Court of Appeal turned its back on the Upjohn LJ approach. The Court of Appeal effectively followed the example of Lloyd-Jacob J in *Rodi* who, despite being bound to apply the Upjohn LJ approach in the light of the decision of the House of Lords in *Van der Lely*, nevertheless applied the Lord Reid approach. When in *Rodi*'s case Lloyd-Jacob J turned his back on his approach that had been approved by the Court of Appeal and the House of Lords, he took that stand alone and must have felt quite isolated when in the subsequent appeals to the Court of Appeal and the House of Lords, both the Court of Appeal and the House of Lords stuck to his previous approach, the Upjohn LJ approach. Of course, he was in the company of the dissenters whose camp he was joining. Those were Lords Evershed, Reid and Pearce. When, however, the Court of Appeal decided *Beecham*'s case unanimously, Lloyd-Jacob J and the dissenters were joined by three Judges of the Court of Appeal. This meant that by this time the Lord Reid approach "movement" on the determination of non-textual infringement of patents and the doctrine of pith and marrow had gathered serious momentum. It also meant that there were now seven Judges in the various courts in England who believed that the Lord Reid approach was the correct approach. The obvious question was: Would the House of Lords stick to its guns and continue to apply the Upjohn LJ approach? If so, for how long would it do so or would it do the right thing and also abandon the Upjohn LJ approach, follow Lloyd-Jacob J and adopt the Lord Reid approach?

5.3 The House of Lords Turns its Back on the Upjohn LJ Approach and Embraces the Dissenters' Approach: *Beecham* in the House of Lords¹⁴

[14] In the House of Lords the appeal came before Lord Diplock, Viscount Dilhorne, Lord Simon of Glaisdale, Lord Salmon and Lord Fraser of Tullybelton. Except for Lord Diplock who was involved in *Rodi*, none of the other Law Lords had been involved either in *Van der Lely* or in *Rodi*. Lord Diplock wrote a speech in which the rest of the Law Lords concurred. The House of Lords upheld the decision of the Court of Appeal and dismissed the appeal. In relation to the facts concerning the nature and functioning of the two products, Lord Diplock said:

¹⁴ *Beecham Group Ltd v Bristol Laboratories Ltd and others* [1978] RPC 192 (HL).

“Both ampicillin and hetacillin are prepared in powder form. They are administered to human beings either orally or by injection in aqueous solution. Hetacillin when administered to human beings was found to have therapeutic qualities and goods as, and indeed identical with, those of ampicillin. And well it might, for the chemical reaction between ampicillin and acetone, which results in the formation of hetacillin, is a reversible reaction. In the presence of water (H₂O) hetacillin inevitably turns back almost entirely into acetone and ampicillin. This is what happens whenever it is used as an antibiotic either upon its being dissolved in water of the purpose of injection, or if taken orally, as soon as the hetacillin comes into contact with the moisture in the human stomach. If this reverse reaction did not take place in the conditions in which the antibiotic is administered, hetacillin would have no therapeutic value at all. So long as it maintains the molecular structure indicated above, it is not capable of destroying harmful bacteria in the human body. It is to the ampicillin to which hetacillin reverts on or before administration to a patient, that the therapeutic effects of administering hetacillin are wholly due.”¹⁵

It is notable that in this passage Lord Diplock did consider the issue of the value of the difference between the patented invention and the accused product. He said that in the presence of water (H₂O) hetacillin inevitably turned back almost entirely into acetone and ampicillin and this happened whenever the hetacillin was used as an antibiotic either upon its being dissolved in water for the purpose of injection, or if taken orally, as soon as it comes into contact with the moisture in the human stomach. Then Lord Diplock said:

“If this reverse reaction did not take place in the conditions in which the antibiotic is administered, hetacillin would have no therapeutic value at all”.¹⁶

[15] The fact that in this case Lord Diplock, in considering the question whether there had been infringement, considered the question whether the variant or the feature of the alleged infringer’s product or device which made it different from the patentee’s invention as claimed in the claims, had any value is very important because it represented a departure from the approach that had been adopted by the majority in the Court of Appeal and the House of Lords to the determination of liability for non-textual infringement and the doctrine of pith and marrow in both the *Van der Lely* case and the *Rodi* case. In those cases the Court of Appeal and the House of Lords failed to take this factor into account despite being aware of Lord Reid’s approach which took it into account in both cases.

¹⁵ Lord Diplock at 195 lines 22-45.

¹⁶ At 195 lines 31-33.

[16] The effect of the above statement by Lord Diplock in regard to hetacillin was that the variation which the defendants had effected in their product was a difference that was for all intents and purposes immaterial. It is important that Lord Diplock took this factor into account because, it is suggested, it is a significant factor in determining whether there is non-textual infringement of a patent claim in a particular case. If the difference is material, there can be no infringement. However, if it is immaterial or insignificant, that should go a long way towards the establishment of non-textual infringement.

[17] Lord Diplock referred to a certain passage in Parker J's judgment in *Marconi's* case on the doctrine of pith and marrow. Thereafter Lord Diplock said that the increasing particularity with which the claims were drafted and multiplied in modern specifications may have reduced the scope of application of the doctrine of pith and marrow, but he was unable to accept the argument advanced by Bristol that this had made the doctrine obsolete. He said that the doctrine remained a part of patent law as had been acknowledged in speeches delivered in the House of Lords in *Van der Lely* and *Rodi*. He expressed the view that, directed as it is against colourable evasion of a patent, it was not, in his view, confined to mechanical inventions or to claims for new combinations of integers, but in appropriate cases, though they may be rare, was applicable to claims for new products.¹⁷ Lord Diplock also referred to the fact that in the Chancery Division *Beecham Group Ltd* had argued that hetacillin was no more than a chemical equivalent of ampicillin. He said that *Beecham Group Ltd* were arguing that hetacillin was "ampicillin wearing a temporary mask to be discarded before it gets to work".¹⁸

[18] Lord Diplock said that the doctrine of pith and marrow was applicable to claims for new products as well as to new processes.¹⁹ He further agreed with the Court of Appeal that the relationship of hetacillin to ampicillin provided a clear case for the application of the pith and marrow doctrine. In support of this, Lord Diplock said:

"It was argued that what is claimed in the patents as an essential feature of the class of products to which ampicillin belongs is the presence of an amino group in the alpha

¹⁷ At 200 lines 8-17.

¹⁸ At 197 lines 28-29.

¹⁹ At 202 lines 11-23.

position, and that this feature is absent in hetacillin. This was literally true at the time of importation and sale but it ceased to be true as soon as hetacillin was put to use for the only purpose for which it was intended. The substitution for the postulated amino group of the variant incorporated in hetacillin is evanescent and reversible and for all practical purposes of use can be regarded as the equivalent of the amino group in ampicillin. In the apt phrase used by the Court of Appeal, it is the reproduction of the substance ampicillin, albeit temporarily masked.”²⁰

Special attention should be drawn to Lord Diplock’s statement in this passage that, although it was literally true that what was claimed in the patents as an essential feature of the class of products to which ampicillin belonged was the presence of an amino group in the alpha position and that this feature was absent in the hetacillin at the time of its importation and sale, it ceased to be true “as soon as hetacillin was put to use for the only purpose for which it was intended”.²¹

[19] What is special about this reasoning on the part of Lord Diplock is that in considering whether the infringer’s product infringed the patentee’s patent, Lord Diplock considered whether, in regard to the use for which the invention was intended, the variant would make any difference. That is the same reasoning which Lord Reid used in his dissent in *Rodi*’s matter to reach the conclusion that the defendants’ bracelet infringed the plaintiffs’ patent in that matter. In *Rodi*, after explaining that in the alleged infringer’s product, EXCALIBUR 59 one limb of the U was extended and joined to the corresponding limb of the corresponding U at the other end of the sleeve, thus making a double link of the shape of an elongated letter “C”, Lord Reid said that this difference made the bracelet slightly less flexible if one tried to bend it in a way which no one would normally try to do.²² Lord Diplock concluded that there was infringement and that he would, accordingly, dismiss the appeal. Lord Diplock’s judgment in this case represented the abandonment of the Upjohn LJ approach and the acceptance of the correctness of the Lord Reid approach. The rest of the Law Lords in the matter agreed with him.

[20] In *Beecham* the House of Lords turned full circle. In *Van der Lely* and *Rodi* it had gone completely to one extreme with regard to the determination of liability for non-textual infringement and the doctrine of pith and marrow and had effectively sounded

²⁰ At 202 lines 14-23.

²¹ Lord Diplock in *Beecham* at 202 lines 14-19.

²² Lord Reid in *Rodi*’s case at 377 lines 36 378 line 5.

the death knell to the concept of non-textual infringement of patents and the doctrine of pith and marrow in English patent law. In *Beecham* it in effect resurrected the doctrine of pith and marrow and effectively over-ruled its decisions in *Van der Lely* and *Rodi* without saying so expressly. Once again inventors whose patents had been infringed non-textually could take their complaints to the English courts and could successfully invoke the doctrine of pith and marrow. Annand has expressed the view that there is liberalisation detectable in *Beecham* and that such liberalisation “is said to have been taken much further by Lord Diplock with his purposive construction test in *Catnic Components Ltd v Hill and Smith Ltd* (1982) RPC 183 (HL).”²³

[21] The period from 1960 to 1978 was a very strange period in English patent law. First, there was Lloyd-Jacob J who, in the Chancery Division in *Van der Lely*, began a new approach to the determination of non-textual infringement which focussed exclusively on the language of the claims to determine what features in an invention were essential and which ones were not. He was then followed by the majority in the Court of Appeal and the House of Lords in the same matter all of which courts approved his approach. Then the same Lloyd-Jacob J changed his mind when he got the *Rodi* matter and did not follow his earlier approach which was now binding on him because it had been approved by the Court of Appeal and the House of Lords and he applied the Lord Reid approach in *Rodi*. He had in all probability read the dissents of Lord Evershed MR in the Court of Appeal and Lord Reid in the House of Lords in *Van der Lely* and had been persuaded that his approach in *Van der Lely*, though approved by the Court of Appeal and the House of Lords, was wrong.

[22] In *Rodi* Lloyd-Jacob J now embraced the Lord Reid approach but this time he did not get the immediate approval of the Court of Appeal and the House of Lords in *Rodi* because those two courts stuck to their guns and applied the approach that Lloyd-Jacob J had applied in *Van der Lely* that the two Courts had applied. When the next important case concerning non-textual infringement of patents came up in the form of *Beecham*, the Judge of first instance, namely, Falconer QC, Deputy Judge, applied the approach approved by the Court of Appeal and the House of Lords in *Van der Lely* and *Rodi*. However, the Court of Appeal and the House of Lords turned their backs

²³ Annand (1992) *Anglo-American Law Review* 39 at 45.

against their own previous decisions in *Van der Lely* and *Rodi* and followed Lloyd-Jacob J in *Rodi* once again, thus also embracing the Lord Reid approach.

[23] Blanco-White did not include in the 5th edition of his work any analysis of the decisions in *Van der Lely*, *Rodi*, *Beecham* and *Catnic* at their different levels and their impact on the direction of the jurisprudence of English patent law on liability for patent infringement.²⁴

5.4 *Catnic* in the Court of First Instance²⁵

[24] One of the most important decisions to be handed down in the construction of patent claims in the United Kingdom over the past fifty years is the decision of the House of Lords in *Catnic*,²⁶ the so-called *Catnic* decision of the House of Lords written by Lord Diplock. Although the subject of this discussion is the *Catnic* decision of the House of Lords, it is necessary in the context of this discussion and the issues to be discussed to have regard to the decisions of the Chancery Division and the Court of Appeal in the *Catnic* case as well. In the Chancery Division the *Catnic* case came before Whitford J. In the Court of Appeal the *Catnic* case came before Buckley LJ, Waller LJ, and Sir David Cairns. A summary of the facts must be given before legal issues can be considered.

[25] The appellants in the *Catnic* matter were the proprietors of a patent for galvanised steel lintels for use in spanning the spaces above window and door openings in cavity walls built of bricks or similar constructional units. Since lintels are supported only at either end by the brick courses on which they rest and must themselves support the superimposed brick courses above the window or door space that they span, rigidity and strength were necessary characteristics. Heavy beams of timber or heavy – gauge metal girders possess the characteristics referred to and had long been used for this purpose. In the patent in suit the necessary strength and rigidity were obtained by adopting a box-girder structure with consequent lightness, economy of material, and ease of handling. The lintel could be made in modules, a three course module where

²⁴ See the discussion of the doctrine of pith and marrow in Blanco-White TA *Patents for Inventions and the Protection of Industrial Designs* (1983) (5th ed) at 44-45.

²⁵ *Catnic Components Limited and Another v Hill and Smith Limited* [1982] RPC 183 (Ch).

²⁶ *Catnic Components Limited and Another v Hill and Smith Limited* [1982] RPC 183 (HL).

the height between the upper and lower horizontal plates was equivalent to three courses of bricks and mortar and a two course module where the height was equivalent to two courses only.

[26] Only the first claim is relevant for present purposes. Claim 1 read as follows:

- “1. A lintel for use over apertures in cavity walls having an inner and outer skin comprising a *first* horizontal plate or part adapted to support a course or a plurality of superimposed units forming part of the inner skin and a *second* horizontal plate or part substantially parallel to the first and spaced there from in a downward vertical direction and adapted to span the cavity in the cavity wall and be supported at least at each end thereof upon courses forming parts of the outer and inner skins respectively of the cavity wall adjacent an aperture, and a *first rigid* inclined support member extending downwardly and forwardly from or near the front edge adjacent the cavity of the first horizontal plate or part and at an intermediate position which lies between the front and rear edge of the second plate or part at an intermediate position which lies between the front and rear edge of the second plate or part forming with the second plate or part *and adapted to extend* across the cavity, and a *second rigid* support member extending vertically from or from near the rear edge of the first horizontal plate or part to join with the second plate or part adjacent its rear edge.”

[27] After the respondents had examined various brochures issued by various manufacturers of steel lintel including that of the appellants, they decided that the *Catnic* lintel was the best. They were unaware that it was the subject matter of a patent. They copied and manufactured it. At some stage the respondents produced a modified design – referred to in the litigation as DH4. Between DH4 and the design described in claim 1 of the appellant’s specification the difference which the respondents relied upon to argue that their machine did not constitute an infringement of the plaintiffs’ patent was that the back plate was not vertical, as required by claim 1, but was inclined at a slight angle to the vertical, *viz* 6 in the case of the three-course module and 8 in the case of the two course module. In the appellant’s design or invention the plate was a horizontal one. The question was whether the substitution of a back plate that was slightly inclined to the true vertical for one that was precisely vertical changed what the patentee by his specification had made an essential feature of the invention claimed having regard to the patentee’s description of the back plate in claim one as extending vertically.

5.5 Whitford J's Judgment: Whitford J Applies the Lord Reid Approach to the Doctrine of Pith and Marrow and not The Upjohn LJ Approach

[28] The trial Judge was Mr Justice Whitford. In dealing with the issue of infringement Whitford J concluded that there was no infringement in terms. "The member described as an inclined member is only inclined at an angle of about 13°, and the question is asked: 'How can members inclined at 8° or 6° be said to be vertically extending?'" In my view, on the proper interpretation of the claim, there is no infringement in terms." He then considered whether or not there was infringement on the basis of the doctrine of pith and marrow. This was in respect of the defendant's device referred to as DH4.

[29] With regard to the question whether DH4 infringed the patentees' patent, Whitford J referred to various cases including *Van der Lely*, *Rodi*, *Marconi* and *Birmingham*. Whitford J borrowed from Romer J in *Nobels Explosive Co*²⁷ to formulate the question to be asked to determine non-textual infringement. He said:

"There remains the question as to whether DH4, to quote the words of Romer J, in *Nobels Explosive Co Ltd v Anderson* (1894) 11 RPC 115 at 118: 'As a matter of substance is taking the invention claimed by the patent; not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification'."²⁸

[30] Whitford J also quoted a passage from Lord Reid's dissent in the *Rodi* matter in which Lord Reid *inter alia* highlighted the fact that claims are not addressed to conveyancers but are addressed to "practical men skilled in the prior art" and warned that they "ought not to be construed with the meticulousness which was once thought appropriate for conveyancing documents".²⁹ Whitford J also referred to Lord Morris' speech in the *Van der Lely* case where Lord Morris referred to Parker J's statement in *Marconi* where Parker J *inter alia* referred to the rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations.³⁰

²⁷ *Nobels Explosive Co Ltd v Anderson* (1894) 11 RPC 115 at 118.

²⁸ Whitford J in *Catnic* at 213 lines 9-15.

²⁹ Whitford J in *Catnic* at 213 lines 24-27.

³⁰ Whitford J in *Catnic* at 214 lines 11-19 quoting Parker J in *Marconi*'s case at 217.

[31] Whitford J further referred to a statement by Parker J in *Marconi* that:

“Everyone who produces the same results by using the essential parts of the combination or process is an infringer, even though he has, in fact, altered the combination or process by omitting some unessential part or step which is, in fact, equivalent to the part or step he has omitted”.³¹

Whitford J quoted another passage from Lord Morris’ speech in *Van der Lely* where Lord Morris *inter alia* said:

“It becomes necessary, in the first place, to study claim 1 in order to see what is the invention of the plaintiffs: if necessary the claim must be construed. Thereafter, it has to be considered what the defendants have done. Have they or have they not taken all the essential features or integers of the invention claimed? If there are variations, are they immaterial? If there are differences, are they differences in essential respects or in inessential respects?”³²

[32] Whitford J referred to a passage in Lord Pearce’s speech in *Rodi* where Lord Pearce *inter alia* said: “It is a well-known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations. From this point of view, the question is whether the infringing apparatus is substantially the same as the apparatus said to have been infringed.”³³

[33] In due course Whitford J dealt with what the question was which he had to answer in order to determine whether DH4 constituted a non-textual infringement. He dealt with such question thus:

“So the question is: have the defendants in DH4 made an immaterial variation or have they, by introducing a sloping back plate, omitted an essential feature?”³⁴

In the next three sentences Whitford J said:

³¹ Parker J in *Marconi* at 214 lines 11-19 quoting Parker J in *Marconi*’s case at 217.

³² Lord Morris in *Van der Lely* at 381 as quoted by Whitford J at 214 lines 43-48.

³³ Whitford J in *Catnic* at 216 quoting Lord Pearce in *Rodi*.

³⁴ Whitford J in *Catnic* at 216 lines 20-21.

“The reason for any change made by an alleged infringer may not be without relevance. A change which does nothing more than avoid a strict textual infringement and which was made only for that purpose may well require the most careful scrutiny. A change to achieve some additional advantage may be in a wholly different category, although, in the classic phrase of Lord Russel of Killowen, ‘the super-addition of ingenuity to robbery’ will not necessarily avoid infringement.”³⁵

Whitford J found that DH4 did infringe the plaintiffs’ patent. This finding was based on the doctrine of pith and marrow. In this passage Whitford J also applied his mind to the very important question of what the reason for the change or variation made by the alleged infringer was. That was one of the most important questions on which Lord Reid had focussed in determining whether or not the relevant integer was essential or whether or not there was infringement. It was a question which all the Judges who found no infringement in *Van der Lely* in the Court of first instance, the Court of Appeal and the House of Lords did not bother to address.

[34] What is most important about Whitford J’s judgment is that in considering the question whether DH4 constituted a non-textual infringement on the basis of the doctrine of pith and marrow he focused on the right issues. He considered the materiality of the variant. He also referred to the well-known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations thereto. Thereafter he applied this to the facts of the case before him. This is reflected in the following passage of his judgment:

“What then is the essential feature so far as the back wall is concerned? On the disclosure in the specification the essential feature of the back wall is the avoidance of the need to infill DH4. DH4 avoids the need to infill. The rear web is in truth not vertical, but the construction in my judgment has all the essential features of claim 1. So far as any question of function is concerned, in as much as there is this difference, it is not such a difference as ought to be considered, in my view, a material difference, applying in particular the criteria put forward by Lord Morris at the end of the passage from his opinion quoted by me. It is a construction having in my judgment all the essential features of claim 1.”³⁶

³⁵ Whitford J in *Catnic* at 216 lines 21-27.

³⁶ Whitford J in *Catnic* at 216 lines 28-32.

[35] The approach adopted by Whitford J in the determination of non-textual infringement in respect of DH4 is to be commended. It was the correct approach. He applied the Lord Reid approach to the doctrine of pith and marrow and in determining the issue of infringement. It entailed having regard to not only the materiality of the variant but also the invocation of the well-known rule of patent law referred to above which led to the correct conclusion that DH4 constituted an infringement. There can be no criticism of Whitford J's judgment in regard to the application of the doctrine of pith and marrow. Whitford J's judgment is proof that the *Catnic* case, which Lord Diplock later decided on the basis of the *Catnic* test, could easily have been decided on the basis of the doctrine of the pith and marrow with just results or the same results as the results achieved when the *Catnic* test was used by Lord Diplock in the House of Lords. Whitford J applied the Lord Reid approach. An appeal to the Court of Appeal was noted.

5.6 *Catnic* in the Court of Appeal³⁷

[36] The three Judges who heard the *Catnic* appeal in the Court of Appeal, namely, Buckley LJ, Walter LJ and Sir David Cairns, produced three judgments. Though Waller LJ agreed with Buckley LJ's judgment, he, in addition, wrote a separate concurring judgment. It is necessary to examine each one of the three judgments to determine how each one of them dealt with the issue of infringement within the context of the pith and marrow principle.

5.7 Buckley LJ's Judgment: Buckley LJ Applies the Upjohn LJ Approach

[37] Lord Buckley made the following points by way of introduction to the topic of infringement by taking the substance or the "pith and marrow" of an invention:

- (a) To determine whether a claim of a patent has been infringed:
 - (i) one must first discover what is claimed;

³⁷ *Catnic Components Limited and Another v Hill and Smith Limited* [1982] RPC 218 (CA).

- (ii) the claim must be construed and analysed to ascertain what the features or integers of the invention are;³⁸
- (b) the claim must be construed in the context of the specification as a whole;³⁹
- (c) the claim must be construed in the light of any admissible evidence;⁴⁰
- (d) the claim must be read and interpreted as it would be read and interpreted by the notional addressee of the specification, that is to say, a man skilled in the relevant art who has at his disposal the common knowledge in that art at the date of publication of the specification;⁴¹
- (e) when construed as aforesaid, the claim must be analysed to discover what the several features of the thing for which a monopoly is claimed are;⁴²
- (f) one must next consider the alleged infringement to determine whether it infringes the claim;
- (g) if the alleged infringement has all the features of the claim, it must infringe the claim, even if it also incorporates other features;
- (h) if the alleged infringement lacks one of the features of the claim, it may or may not infringe the claim;
- (i) if the feature which is lacking is an essential feature of the claim, there will be no infringement; and
- (j) if the feature of the claim which is lacking in the alleged infringement is an inessential feature of the claim, whether or not there is infringement of the claim will depend upon whether or not the alleged infringement has all the essential integers of the claim; if it has, there is infringement. This will be the position irrespective of whether or not the inessential feature has been wholly omitted without a replacement equivalent or whether it has been

³⁸ At 225 lines 20-22.

³⁹ At 225 lines 22-23.

⁴⁰ At 225 lines 23.

⁴¹ At 225 lines 23-27.

⁴² At 225 lines 27-28.

replaced with an equivalent. If it does not have all the essential features of the claim, there is no infringement.⁴³

Buckley LJ stated that he thought that the above points represented the effect of the decision of the House of Lords in the *Rodi* case on this point, namely, construction of claims in the context of the application of the pith and marrow principle.

[38] Buckley LJ then turned to the question of how a Court determines whether a feature is essential or inessential. He went on to say:

“So it becomes necessary to consider what distinguishes a feature of a claim which is essential from one which is not essential. This gives rise to the question in what respect the feature must be essential. Must it be essential to the practical working of the invention; or must it be essential to the validity of the claim; or will it be essential for the relevant purpose if the patentee has indicated that he regards it as an essential feature of his invention, whatever its true essentiality may be; or will it suffice that the patentee has elected to limit his claim by the inclusion in it of the feature in question, thus disclaiming a monopoly in anything not incorporating that particular feature?”⁴⁴

[39] Buckley LJ then referred to the use of the expression “colourable evasion” or “colourable imitation” which he said had been used in many of the pith and marrow cases. He suggested that some of the cases appeared to be based on approaching the matter as if the motive of the alleged infringer was important. He said: “The expression ‘colourable evasion’ has a condemnatory ring, suggesting that the alleged infringer has unfairly sought to sail as close to the wind as possible, to come as near to reproducing the patented invention as he can without actually being held to infringe”.⁴⁵

[40] Buckley LJ then quoted a passage from Lord Reid’s judgment in the *Rodi* matter where Lord Reid said:

“No doubt if the reader of a specification is astute enough to see that the patentee has framed his claims so narrowly as to leave it open to him by some

⁴³ At 225 lines 19-40.

⁴⁴ At 225 lines 41-49.

⁴⁵ At 226 lines 1-12.

small modification to use the invention without infringing the claim, he is quite entitled to do that. He cannot be accused of sharp practice. He is within his legal rights.”⁴⁶

[41] Buckley LJ quoted what Diplock LJ said in *Rodi* in the Court of Appeal with regard to the expression: “colourable imitation”. The passage he quoted reads as follows:

“These emotive words mean no more than that the infringer has adopted all the essential features claimed in the patent but has altered one or more unessential features, or has added some additional feature which may or may not itself involve a new inventive step. A process or an article which makes use of the same principle as the patented invention or achieves the same result or makes use of some only of the essential features is not a ‘colourable imitation’ in any sense relevant to patent law unless it does adopt all the essential features which the patentee specified in his claim.”⁴⁷

Buckley LJ took the view that “(t)he question whether there has been an infringement must be answered objectively by comparing the alleged infringing article with the claim said to have been infringed, without reference to any motive on the part of the alleged infringer”.⁴⁸ In the next paragraph Buckley LJ made very important statements. He said:

“If an inventor of an apparatus, for example, explicitly states in his specification, either expressly or upon construction, that part A of the apparatus must lie at a right-angle to part B, and accordingly claims an apparatus in which part A lies at a right angle to part B, anyone who makes an apparatus for performing the same function which in other respects exactly resembles the inventor’s apparatus but in which part A does not lie at a right angle to part B, will not infringe”.⁴⁹

[42] It is suggested that Buckley LJ’s view as expressed in the passage just quoted is problematic. It is clear from the passage that this case is one where the alleged infringer’s apparatus had the same features as the inventor’s apparatus except that, in the alleged infringer’s apparatus, the alleged infringer had made a minor variation, namely, where part A is supposed to lie at a right-angle to part B, the alleged infringer made sure that in his apparatus part A did not lie exactly at a right-angle to part B.

⁴⁶ Buckley LJ at 226 lines 13-17 quoting Lord Reid in *Rodi*’s matter at 378.

⁴⁷ Buckley LJ at 226 lines 23-30 quoting Diplock LJ in *Rodi* in the Court of Appeal at 467.

⁴⁸ Buckley LJ at 226 lines 33-35.

⁴⁹ Buckley LJ in the Court of Appeal in *Catnic* at 226 lines 33-35.

Buckley LJ's view was that, without any further question, the alleged infringer's apparatus did not infringe. His view means that, in such a case, it did not matter whether the alleged infringer's variation added any value to the working of the apparatus nor did the reason for the variation, if any. Indeed, Buckley LJ's view meant that an alleged infringer could copy an inventor's invention in every respect as long as he introduced some variation even if such variation was inconsequential.

[43] It seems that Buckley LJ's view in this regard was in conflict with the principle of patent law that if you borrow the substance of an invention, you cannot escape the consequences of infringement by making immaterial variations to the invention. However, Buckley LJ went on to explain⁵⁰ why he took the view that, once there was a variation such as the one he referred to in the passage quoted above, there was no infringement. He explained his view thus:

“This is because the inventor has demonstrated that in his belief it is a necessary feature of his invention that part A should be at a right angle to part B. He has claimed it as a feature of his invention upon that footing. In such a case it matters not, in my opinion, that it may not be essential to the successful working of the invention that part A shall lie at a right-angle to part B.”⁵¹

[44] It is clear from what Buckley LJ said in the passage just quoted that he made his decision on whether or not an inventor had deliberately chosen that a particular feature of his claim was an essential feature of his invention simply on the strength of the fact that the inventor had mentioned that feature in his claim and not because the words which the inventor chose to employ to mention that feature could necessarily be said to reflect an intention on his part to claim that such feature was, or, should be, regarded as an essential feature. That this was Buckley LJ's approach is to be inferred from the fact that with regard to the example which he gave in his judgment relating to part A of an apparatus lying at a right-angle to part B, he reached the conclusion in the passage just quoted that in that example “[t]he inventor [had] demonstrated that in his belief it [was] a necessary feature of his invention that part A should lie at a right angle to part B”.⁵² Hitchman and MacOdrum refer to Thorson P's judgment in

⁵⁰ At 226 line 47 to 227 line 5.

⁵¹ *Ibid.*

⁵² At 227 line 1-2.

McPhar v Sharpe and quote him as *inter alia* having also held that the mention of a feature of an invention in a claim does not necessarily make it essential to the invention and that there would be no room at all for the doctrine of equivalency if this were so.⁵³

- [45] Buckley LJ's reasoning in regard to the effect of the mentioning of a feature in a claim is not similar to the reasoning that was adopted in the *Van der Lely* case by the majority in the Court of Appeal and in the House of Lords. Buckley LJ applied the Upjohn LJ approach. On the normal rules governing the drawing of inferences, simply because a patentee has mentioned a certain feature in his claims cannot on its own give rise to an inference that he intended that feature to be an essential of his invention. It seems that this is, indeed, the way that the literalists approach cases of infringement.
- [46] The flaw in the approach is: what is it that would be needed before the doctrine of pith and marrow could be applied in a particular case? Furthermore, it is clear from the passage quoted above in which Buckley LJ was expressing his views on, for example, a part leaning at a right-angle to part B that in his view there was no role to be played by the doctrine of pith and marrow. It is also clear from the passage that has just been quoted that Buckley LJ's view was that the test for determining whether or not a feature of an invention was an essential one was not an objective one but a subjective one in the sense that, as long as the inventor intended, rightly or wrongly, that a particular feature of his invention should be an essential feature, it would be taken as an essential feature of the invention, even if, objectively speaking, it was not essential for the working of the invention.
- [47] Criticism can be levelled at Buckley LJ's view in this regard on the basis that it does not determine the real essentiality of a feature but only the supposed essentiality thereof as believed by the inventor. Another criticism of Buckley LJ's view in this regard would be that where, as in the example that he gave in the passage quoted earlier, the inventor simply said in the claim that part A shall lie at a right-angle to part B, that should not on its own be enough to justify the conclusion that the inventor intended that, if a slight variation was made, the resultant product or process would necessarily fall outside his monopoly. An inventor cannot be expected to deal with

⁵³ See Hitchman and MacOdrum (1990) at 187.

every eventuality that can be thought out by those seeking to reap where he sowed without suffering the consequences of infringement of his invention. For that reason there will always be variations of his invention that he did not say would or would not be essential but which may or may not be essential. If the test is a subjective one, this will operate unjustly against the inventor. If, however, the test is an objective one, there will be an infringement and pirates will not be allowed to reap where they did not sow.

[48] In support of his view⁵⁴ Buckley LJ said the following:

“In the *Rodi* and *Wienenberger* case both Lord Hodson (at 385 line 23) and Lord Upjohn (at 394 line 1) held that the inventor in that case had made the use of U-shaped connecting bows an essential feature of his claim. Lord Morris, who was the third member of the majority in that case, reached the same conclusion (at 382 lines 3 and 37). It was not, however, essential to a successful working of the device which was there patented that the connecting links should be U-shaped. The defendants’ bracelet operated upon precisely the same mechanical principles and resembled the plaintiffs’ bracelet in all essential respects except that the connecting links were of a different shape.”⁵⁵

[49] Buckley LJ went on to state that in the *Rodi* case the minority, consisting of Lord Reid and Lord Pearce, concluded that the defendants had taken the substance of the plaintiffs’ invention but that the majority, consisting of Lord Hodson, Lord Morris and Lord Upjohn, took the view that the defendants in that case had not taken the

⁵⁴ That is the view that: If an inventor of an apparatus, for example, explicitly states in his specification either expressly or upon construction, that part A of the apparatus must lie at a right-angle to part B, and accordingly claims an apparatus in which part A lies at a right-angle to part B, anyone who makes an apparatus for performing the same function which in other respect exactly resembles the inventor’s apparatus but in which part A does not lie at a right angle to part B, will not infringe. This is because the inventor has demonstrated that in his belief it is a necessary feature of his invention that part A should lie at a right-angle to part B. He has claimed it as an opinion, that it may not be essential to the successful working of the invention that part A shall lie at a right-angle to part B. in the *Rodi and Wienenberger* case both Lord Hodson (at 385 line 23) and Lord Upjohn (at 394 line 1) held that the inventor in that case had made the use of U-shaped connecting bows an essential feature of his claim. Lord Morris, who was the third member of the majority in that case, reached the same conclusion (at 382 lines 3 and 37). It was not, however, essential to a successful working of the device which was there patented that the connecting links should be U-shaped. The defendants’ expanding bracelet operated upon precisely the same mechanical principles and resembled the plaintiffs’ bracelet in all essential respects except that the connecting links were of a different shape. The minority in the House of Lords, consisting of Lord Reid and Lord Pearce, considered that the defendants had taken the substance of the plaintiffs’ invention, but the majority considered that the defendants had not taken all the essential features of that invention for the purposes of the doctrine of “pith and marrow” because the inventor had made the shape of the connecting links an essential part of the claim. See Buckley LJ in the Court of Appeal in *Camic* at 22 line 47 to 227 line 7.

⁵⁵ At 227 lines 5-14.

substance of the plaintiffs' invention because, so went the majority's reasoning, the inventor in that case had made the shape of the connecting links an essential part of his claim.⁵⁶

[50] Buckley LJ then said that there could be a scenario in terms of which the specification would be less emphatic as the specification in the fictitious case he had given. In this regard he pointed out that: "The specification must be read and interpreted as it would be by a man skilled in the art".⁵⁷ He went on to say that it was possible that a man skilled in the art would, upon reading the specification, say that, although the patentee said 90, that obviously must be interpreted as "90 more or less within the normal accepted tolerances". In such a case, said Buckley LJ, anyone who were to make the same invention but put the angle at more or less 90 that would not be an infringement because it would mean that 90 is not an essential but 90 more or less would be. He said that this would mean that on the true construction of the specification this was no infringement of the invention.⁵⁸

[51] Buckley LJ expressed the view that the nature of the invention must be relevant to what its essential features are. This statement suggests that Buckley LJ was referring to the objective determination of what the essential features of an invention are as opposed to a determination of the inventor's subjective belief of what the essential features of his invention are. Indeed, if one contrasts this sentence with the one that followed it, this point becomes even clearer. In the next sentence Buckley LJ went on to say:

"The language of the specification and the claims contained in it must be relevant to what the inventor claims to be the essential features of his invention and of the monopoly which he claims".⁵⁹

Buckley LJ then said:

"The alleged infringement and the motive of the alleged infringer are irrelevant to the question of essentiality. The nature of the alleged infringement, but not the motive of

⁵⁶ Buckley LJ at 227 lines 14-19.

⁵⁷ At 227 lines 25-26.

⁵⁸ At 227 lines 20-35.

⁵⁹ At 227 lines 37-39.

the alleged infringer, is relevant to whether the alleged infringement incorporates all the essential features of a claim”.⁶⁰

[52] Probably the most important paragraph in Buckley LJ’s judgment is the one where, with courage, he ventured what he called generalisations on the question of essentiality.⁶¹ That passage basically reveals his view as to how a Court determined whether a feature of an invention was or was not essential. There Buckley LJ said:

- “(1) If that feature of the claim which is under consideration is in fact essential to the working of the claimed invention, then it must be an essential feature of the claim.
- (2) If the feature is not in fact essential to the working of the claimed invention, the applicant for a patent may nevertheless have made it an essential feature of the claim, that is to say, he may by the terms of the claim as properly construed have clearly limited his claim to a subject matter having that particular feature. If so, that feature will be an essential feature of the claim and anyone who makes a product or carries out a process which has all the features of the claim except that particular feature will not infringe the claim.
- (3) But, all claims are not perfectly framed. Sometimes a draftsman may include some feature in a claim either explicitly or by implication, which is not in fact essential to the working of the claimed invention and which the applicant has not by the terms of his specification and the claim clearly indicated as a feature which he regards as an essential feature of his monopoly. In such a case an alleged infringer may be held to have infringed the claim notwithstanding that his product or process does not incorporate the feature in question or substitutes some equivalent for it.
- (4) The fact that a claim incorporates a particular feature does not alone suffice to make that feature an essential one. If this were not so, no feature of a claim could ever be inessential, but the speeches in *Rodi* and *Weinenberger* all assume that a claim may include an inessential feature.”⁶²

[53] Buckley LJ then proceeded to apply the generalisations set out in the above paragraph to the facts of the *Catnic* case. In this regard Buckley LJ expressed the view that it could not be said that “it was essential to the efficacy of the lintel claimed in claim 1 of the patent in suit that the back plate should be precisely vertical.”⁶³ He went on to demonstrate how the evidence of Dr Gibbons supported that conclusion. He also went

⁶⁰ At 227 lines 41-43.

⁶¹ Buckley LJ in *Catnic* in the Court of Appeal at 228 lines 9-30.

⁶² At 228 lines 9-30.

⁶³ At 228 lines 31-33.

on to consider the meaning of “vertical” as that term was used in the patent in suite. He said that the patentee had used the term “vertical” in contra-distinction to “inclined”. He said that, this being the sense in which the term was used, he felt no doubt that the patentee in the *Catnic* case had elected to limit his claim to a subject matter having that particular feature.⁶⁴ Buckley LJ then referred to how the House of Lords had dealt with the issue in the *Van der Lely* case and went on to apply that same approach. The effect of Buckley LJ’s decision on this point was that, while he had concluded that the lintel claimed in claim 1 of the patent in suit was not essential for the efficacy or working of the lintel in question,⁶⁵ after referring to facts which supported that conclusion, he took the view⁶⁶ that by the terms of his specification the patentee had made the feature an essential feature of his invention.⁶⁷

[54] Buckley LJ referred to the fact that Whitford J, in the Chancery Division, had taken the view that the essential feature of the back plate was the avoidance of the need to in-fill, that is to say, to fill in the space in the inner skin wall between the base plate of the lintel and the upper arm of the “lazy Z”. Buckley LJ expressed the view that, while it was true that the presence of the back plate had the effect stated by Whitford J and that this was specifically mentioned in the specification, to his mind, to say that this was an essential feature of the back plate was “putting it too high”.⁶⁸ Buckley LJ went on to say that the DH4 lintel of the allegedly infringing apparatus or device avoided the need to in-fill in just the same way as the lintel of claim 1, notwithstanding that its back plate was not vertical. He later said that, because DH4 avoided the need to in-fill, Whitford J had reached the conclusion that it possessed all the essential features of claim 1 notwithstanding that its back plate was not truly vertical. Buckley LJ mentioned that Whitford J thought that, so far as any question of function was concerned, that difference ought not to be considered as material.

[55] Buckley LJ disagreed with Whitford J’s conclusion that DH 4 contained all the essential features of claim 1. The basis for his different view – that is Buckley LJ’s different view – was that he construed claim 1 to require as an essential feature that

⁶⁴ At 229 lines 8-9.

⁶⁵ At 228 lines 31-41.

⁶⁶ At 228 line 42 229 line 22.

⁶⁷ At 229 line 22.

⁶⁸ At 229 lines 30-34.

the back plate shall be truly vertical. Because, according to Buckley LJ, the back plate of DH4 was not vertical, DH4 did not, in his view, have all the essential features of claim 1. Accordingly, so concluded Buckley LJ, DH4 did not infringe claim 1. Buckley LJ then said that he would allow the defendants' appeal and dismiss the plaintiffs' cross-appeal. It is now necessary to turn to the judgment of Waller LJ in the Court of Appeal. Buckley LJ's judgment to the effect that in *Catnic* there was no infringement is a clear illustration of the effect of the Upjohn LJ approach to the determination of non-textual infringement. It is incomprehensible that anyone could conclude that there was no infringement in the *Catnic* case. The *Catnic* case was a much clearer case of non-textual infringement than the *Van der Lely* case and no judge should have had any hesitation in applying the doctrine of pith and marrow if he did not consider that the decisions of the Court of Appeal and the House of Lords in *Van der Lely* and *Rodi* stood in the way of invoking the pith and marrow doctrine.

5.8 Waller LJ's Judgment

[56] Waller LJ began his judgment by expressing agreement with Buckley LJ's judgment but then went on to give his own judgment. Waller LJ referred to a statement made by Whitford J in *Catnic* which ran thus: "The reasons for any change made by an alleged infringer may not be without relevance. A change which does nothing more than avoid a strict textual infringement and which was made only for that purpose may well require careful scrutiny".⁶⁹ A significant omission in the Upjohn LJ approach had been the omission to inquire into the reason for change introduced by the alleged infringer.

[57] Waller LJ also referred to Lord Diplock's speech in *Beecham* where Lord Diplock referred to the pith and marrow doctrine as "directed as it is against colourable evasion of a patent"⁷⁰ ...". Waller LJ also draw attention to a passage in Parker J's judgment in *Marconi*, quoted with approval by Lord Pearce in *Rodi*. There Parker J said:

⁶⁹ Waller LJ in *Catnic* at 232 quoting Whitford at 28 of Whitford J's judgment.

⁷⁰ Lord Diplock in *Beecham* at 200 lines 14-17.

“It is a well known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations”.⁷¹

Waller LJ then referred to the fact that in *Van der Lely* Lord Reid observed that the respondents in that case “cannot point to any mechanical reason for making the change and that [the change] is simply done to try and evade the claim”,⁷² and then quoted James LJ in *Adie* where James LJ said:

“But it has long been recognised that there may be an essence or substance of the invention underlying the mere accident of form; and that invention like every other invention may be pirated by a theft in a disguised or mutilated form and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect or is a substantially new or different combination”.⁷³

[58] The effect of most of the quotations made by Waller LJ in his judgment⁷⁴ was that they supported the proposition that the making of immaterial variations to someone else’s invention does not provide a basis for an alleged infringer to escape the consequences of infringement. In this regard it is significant that Waller LJ referred to the fact that in *Adie* in the House of Lords, Lord Cairns, LC had posed the question whether an instrument that in many but not all respects resembled a patented instrument would infringe the patented instrument and that the question would be for a jury or any tribunal judging the facts to say “whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented and whether in what he had done he had not really taken and adopted the substance of the instrument patented”.⁷⁵

[59] The importance of this statement taken from a passage in the judgment of Lord Cairns LC in *Adie*’s case is two-fold. Firstly, it emphasised that formalism should not be allowed to prevail over substance and that the bottom line was whether or not the alleged infringer had taken the substance of the patentee’s invention. Secondly, it made the point that it was not a *sine quo non* for infringement that only one feature of

⁷¹ Parker J in *Marconi*’s case at 217.

⁷² Waller LJ at 232 lines 12-15 quoting from *Van der Lely*’s case at [1963] RPC 61 at 65.

⁷³ Waller LJ in *Catnic* at 232 lines 16-21 quoting from James LJ in *Clark v Adie* (1873) LR 10 Ch at 667.

⁷⁴ From 231 line 50 232 line 31.

⁷⁵ As quoted by Waller LJ in *Catnic* at 232 lines 27-31

the patented invention be missing from the accused device but more than one feature of the patented invention could be missing from the allegedly infringing product or device and the question would always be whether or not in doing what the alleged infringer did “he had not taken and adopted the substance of the instrument patented”.⁷⁶

[60] When he had to decide whether on the facts of the *Catnic* case, there had been an infringement of the patent en suite, Waller LJ did not follow the cases which directed that the Court should consider whether the alleged infringer had taken the substance of the invention. Instead, he asked the question whether the specification had made verticality essential. He said it had and, for that reason, he concluded that there was no infringement. Waller LJ’s judgment is an exception to a number of cases discussed herein in that most of those which found no infringement were arrived at without the benefit of a consideration of the rule of patent law that, if you borrow the substance of a patented invention, you cannot escape the consequences of infringement by making immaterial variations to the invention. In the *Catnic* case Waller LJ referred to that rule but, nevertheless, came to the conclusion that there was no infringement.

5.9 Sir David Cairns’ Judgment

[61] Sir David Cairns also gave his judgment. He said that all relevant law was contained in the speeches of the Law Lords in the House of Lords in the *Van der Lely* and the *Rodi* cases. Sir David Cairns’ view that as at the time of the *Catnic* case in the Court of Appeal the law was as set out in *Van der Lely* and *Rodi* was not correct. The decision of the House of Lords in *Beecham* had been handed down in 1977 and the Court of Appeal was dealing with the *Catnic* case in 1979. Accordingly, the legal position was as set out by the House of Lords in *Beecham*’s case and not in *Van der Lely* and *Rodi*. Those two decisions had effectively been overruled by *Beecham* even though this was not said in any express terms.

⁷⁶ Waller LJ at 232 lines 30-31 quoting Lord Cairns in *Clark v Adie* (1877) 2 App. Cas. 315 (HL) at 320.

Sir David Cairns then went on to say that the relevant law could be summarised in five points. He said that those points⁷⁷ were as follows:

- 1 There are two types of infringement, textual infringement and infringement of the pith and marrow (*Van der Lely* 75 lines 35-9, per Lord Reid; 77, lines 45, per Lord Radcliffe; 79 lines 48-9, per Lord Jenkins; 80 lines 15-21, per Lord Hodson. *Rodi*, 380 lines 21-36, per Lord Morris of Borth-y-Gest; 384 line 6, per Lord Upjohn; 385 line 1, per Lord Hodson).
- 2 The textual infringement occurs when the defendant's product contains all the features of the plaintiff's claim, interpreted literally (*Van der Lely* 75 lines 35-39 per Lord Reid; 80 per Lord Hudson. *Rodi*, 380 lines 21-25 per Lord Morris; 385 line 1 per Lord Hudson).
- 3 Infringement of the pith and marrow occurs when the defendant's product contains all the essential features of the plaintiff's claim despite some variation in inessential features (*Van der Lely* 75 lines 45-50, per Lord Reid; 79 lines 43-7, per Lord Jenkins p 80 lines 15-19, per Lord Hudson. *Rodi* 380 line 38 to 381 line 3, per Lord Morris; 384 lines 18-32, per Lord Hodson; 388 lines 8-15, per Lord Pearce; 391 lines 14-20, per Lord Upjohn).
- 4 The question of what are the essential features of a claim is a question of construction of the claim and is to be answered without reference to any alleged infringement.
- 5 In construing the claim for the purpose of deciding what are its essentials, it is to be interpreted as it would be by a practical man skilled in the art.

[62] Sir David Cairns went on to state that the difficulty was to decide, as a matter of construction, what, in any particular case, were the essentials of a claim under consideration. He said that the differences of opinion among different judges in the *Van der Lely* case and in the *Rodi* case on whether or not the patentee had made a particular feature an essential feature of the relevant claims showed that the problem of deciding whether the patentee has or has not made a particular feature essential may be a finely balanced one.⁷⁸ He also said that, although in both cases the majority in the House of Lords held that the feature in question was made essential, it could not

⁷⁷ At 234 line 28 to 235 line 18.

⁷⁸ At 235 lines 36-38.

be said that they laid down any principle which would enable a court to decide whether a feature is essential or not. Sir David Cairns took the view that probably no such principle could be enunciated and every case had to depend on its own facts.⁷⁹ Sir David Cairns went on to say that the mentioning of a particular feature in a claim was not sufficient to make that feature essential.⁸⁰ This meant that there had to be something more in the wording of a claim than the mere mentioning to justify the conclusion that the patentee intended a particular feature to be an essential feature. This point had also been made by Lord Reid in the *Van der Lely* case.

[63] Sir David Cairns went on to state that, apart from the expression “extending vertically” in claim 1, he could not find anything in the wording of that claim or in the specification as a whole to suggest that a strictly vertical back member was an essential feature.⁸¹ He went on to say that Whitford J had found that on the disclosure in the specification the essential feature of the back wall was the avoidance of the need to infill.⁸² Sir David Cairns further stated that Mr Everington, one of the Counsel in the matter, had contended that what was essential was the strength of the back wall. However, Sir David Cairns thought that each of these functions was complementary to the other. He expressed the view that neither function was spelt out in terms in the specification but he thought each would be obvious to the man skilled in the art reading it.

[64] At this stage Sir David Cairns stated that “the question of construction involved ... is not to be answered by the court putting its own meaning on the matter to be construed, but is to be answered as it would be by a man skilled in the art”⁸³ and because of this, Sir David Cairns said that he considered it legitimate to take account of any evidence adduced as to the understanding of such persons.⁸⁴ It seems from what Sir David Cairns was saying in this regard that his view was that whether or not a claim was to be construed to mean that a particular feature was an essential feature of such claim or whether the patentee could be said to have intended the feature to be

⁷⁹ At 235 lines 36-42.

⁸⁰ Sir David Cairns at 235 lines 43-45.

⁸¹ At 236 lines 2-4.

⁸² Sir David Cairns at 236 lines 4-5.

⁸³ Sir David Cairns at 236 lines 10-12.

⁸⁴ At 236 lines 10-14.

an essential feature of the claim had to be decided on the basis of what the construction was that a man skilled in the art would give to the wording of the claim. If he would give a meaning that is to the effect that such a feature was intended to be an essential feature or whether such a feature was an essential feature, that would be the meaning that had to be given to the wording of the claim.

[65] It is interesting to note that in his judgment Sir David Cairns did not refer to what the man skilled in the art would understand to have been the patentee's intention on the essentiality or otherwise of a particular feature but simply referred to what meaning such skilled man would give to the specification. In *Adie* it was not said that this was the position. What was said was that whether a feature was essential was a question of fact to be decided by the tribunal "judging of the facts". However, when the *Catnic* case came to the House of Lords, it was said that it was the intention of the patentee as understood by the skilled man that was important. This made the question one of construction.

[66] Sir David Cairns then analysed the evidence given by the "expert witnesses" – that is people skilled in the art – and concluded that, based thereon, the defendants' model DH4 contained all the essential features of the plaintiffs' patented invention and that the variation it had was an unimportant variation. Using the phrases used in other judgments he held that the defendants' lintel differed from the plaintiffs' lintel as described in claim 1 only in some unimportant respect⁸⁵ and that the defendants' lintel was the same in substance and effect as the plaintiffs'.⁸⁶ He said that it was not a "substantially new or different combination" and that the variation was "an unimportant variation". He observed that the defendants' lintel consisted of "substantially the same parts acting upon each other in substantially the same way" as the plaintiffs'.⁸⁷ In conclusion he agreed with Whitford J that there had been infringement. In reaching this conclusion Sir David Cairns decided the *Catnic* case on the basis of the doctrine of pith and marrow. Quite clearly, he did not apply the Upjohn LJ approach because, if he had, he would not have reached the conclusion that there was infringement.

⁸⁵ Sir David Cairns at 236 lines 41-43.

⁸⁶ Sir David Cairns at 236 lines 43-47.

⁸⁷ At 236 lines 42-47.

[67] Sir David Cairns' judgment may be important for a number of reasons. One of these would be the basis upon which he concluded that there had been an infringement. He did not refer to what the patentee may have intended. He referred to the evidence of those witnesses who qualified to be referred to as people skilled in the art to establish what they understood with regard to the essentiality or otherwise of the feature in question. However, in the end he went back to the question of whether or not the accused article was the same in "substance and effect" as the patentee's article.

[68] Since the majority in the Court of Appeal found that there was no infringement, the plaintiffs appealed to the House of Lords. Sir David Cairns' judgment was a dissent and minority. As the other two Judges in the Court of Appeal found that there was no infringement and Sir David Cairns found that there was infringement which was the same conclusion that Whitford J had also reached in the Chancery Division, this means that when the matter went on appeal to the House of Lords, it had been dealt with by four Judges and there was a tie as to whether there was infringement. Two had held that there was infringement and two had held that there was no infringement. It seems appropriate at this stage to make general observations about the application or non-application of the doctrine of pith and marrow in the cases discussed so far before a discussion of the all important decision of the House of Lords in *Catnic*.

5.10 General Comments on the Approach to the Determination of non-Textual Infringement and to the Doctrine of Pith and Marrow Adopted in the Cases Discussed Above

[69] In each of the cases discussed above, comments on various aspects of each case were made in the course of the discussion of those cases. These included comments and views on the court's decision in each case on either that the doctrine of pith and marrow was applicable or that it was not applicable. However, it is necessary at this stage to make some general observations about the cases. The cases in which the Courts found that the doctrine of pith and marrow was applicable are:

- (a) *The Incandescent Gas Light* case
- (b) *Marconi's* case

- (c) Lord Evershed MR's dissent in the Court of Appeal in the *Van der Lely* case
- (d) Lord Reid's dissent in the House of Lords in *Van der Lely*
- (e) Lloyd-Jacob J's judgment in *Rodi* in the Court of first instance
- (f) Lord Reid's dissent in the House of Lords in *Rodi*
- (g) Lord Pearce's dissent in the House of Lords in *Rodi*.
- (h) *Beecham* in the Court of Appeal (Russell LJ's judgment)
- (i) *Beecham* in the House of Lords
- (j) *Catnic* in the Chancery Division
- (k) Sir David Cairns' dissent in *Catnic* in the Court of Appeal

It is suggested that a study of each one of these cases leads one to the conclusion that the correctness of the judgments which applied the doctrine of pith and marrow can simply not be questioned. Furthermore, in each one of these cases the Court had regard to whether or not the variant or integer that was omitted or varied added any value to the invention and this factor weighed heavily in the decision whether or not there had been infringement. In most, if not all, the cases, before the courts or the Judges concerned concluded whether or not there had been infringement, they referred to and considered the well-known rule of patent law on immaterial variations. The result in each one of the cases was a just result.

[70] The cases discussed above in which it was decided that the doctrine of pith and marrow did not apply are the following:

- (a) *Birmingham*;
- (b) Lloyd-Jacob J's judgment in the Chancery Division in *Van der Lely*
- (c) the majority judgment in the Court of Appeal in *Van der Lely*;

- (d) the majority judgment in the House of Lords in *Van der Lely*;
- (e) the judgment in the Court of Appeal in *Rodi*;
- (f) the majority judgment of the House of Lords in *Rodi*;
- (g) the judgment of Falconer QC in *Beecham*
- (h) the majority judgment in the Court of Appeal in *Catnic*.

[71] In these cases it was decided that the doctrine of pith and marrow did not apply. It is suggested that of these cases only the *Birmingham* case was correctly decided in this regard. The others, namely, *Van der Lely*, *Rodi*, *Beecham* in the Chancery Division and *Catnic* at Court of Appeal level were wrongly decided. There can be absolutely no doubt that *Beecham* in the Chancery Division and the majorities in both the Court of Appeal and in the House of Lords in *Van der Lely* and in *Rodi* and in *Catnic* at Court of Appeal level erred in a fundamental way in coming to the conclusion that the doctrine of pith and marrow did not apply in those cases and that there was no infringement. The fundamental reasons why the majority in *Van der Lely* at Court of Appeal level and in the House of Lords reached the conclusion that the doctrine of pith and marrow was of no application to the case and that, therefore, there was no infringement are:

- (a) that the majority did not consider nor did it even refer to, the question of whether the defendants' decision to dismount the foremost instead of the hindmost wheels added any value to the invention.
- (b) that the majority did not consider nor did it even refer to the well-known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the patented invention.
- (c) that the majority elevated the mere mention of an integer in a claim to a statement by the patentee that he considered such an integer to his invention essential despite the fact that there was nothing more to suggest this than the mere mentioning of the integer in the claim.

- (d) that the majority failed to deal with the reasons given by Lord Reid as to why the doctrine of pith and marrow was applicable in that case.
- (e) that the majority overemphasised the language of the claim far above other relevant factors with the result that form was elevated above substance.
- (f) that the majority did not inquire into what the reason was for the change or variation made by the alleged infringer so that, if there was a no reason or no convincing reason, this would support the conclusion that there was infringement.

[72] Lord Reid's dissent⁸⁸ in *Van der Lely* was a powerful dissent. Extensive comments were made on Lord Reid's dissent in the course of the discussion of the *Van der Lely* judgment. It is not necessary to repeat those save to emphasise four points thereanent. These are that:

- (a) Lord Reid took into account the question of whether or not the defendants' variant added any value at all to the invention and found that it did not.
- (b) Lord Reid considered whether the defendants had given any reason as to why they had chosen to dismount the foremost wheels instead of the hindmost wheels as specified in the specification and found that the defendants had not proffered any explanation or reason for this decision on their part.
- (c) Lord Reid heeded the well-known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations to the invention.
- (d) Lord Reid appreciated that the mere mention of an integer in a claim was no sufficient basis for concluding that the patentee had intended such an integer to be an essential integer of the invention.

⁸⁸ Pendleton has also described the dissents in the House of Lords in *Van der Lely* and in *Rodi* as "powerful dissents" (see Pendleton Michael "The Purposive Approach to Patent Construction: A Divergence in Anglo-Australian Judicial Interpretation" (June 1983) 14 *Melbourne University Law Review* 75 at 77)

[73] It is suggested that Lord Reid's powerful dissent in the *Van der Lely* case as well as in the subsequent case of *Rodi*, but particularly in *Van der Lely*, had far reaching implications. It exposed the fundamental flaw in the approach taken by the majority in the same case in both the Court of Appeal and the House of Lords. The approach of the majority in *Van der Lely* was such that, if followed, it would have effectively meant that the doctrine of pith and marrow would not have been applicable in any case and patent pirates were given a licence to make immaterial variations to patented inventions for which they could proffer no reason or explanation but suffer no consequences of infringement. It is suggested that, when, subsequently, Lord Diplock wrote his judgment in *Beecham*'s case, he probably sought to rescue the situation that had been created by the majority in *Van der Lely*. When one reads his speech in the *Beecham* case, one observes that he did not repeat the error committed by the majority in *Van der Lely* of not considering inter alia what value the defendants' variant added to the patented invention. In fact it is suggested that there are features in that judgment which he seems to have taken from Lord Reid's dissent in the *Van der Lely* case.

[74] Lord Reid correctly applied the doctrine of pith and marrow in the *Van der Lely* case and the majority erred in not applying it. The *Beecham* case was also a correct application of the doctrine of pith and marrow. Justice was done in the *Beecham* case. Justice would also have been done in the *Van der Lely* case if the majority had approached the matter the way Lord Reid had approached it. In the *Catnic* case at the level of the Court of first instance the doctrine of pith and marrow was applied but in the Court of Appeal the majority found that the doctrine of pith and marrow did not apply and found that there was no infringement. Only Sir David Cairns in the Court of Appeal in the *Catnic* case found that the doctrine of pith and marrow was applicable and found that there was infringement.

CHAPTER 6

6 1980: THE HOUSE OF LORDS SAVES ITS FACE! *CATNIC* IN THE HOUSE OF LORDS¹

[1] In the House of Lords the appeal in the *Catnic* case was heard by Lord Diplock, Lord Keith of Kinkel, Lord Seaman, Lord Lowry and Lord Roskill. Lord Diplock wrote the speech in which all the other members of the House concurred. It seems that Lord Diplock understood the question before the House of Lords to have been whether “the substitution of a back plate that was slightly inclined to the true vertical for one that was precisely vertical change what the patentee by his specification had made an essential feature of the invention claimed having regard to the patentee’s description of the back plate in claim 1 as ‘extending vertically’.”²

[2] In his speech Lord Diplock pointed out that the appellant’s invention was designed for use by builders engaged in ordinary building operations. He also pointed out that the readers to whom the appellants’ specification was addressed were builders engaged in ordinary building operations. He pointed out that, as any builder would know, “a slight inclination from the vertical of an upright support reduces its load bearing capacity proportionately to the cosine of the angle of such inclination”. He continued:

“Where that angle is 6 as in the [respondent’s] three-course module DH4 the reduction is 0.6 percent, where it is 8 as in the two course module the reduction is still 1.2 per cent. From the point of view of function a reduction of this order in vertical support provided for the upper horizontal plate is negligible.”³

It is interesting to note here that, as he did in *Beecham*, following upon Lord Reid’s dissents in *Van der Lely* and *Rodi*, Lord Diplock took into account the question whether the variant affected the functioning of the device or apparatus.

¹ *Catnic Components Limited and Another v Hill and Smith Limited* [1982] RPC 183 (HL).

² At 241 lines 29-32.

³ At 241 line 40 to p. 242 line 2.

[3] Lord Diplock drew attention to how the parties in the *Catnic* matter had dealt with the concepts of “textual infringement” and infringement of the “pith and marrow” of the invention.

Lord Diplock put this in the following terms:⁴

“My Lords, in their closely reasoned written cases in this House in the oral argument, both parties to this appeal have tended to treat ‘textual infringement’ and infringement of the ‘pith and marrow’ of an invention as if they were separate causes of the action, the existence of the former to be determined as a matter of construction only and of the latter upon some broader principle of colourable evasion. There is, in my view, no such dichotomy; there is but a single cause of action and to treat it otherwise, particularly in cases like that which is the subject of the instant appeal, is liable to lead to confusion.”⁵

Then Lord Diplock explained the phrase “no textual infringement” thus:

“The expression ‘no textual infringement’ has been borrowed from the speeches in this House in the hay-rake case, *Van der Lely v Bamfords*, where it was used by several of their Lordships as a convenient way of saying that the word ‘hindmost’ as descriptive of rake wheels to be dismantled could not as a matter of linguistics mean ‘foremost’: but this did not exhaust the question of construction of the specification that was determinative of whether there had been an infringement of the claim or not. It left open the question whether the patentee had made his reference to the ‘hindmost’ (rather than any other wheels) as those to be dismantled, an essential feature of the monopoly that he claimed. It was on this question that there was a division of opinion in this House and in the Court of Appeal in the hay-rake case.”⁶

[4] What Lord Diplock was saying in this passage was that the phrase “no textual infringement” was used in the speeches of the House of Lords in the *Van der Lely*

⁴ At 242 lines 25-32.

⁵ For a South African lawyer who is familiar with the Constitutional Court judgment in *Pharmaceutical Manufacturers of SA: In re EX PARTE President of the Republic of South Africa* 2000 (2) SA 674 (CC), it is difficult to read this passage of Lord Diplock’s speech without being reminded of a passage in Chaskalson P’s judgment in that case which has lines that run along almost the same theme as the lines in the passage of Lord Diplock’s speech. In *Pharmaceutical Manufacturers* it was argued that, when a litigant relied upon common law grounds of review, the matter was not to be treated as a constitutional matter, in which case, the Constitutional Court, said at 696B-C (par 44). “I cannot accept this contention, which treats the common law as a body of law separate and distinct from the Constitution. There are not two systems of law, each dealing with the same subject matter, each having similar requirements, each operating in its own field with its own highest Court. There is only one system of law. It is shaped by the Constitution which is the supreme law, and all law, including the common law, derives its force from the Constitution and is subject to constitutional control.”

⁶ At 242 lines 33-43.

case to say nothing more than simply that the use by the patentee in that case of the phrase “hindmost” to describe the rake wheels to be dismantled in performing his invention could not as a matter of language mean “foremost”. That is the first point Lord Diplock made. In other words that is the context in which the phrase “no textual infringement” was used in the *Van der Lely* case. The second part of that same point that Lord Diplock made in the passage quoted is that to say that there was “no textual infringement” “did not exhaust the question of construction of the specification that was determinative of whether there had been an infringement of the claim or not”. It is interesting to note that in *Catnic*, Lord Diplock said that the fact that as a matter of language the word “hindmost” could not mean “foremost” did not exhaust the question of construction of the specification that was determinative of whether there was infringement in *Van der Lely*. This is interesting because the Upjohn LJ approach took the language of the claims in a specification as decisive of the question of construction for the determination of whether there was infringement of a patent or not. In this regard it needs to be pointed out that Lord Diplock (as Diplock LJ) delivered a judgment in the Court of Appeal in *Rodi* in which he expressed agreement with the principles set out in the judgment of Upjohn LJ and Pearson LJ in the Court of Appeal in *Van der Lely*. In other words Lord Diplock clearly and unequivocally endorsed the principles and approach adopted by the two Lord Justices.

- [5] This second part of the point that Lord Diplock made revealed the second point. The second point he made was that ... “the [correct] question of construction of a specification that was determinative of whether there had been an infringement of the claim or not”⁷ was “whether the patentee had made his reference to the ‘hindmost’ (rather than any other wheels) as those to be dismantled, an essential feature of the monopoly that he claimed”.⁸ This suggests that Lord Diplock was saying that the question that was determinative of whether or not there had been infringement of a claim in any particular case was whether or not it could be said that the patentee had made that particular feature an essential feature of the monopoly that he claimed. If he had not made that feature an essential feature of his invention, then there was

⁷ At 242 lines 38-39.

⁸ At 242 lines 39-41.

infringement. If he had, then there was no infringement. Those are the two points that Lord Diplock made at this stage of his speech.⁹

- [6] After making the two points referred to above, Lord Diplock proceeded to make what must rank as the most frequently quoted passage of his judgment in the *Catnic* case. He said:

“My Lords, a patent specification is a unilateral statement by the patentee, in words of his choosing, addressed to those likely to have a practical interest in the subject matter of his invention (ie, skilled in the art), by which he informs them what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly. It is those novel features only that he claims to be essential that constitute the so-called ‘pith and marrow’ of the claim. A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. *The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.*”¹⁰

It is in this passage that the essence of the *Catnic* test is contained. In the first sentence of Lord Diplock’s passage commencing with “My Lords, a patent specification is ...” Lord Diplock says that in a specification a patentee informs those who are likely to have a practical interest in the subject matter of his invention what the essential features of his product or process are for which he seeks a grant of

⁹ Lord Diplock made the two points at 242 lines 33-43. Catherine has expressed the view that purposive construction requires the Court to focus on the reasons for enacting the legislation and the directions in which it points, rather than strictly on the meaning of the text (Catherine NG “The Purpose of ‘Purposive Construction’” (2000-2001) *Intellectual Property Journal* at 5). Catherine says these reasons and directions are drawn from two sources: from authoritative descriptions of purpose by the drafter as well as by scholars in the field, and from inferences made from the text, from the circumstances, from the context and the mischief to be cured at the time of the legislation, from its relationship to other legislative scheme or structure and from legislative evolution (*idem* at 5).

¹⁰ Lord Diplock at 242 line 44 to 243 line 11. Brian Reid doubts whether in using the term “purposive” in describing the interpretive approach that Lord Diplock adopted in *Catnic*, Lord Diplock meant anything much more than “sensible view”. (Reid Brian C *A Practical Guide to Patent Law* (1999) (3rd ed) at 108). Brian Reid then went on to remark that “purposive construction” happened to be a phrase then favoured by their Lordships (particularly in relation to the interpretation of statutes) and *Catnic* was the first instance where it was applied by them in a patent context (Reid Brian C (3rd ed) at 108) (author’s emphasis).

monopoly. Lord Diplock says it is only those novel features that the patentee claims to be essential that constitute the “pith and marrow” of the invention.

[7] What Lord Diplock said in the first two sentences of the passage quoted in the preceding paragraph is that in his specification the patentee indicates the essential features of his invention. Lord Diplock puts this as if the essential features are the only features that a patentee indicates in his specification. The fact of the matter is that in conveying what he conveys in the specification the patentee makes mention of both essential and unessential features. Accordingly, Lord Diplock’s statements in the first two sentences of the paragraph are misleading. The more correct statement would be to say that a specification is a unilateral statement by the patentee, in words of his choosing, addressed to those likely to have a practical interest in the subject matter of his invention by which he informs them of the features – essential and unessential – of the new product or process and in respect of which essential features the letters patent grant him a monopoly. In this regard one cannot fail to remember Sir David Cairns’ statement in his judgment in the *Catnic* case in the Court of Appeal where he said that “the mention of a particular feature in the claim is not sufficient to make that feature essential”.¹¹ No impression must be created that there are no unessential features to which the patentee refers in his specification. The Supreme Court of Canada pointed out in paragraph 31(e) of its judgment in the *Free World* that the claims language will, on a purposive construction, show that some elements of the claimed invention are essential while others are non-essential.

[8] It is clear from the passage from Lord Diplock’s speech under consideration that his test for determining the essentiality or otherwise of any feature of a claim is intention-based. It is intention-based in that the question is answered with reference to what the patentee intended as understood by persons with practical knowledge and experience in the kind of work in which the invention was intended to be used. Lord Diplock’s approach was not based on what the claim means – as it would objectively be understood by the persons to whom it was addressed or by persons in general. It seems that what Lord Diplock had in mind was that the understanding that would be used to determine what the patentee intended was that of a person with practical

¹¹ Sir David Cairns in the *Catnic* case in the Court of Appeal at 202.

knowledge and experience in the relevant field and not the Court's understanding thereof.

[9] What Lord Diplock said in the fourth sentence – which is the last sentence of the passage – is that:

- (a) the determinant of whether or not a feature is an essential feature is the intention of the patentee; if he intended it to be an essential feature, then it is an essential feature; if he did not intend it to be an essential feature, then it is not an essential feature.
- (b) whether the patentee intended a particular feature to be essential or unessential is not determined on the basis of the Court's opinion or view of what the patentee intended but on the basis of what persons with practical knowledge and experience in the relevant art would understand from the specification to have been the patentee's intention.
- (c) in seeking to determine what the intention of the patentee was, persons with the skills and experience in the relevant art look at a particular word or phrase in the relevant claim and express an opinion whether the patentee intended strict compliance with that word or phrase in the claim to be an essential feature of the invention so that any variant would fall outside the monopoly. This is done in the light of the prior art at the time of the publication of the patent.
- (d) If the position is that persons with practical knowledge and experience in the relevant art would understand that the patentee intended the feature that is omitted or varied or replaced to be an essential feature, then there would be no infringement. However, if they say that he did not so intend, there would be infringement.

[10] In the last part of the fourth sentence of the passage starting with the words "My Lords" Lord Diplock said that this would be the case even if the feature would have

no material effect upon the way the invention worked.¹² What the last part of the last sentence reveals is that Lord Diplock was saying that, even if the feature is immaterial to the working of the invention, if the persons with knowledge and experience in the relevant art understand that the patentee intended that there would be strict compliance with a certain word or phrase in the claim, there is no infringement if there is no strict compliance with such word or phrase in a particular case – and that marks the end of the matter. This means that in terms of the *Catnic* decision a feature of an invention which does not add any value upon the way the apparatus or device works can be treated as unessential as long as it is found that it would be the understanding of persons with the knowledge and experience in the relevant art that the patentee did not intend that strict compliance therewith be an essential requirement of the invention. Accordingly, the view of the Court and the objective position count for nothing in a case where the feature does not affect the working of the invention. They are not even some of the factors to be taken into account.

[11] In the third sentence of the passage quoted above Lord Diplock said that a specification must be given a purposive construction rather than a purely literal one. Clarizo views purposive construction as meaning that the claims must be interpreted so as to further the object or purpose of the invention and it is necessary when reading the patent to try to determine what was the intention of the inventor when the invention was made.¹³ It is suggested that in this passage Lord Diplock did not say anything to the effect that words must not be given their ordinary and grammatical meaning when a patent specification is being construed. That can still be done. What Lord Diplock said should not be done is to give words a “purely literal” meaning.

[12] Lord Diplock went on to make the point that the question does not arise where the variant would have a material effect upon the functioning of the invention.¹⁴ He said that the question also does not arise in a case where at the date of publication of the specification it would be obvious to the informed reader that the variant would have no material effect upon the functioning of the invention. Lord Diplock put it thus:

¹² At 242 of the reported judgment.

¹³ Clarizo Dino P “The New Test for Claim Construction and Patent Infringement in Canada” (2003-2004) *IPL Newsletter* 15 at 16.

¹⁴ At 243 lines 12-13.

“The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not obvious, in the light of the then existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary. It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by a patentee, who was so skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked.”¹⁵

[13] In a certain¹⁶ passage Lord Diplock addressed four situations. The first situation he addressed is a situation where the question would not arise as to whether people with practical knowledge and experience in the field in which the invention was intended to be used would understand that the patentee intended that there be strict compliance with a particular word or phrase in a claim was to be an essential requirement. He said that such a case would be where the variant would not have a material effect upon the invention. The second scenario where the question does not arise is where at the date of publication of the specification it would be obvious to the informed reader that the variant would not have a material effect upon the functioning of the invention. The third situation that Lord Diplock addressed when it would not be obvious is where the reader would be entitled to assume that the patentee had a good reason to limit his monopoly the way he did. This would be the case even where subsequent work by the patentee or others showed that it was unnecessary for the patentee to limit his monopoly in that way. Lord Diplock stated that the question is to be answered in the negative where it would be apparent to any reader skilled in the art that a particular descriptive word or phrase could not have been intended by the patentee to exclude minor variants which, to the knowledge of both himself and the intended readers,

¹⁵ At 243 lines 12-24. Young *et al Terrel on the Law of Patents* refer to the sentence in Lord Diplock’s *Catnic* decision that says “Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so”. This is the second sentence of the paragraph in Lord Diplock’s judgment in *Catnic* which begins with the sentence “the question of course, does not arise where the variant would in fact have a material effect upon the way the invention worked”. Young *et al* express the view that the word “this” at the end of the second sentence of the paragraph refers back to the qualification “even though it could have no material effect upon the way the invention works” rather than to its immediately preceding sentence. (Young *et al* 187)

¹⁶ That passage is at 243 lines 12-24.

could not have any material effect upon the way the invention worked.¹⁷ Lord Diplock then stated the differing judicial views in *Van der Lely* and *Rodi* cases. He dealt with the *Beecham Group* case as well.

- [14] The passage in Lord Diplock’s speech quoted above which starts with the words: “My Lords ...” and ends with the words “... the way the invention worked” is the passage in Lord Diplock’s speech in *Catnic* which Lord Hoffmann subsequently said in par 51 of his speech in *Kirin-Amgen* he tried to summarise with the use of the Protocol questions. In relation to this passage it is important to bear in mind what Lord Hoffmann said in par 52 of his speech in *Kirin-Amgen*.¹⁸ There Lord Hoffmann, *inter alia*, said:

“When speaking of the ‘*Catnic* principle’ it is important to distinguish between, on the one hand, the principle of purposive construction which I have said gives effect to the requirements of the Protocol, and on the other hand, the guidelines for applying that principle to equivalents, which are encapsulated in the Protocol questions. The former is the bedrock of patent construction, universally applicable. The latter are only guidelines, more useful in some cases than in others. I am bound to say that the cases show a tendency for counsel to treat the Protocol questions as legal rules rather than guides which will in appropriate cases help to decide what the skilled man would have understood the patentee to mean. The limits to the value of the guidelines are perhaps most clearly illustrated by the present case...”¹⁹

- [15] In *Kirin-Amgen* Lord Hoffman also said:

“The determination of the extent of protection conferred by a European patent is an examination in which there is only one compulsory question, namely that set by article 69 and its Protocol: What would a person skilled in the art have understood the patentee to have used the language of the claim to mean? Everything else including the Protocol question is only guidance to a judge trying to answer that question. But there is no point in going through the motions of answering the Protocol questions when you cannot sensibly do so until you have construed the claim. In such a case – and the present is in my opinion such a case – they simply provide a formal justification for a conclusion which has already been reached on other grounds.”²⁰

¹⁷ At 243 lines 12-24.

¹⁸ *Kirin-Amgen Inc and Others v Hoechst Marion Russell Ltd and Others* (2005) RPC 169 (HL).

¹⁹ Lord Hoffmann in *Kirin-Amgen* at par 52.

²⁰ Lord Hoffmann in *Kirin-Amgen* at par 69.

Lord Hoffmann also *inter alia* said “The Protocol questions are useful in many cases, but they are not a substitute for trying to understand what the person skilled in the art would have understood the patentee to mean by the language of the claims.”²¹

[16] There seems to be a link of some kind between the judgment of Lord Reid in the *Van der Lely* case and Lord Diplock’s judgment in the House of Lords in *Catnic*. The link appears to be the reference in both judgments to obviousness of variants and the question of whether or not a variant has a material effect upon the way that the invention works. In *Van der Lely* Lord Reid addressed²² the question of an “obvious equivalent”. He said: “... you cannot avoid infringement by substituting an obvious equivalent for an unessential integer”.²³ In the second last sentence of the first paragraph at 76 in *Van der Lely* Lord Reid pointed out that he could not “imagine any more obvious equivalent than substituting the foremost for the hindmost wheels in that machine”.²⁴ In *Catnic* Lord Diplock also dealt with the applicability or otherwise of the question he said had to be asked in every case to situations where it would be obvious to the informed reader that the variant would in fact have a material effect upon the way the invention worked and where it would not have been obvious that this would be the case. Satiriadis²⁵ seems to also take the view that Lord Diplock’s judgment in *Catnic* has some features of Lord Reid’s judgment in *Van der Lely*. He has said that some of the most important elements of the doctrine of purposive construction require the court in cases of infringement in substance to analyse the variant in order to ascertain whether it does in fact have a material effect upon the way the invention works. He then says: “In *Catnic* the House of Lords in this respect vindicated the position of Lord Reid, who had rendered the minority decision in *Van der Lely NV v Bamfords Limited* “hay rake a case.”²⁶

[17] Hoffmann J also addressed in his judgment in the *Improver*²⁷ case the situation where it would have been obvious that the variant had no material effect upon the way the

²¹ Lord Hoffmann in *Kirin-Amgen* at par 71.

²² In the first paragraph at 76 in *Van der Lely*.

²³ Lord Reid in *Van der Lely* in the first par at 76

²⁴ Lord Reid in the second last sentence in *Van der Lely* at 76.

²⁵ Satiriadis Bob H “Purposive Construction in Canadian Patent Infringement Cases since O’ Hara” (1996) 11 *IPJ* 111 at 112.

²⁶ *Ibid* at 112.

²⁷ *Improver Corporation and others v Remington Consumer Products Limited and others* 1990 FSR 181 (Patent Court).

invention worked. The obviousness was to be to the person skilled in the art. In the *Van der Lely* case Lord Reid pointed out that “[n]othing could be less inventive than selecting the hindmost against the foremost wheels when the selection makes no practical difference as regards efficiency. No one suggests that the use by the respondents of the foremost wheels results in producing an inferior machine.”²⁸ In *Catnic* Lord Diplock said that the question that should be asked in each case did not arise “where the variant would in fact have a material effect upon the way that the invention worked.”²⁹ In the first of the Protocol questions in the *Improver* case Hoffmann J referred to a situation where the variant did not have a material effect upon the way the invention worked.

[18] Finally, in *Van der Lely* Lord Reid pointed out that, while the position was that, if the specification made it clear that the patentee regarded a particular integer as essential, the integer had to be treated as essential, he could not see “why one should shut one’s eyes to facts of which the patentee must have been aware when framing the specification”, Lord Diplock, *inter alia*, said that the question³⁰ he refers to in his speech has to be answered in the negative “only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by a patentee, who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked.”³¹

[19] Lord Diplock stated³² that the essential features of the invention that was the subject of claim 1 of the patent in suit in *Catnic* were much easier to understand than those of any of the patents in the *Van der Lely*, *Rodi* and *Beecham* cases. He said that, put in a nutshell, the question to be answered was: “Would the specification make it obvious to a builder familiar with ordinary building operations that the description of a lintel in the form of a weight-bearing box girder of which the back plate was referred to as ‘extending vertically from one of the two horizontal plates to join the other, could not

²⁸ Lord Reid in *Van der Lely* at 76 (2nd par).

²⁹ Lord Diplock at 243 lines 12-13.

³⁰ That question is the one appearing at Lord Diplock’s speech at 243 lines 5-11.

³¹ At 243 lines 18-24.

³² At 244 line 3.

have been intended to exclude lintels in which the back plate although not positioned at precisely 90 to both horizontal plates was close enough to 90 to make no material difference to the way the lintel worked when used in building operations?”³³ This is a very long³⁴ question. However, it seems that the gist of it is that the question that Lord Diplock said in effect would determine the issue there under consideration was whether or not the specification of the patent in question would make it obvious to the person who would work with it that the description of the relevant feature of the patent in the claim specification as it stands could not have been intended by the patentee to exclude the variant in the allegedly infringing product or process. If yes, there is no infringement. If no, there is infringement because the feature in question is covered by the patent.

[20] Lord Diplock went on to say:

“No plausible reason has been advanced why any rational patentee should want to place so narrow a limitation on his invention. On the contrary, to do so would render his monopoly for practical purposes worthless, since any imitator could avoid it and take all the benefit of the invention by the simple expedient of positioning the back plate a degree or two from the exact vertical.”³⁵

[21] It seems from this passage that Lord Diplock was saying that, if no plausible reason could be advanced why any rational patentee should have narrowed his monopoly in the manner indicated in the allegedly infringing article or product, this would be an indication that he could not have intended to exclude the variant or substitution in the allegedly infringing product or process to be an essential of his invention. If the majority in *Van der Lely* in the Court of Appeal and in the House of Lords had, like Lord Diplock in the passage in *Catnic*, enquired into whether or not there could be a plausible reason for the patentee in that case to have narrowed his monopoly to the hindmost wheel, which is what Lord Reid did in the *Van der Lely* case, they would have found that there was infringement. It seems that, according to Lord Diplock, if a

³³ At 244.

³⁴ Brian Reid says Lord Diplock, in particular, “had a predilection towards the long word and convoluted phrase” and provides examples taken from Lord Diplock’s other speeches (Reid Brian C (3rd ed)108). Brian Reid says that the *Catnic* question was subsequently redefined in simpler terms by the Patents Court in *Improver Corporation v Consumer Products* [1990] FSR 181 (Reid Brian C (3rd ed) 109). This statement by Brian Reid supports the proposition made in this dissertation that Lord Diplock’s *Catnic* test was confusing.

³⁵ At 244.

construction would have the effect that the patentee's monopoly would for all practical purposes be worthless because somebody could take it and simply make some minor variation, then, generally speaking, the patentee could not be taken to have intended the variant to be an essential feature of his invention and, therefore, there would be infringement.³⁶ What Lord Diplock said in this regard ran contrary to the approach adopted by the Court of Appeal and the House of Lords in *Van der Lely* because in *Van der Lely* the mere fact that the patentee had mentioned an integer in his claim was taken as a sufficient basis to justify the conclusion that he intended that feature to be an essential integer of his invention.

[22] Lord Diplock went on to say that the expressions “horizontal”, “parallel”, “vertical” and “vertically”, when used by a geometer addressing himself to fellow geometers, could be understood as words of precision. However, when used in the description of a manufactured product intended to perform the practical function of a weight-bearing box girder in supporting courses of brickwork over window and door spaces in buildings, the expression “extending vertically” is descriptive of the position of what in use will be the upright member of a trapezoid-shaped box girder. Lord Diplock also said that it was capable of meaning positioned near enough to the exact geometrical vertical to enable it in actual use to perform satisfactorily all the functions that it could perform if it were precisely vertical. He then said that that was, in his view, the sense in which “extending vertically” would be understood by a builder who was familiar with ordinary building operations.³⁷

Lord Diplock said that another way of putting this would be to say that “[i]t would be obvious to [a builder familiar with ordinary building operations] that the patentee did not intend to make exact verticality in the positioning of the back plate an essential feature of the invention claimed.”³⁸

[23] Lord Diplock reached the same conclusion as the trial judge, namely, that there had been infringement. In Canadian patent law it has been said that the identification of elements of a patent claim as essential or non-essential is made:

³⁶ At 244 lines 15-17.

³⁷ At 244 lines 19-31.

³⁸ At 244.

- (i) on the basis of the common knowledge of the worker skilled in the art to which the patent relates;
- (ii) as of the date the patent is published;
- (iii) having regard to whether or not it was obvious to the skilled reader at the time the patent was published that a variant of a particular element would not make a difference to the way in which the invention works; or
- (iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect; and
- (v) without, however, resort to extrinsic evidence of the inventor's intention.³⁹

[24] The doctrine of purposive construction as advocated by Lord Diplock in *Catnic* is used for the determination of the essential features of a patent claim and not to provide a general tool of construction of a specification. That Lord Diplock advocated the adoption of purposive construction as a tool for the identification of the essential integers of a patent claim is supported by at least four sentences in his speech in *Catnic*. The first of those sentences is the one which Lord Diplock began with the words: "My Lords, a patent specification is a unilateral statement by the patentee ...". The second, third and fourth sentences are the three sentences that come immediately after that sentence. These four sentences read thus:

"My Lords, a patent specification is a unilateral statement by the patentee, in words of his own choosing, ..., *by which he informs* [those skilled in the art] what he *claims to be the essential features* of the new product or process for which the letters patent grant him a monopoly. It is those novel features only that he claims to be essential that constitute the so-called 'pith and marrow' of the claim. A specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be *an essential requirement* of the invention so that any variant would fall outside the monopoly

³⁹ Binnie J in *Free World* par 31.

claimed, even though it could have no material effect upon the way the invention worked.”⁴⁰

[25] Dealing with the principles of construction of patent claims in *Whirlpool*⁴¹ Binnie J, *inter alia*, said:

“The key to purposive construction is therefore the identification by the court, with the assistance of the skilled reader, of the particular words or phrases in the claims that describe what the inventor considered to be ‘essential’ elements of his invention. This is no different, I think, than the approach adopted roughly 40 years earlier by Duff CJ in *JK Smit and Sons Inc v McClintock* [1940] SCR 279.”⁴²

David Vaver says purposive construction reminds judges not to read patents too literally.⁴³ He says purposive construction allows the brushing aside of technical objections so that specifications are construed “fairly with a judicial anxiety to support a really useful invention if it is can be supported on reasonable construction of the patent.”⁴⁴ In support of this, Vaver cites *Hinks and Son v Safety Lighting Co.*⁴⁵

[26] It is suggested that the Canadian Supreme Court’s first statement in the above quotation does not correctly reflect the *Catnic* test or purposive construction. In the statement the Canadian Supreme Court said that the Court identifies the particular words or phrases in the claims that describe what the inventor considered to be “essential” elements of his invention assisted by the skilled reader. The true *Catnic* approach is that it is the notional addressee who identifies such elements and not the Court. According to Binnie J in the *Free World* case the *Catnic* approach has been accepted in a number of countries including New Zealand as well.⁴⁶

⁴⁰ Lord Diplock in *Catnic* at 242 lines 44 to 243 line 11 (author’s emphasis).

⁴¹ *Camco Inc and General Electric Company v Whirlpool Corporation and Inglis Ltd* 2000 SCC 67 or [2000] 2 SCR 1067.

⁴² At par 45 in *Whirlpool*.

⁴³ Vaver David “Essentials of Canadian Law” (1997) *Intellectual Property* at 142.

⁴⁴ Vaver at 142-143.

⁴⁵ (1876) 4 Ch D 607 at 612.

⁴⁶ Par 39 of Binnie J’s judgment in *Free World*. In support of this Binnie J refers to the cases of *Interpress Associates Ltd v Pacific Coilcoaters Ltd* (1994) 29 IPR 635 (HC), and *Swale v North Sails Ltd* [1991] 3 NZLR 19 (HC). Binnie J says in Australia approval of the *Catnic* approach has been given in the case of *Populin v HB Nominees (Pty) Ltd* (1982) 59 FLR 37 (Fed Ct) (Gen Div.) at 43 and *Rhone – Poulenc Agrochimie SA v UIM Chemical Service (Pty) Ltd* (1986) 68 ALR 77 (Fred CT) (Gen Div.) at 92-93. Binnie J says in Hong Kong such approval has been given in *Improver Corp v Raymond Industrial Ltd* [1991] FSR 233 (CA).

[27] It is suggested that, after the *Rodi* decision of the House of Lords, Lord Diplock realised that the approach to the doctrine of pith and marrow which had been applied by the Court of Appeal and the House of Lords in both the *Van der Lely* and the *Rodi* cases was wrong⁴⁷ and sought to introduce a new way forward by way of the *Catnic* test and embraced the thrust of the Lord Reid approach to the doctrine. The reasons upon which this proposition is based are the following:

- (a) both the Court of Appeal and the House of Lords in *Van der Lely* and *Rodi* did not criticise the Lord Reid approach;
- (b) both the Court of Appeal and the House of Lords did not deal in any way with the reasons given by Lord Evershed MR, Lord Reid and Lord Pearce for their approach to the doctrine of pith and marrow;
- (c) in *Beecham*, the first opportunity that Lord Diplock and the House of Lords got after its *Rodi* decision to continue using its model of the doctrine of pith and marrow, Lord Diplock and the House of Lords elected not to do so but, instead, elected to effectively apply the model or approach to the doctrine of pith and marrow which had been used by Lord Reid, Lord Evershed MR, and Lord Pearce in their dissents in *Van der Lely* and *Rodi*;
- (d) in *Catnic* Lord Diplock criticised an approach to the construction of patent claims that was “purely literal” and based on a “meticulous verbal analysis” in which he said lawyers were too often tempted by their training to indulge; a careful analysis of the English patent law jurisprudence before the *Catnic* decision reveals that the decisions that were most recent before Lord Diplock’s *Catnic* decision in which such “purely literal” and “meticulous verbal analysis” approach was adopted were the majority decisions of the House of Lords and the Court of Appeal in both *Van der Lely* and *Rodi*; this, therefore, means that in *Catnic* Lord Diplock criticised the Upjohn LJ approach but did not criticise the Lord Reid approach to the doctrine of pith and marrow;

⁴⁷ Pendleton also states that it has been argued that *Catnic* involved an implicit over-ruling by the House of Lords of its decisions in *Van der Lely* and *Rodi* (see Pendleton Michael “The Purposive Approach to Patent Construction: A Divergence in Anglo-Australian Judicial Interpretation” (1983) 14 *Melbourne University Law Review* 75 at 82).

- (e) the dissents of Lord Reid and Lord Pearce in *Rodi* had spoken against the same approach to the construction of patents against which Lord Diplock spoke in *Catnic*, namely, one that is “purely literal”, one that is marked by the meticulousness associated with conveyancing and other legal documents and one that is “alphabetical” and concerned itself with words and not with essentials;
- (f) in *Catnic* Lord Diplock did not criticise the Lord Reid approach nor did he criticise the conclusions reached by Lord Reid and Lord Pearce in their speeches in *Van der Lely* and *Rodi* and the reasons each one gave for his conclusion;
- (g) in *Beecham* and *Catnic*, Lord Diplock adopted some of the reasoning that Lord Reid had used in *Van der Lely* and *Rodi* to reach the conclusions that he had reached in his two dissents in those cases; and
- (h) if Lord Diplock was in disagreement with the Lord Reid approach after *Rodi*, he would not have used it in his *Beecham* speech nor would he have failed to criticise it in *Catnic*.

[28] In the 3rd edition of his work published in 1999 Brian C Reid has said that the correlation of *Catnic* with *Rodi*, given that both cases were decided under the 1949 Patent Act of the UK, is as yet to be clarified.⁴⁸ It is suggested that this dissertation provides the clarification not only of the correlation of *Catnic* with *Rodi*, but also that of *Catnic* with a number of other important decisions of the English Courts on the issue of the determination of patent infringement handed down during the last half of the 20th century, particularly *Van der Lely*, *Rodi*, *Beecham* and *Catnic*. In other words, this dissertation responds to the issue raised by Reid and provides the clarification needed on the issue, and more.

⁴⁸ Reid Brian C *A Practical Guide to Patent Law* (3rd ed) at p112.

CHAPTER 7

7 SPECIAL COMMENTARY ON THE *CATNIC* DECISION

- [1] According to Lord Diplock the test for determining the essentiality or otherwise of an integer or feature of an invention has as its basis the intention of the patentee. What is important is to establish that intention. However, that intention is not established in the same way that a court establishes the intention of parties to a contract when it interprets a contract nor is it established in the same way that a court establishes the intention of the legislature when it interprets a statute on the basis of the doctrine of intentionalism. According to Lord Diplock in *Catnic* the Court does not read the patent claims and make up its own mind about whether or not the patentee intended a particular feature in an invention to be an essential integer. The reason why the Court does not establish the patentee's intention in this way is that the specification is addressed to a certain category of persons and, in formulating the claims in the terms that the patentee formulates them, it is said that he would have expected the persons to whom he was addressing the claims to understand them in a certain way. He would also be entitled to assume that such people had a certain amount of knowledge of the field in which his invention would be utilised.
- [2] To establish the patentee's intention, the Court brings in a "middle" man. That is a person who comes from the class of persons to whom the patentee was addressing the claims. That is a person with practical knowledge and experience in the field in which the invention is intended to be used. The Court asks the question: would a person with practical knowledge and experience in the relevant field understand that the patentee intended that strict compliance with the descriptive word or phrase in the claim would be an essential requirement with the result that any variant would fall outside the monopoly claimed by him even if the variant could not have any material effect upon the working of the invention? If the answer is that such a person would understand that the patentee did not so intend, then strict compliance with such descriptive word or phrase in the claim is not an essential requirement of the invention and, therefore, there is infringement of the patented invention. If the answer is that such a person would understand that the patentee did intend that there be strict compliance with such descriptive word or phrase in the claim, the feature is an essential requirement of

the invention and the variant does not infringe the patent.¹ That is because, if the accused device is without one of the essential integers of the patented invention, that is enough to take the accused product or process out of the claims of the patent and this means that the accused device is not an infringement.

- [3] Before dealing with the next issue that Lord Diplock mentions in this regard, it is important to remember what, according to Lord Diplock, the question is in each case. According to Lord Diplock the question in each case is:

“Whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could not have any material effect upon the way the invention worked?”²

Lord Diplock said that this question would only be answered in the negative when it would be apparent to a reader skilled in the art that such a descriptive word or phrase could not have been intended to exclude minor variants which would have no material effect upon the working of the invention.³ An answer in the negative to the above question would be an answer that says: No, persons with practical knowledge and experience would not understand that the patentee intended strict compliance with the particular word or phrase to be an essential requirement for the invention even if the variant would have no material effect upon the way the invention worked! Lord Diplock said that that answer could only be given “when it would be apparent to a reader skilled in the art that such a descriptive word or phrase could not have been intended to exclude minor variants which would have no material effect upon the way that the invention worked?”⁴

- [4] It is suggested that what Lord Diplock meant on this last point is this: After putting the question framed above but before answering it, there is another question that you must ask. That is: would it be apparent to a reader skilled in the art that the particular

¹ Lord Diplock in *Catnic* at 241.

² Lord Diplock at 243 lines 5-11.

³ *Catnic* at 243 lines 18-24.

⁴ *Catnic* at 243 lines 18-24.

descriptive word or phrase could not have been intended to exclude minor variants from the monopoly claimed? If the answer to this subsidiary question is: yes, it would be apparent to the reader skilled in the art that the descriptive word or phrase could not have been intended to exclude minor variants from the monopoly claimed, there is infringement. It stands to reason that, if the answer is: No, it would not be apparent to the reader skilled in the art that the descriptive word or phrase could have been intended to exclude minor variants, then there is no infringement.

- [5] Lord Diplock said the question of whether persons with practical knowledge and experience in the relevant art would understand the patentee to have intended that strict compliance with a descriptive word or phrase was to be an essential feature of the invention does not arise where the variant would in fact have a material effect upon the way the invention worked. Lord Diplock then went on to say in the next sentence:

“Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so”.⁵

The sentence just quoted above is the second sentence in that paragraph. The first sentence means that, if the variant would, as a matter of fact, have a material effect on the way the invention worked, the question of whether the patentee had intended such variant to be part of the monopoly does not arise and that variant does not constitute an infringement. This is in line with the principle that the doctrine of “pith and marrow” only applies to those cases where the variant is unessential. It would, therefore, seem⁶ from the first sentence in the second paragraph of page 243 of the *Catnic* judgment that Lord Diplock said that, if the variant would, objectively speaking, have a material effect on the working of the invention, no infringement occurred.

- [6] What happens if it would be obvious to the informed reader at the date of publication of the specification that the variant would have a material effect on the way the

⁵ *Catnic* at 243. The sentence that is to the effect that the question does not arise where the variant would in fact have a material effect upon the working of the invention is the 1st sentence of the 2nd paragraph at 243 of the judgment.

⁶ See the 1st sentence in the 2nd par at 243 of the *Catnic* judgment.

invention worked? The answer to this question is in the second sentence of the second paragraph at 243 of the *Catnic* judgment. The answer is that, if it would be obvious to the informed reader at the date of publication of the specification that the variant would have a material effect upon the way the invention worked, the question of what the understanding of the informed reader would be as to whether the patentee intended that there be strict compliance with the descriptive word or phrase would not arise. The reason why it would not arise is because the patentee would obviously also have intended that such a variant would fall outside the monopoly that he sought to be granted in respect of his invention.

[7] What if it would not have been obvious to the informed reader, in the light of the then existing knowledge, that the variant would have a material effect upon the way the invention worked? The answer to this question is to be found in the third sentence of the third paragraph at 243 of the *Catnic* judgment. That is that, if it would not have been obvious to the informed reader that the variant would in fact have a material effect on the way the invention worked, according to Lord Diplock the informed reader is entitled to assume that the patentee intended to limit his monopoly so strictly and had a good reason to do so even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary.⁷

[8] The last sentence of the second paragraph at 243 deals with when the relevant question should be answered in the negative. The relevant question here is whether persons with practical knowledge and experience in the relevant art would understand the patentee to have intended strict compliance with the descriptive word or phrase to be an essential requirement of the invention. It reads:

“It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by a patentee who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked”.⁸

⁷ *Catnic* at 243 lines 15-18.

⁸ *Catnic* at 243 lines 18-24. For a comparative discussion of the three *Catnic* questions and the so-called three Schneidmesser questions in German patent law, see Axel von Hellfeld: “Patent infringement in Europe: The British and the German approaches to claim construction or purposive construction versus equivalency” EIPR 2008, 3(9), 364-370.

This is an extremely long sentence. However, all it means is that, where it would be apparent to any reader skilled in the art that the patentee could not have intended to exclude the variant from his monopoly, the answer must be that persons with practical knowledge and experience in the relevant field would not understand that the patentee intended that strict compliance with the descriptive word or phrase should be an essential feature of the monopoly with the result that any variant would fall outside the monopoly claimed. That would be an answer in the negative to the question and that would mean that there is infringement.

[9] The following additional points or observations can be made about Lord Diplock's speech in *Catnic*:

(a) that part of Lord Diplock's speech in which he considered the issues on appeal before the House of Lords as opposed to setting out the history and background of the case and the decisions of the earlier Courts which had dealt with the matter is brief; it comprises only a few paragraphs starting with the words "My Lords, in their closely reasoned written cases in this House ...".⁹ He considered the principles of construction in that paragraph and the next two paragraphs. After that he sought to apply the principles to the facts of the case. He did this in the following five paragraphs. The famous passages from Lord Diplock's speech that have been quoted in various jurisdictions including South Africa, Canada and the USA are to be found in the second half of page 242 and the first half of page 243 of the judgment.

(b) Subject to what will be said later herein, there is no difficulty with the main question that Lord Diplock said would have to be asked in every case. That is the question whether persons with practical knowledge and experience in the relevant field would understand the patentee to have intended that strict compliance with the descriptive word or phrase would be an essential requirement of the invention so that any variant would fall outside the monopoly claimed. There is also no difficulty with the statement to the

⁹ Lord Diplock in *Catnic* at 242.

effect that this question does not arise where the variant would in fact have a material effect upon the way the invention worked.

- (c) One part of Lord Diplock's speech which is problematic is the one in which he said that a patent specification is a statement by the patentee "by which he informs" those skilled in the art "what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly", and that "It is those novel features only that he claims to be essential that constitute the so-called 'pith and marrow' of the claim".¹⁰ The difficulty with this part of Lord Diplock's speech is in the formulation of those two sentences. They are formulated in a way that gives the impression that everything that is mentioned in a claim by a patentee is something he intends to be an essential feature of his invention and that there are no features contained in a claim which the patentee would not intend to be essential integers. The fact of the matter is that there will be such features in a claim. Once that is factored into the interpretation of a claim, the task of interpreting a claim will be more balanced and will be based upon an acknowledgement that there are features or integers which the patentee intended to be essential integers of his invention and there are others which he would not be intending to be essential integers.
- (d) Another part that is problematic in Lord Diplock's speech is the third sentence of the second paragraph at 243. That is the sentence which deals with what should happen if it would not have been obvious to the informed reader that the variant would have a material effect upon the way the invention worked. That sentence says that in such a case the reader is entitled to assume that the patentee thought at the time of the specification that he had a good reason for limiting his monopoly so strictly that such a variant would fall outside the monopoly claimed. The difficulty with the approach contained in this sentence is that, without any justification or warrant, it facilitates the escape from liability of an infringer whose variant may otherwise fall within the monopoly. Lord Diplock advanced no reason why in such a case the patentee must be assumed to have deliberately

¹⁰ Lord Diplock in *Catnic* at 242 lines 44 to 243 line 3.

wanted to exclude such a variant from his monopoly. It is suggested that the better approach would be to say that, if the defendant's apparatus or process is the same as the invention of the patentee and falls within the patentee's claims except for an immaterial difference, there would be infringement but, if the difference is a material difference, there would be no infringement of the patentee's patent. In either case any inquiry into what the patentee intended or did not intend should be irrelevant.

- (e) Lord Diplock said that a patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. A superficial reading of this sentence may give the impression that Lord Diplock was advocating an approach to interpretation that would ignore the literal meaning of words used in a claim. However, he said no such thing. He was simply against an approach that was too literal.
- (f) It is to be noted that in those paragraphs of his speech in which Lord Diplock dealt with the construction of claims, he only referred to the *Van der Lely*, *Rodi* and the *Beecham Group* cases. The *Catnic* decision was handed down in 1980. At that time there was case law stretching over a period of at least a century during which the Courts, including the House of Lords, had given judgments dealing with what the correct approach to adopt was in dealing with cases of infringement by the pith and marrow. These included cases such as *Marconi*, *Birmingham*, *Beecham*, Lord Reid's judgment in *Van der Lely* and in *Rodi*, Lord Evershed MR's judgment in *Van der Lely* and Lord Pearce's judgment in *Rodi* in the House of Lords. The approach which was used as at that time was different from the approach that Lord Diplock advocated and yet he did not refer to those cases, let alone discuss them and say what was wrong with the approach that the Courts had followed for so long. He should have given reasons why he was departing from such approach.

[10] In a number of cases it had been said that, where the defendant's apparatus was different in one or other respect from the description in the claim of the patentee's invention, the question to ask to determine whether there was infringement of the pith and marrow of the patented invention was whether the defendant's apparatus or process was the same in substance as that of the patentee and whether it worked in substantially the same way to produce substantially the same result. It was said that, if the answer to this question was yes, then there was infringement but, if the answer either to all or anyone of the elements of the question was no, then there was no infringement. Lord Diplock did not say what he saw as wrong with that approach to justify abandoning it. It is suggested that it was a simple and straightforward approach that was flexible enough to strike a fair balance between the need for certainty for the public and the need for the protection of the patentee's monopoly. Instead, Lord Diplock advocated an approach that was cumbersome, complicated and confusing which brought about, it is suggested, much uncertainty that would have been avoided if he had followed the approach that had been followed by all the Courts in the UK for over a century.

[11] In the Court of Appeal in *Catnic*, Buckley LJ set out a number of "generalisations",¹¹ as he called them, which, it is suggested, are like principles to be followed in the determination of what is and what is not an essential feature of a patented invention. Some of the principles set out by Buckley LJ are similar to those set out by Lord Diplock in *Catnic* but the principles set out by Buckley LJ are clear and simple and cannot result in confusion or uncertainty. Since it was Buckley LJ's judgment that was on appeal in the House of Lords in *Catnic*, it is not apparent why Lord Diplock shied away from following the same principles¹² that Buckley LJ set out, nor is it apparent what it was that he found wrong with Buckley LJ's principles. Buckley LJ set out four principles. They were the following:

- (1) If that feature of the claim which is under consideration is in fact essential to the working of the claimed invention, then it must be an essential feature of the claim.

¹¹ Buckley LJ in *Catnic* at 228 lines 9-30.

¹² Buckley LJ set those principles out at 228 Lines 9-30

- (2) If the feature is not in fact essential to the working of the claimed invention, the applicant for a patent may nevertheless have made it an essential feature of the claim, that is to say, he may by the terms of the claim as properly construed have clearly limited his claim to a subject matter having that feature. If so, that feature will be an essential feature of the claim and anyone who makes a product or carries out a process which has all the features of the claim except that particular feature will not infringe the claim.
- (3) Not all claims are perfectly drafted. Sometimes a draftsman may include some feature in a claim, either explicitly or by implication, which is not in fact essential to the working of the claimed invention and which the applicant has not by the terms of his specification and claim clearly indicated as a feature which he regards as an essential feature of his monopoly. In such a case an alleged infringer may be held to have infringed the claim notwithstanding that his product or process does not incorporate the feature in question or substitutes some equivalent for it.
- (4) The fact that a claim incorporates a particular feature does not alone suffice to make that feature an essential one. If this were not so, no feature of a claim could ever be inessential, but the speeches in *Rodi* and *Wienerberger* all assume that a claim may include an inessential feature.¹³

For convenience these four principles will be referred to as the BLJ principles. In this instance the letters BLJ stand for Buckley LJ.

[12] The first of the BLJ principles corresponds with the principle contained in the first sentence of the second paragraph at 243 of Lord Diplock's speech in the House of Lords in *Catnic*. There is not a certain correspondence between the rest of the BLJ principles and the rest of the statements of Lord Diplock's speech in *Catnic*.¹⁴ However, in other parts of his speech Buckley LJ did make statements which seem to be to the same effect as some of the statements to be found in Lord Diplock's speech.

¹³ Buckley LJ in *Catnic* at 228 lines 9-30.

¹⁴ At 242-244.

Buckley LJ said that “(t)o determine whether a claim of a patent has been infringed one must first discover what is claimed”:¹⁵ He went on to say:

“The claim must be construed and analysed to ascertain what are the features – sometimes called the integers – of the subject matter for which a monopoly is claimed. The claim must be construed in the context of the specification as a whole and in the light of any admissible evidence. It must be read and interpreted as it would be read and interpreted by the notional addressee of the specification, that is to say, a man skilled in the relevant art who has at his disposal the common knowledge in the art at the date of the publication of the specification. When so construed the claim must be analysed to discover what are the several features of the thing for which a monopoly is claimed. One must next consider the alleged infringement to determine whether it infringes the claim. If the alleged infringement of the claim has all the features of the claim it must infringe the claim, even if it also incorporates other features. If it lacks one of the features of the claim, it may or may not infringe the claim. If the feature which is lacking is an essential feature of the claim, there will be no infringement; but, if the feature which is lacking is an inessential feature of the claim, the fact that it is wholly omitted from the alleged infringement or is replaced by some equivalent, will not save the alleged infringement from being an infringement, for, if it has all the essential features of the claim, it will infringe the claim notwithstanding the omission or substitution of an inessential feature.”¹⁶

[13] It will be noticed that in the passage quoted above Buckley LJ said that a claim “must be read and interpreted as it would be read and interpreted by the notional addressee of the specification, that is, to say, a man skilled in the relevant art who has at his disposal the common knowledge in that art at the date of the publication of the specification”.¹⁷ This seems to be substantially the same as what Lord Diplock said¹⁸ in relation to the person whose interpretation must be used to construe a claim. The difference between the two is simply that in respect of the qualifications of the addressee Buckley LJ referred to such person being “skilled” in the relevant art whereas Lord Diplock referred to someone who has “practical knowledge and experience” in the relevant art. The two persons do not necessarily have the same qualifications.

[14] One of the criticisms levelled at Lord Diplock’s speech in *Catnic* above is to the effect that the approach that he advocated on how to establish the intention of the

¹⁵ Buckley LJ in *Catnic* at 225 line 19-20.

¹⁶ Buckley LJ in *Catnic* at 225 lines 20-39.

¹⁷ Buckley LJ in *Catnic* at 225 lines 23-27.

¹⁸ At 243 lines 5-11 *Catnic*.

patentee gives the impression that the contents of a claim consists only of the essential features of the invention whereas they also include unessential features. It is interesting to note that Buckley LJ warned against such an approach.¹⁹ There Buckley LJ said:

“The fact that a claim incorporates a particular feature does not alone suffice to make that feature an essential one. If this were not so, no feature of a claim could ever be inessential...”²⁰

In fact Sir David Cairns said the same thing in his separate judgment in the Court of Appeal in *Catnic*. He put it thus:

“Since the cases recognise a difference between textual infringement and infringement of the pith and marrow, it must follow that the mention of a particular feature in the claim is not sufficient to make that feature essential”.²¹

[15] In fact that approach was set out as the correct approach in *Birmingham*²² which was quoted in the judgment of the Court of first instance in *Catnic*, namely, in Whitford J’s judgment. In *Birmingham* it was said in the relevant passage:

“The question therefore appears to be whether the allegedly infringing apparatus consists of substantially the same parts acting upon each other in substantially the same way as the apparatus claimed as constituting the invention”.²³

As this approach had been included in Whitford J’s judgment, it is even more puzzling why Lord Diplock said absolutely nothing about it in his judgment before adopting the new approach in *Catnic*. In fact even in the judgment of Waller LJ in the Court of Appeal in *Catnic*, Waller LJ did refer to what was said in *Adie*’s case where James LJ, *inter alia*, said:

“and that invention like every other invention may be pirated by a theft in a disguised or mutilated form and it will be in every case a question of fact whether the alleged

¹⁹ *Catnic* in the Court of Appeal at 228 lines 26-28 which is the fourth of the BLJ principles.

²⁰ Buckley LJ in the Court of Appeal in *Catnic* at 228 lines 26-30.

²¹ Sir David Cairns in the Court of Appeal in *Catnic* at 235 lines 43-45.

²² [1956] RPC 232 at 245.

²³ Whitford J in *Catnic* at 214.

piracy is the same in substance and effect or is a substantially new or different combinationé”,²⁴

[16] Sir David Cairns said that he could find nothing in the wording of the claim in *Catnic* or in the specification as a whole to suggest that a strictly vertical back member was an essential feature of the invention. Hitchman and MacOdrum express the view that Lord Diplock’s admonition to give claims a purposive construction did not mean that the other established principles relating to the claims were to be disregarded. They say that this was recognised by the Federal Court of Appeal of Canada in *Beecham v Proctor and Gamble*.²⁵

[17] Tim Burrell²⁶ has expressed the view that the adjective “purposive” in “purposive construction” as used in Lord Diplock’s speech in *Catnic* is to be equated with the more common and understandable word “reasonable” or as he puts it its synonym “sensible”: In support of this statement, Burrell cites the decision of the Appellate Division of the Supreme Court, as the Supreme Court of Appeal was then called, in *Stauffer Chemic and Co and Another v Safson Marketing and Distribution Co (Pty) Ltd*²⁷ and the authorities there cited. This proposition by Burrell is consistent with:

- (a) Lord Diplock’s statement in *Antonios Campania Naviera SA v Salen Raderierna AB*²⁸ where Lord Diplock, using in effect purposive construction to construe a charter party, too that opportunity of restating that if detailed semantic and syntactical analysis of words in a commercial contract was going to lead to a conclusion that fainted business common sense. It had to be made yield to business common sense.
- (b) The statement made by Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussell Ltd*,²⁹ within the context of a discussion of purposive construction, that construction is objective in the sense that it is concerned

²⁴ Waller LJ at 232 lines 15-21.

²⁵ See Hitchman and MacOdrum at 202.

²⁶ Burrell Tim *South African Patent Law and Practice* (1986) (2nd ed) at 246.

²⁷ 1986 BP 462 (A) at 480C.

²⁸ (1985) AC 191 at 201.

²⁹ (2005) 1 All ER 169 (HL) at par 32.

with what a reasonable person to whom the utterance was addressed would have understood the author to use the words to mean.

- (c) The statement made by Lord Denning MR in *James Buchanan and Co Ltd v Babco Forwarding and Shipping (UK)*³⁰ that the European judges, when interpreting an instrument, “ask simply: what is the sensible way of dealing with this situation so as to give effect to the presumed purpose of the legislation?”
- (d) The view expressed by Zondo JP in his minority judgment in *Equity Aviation Services (Pty) (Ltd) v S A Transport Allied Workers Unions and others*.³¹
- (e) The view expressed by Mureinik that purposive interpretation enjoins a reader to prefer the construction that makes sense of the statute as a whole; Mureinik also said that purposive interpretation seeks the construction that makes the statute coherent.³²
- (f) The view expressed by Lord Hoffmann, which was concurred in by the majority in *Investors Compensation Scheme Ltd v West Brownwich Building Society*³³ in explaining what in effect was purposive construction of contracts, that any serious utterance would be interpreted in ordinary life and that “interpretation is the ascertainment of the meaning which the document would convey to a reasonable person having all the background knowledge which would reasonably have been available to the parties in the situation in which they were at the time of contract”.³⁴
- (g) The fact that, within the context of applying the *Catnic* approach in *Wheatley (Davina) v Drillsafe Ltd*,³⁵ Aldous LJ said that “It is reasonable to infer, absent express words to the contrary, that the patentee intended to

³⁰ [1977] 1 All ER 518 (CA).

³¹ (2009) 30 ILJ 1997 (LAC) at par 65.

³² Mureinik: “Administrative Law in South Africa” (1986) SALJ 615 at 620.

³³ *Investors Compensation Scheme Ltd v West Brownwich Building Society*, *The Weekly Law Reports* 22 May 1998 at 896.

³⁴ See Lord Hoffmann in *Investors Compensation Scheme Ltd v West Brownwich Building Society*, *The Weekly Law Reports* 22 May 1988 896 at 912H.

³⁵ [2001] RPC 7 at 23.

include within his monopoly that can be termed immaterial variant was not intended to be within ambit of the monopoly....”³⁶

³⁶ Author’s emphasis.

CHAPTER 8

8 HOW THE *CATNIC* TEST CAME TO REPLACE THE DOCTRINE OF PITH AND MARROW IN ENGLISH PATENT LAW

- [1] The question which arises is: why did Lord Diplock decide to replace the doctrine of pith and marrow in the first place and, in the second place, why he decided to replace it with the *Catnic* test. To answer this question one needs to understand what happened in the various stages of the *Van der Lely* case and the *Rodi* case and to analyse *Beecham's* case and *Catnic*. This includes understanding the composition of the panel of the Judges and Law Lords in the *Van der Lely* and *Rodi* cases at different levels, particularly in the Court of Appeal and in the House of Lords.
- [2] The composition of the panels in the Chancery Division, Court of Appeal and the House of Lords in the *Van der Lely* and *Rodi* cases was as follows:

***Van der Lely* case**

Chancery Division: 1960

Lloyd-Jacob J 1960

Court of Appeal: 1961

Lord Evershed MR

Upjohn LJ

Pearson LJ

House of Lords: 1962

Lord Reid

Viscount Radcliffe

Lord Jenkins

Lord Hodson

Lord Devlin

The *Rodi* Case

Chancery Division

Lloyd-Jacob J 1965

Court of Appeal: 1965

Harman LJ

Diplock LJ

Winn LJ

House of Lords: 1968

Lord Reid

Lord Morris of Borth-y-Gest

Lord Hodson

Lord Pearce

Lord Upjohn

[3] From the above one can see that in 1961, when the Court of Appeal decided the *Van der Lely* case, Upjohn LJ was part of the panel which decided that case. In fact he delivered the majority judgment which was a judgment of himself and Pearson LJ in the *Van der Lely* case in terms of which they found that there was no infringement. Lord Evershed MR delivered a dissent in which he found that there was infringement. As it was pointed out earlier in the discussion of Upjohn LJ's judgment, he and Pearson LJ found that the doctrine of pith and marrow was of no application in the case and concluded that the patentees had chosen to confine their monopoly in a manner which allowed the alleged infringer to produce the apparatus that it did. Their approach was almost exclusively focussed on the language of the claims and they made no reference whatsoever to the rule on immaterial variations. They did not even consider whether the variant chosen by the alleged infringer was of any practical significance or had any material effect on the functioning of the invention. Indeed, they did not deal with the reasons given by Lord Evershed MR in his dissent for the contrary conclusion that he reached.

[4] It is suggested that Lloyd-Jacob J's judgment in the Chancery Division in *Van der Lely* was the first judgment which opened the way to the Upjohn LJ approach. Thereafter, the judgment of Upjohn LJ and Pearson LJ in the Court of Appeal followed the approach to the determination of patent infringement and the doctrine of pith and marrow that was initiated by Lloyd-Jacob J in *Van der Lely*. It is suggested that Upjohn LJ's and Pearson LJ's judgment was the first judgment of the Court of Appeal to adopt the Upjohn LJ approach. When the *Van der Lely* case went on appeal to the House of Lords, the majority of the panel in the House of Lords upheld Upjohn LJ and Pearson LJ and even approved their understanding of the doctrine of pith and marrow, thus producing another one of the judgments which were based upon a wrong understanding of the doctrine of pith and marrow. Particular note must be taken of the fact that Lord Reid, who gave a dissent in the *Van der Lely* case in the House of Lords, and, Lord Hodson, were members of the panel which heard the appeal in the *Van der Lely* matter in the House of Lords. Lord Reid found that there was infringement of claim 11 whereas Lord Hodson found that there was no infringement of that claim. It is important to also point out that the majority effectively adopted the same approach as Upjohn LJ and Pearson LJ in the Court of Appeal and that Lord Reid adopted a different approach which, it is suggested,

revealed the correct understanding of the determination of patent infringement and the doctrine of pith and marrow. The approach adopted by Lord Reid in the House of Lords in *Van der Lely* was effectively the same as the approach reflected in Lord Evershed MR's dissent in the Court of Appeal.

- [5] As indicated above, the Court of Appeal decided the *Van der Lely* matter in 1961 and the House of Lords decided the appeal in 1962. Three years thereafter, namely in 1965, the *Rodi* matter came before Lloyd-Jacob J in the Chancery Division. Lloyd-Jacob J had also decided the *Van der Lely* matter in the Chancery Division. He found in the *Rodi* matter that there was infringement of the plaintiffs' patent by the defendants' EXCALIBUR 59. This was interesting because the *Van der Lely* case was a clearer case for infringement than was the *Rodi* matter and in the *Van der Lely* matter he had found no infringement. It is also very interesting that in *Rodi* Lloyd-Jacob J neither referred to the judgment of the Court of Appeal nor to that of the House of Lords in *Van der Lely*. What is even more interesting is that he specifically referred to Lord Reid's speech in the House of Lords in the *Van der Lely* matter. In fact he referred to it as if it was the majority decision. Lloyd-Jacob J made the reference to Lord Reid's speech in the following terms:

“But if a finding of non-infringement is to be justified the court must additionally be satisfied that the substance of the invention claimed, the pith and marrow of it, in Lord Cairns' phrase, has not been appropriated by the defendants, for the House of Lords has recently re-affirmed that the court should not permit a patent monopoly to be avoided by what, in the language of Lord Reid, may constitute sharp practice (see *Van der Lely v Bamfords Ltd* [1963] RPC 61)”.¹

Ironically, the majority decision of the House of Lords in *Van der Lely* effectively made such avoidance very easy.

- [6] Furthermore, when one reads Lloyd-Jacob J's judgment in *Rodi* and one reads Lord Reid's speech in *Van der Lely* it seems very clear that Lloyd-Jacob J did not apply the approach adopted by the Court of Appeal and the House of Lords in *Van der Lely* but

¹ Lloyd-Jacob J in *Rodi* at 458 line 47 to 459 line 2. Lloyd-Jacob J is not the only one who treated Lord Reid's dissent in the *Van der Lely* matter as if it was the majority decision of the House of Lords. Catherine NG also did so in the article: “The Purpose of Purposive Construction” (2000-2001) *Intellectual Property Journal* 1 at 2. Fox also seems to have treated Lord Reid's dissenting judgment in the House of Lords in *Van der Lely* as if it was the majority decision. See Fox *Canadian Patent Law and Practice* (1969) (5th ed) at 354.

in effect applied the approach adopted by Lord Reid in his dissent. It is difficult to resist the temptation to think that Lloyd-Jacob J, despite the fact that he, too, had found no infringement in *Van der Lely*, had subsequently been persuaded that Lord Reid's dissent in *Van der Lely* was right and that the majorities in both the Court of Appeal and the House of Lords were wrong. That would explain why reference to any of those decisions is conspicuous by its absence in his judgment. That also explains why he referred to Lord Reid's dissent in the terms in which he did. Indeed, it is suggested that Lloyd-Jacob J played a very important role in the abandonment of the doctrine of pith and marrow.

[7] Through his judgment in the Chancery Division in *Van der Lely*, Lloyd-Jacob J initiated an approach to the determination of patent infringement and the doctrine of pith and marrow which, once approved by the Court of Appeal and the House of Lords in *Van der Lely* later effectively put the final nail in the coffin of the doctrine of pith and marrow in English patent law and yet he was also the first one, after the House of Lords' decision in *Van der Lely*, to turn his back on that approach and effectively adopted the approach of the dissenters. He did this in his judgment in *Rodi* in the Chancery Division. Although his new direction was initially not followed by the Court of Appeal and the House of Lords in the *Rodi* matter, it was ultimately followed by the Court of Appeal and the House of Lords in *Beecham*. It was when the *Beecham* case came before the Court of Appeal and the House of Lords that the Court of Appeal and the House of Lords turned their backs on the Upjohn LJ approach and embraced the Lord Reid approach.

[8] The appeal from the judgment of Lloyd-Jacob J in *Rodi* to the Court of Appeal was heard in 1965. The three Judges who heard the appeal, namely, Harman LJ, Diplock LJ and Winn LJ, all gave separate judgments, but all found that the defendants' EXCALIBUR 59 did not infringe the patentee's patent. In their separate judgments neither Harman LJ nor Diplock LJ made any reference to the rule of patent law on immaterial variations. In his judgment, Harman LJ referred to the *Van der Lely* case which he said was "a striking example" of the proposition that, "once you find that an essential element of the patented invention is not found in the rival machine, the latter

does not infringe the former.”² Harman LJ then proceeded to say of the *Van der Lely* case:

“The change from displacing the hindmost wheels of the hayrake to that of displacing the foremost wheels seem[s] to be a merely mechanical alteration: nevertheless the claim for infringement failed”.³

In this passage Harman LJ seems to have taken the view that Lord Reid was probably right in his conclusion in *Van der Lely* and the majority in the Court of Appeal and in the House of Lords probably not right.

[9] In his judgment Diplock LJ accepted Upjohn LJ’s approach in the *Van der Lely* matter in the Court of Appeal, which had subsequently been approved by the majority in the House of Lords as being the correct approach. Diplock LJ said in this regard:

“The law as to principles of construction of claims in specifications in the modern form seems to me so laid down clearly and authoritatively in the judgment of Upjohn LJ in *Van der Lely v Bamfords Ltd* [1961] RPC 296 at 312, which was approved by the majority of the House of Lords on appeal: [1963] RPC 61”.⁴

The effect of the above statement by Diplock LJ was that he accepted as correct Upjohn LJ’s understanding of the doctrine of pith and marrow and how it was to be applied. Diplock LJ, like Upjohn LJ in the *Van der Lely* matter, decided the issue of non-textual infringement with no regard to the rule of patent law on immaterial variations and no regard to the question whether or not the variant added any value or was of any practical significance. He did not refer to or in any way discuss Lord Evershed MR’s dissent in the Court of Appeal in *Van der Lely*. Diplock LJ also did not refer to the *Marconi* judgment or the *Birmingham* judgment which had discussed the doctrine of pith and marrow. In his defence it may be said that there was no need for him to refer to or discuss such judgments in the light of the then recent judgment of Upjohn LJ in the Court of Appeal in *Van der Lely* which had just received the House of Lords’ “imprimatur”. Winn LJ did refer in his judgment to the judgment of

² Harman LJ in *Rodi* at 465 lines 10-15.

³ Herman LJ in *Rodi* at 465 lines 15-17.

⁴ Diplock LJ in *Rodi* at 467 lines 17-21.

the Court of Appeal in *Van der Lely*. He made no reference to the rule on immaterial variations.

[10] The *Rodi* matter came before the House of Lords in 1967 and the decision was handed down early in 1968. In the meantime Upjohn LJ, who had written the judgment of the Court of Appeal in *Van der Lely* which had been approved by the House of Lords, had been promoted to the House of Lords. The panel that heard the *Rodi* appeal in the House of Lords consisted of Lord Reid, who had given a dissent in the House of Lords in *Van der Lely*, Lord Morris of Borth-y-Gest, who had never been involved in the *Van der Lely* matter at any stage, Lord Hodson, who had concurred in the majority speech of Viscount Radcliffe in the House of Lords in *Van der Lely*, Lord Pearce, who had not been involved in any way in the *Van der Lely* matter and Lord Upjohn. So two of the Law Lords in the panel had already adopted the Upjohn LJ approach to the determination of patent infringement and the doctrine of pith and marrow. One had already adopted the Lord Reid approach to the doctrine which, it is suggested, was the correct understanding of the doctrine. That is Lord Reid. Two of the Law Lords had not had any involvement in the *Van der Lely* case. Those were Lord Morris and Lord Pearce. Which way the House of Lords was going to go was to depend upon the views taken by the two Law Lords who had had no prior involvement in the *Van der Lely* case.

[11] As it turned out Lord Reid stuck to the approach he had adopted in his dissent in *Van der Lely*. Lord Upjohn and Lord Hodson stuck to the Upjohn LJ approach. Lord Pearce wrote a separate speech in which he adopted the same approach as Lord Reid. Lord Morris came to the same conclusion as Lord Upjohn and his judgment proved decisive against the Lord Reid approach. The result of the appeal in the *Rodi* matter in the House of Lords was that the appeal against the judgment of the Court of Appeal was dismissed by a majority of 3 to 2. The minority, consisting of Lord Reid and Lord Pearce, would have upheld the appeal. The majority was continuing in its adherence to the Upjohn LJ approach. As stated earlier, in *Rodi* Lloyd-Jacob J had turned his back on the Upjohn LJ approach but the Court of Appeal and the House of Lords in *Rodi* did not follow him as they had done in the *Van der Lely* matter. The Upjohn LJ approach, followed once again by the House of Lords in *Rodi*, confirmed the closure

of any avenue for the application of the doctrine of pith and marrow in English patent law.

- [12] Viscount Radcliffe's speech adopted the same approach as that adopted by Upjohn LJ and Pearson LJ in the Court of Appeal. He looked at the language of the specification to see whether the patentee had not, by the manner in which he had framed his claim in fact left room for the infringer to do what he did. He refused to inquire into whether or not the variant added any value or whether it made any practical difference. He said:

“When, therefore, one speaks of theft or piracy of another's invention or says that it has been ‘taken’ by an alleged infringer and this ‘pith and marrow’ principle is invoked to support the accusations, I think that one must be very careful to see that the inventor has not *by the form of his claim* left open to the world the appropriation of just that property that he says has been filched from him by piracy or theft. After all it is he who has committed himself to the unequivocal description of what he claims to have invented, and he must submit in the first place to be judged by his own action and words.”⁵

This passage reveals in effect an admission by Viscount Radcliffe that he would allow form to prevail over substance in a case where “by the form of his claim” the patentee had left open to the whole world the appropriation of just that property that he says has been filched from him.

- [13] A little later Viscount Radcliffe expressed the view that claim 11 envisaged the dismounting of the hindmost wheels as an essential feature, and, that, therefore, he could not consider whether the dismounting of the hindmost wheels was an essential feature of the invention or not “because it seems to me that the patentee himself has told us by the way that he has drawn up claim 11 that this dismountability of the hindmost wheels is the very element of his idea that makes it an invention”.⁶ The other Law Lords adopted the same approach as Viscount Radcliff in the House of Lords or Upjohn LJ in the Court of Appeal. Davidson *et al* say that the early approach to construction of claim was one of literalism. In support of this assertion these

⁵ Viscount Radcliffe in *Van der Lely* at 78 lines 10-17 (author's emphasis).

⁶ Viscount Radcliffe in *Van der Lely* at 78 lines 23-28.

authors cite the *Van der Lely* case.⁷ These authors say that courts found ways of circumventing the type of colourable evasion that could result where claims were construed using a literalist interpretation. In support of this statement they refer to Lord Reid's dissenting judgment in the House of Lords in *Van der Lely* at 77.⁸

- [14] It is suggested that the decisions of the Court of Appeal and the House of Lords in *Van der Lely* and in *Rodi* and the approach they adopted in the determination of non-textual infringement of patent claims were disastrous for the future determination of non-textual infringement cases in English patent law. It is suggested that Lord Diplock realised this. That is why, when next the House of Lords was required to decide an appeal relating to the determination of non-textual infringement of patents, he did not follow the approach of the Court of Appeal and the House of Lords in those two cases despite the fact that he had agreed with that approach in *Rodi* in the Court of Appeal.
- [15] In *Beecham* in the House of Lords in effect adopted Lord Reid's approach. Later on in *Catnic* he introduced the *Catnic* test as the test for the determination of infringement of patents in which he embraced a good deal of Lord Reid's approach without giving him any credit. To show how Lord Diplock turned his back on the Upjohn LJ approach that had been approved not only by himself but also by the Court of Appeal and the House of Lords, it is necessary to highlight certain special features of Lord Reid's speech in *Van der Lely* and *Rodi* as well as certain special features of Lord Pearce's speech in *Rodi* all of which are to be found in Lord Diplock speeches in both *Beecham* and *Catnic*. Where it is deemed necessary, some of the special features in Lord Reid's and Lord Pearce's speeches will be underlined.
- [16] Certain features in Lord Reid's dissent as well as in Lord Pearce's dissent in *Rodi* need to be highlighted. The reason for highlighting them will emerge later herein. However, before that is done, it may be helpful to briefly highlight certain features of Lord Evershed MR's judgment in the Court of Appeal in *Van der Lely* and certain features of Lord Reid's speech in *Van der Lely*. Hitchman and MacOdrum⁹ discuss

⁷ Davidson *et al* *Australian Intellectual Property Law* (2008) at 514.

⁸ Davidson *et al* at 514.

⁹ Hitchman and MacOdrum at 175-178.

the *Van der Lely*, *Rodi*, *Beecham* and *Catnic* cases but seem not to have appreciated the extent of the legal significance of each of these cases to the evolution of English patent law jurisprudence with regard to the determination of patent infringement. The authors do not even discuss the dissents given in both *Van der Lely* and *Rodi*.¹⁰

¹⁰ Hitchman and MacOdrum at 175-178.

CHAPTER 9

9 SPECIAL FEATURES OF CERTAIN JUDGMENTS OF THE DISSENTERS AND LORD DIPLOCK'S SPEECHES IN *BEECHAM* AND *CATNIC*

9.1 Special Features of Lord Evershed MR's Dissent in the Court of Appeal in *Van der Lely*

[1] In considering whether the defendants' apparatus in *Van der Lely* had infringed the patented invention, Lord Evershed MR considered what the defendants had done. He said:

“What then have the respondents done by way of avoidance (as Mr Forrester thought and said) of infringement of the claim? So far as relevant to the claim under consideration, no more than reverse direction of the machine. If the appellants' machine and that of the respondents were placed side by side upon the ground without any indication of the direction of traction, then those of the wheels to be disposed and remounted would be in both cases the same three. So in each case would the transition from side raking to swath turning be identically achieved. The result in each case would be that the six wheels would become disposed in the required position, ‘adjacent and parallel’. For my own part I would therefore hold that the appellants' claimed device had in substance been infringed. Regarding the machines as pieces of mechanism the same three of the wheels of each are to be displaced and remounted; but because the directions in use are reversed the three wheels are called hindmost in the one and foremost in the other.”¹

It is suggested that this passage in Lord Evershed MR's judgment reveals that, in seeking to determine whether there had been non-textual infringement, he, *inter alia*, focused his mind on what difference in substance the variant made. It is suggested that that was a very important part of the inquiry under the doctrine of pith and marrow.

9.2 Special Features of Lord Reid's Speech in *Van der Lely* in the House of Lords

[2] In *Van der Lely*, Lord Reid, *inter alia*, directed his mind to the question whether the respondents could point to any mechanical reason for the variant or to any advantage

¹ Lord Evershed MR in *Van der Lely* in the Court of Appeal at 319 lines 31-44.

resulting from the variant.² He said that the variation “is simply done to try to evade the claim and the respondents’ method. But they do avoid textual infringement of claim 11 because claim 11 refers to dismounting ‘rake wheels situated hindmost in the direction of motion.’”³ After pointing out that “[c]opying an invention by taking its ‘pith and marrow’ without textual infringement of the patent is an old and familiar abuse which the law has never been powerless to prevent”,⁴ Lord Reid pointed out that it had “long been recognised that there may be an essence or substance of the invention underlying the mere accident of form, and that that invention, like every other invention, may be pirated by a theft in disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination” (Per James LJ in *Clark v Adie* (1873) LR 10 Ch 667). It was in *Clark v Adie* that Lord Cairns used the expression pith and marrow of the invention (1877) 2 App Cas 315 at 320.”⁵

- [3] Lord Reid also took into account the question of whether the alleged infringer’s decision to introduce the variant made “any practical difference as regards efficiency”.⁶ While Lord Reid acknowledged that, if the specification made it clear that the patentee regarded a particular integer as essential it had to be treated as essential, he pointed out that “if the question was one of construction of the specification”, he could not see why “one should shut one’s eyes to the facts of which the patentee must have been aware when framing the specification”.⁷
- [4] Lord Reid criticised the approach taken by Upjohn LJ and Pearson LJ in the Court of Appeal on, *inter alia*, the basis that they had taken the mere mention of an integer in a specification as meaning that the patentee had intended such integer to be an essential feature of the invention. Lord Reid said that, if that were the correct approach to take, he could not see “how there could ever be an unessential feature or how this principle [of pith and marrow] could ever operate. And I think that the principle is very

² Lord Reid in *Van der Lely* at 75 lines 27-36.

³ Lord Reid in *Van der Lely* at 75 lines 30-36.

⁴ Lord Reid in *Van der Lely* at 75 lines 37-39.

⁵ Lord Reid in *Van der Lely* at 75 lines 37-53.

⁶ Lord Reid in *Van der Lely* at 76 lines 22-24.

⁷ Lord Reid in *Van der Lely* at 76 lines 29-33.

necessary to prevent sharp practice.”⁸ Other special features of Lord Reid’s speech in *Van der Lely* are the following:

(a) Lord Reid said:

“Nothing could be less inventive than selecting the hindmost as against the foremost wheels when the selection makes no practical difference as regards efficiency. No one suggests that the use by the respondents of the foremost wheels results in producing an inferior machine”.⁹

Lord Reid pointed out:

“... you cannot avoid infringement by substituting an obvious equivalent for an unessential integer. On the other hand [Sir Lionel Heald], for the respondents, said, again I think rightly, that you cannot be held to have taken the substance of an invention if you omit, or substitute something else for an essential integer. I cannot imagine any more obvious equivalent than substituting the foremost for the hindmost wheels in this machine. So the question is whether selecting the hindmost wheels on claim makes them essential or an unessential integer.”¹⁰

Lord Reid observed:

“If the specifications makes it clear that the patentee regards a particular integer as essential, then it must be treated as essential, but otherwise even if the question is one of construction of the specification I cannot see why one should shut one’s eyes to facts of which the patentee must have been aware when framing the specification”.¹¹

(b) Lord Reid also had this to say:

“It must be true as Lloyd-Jacob J says that in framing their specification the applicants did not appreciate that the same results could be achieved by moving the foremost wheels, for otherwise they would have made their claims wide enough to cover this. But surely the same must be true of most if not all cases where there is an attempt to avoid infringement by the substitution of a mechanical equivalent: if the patentee had foreseen that possibility he would have made his claim cover it. If that were a good

⁸ Lord Reid in *Van der Lely* at 76 lines 5 to p. 77 line 4.

⁹ Lord Reid in *Van der Lely* at 76 lines 21-24.

¹⁰ Lord Reid: *Van der Lely*: at 76 lines 7-13.

¹¹ Lord Reid in *Van der Lely* at 76 lines 29-33.

reason for refusing protection to the patentee against a person who later thinks of and adopts the mechanical equivalent, it seems to me that there would be very little left of this principle. Upjohn LJ said that the appellants have deliberately chosen to make it an essential feature of the claim that the hindmost wheels should be detachable. If by that he meant that there is something in the specification to show that they deliberately refrained from including the foremost wheels or went out of their way to make hindmost wheels an essential feature, I cannot find anything on which to base such a conclusion. But I do not think that he meant that because he went on to agree with Lloyd-Jacob J that apparently the appellants did not appreciate the possibility that the foremost wheels might be moved. So I think that he must have meant that the mere fact that they only mentioned the hindmost wheels was sufficient to make the limitation to the hindmost wheels an essential feature of the claim. But if that were right, then I cannot see how there could ever be an unessential feature or how this principle could ever operate. And I think that the principle is very necessary to prevent sharp practice.”¹²

(c) Lord Reid went on to say:

“In my judgment taking the way in which the specification is framed and the nature of the mechanism in respect of which this claim is made, the reference to the hindmost wheels is of minor importance and is an unessential integer. The respondents’ substitution of the foremost wheels is merely a mechanical equivalent and therefore they must be held to have infringed this claim.”¹³

9.3 Special Features of Lord Reid’s Speech in *Rodi* in the House of Lords

[5] The first feature of Lord Reid’s speech in *Rodi* to highlight is the fact that, consistent with the approach he had taken in *Van der Lely*, Lord Reid asked himself the question whether functionally the variant made any material difference. After considering the relevant features of the patented invention, Lord Reid turned his attention to the defendants’ EXCALIBUR 59. He then said:

“In EXCALIBUR 59 one limb of the U is extended and joined to the corresponding limb of the corresponding U at the other end of the sleeve, thus making a double link of the shape of an elongated letter C. *Functionally this, in my opinion, makes no material difference. It makes the bracelet slightly less flexible if one tries to bend it in a way which no one would normally try to do. It makes the role of the spring slightly different – a matter to which I shall return. It makes no material difference to the case*

¹² Lord Reid in *Van der Lely* at p76 line 36 to 77 line 4.

¹³ Lord Reid in *Van der Lely* at 77 lines 5-9.

with which the parts can be assembled or the bracelet can be shortened by taking out one or more sleeves. But it is said that nevertheless this small change takes EXCALIBUR 59 out of the ambit of the claim in the plaintiff's specification."¹⁴

A little later Lord Reid pointed out that it was not disputed that:

*"a very slight alteration of the wording of the claim would make it quite clear that the claim is wide enough to cover C-shaped connecting links. But it is said that the inventor has tied himself to words which are not wide enough to cover C-shaped links. It is not suggested that there was any possible reason for limiting the claim in this way. If it has been so limited it must have been per incuriam. No doubt if the reader of a specification is astute enough to see that the patentee has framed his claim so narrowly as to leave it open to him by some small modification to use the invention without infringing the claim, he is quite entitled to do that. He cannot be accused of sharp practice. He is within his legal rights. But claims are not addressed to conveyancers: they are addressed to practical men skilled in the prior art, and I do not think that they ought to be construed with that meticulousness which was once thought appropriate for conveyancing documents."*¹⁵

9.4 Special Features of Lord Pearce's Speech in *Rodi* in the House of Lords

[6] Some features of Lord Pearce's dissenting speech in *Rodi* also need to be highlighted.

6.1. Referring to a construction which the defendants sought to place upon the patentee's claim in *Rodi*, Lord Pearce described their approach to construction as "the alphabetical approach"¹⁶ He also referred to the defendants' construction as a "meticulous construction."¹⁷ He said that he did not find it attractive.

6.2 Lord Pearce also wrote of someone "thinking on mechanical rather than literary lines"¹⁸ and said, in the context of the facts of the *Rodi* case, that to such a person the essence of the connector "would be a bridge connecting two parallel limbs which would lie in adjacent sleeves".¹⁹ Lord Pearce had the following to say:

¹⁴ Lord Reid in *Rodi* at 377 line 40 to 378 line 3 (author's emphasis).

¹⁵ Lord Reid in *Rodi* at 378 lines 6-18 (author's emphasis).

¹⁶ Lord Pearce in *Rodi* at 387 line 27.

¹⁷ Lord Pearce in *Rodi* at 387 lines 30-31.

¹⁸ Lord Pearce in *Rodi* at 387 line 34.

¹⁹ Lord Pearce in *Rodi* at 387 lines 34-37.

“It is important that in construing a patent one should seek to find what it meant to the reasonable person who is reasonably versed in the matters of which it speaks – in this case mechanical. It is directed to the workshop and the market place rather than to the cloister. For that reason a plain straightforward construction is generally to be preferred to one that is strained or literary or tortuous. And meticulous niceties of construction which are wholly appropriate to a legal document may seem to the practical man to have a flavour of pedantry if they so whittle away a patent that they enable a copyist to avoid its ambit by means that seem to be concerned with words rather than essentials.”²⁰

A little later Lord Pearce once again referred to a construction of the claim that he described as “too strained and meticulous a construction of the claim”.²¹

9.5 Special Features of Lord Diplock’s Speech in *Beecham*

[7] When the *Beecham* case came before the House of Lords, Lord Diplock appears to have been the most senior of the Law Lords who heard that appeal. When one looks at the facts of the *Beecham* case and the wording of the relevant claim, one can say that the case was not materially different from the *Van der Lely* case. If Lord Diplock had decided it upon the same approach as had been adopted by the Court of Appeal and the House of Lords in *Van der Lely*, it would have been accepted as something to be expected. However, he did not follow that approach. Instead he followed in effect the Lord Reid approach and found that there was infringement.

[8] It is suggested that the fact that Lord Diplock chose not to follow the Upjohn LJ approach in the *Beecham* case despite the fact that the Upjohn LJ approach had twice been approved by the House of Lords speaks volumes. This is more so because in his speech in *Beecham* Lord Diplock did not explain why it could be said that the doctrine of pith and marrow applied in that case when it had been held not to apply in both the *Van der Lely* case and in the *Rodi* case. It is well to remember that Lord Diplock had in his judgment in the *Rodi* matter in the Court of Appeal approved the Upjohn LJ approach as reflected in Upjohn LJ’s judgment in *Van der Lely* in the Court of Appeal. Why then did Lord Diplock not follow the same approach in *Beecham*?

²⁰ Lord Pearce in *Rodi* at 387 lines 44 to 388 line 7.

²¹ Lord Pearce in *Rodi* at 387 lines 44 to 388 line 7.

[9] In *Beecham* Lord Diplock took into account a factor which had been disregarded in the Upjohn LJ approach in the Court of Appeal and in the House of Lords in both the *Van der Lely* and the *Rodi* cases. That is the question whether or not the variant, or in the *Beecham* case, the addition, was of any practical significance or whether it added any value. This is a factor that Lord Evershed MR, Lord Reid and Lord Pearce all took into account in considering whether or not the accused product in the *Van der Lely* case and the *Rodi* case had infringed the patented invention. Those Judges who had effectively adopted the Upjohn LJ approach had neglected to take this factor into account and had focused on the language of the claims in the specification. In *Beecham* Lord Diplock said:

“Both ampicillin and hetacillin are prepared in power form. They are administered to human beings either orally or by injection in aqueous solution. Hetacillin when administered to human beings was found to have therapeutic qualities as good as, and indeed identical with, those of ampicillin. And well it might, for the chemical reaction between ampicillin and acetone, which results in the formation of hetacillin, is a reversible reaction. In the presence of water (H₂O) hetacillin inevitably turns back almost entirely into acetone and ampicillin. This is what happens whenever it is used as an antibiotic either upon its being dissolved in water for the purpose of injection, or if taken orally, as soon as the hetacillin comes into contact with the moisture in the human stomach. *If this reverse reaction did not take place in the conditions in which the antibiotic is administered, hetacillin would have no therapeutic value at all.* So long as it maintains the molecular structure indicated above, it is not capable of destroying harmful bacteria in the human body. It is to the ampicillin to which hetacillin reverts on or before administration to a patient that the therapeutic effects of administering hetacillin are wholly due.”²²

[10] There is another feature of Lord Diplock’s speech in *Beecham* that is important. Its importance lies in the fact that it reveals the type of reasoning that Lord Reid had adopted in his dissent in *Rodi*. Before reference can be made to that feature it is important to remember that the Upjohn LJ approach to which Lord Diplock had subscribed in *Rodi* focussed on the language used by the patentee in the claims whereas Lord Reid’s approach went beyond the language and also considered what the practical significance of the difference introduced by the alleged infringer was.

[11] In *Beecham*’s case it was argued that what was claimed in the patents as an essential feature of the class of products was the presence of an amino group in the alpha

²² Lord Diplock in *Beecham* at 195 lines 22 to 196 line 3 (author’s emphasis).

position and that, since this feature was absent in the hetacillin, there was no infringement. In response to this argument Lord Diplock had this to say in *Beecham*:

“This is literally true at the time of importation and sale but it ceases to be true as soon as hetacillin is put to *use for the only* purpose for which it is intended. The substitution for the postulated amino group of the variant incorporated in hetacillin is evanescent and reversible and for all *practical purposes of use* can be regarded as the equivalent of the amino group in ampicillin. In the apt phrase used by the Court of Appeal, it is the reproduction of the substance ampicillin, albeit temporarily masked.”²³

[12] The statement in the above passage by Lord Diplock that it was true that the amino group was not present in the hetacillin whereas it was what was claimed in the patents in respect of the ampicillin but that this “ceased to be true as soon as hetacillin was put to use for the only purpose for which it [was] intended” resonates with the statement by Lord Reid in *Rodi* in respect of the difference introduced by the defendant in EXCALIBUR 59: There Lord Reid said of the difference introduced by the alleged infringer.

“Functionally this, in my opinion, makes no material difference. *It makes the bracelet slightly less flexible if one tries to bend it in a way which no-one would normally try to do.*”²⁴

It is also suggested that Lord Diplock’s statement in the passage quoted above that the substitution for the postulated amino group of the variant incorporated in hetacillin could for all practical purposes of use, be regarded as the equivalent of amino group in ampicillin was in effect a statement about the practical significance of the variant.

[13] It is suggested that at this stage Lord Diplock had realised that the Upjohn LJ approach was wrong and that the Lord Reid approach was the correct one but lacked the courage to say so. That is the only reasonable inference that can be drawn from his decision to use the Lord Reid approach in *Beecham* and not the Upjohn LJ approach. The soundness of this proposition is fortified by certain features of Lord Diplock’s speech in *Catnic* to which the discussion now turns.

²³ Lord Diplock in *Beecham* at 202 lines 14-23 (author’s emphasis).

²⁴ Lord Reid in *Rodi* at 377 line 42-44 (author’s emphasis).

9.6 Special Features of Lord Diplock's Speech in *Catnic*

[14] With regard to Lord Diplock's speech in *Catnic* it is important to highlight the fact that Lord Diplock did not in terms criticise any of the judgments that had adopted the Lord Reid approach. He did not criticise any of Lord Reid's dissents nor did he criticise Lord Evershed M.R.'s judgment or Lord Pearce's speech in *Rodi*. Not only that, but he also did not deal with any of the reasons upon which Lord Reid, Lord Pearce and Lord Evershed MR had based their conclusions in the *Van der Lely* and *Rodi* cases. It is also important to point out that he said nothing about Whitford J's judgment in *Catnic* despite the fact that in *Catnic* Whitford J adopted the Lord Reid approach without saying so in so many words. It is also noted that Lord Diplock did not in terms say that the doctrine of pith and marrow would no longer be used. However, what he said when he framed the question to be asked is what in effect sounded the death knell to the doctrine of pith and marrow in English patent law. That is because it was a different question from the question that used to be asked under the doctrine of pith and marrow.

[15] In *Van der Lely* and *Rodi* the Court of Appeal and the House of Lords had followed literalism in dealing with the construction of patent claims and the determination of non-textual infringement. In *Beecham's* case the House of Lords turned its back on literalism and the Upjohn LJ approach. In *Catnic* it continued with its rejection of literalism. At that time the recent cases in which literalism had been very prominently used were *Van der Lely* and *Rodi*. In its subsequent decision in *Kirin-Amgen* the House of Lords, through Lord Hoffman, made a statement which corroborates the proposition that in *Catnic* the House of Lords turned its back on literalism. Lord Hoffman wrote:

“If literalism stands in the way of construing patent claims so as to give fair protection to the patentee, there are two things that you can do. One is to adhere to literalism in construing the claims and evolve a doctrine which supplements the claims by extending protection to equivalents. That is what the Americans have done. The other is to abandon literalism. That is what the House of Lords did in the *Catnic* case, ...”²⁵

²⁵ Lord Hoffman in par 41 in *Kirin-Amgen*.

It is clear from what Lord Hoffman said in this passage that he was of the view that prior to *Catnic* the House of Lords had used literalism and literalism had stood in the way of construing patent claims so as to give fair protection to the patentee. The question that arises is: which cases were the ones in which the application of literalism prompted the House of Lords to abandon literalism and advocate the use of the *Catnic* test?

[16] Of course, of all the cases which may have come before the House of Lords on this issue over the period of about 100 years before *Catnic*, *Van der Lely* and *Rodi* emerge as the most probable cases in which literalism was applied and stood in the way of fair protection for the patentee. Accordingly, the House of Lords' own decisions in *Van der Lely* and *Rodi* as well as the decisions of the Court of Appeal in the same two cases must have been the ones which Lord Hoffman had in mind when he wrote the passage quoted above from the *Kirin-Amgen* case as the instances where literalism had stood in the way of fair protection for the patentee. That is why in *Beecham* and *Catnic* the House of Lords turned its back on the Upjohn LJ approach. It was too literalist and failed to provide fair protection for the patentee. The House of Lords said in *Kirin Amgen*²⁶ that article 69, which came after the *Catnic* case, firmly shut the door on any doctrine which extends protection outside the claims. It is suggested that the House of Lords overstated the position because humanly it is impossible to have a system where anyone can draw a claim or claims which cover literally all eventualities. There will always be eventualities which fall outside the literal terms of the claims but which, without any doubt, were intended to be covered and should, in all fairness, be covered by a particular claim.

[17] Cornish says that before the 1977 Patent Act of the UK there were two poles of thought. He says that one laid stress on the public duty of the patentee to define the scope of his monopoly while the other emphasised the danger of making it easy to avoid infringement by too meticulous an approach to the scope of the claim.²⁷ Cornish refers to an approach in terms of which, if in the defendant's chemical combination, for example, an integer was replaced by something that did not fall within the description, it would be taken as not infringing. Cornish says that in such a case there

²⁶ See *Kirin-Amgen* at par 44.

²⁷ Cornish *Intellectual Property: Patent Copyright, Trade Marks and Allied Rights* (1981) at 192.

would be no investigation to see whether the alterations made any functional difference. He says that this was the majority approach and in support thereof he refers to the judgment of Viscount Radcliffe in *Van der Lely*. That judgment found that there was no infringement at all in *Van der Lely* and did not investigate to see whether the alteration made any functional difference. Cornish's view supports the view expressed in many areas in this dissertation that the majority in both *Van der Lely* and *Rodi*, in both the Court of Appeal and the House of Lords, did not inquire into whether or not the variant made any practical difference or added any value to the invention. Cornish says that the approach of the minority entailed embarking precisely upon this type of enquiry. In this dissertation the view is expressed that the Upjohn LJ approach, which is the approach that was applied by the majority to which Cornish refers, focused on the literal meaning of words used in a claim and disregarded the question of whether the variant added any value or made any practical difference and that the dissenters went into this issue in their inquiry.

[18] The features of Lord Diplock's speech in *Catnic* which must be highlighted are the following:

- (a) In advocating the purposive construction of patents, Lord Diplock said that that was the approach to be used "rather than a *purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge*".²⁸ It is suggested that it could not have been a coincidence that Lord Diplock wrote with disapproval of an approach to construction that was a "purely literal one" and involved a "meticulous" verbal analysis when both Lord Reid and Lord Pearce in their dissents in *Rodi* had also written specifically against an approach to construction of patents that was literal or involved "meticulousness" associated with legal documents or conveyancing documents.
- (b) In his speech in *Catnic*, Lord Diplock highlighted the importance of inquiring into the materiality or otherwise of those features of the accused device or apparatus that made it appear different from the description in the

²⁸ Lord Diplock in *Catnic* at 243 lines 3-5 (author's emphasis).

relevant claim.²⁹ In some of the judgments using the Lord Reid approach the reference to this factor is reflected by a statement to the effect that the variant or difference had no practical significance or made no practical or material difference. In the judgments and speeches using the Upjohn LJ approach, this factor was not taken into account. The fact that in *Catnic* Lord Diplock gave this factor a prominent place or role also supports the proposition that Lord Diplock had realised that continuing with the Upjohn LJ approach as shown in the *Van der Lely* and *Rodi* decisions in both the Court of Appeal and the House of Lords was simply unsustainable in the long term and that the correct approach was the Lord Reid approach.

- (c) When he sought to apply the *Catnic* test to the facts of the case before him in *Catnic*, Lord Diplock formulated the question that had to be asked thus: “would the specification make it obvious to a builder familiar with ordinary building operations that the description of a lintel in the form of a weight-bearing box girder of which the back plate was referred to as ‘extending vertically’ from one of the two horizontal plates to join the other, could not have been intended to exclude lintels in which the back plate although not positioned at precisely 90° to both horizontal plates was close enough to 90° to make no material difference to the way the lintel worked when used in building operations?”³⁰ In seeking to answer this question, Lord Diplock inquired into whether or not there was any plausible reason why any rational patentee should have wanted to place so narrow a limitation on his invention that a slight variation would fall outside his monopoly. His answer was that: “No plausible reason has been advanced why any rational patentee”³¹ should have done so. In fact he said:

“On the contrary, to do so would render his monopoly for practical purposes worthless, since any imitator could avoid it and take all the benefit of the invention by the simple expedient of positioning the back plate a degree or two from the exact vertical”.³²

²⁹ Lord Diplock in *Catnic* at 243 lines 10 to 244 line 2.

³⁰ Lord Diplock in *Catnic* at 244 lines 6-13.

³¹ Lord Diplock in *Catnic* at 244 lines 13-14.

³² Lord Diplock in *Catnic* at 244 lines 13-18.

[19] An analysis of Lord Diplock’s speech reveals that the fact that there was no plausible reason why the patentee should have placed so narrow a limitation on his invention where the result would have been that an imitator could avoid the infringement of his patent by the expedient of making a slight variation which had no plausible reason and take all the benefit of the invention was an important reason for his conclusion that there was infringement in *Catnic*. The approach of inquiring into such a reason was part of the Lord Reid approach.³³ In *Van der Lely* Lord Reid said:

“The respondents have copied the appellant’s method of conversion of the machine to a swath turner with one difference. The appellant’s dismount the three hindmost wheels of the row of six and remount them separately in accordance with claim 11. The respondents’ do exactly the same except that they dismount and remount the three foremost wheels. *They cannot point to any mechanical reason for doing this or to any advantage resulting from it.* It is simply done to try and evade the claim, and the respondents’ method is the exact mechanical equivalent of the appellants’ method.”³⁴

Lord Reid’s reasoning or approach as revealed in this passage was “borrowed” by Lord Diplock in *Catnic* in the passage quoted a little earlier.

[20] After a discussion of Lord Diplock’s *Catnic* decision and Hoffman J’s decision in *Improver*, Leger concludes: “we are BACK TO COMMON SENSE”.³⁵ Leger also seems to suggest³⁶ that Lord Diplock’s *Catnic* decision does not depart from the “good sense” which he says was to be found in Lord Reid’s judgment in *Van der Lely*. Leger even refers to Lord Reid’s judgment in *Van der Lely* at page 75. This statement by Leger supports the proposition, made in this dissertation, that Lord Diplock took certain features of Lord Reid’s reasoning in *Van der Lely* and *Rodi* and used them in his *Catnic* decision. Leger, after discussing Muldoon JA’s judgment in *Gorse v Upwardor Corporation*,³⁷ states that the decision like the O’Hara decision demonstrated that the purposive construction doctrine did not necessarily permit a

³³ See Lord Reid in *Rodi* at 377 lines 35-p.378 line 53; See also Lloyd-Jacob in *Rodi* at 458 lines 3-13 at 456 lines 1-18.

³⁴ Lord Reid’s reasoning in *Van der Lely* at 75 lines 27-34 (author’s emphasis).

³⁵ Leger at 243.

³⁶ See Leger at 243 read with what he says at 231 about the *McPhar* case and Lord Reid’s speech in *Van der Lely*.

³⁷ (1989) 25 CPR (3rd) 479 (Fed CA).

patentee to unfairly expand the protection afforded by his patent.³⁸ After making this point, Leger states that in his opinion that was back to real common sense and, indeed, is not really a departure from the good sense cited above under which theory Lord Reid reiterated the doctrine of infringement in substance.

³⁸ Leger at 243.

CHAPTER 10

10 COMPARISON OF LORD DIPLOCK'S JUDGMENTS IN *BEECHAM* AND *CATNIC* TO LORD REID'S JUDGMENTS IN *VAN DER LELY* AND IN *RODI* AS WELL AS LORD PEARCE'S JUDGMENT IN *RODI*

[1] It is suggested that in *Beecham* the House of Lords was bound to use the Upjohn LJ approach to the determination of non-textual infringement and to the doctrine of pith and marrow. This was so because of its decisions in *Van der Lely* and *Rodi*. However, Lord Diplock turned his back on these two decisions of the House of Lords. It is suggested that a reading of his decision in *Beecham* reveals quite clearly that he did not apply the Upjohn LJ approach in that case. He applied the Lord Reid approach! This means that the House of Lords turned its back on its own decisions upholding the Upjohn LJ approach to the determination of infringement and the doctrine of pith and marrow. It applied the approach of the dissenters led by Lord Reid. What follows below provides clear proof of this.

10.1 The *Beecham* Case

- (a) In the *Beecham* case, Lord Diplock considered whether the variant added any value to the product or device. He found in *Beecham* that the hetacillin would have no therapeutic value at all if it did not revert into acetone and ampicillin in the presence of water.¹ The taking into account of this factor in the determination of non-textual infringement and in the approach to the doctrine of pith and marrow was part of the Lord Reid approach. In *Van der Lely* Lord Reid had concluded that the alleged infringer's decision to choose to dismount the foremost wheels as opposed to the hindmost wheels as dictated by the claim had no "practical significance".² In *Rodi*, Lord Reid said the same thing. He said that functionally the fact that in EXCALIBUR 59 one limb of the U was extended and joined to the corresponding limb of

¹ See Lord Diplock in *Rodi* at 195 line 28 to 196 line 3.

² See Lord Reid in *Van der Lely* at 76 lines 21-24.

the corresponding U at the other end of the sleeve, making a double link of the shape of an elongated letter C, did not make any material difference.³

- (b) When Lord Diplock responded in *Beecham* to the argument advanced on behalf of the alleged infringer that what was claimed in the patents as an essential feature of the class of products to which the ampicillin belonged was the presence of an amino group in the alpha position which feature, it was argued, was absent in the hetacillin, he said that, although this was “literally true at the time of importation and sale”, “it ceased to be true as soon as hetacillin is put to use for the only purpose for which it is intended”. He continued: “The substitution of hetacillin is evanescent and reversible and for all practical purposes of use can be regarded as the equivalent of the amino group in ampicillin. In the apt phrase used by the Court of Appeal, it is the reproduction of the substance ampicillin, albeit temporarily masked”.⁴ Lord Diplock’s reasoning in this passage to the effect that, while it was true that the amino group was not present in the alpha position in the hetacillin was literally true at the time of importation and sale, but ceased to be true as soon as hetacillin was put to use for the only purpose for which it was intended, is similar to the reasoning that was used by Lord Reid in *Rodi* when, dealing with the main difference relied upon by the alleged infringer to say that there was no infringement of the plaintiff’s patent, he said that functionally the fact that in EXCALIBUR 59 one limb of the U was extended and joined to the corresponding limb of the corresponding U at the other end of the sleeve, thus making a double link of the shape of an elongated C, in his opinion made no material difference because “it makes the bracelet slightly less flexible if one tries to bend it in a way which no one would normally try to do”.⁵

- (c) The Upjohn LJ approach which was applied by the Court of Appeal and the House of Lords in the cases of *Van der Lely* and *Rodi* – which included the participation of Lord Diplock – looked exclusively on the wording of the claim in determining whether or not a particular feature was an essential

³ See Lord Reid in *Rodi* at 377 lines 36 to 378 line 5.

⁴ See Lord Diplock in *Beecham* at 202 lines 14-23.

⁵ See Lord Reid in *Rodi* at 377 lines 36-45.

feature. It was a literalist approach of the worst order. However, a reading of Lord Diplock's judgment in *Beecham* reveals that he did not follow that approach. A reading of Lord Reid's judgments in *Van der Lely* and *Rodi* reveals that Lord Diplock substantially applied the Lord Reid approach in deciding whether or not there was infringement in *Beecham*.

10.2 The *Catnic* Case

- (a) With regard to the *Catnic* case, it is important to point out that in the Court of Appeal, Buckley LJ had taken the view that, although it was not in fact essential to the working of the invention that the back plate should be precisely vertical, the patentee had, nevertheless, by the language used in his specification made such precision an essential feature of the monopoly he claimed. It is suggested that this attitude to the language used in a specification, or in claims was probably the most significant characteristic of the Upjohn LJ approach used in *Van der Lely* and *Rodi* by the Court of Appeal and the House of Lords of which Lord Diplock had approved. In fact in his judgment in the Court of Appeal in *Rodi*, Diplock LJ specifically said that the principles of construction of claims in specifications were those laid down in Upjohn LJ's judgment in *Van der Lely* at [1961] RPC 296 at 312 which were approved by the House of Lords in *Van der Lely*.
- (b) In his speech in *Catnic* Lord Diplock placed the person skilled in the art to which the patented invention relates at the centre of the *Catnic* test or of the doctrine of purposive construction.⁶ He said that a patent specification is a unilateral statement by the patentee addressed to those likely to have a practical interest in the subject matter of his invention (ie skilled in the art). In *Rodi*, Lord Reid made it quite clear that "claims are addressed to practical men skilled in the prior art ...".⁷ It must be noted that in his speech in the House of Lords, Lord Pearce, one of the dissenters, said pertinently that it was important in construing a patent that one should seek to find

⁶ See Lord Diplock in *Catnic* at 242 lines 44 to 243 line 1.

⁷ See Lord Reid in *Rodi* at 378 lines 14-18.

what it means to the reasonable person who is reasonably versed in the matters of which it speaks – in that case mechanical.⁸

- (c) Lord Diplock said in *Catnic* that a patent specification should be given a purposive construction. The approach taken by Lord Reid in both *Van der Lely* and *Rodi* and the approach taken by Lord Pearce in *Rodi* was purpose-driven.

- (d) Lord Diplock spoke against the use of a “purely literal” approach to the construction of a patent specification. He spoke against an approach to interpretation that was “derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge”.⁹ In *Rodi*, Lord Pearce spoke against the same kind of approach to the construction of patent specifications. Among other epithets, he called it an alphabetical approach, an approach which produced in *Rodi* a construction to which he referred as a “meticulous construction” that Lord Pearce found unattractive.¹⁰ He thought that such an approach had “meticulous niceties” of construction which, though could be wholly appropriate for a legal document, “may seem to the practical man to have a flavour of pedantry if they so whittle away a patent that they enable a copyist to avoid its ambit by means that seem to be concerned with words rather than essentials”.¹¹ A little later after this Lord Pearce rejected one of the alleged infringer’s arguments as seeming to him to be “too strained and meticulous a construction of the claim.”¹² Before he completed his judgment, Lord Pearce once again said something against literal interpretations. He said:

“further, if one is going to be so literal and say that ‘inserted’ (alone among the various directions) refers to a method of assembly, one should presumably limit the claim to bows ‘inserted in pairs’, so that it would not cover operators who chose to insert them one at a time”.¹³

⁸ See Lord Pearce in *Rodi* at 387 line 44 to 388 line 1.

⁹ See Lord Diplock in *Catnic* at 243 lines 3-5.

¹⁰ See Lord Pearce in *Rodi* at 387 lines 18-37.

¹¹ See Lord Pearce in *Rodi* at 388 lines 2-7.

¹² See Lord Pearce in *Rodi* at 388 at lines 30-33.

¹³ See Lord Pearce in *Rodi* at 309 lines 20-24.

In his speech in *Rodi* Lord Pearce repeatedly and emphatically spoke against an approach to the construction of patent specifications that was, as he put it, alphabetical, that was a meticulous construction and that was literal.¹⁴ In *Rodi* Lord Reid also spoke against the approach to construction that has “meticulousness which was once thought appropriate for conveyancing documents”.¹⁵

- (e) Lord Reid said in *Rodi* that a patent specification is not addressed to conveyancers.¹⁶ Conveyancers are lawyers. In *Catnic* Lord Diplock effectively disapproved of an approach to construction that is derived from applying to it the kind of meticulous verbal analysis in which lawyers were too often tempted to indulge.¹⁷

- (c) Lord Diplock made it quite clear in *Catnic* that the question which he formulated as the test for determining the essentiality of an integer did not arise where the variant would have a material effect on the way the invention worked.¹⁸ That statement is derived from the rule of patent law that no one who borrows the substance of a patented invention may escape the consequences of infringement by making immaterial variations. What the rule meant was that, if a variation was material, there would be no infringement but, if the variation was immaterial, there would be infringement. This is the rule of patent law on immaterial variations which in *Van der Lely*'s case was ignored from the court of first instance to the House of Lords, with the consequences which flowed from the adoption of the Upjohn LJ approach. That rule was applied by Lord Reid in *Van der Lely* even though he may not have referred to it in terms. Lord Pearce specifically referred to that rule in his dissent in *Rodi*.¹⁹ So, Lord Diplock effectively incorporated this rule into his judgment in *Catnic*. In his judgment in the Chancery Division in *Rodi* Lloyd-Jacob J referred to this rule of patent law and applied it to the case before him. In doing so he

¹⁴ See Lord Pearce in *Rodi* at 388 and 389.

¹⁵ See Lord Reid in *Rodi* at 378 lines 15-18.

¹⁶ See Lord Reid in *Rodi* at 378 line 15.

¹⁷ See Lord Diplock in *Catnic* at 243 lines 3-6.

¹⁸ See Lord Diplock in *Catnic* at 243 lines 12- 15.

¹⁹ See Lord Pearce in *Rodi* at 388 lines 10-12.

turned his back on the Upjohn LJ approach and in defiance of the Court of Appeal's decision in *Van der Lely* and *Rodi* as well as the decision of the House of Lords in *Van der Lely*. In this regard it is significant that in his judgment in the Court of Appeal in *Rodi* Diplock LJ did not refer to this rule.

- (h) In *Catnic* Lord Diplock laid much stress on what would be obvious or not obvious to the informed reader of the specification or to the notional addressee.²⁰ In dealing with the question of how to determine the essentiality of a feature of an invention in *Van der Lely*, Lord Reid had drawn attention to the fact that there was no unanimity on how this should be done. He pointed out that some said it was a question of construction whereas others said one should have regard to all the facts of the case. He then said:

“I doubt if there is much difference between these two points of view. If the specification makes it clear that the patentee regards a particular integer as essential, then it must be treated as essential but otherwise even if the question is one of the construction of the specification, I cannot see why one should shut one's eyes to facts of which the patentee must have been aware when framing the specification.”²¹

It is suggested that when, in *Catnic*, Lord Diplock referred to what would be obvious to the notional addressee, the purpose was to determine what the patentee must have been aware of at the time of framing his specification or at the time of the publication of his patent. The reasoning was that, if a man skilled in the art would have been aware of certain facts at the time when the specification was published or framed, the patentee must also have been aware of those facts at the time. Furthermore, Lord Reid also said in *Van der Lely* that “you cannot avoid infringement by substituting an obvious equivalent for an unessential integer”. He added: “I cannot imagine any more obvious equivalent than substituting the foremost for the hindmost wheels in this machine”.²² It is conceded that in his judgment in *Rodi* in the House of Lords Upjohn LJ did say that whether a claim has been infringed

²⁰ See Lord Diplock in *Catnic* at 242 lines 12 to 244 line 18.

²¹ See Lord Reid in *Van der Lely* at 76 lines 28-33.

²² See Lord Reid in *Van der Lely* at 76 lines 1-13.

or not was a question of construction and that a claim “must be read through the eyes of the notional addressee, the man who is going to carry out the invention described”.²³

- (h) In *Catnic* one of the important bases for Lord Diplock’s conclusion that there was infringement of the relevant claim despite the fact that the allegedly infringing device or machine did not fall within the literal terms of the relevant claim was that he inquired into whether there was any reason why the patentee would have limited his monopoly in the manner suggested by the alleged infringer. In *Catnic* Lord Diplock said:

“No plausible reason has been advanced why any rational patentee should want to place so narrow a limitation on his invention. On the contrary to do so would render his monopoly for practical purposes worthless, since any imitator could avoid it and take all the benefit of the invention by the simple expedient of positioning the back plate a degree or two from the vertical.”²⁴

This was the kind of reasoning that had been adopted by Lord Reid in both *Van der Lely* and *Rodi* in determining whether or not there was infringement. Lord Reid said in *Van der Lely*:

“The respondents have copied the appellants’ method of conversion of the machine to a swath turner with one difference. The appellants dismount the three hindmost wheels of the row of six and remount them separately in accordance with claim 11. The respondents do exactly the same except that they dismount and remount the three foremost wheels. They cannot point to any reason for doing this or to any advantage resulting from it. It is simply done to try to evade the claim and the respondents’ method is the exact mechanical equivalent of the appellants’ method.”²⁵

In *Van der Lely* and *Rodi* the judges who dealt with those cases at the different levels and who adopted the Upjohn LJ approach and therefore, found that there was no infringement in each one of the cases did not extend the inquiry into the question as to why the alleged infringer had chosen to introduce the difference upon which he relied to contend that there was no infringement. However the Lord Reid approach in both *Van der Lely* and

²³ See Lord Upjohn in *Rodi* in the House of Lords at 391 lines 5-6.

²⁴ See Lord Diplock in *Catnic* at 244 lines 13-18.

²⁵ See Lord Reid in *Van der Lely* at 75 lines 27-34; see also Lord Reid in *Rodi* at 378 lines 6-11.

Rodi entailed asking this question before finally determining whether or not there was infringement.

[2] As already stated above, the approach adopted by both the Court of Appeal and the House of Lords in both the *Van der Lely* case and in the *Rodi* case was one which focussed exclusively on the language of the claims in the specification whereas Lord Reid's approach looked at not only the language of the claim and the objective materiality of the feature that had been omitted, varied or added but also in effect applied the rule of patent law on immaterial variations of patented inventions. In *Beecham's* case, which came after both the *Van der Lely* and the *Rodi* decisions of both the Court of Appeal and the House of Lords, Lord Diplock, who wrote for a unanimous House of Lords, took the materiality factor into account and effectively followed the same approach as that which had been followed by Lord Reid in his dissent in *Van der Lely* and *Rodi*. The question which arises is: why did Lord Diplock in the *Beecham* matter not follow the same approach that had been followed by the Court of Appeal and the House of Lords in the *Van der Lely* case and in the *Rodi* case? Why did he choose to in effect follow the approach that had been adopted by Lord Reid in his dissents in the two matters? Furthermore, why did he not continue to use the same approach when he wrote his *Catnic* speech?

[3] It is suggested that the reason is that Lord Diplock must have realised that the Upjohn LJ approach was wrong and produced unjust results. This must particularly be so when regard is had to the fact that in certain respects he relied upon some aspects of Lord Reid's reasoning in the latter's dissents in *Van der Lely* and in *Rodi*. In fact, when one reads Lord Diplock's speech in *Catnic* carefully and reads Lord Reid's dissents in the two cases and Lord Diplock's speech in *Beecham*, one is driven to conclude that Lord Diplock should have acknowledged the soundness of Lord Reid's approach as revealed in his dissents. Lord Reid's dissents reveal that the decisions of the majorities in *Van der Lely* and in *Rodi* were simply untenable and it was the untenability of the approach reflected in those decisions which had ignored the materiality of the variant and the well-known rule of patent law referred to above which drove Lord Diplock to introduce the *Catnic* test in *Catnic*. However, it is suggested that the untenability of the approach of the Court of Appeal and the House of Lords in *Van der Lely* and in *Rodi* should rather have driven Lord Diplock to

acknowledge and embrace Lord Reid's approach in its entirety and he should have proceeded to apply the doctrine of pith and marrow – the Lord Reid way – and should not have replaced it with the *Catnic* test.

[4] Pendleton says that in both the *Van der Lely* and *Rodi* cases which split the House of Lords and, in the case of the *Van der Lely* matter, the Court of Appeal as well, the intention of the patentee to claim a feature as an essential integer of the invention was held by the majority to be the test for determining whether an infringement had occurred. He says that for infringement to exist there had to be copying of each and every such integer. He then says that this was the traditional formulation of the pith and marrow doctrine. He emphasised that such intention on the part of a patentee was to be imputed wherever a feature was included in a claim in clear language deliberately chosen. He says that the essentiality of the feature in relation to the working of invention as a whole was not considered as an aid in determining the patentee's intention.²⁶ Pendleton's statement that the approach adopted by the majority in both *Van der Lely* and *Rodi* in the House of Lords and the Court of Appeal in both cases did not include the consideration of the essentiality of the feature in relation to the working of the invention as a whole was not considered as an aid in determining the patentees' intention supports the same point made in this dissertation.²⁷

[5] Pendleton has submitted that the minority views in *Van der Lely*, *Rodi* and *Catnic* in the Court of Appeal were subsequently adopted and taken further by Lord Diplock in *Catnic*. However, Pendleton fails to advance any reasons for this proposition.²⁸ It is suggested that Pendleton's submission in this regard supports the contention made in this dissertation that Lord Diplock, who had previously gone along with the Upjohn LJ approach, changed his mind after the decision of the House of Lords in *Rodi* and Lloyd Jacob J's judgment in *Rodi* and adopted the dissenters' approach, particularly Lord Reid's reasoning in *Van der Lely* and *Rodi* which is evident in Lord Diplock speeches in *Beecham* and *Catnic*.

²⁶ Pendleton Michael "Construe Widely and Face Invalidity/Construe Narrowly and Miss Infringement: The Dilemma of Interpreting Patent Specifications" (Sept 2004) 11/3 *Murdoch University Electronic Journal of Law* at par 11.

²⁷ Pendleton at par 11.

²⁸ Pendleton at par 13.

- [6] Pendleton also refers to the passage in Lord Reid’s judgment in *Van der Lely* commencing with the words “Upjohn LJ said that the appellants have deliberately chosen ...” and ending with the sentence: “I think that the principle is very necessary to prevent sharp practice”. Pendleton then submits that in that passage Lord Reid implied that, if a patentee did not appreciate that he was creating a functionally unnecessary limitation, provided always that the claims will not be construed to comprehend variants having a material effect upon the way the invention works, the court should not hold the patentee to the oversight. Pendleton submits that this test was explicitly adopted by Lord Diplock for this type of situation.²⁹
- [7] Pendleton has also submitted that it is implicit in Lord Diplock’s analysis of the decision in *Van der Lely* that the court should have had regard in its judgment to expert evidence on whether or not the defendants’ machine’s utilising dismountable foremost wheels could have a material effect upon the way the patented hay raking machine worked.³⁰ It is suggested that this submission by Pendleton accords with the contention advanced in this dissertation that the majority in *Van der Lely* should have considered whether the dismounting of the foremost wheels instead of the hindmost wheels as stipulated in the claim had any material effect or added any value to the functioning of the machine which is what the minority did. Had the majority done the same in this regard, they would have reached the same conclusion as the one reached by the minority. Pendleton’s submission in this regard also further supports the contention advanced in this dissertation that Lord Diplock borrowed Lord Reid’s approach and reasoning.
- [8] Pendleton has also said, in the context of a discussion of “The true status of *Catnic* and purposive construction in Australia” that one of two difficulties which he identifies with regard to the “apparent acceptance” of *Catnic* in Australian law is that Lord Diplock appears to endorse the minority judgments of Lord Reid in *Van der Lely NV v Bamfords Ltd* and those of Lord Pearce in *Rodi and Wienenberg, AG Henry v Showell Ltd (Rodi)* rather than the majority judgments (authored by Lord Upjohn in *Van der Lely*) “yet it is these majority judgments which have enjoyed predominant

²⁹ Pendleton at par 15-16.

³⁰ Pendleton at par 23.

support in Australia and it should be said in England before *Catnic*".³¹ Pendleton suggests that under a true purposive construction the essentiality of the feature is decided by reference to the importance or otherwise of the function of the feature in the invention as a whole.³² If this is true, it would lend further support to the proposition made in this dissertation that Lord Reid's approach in *Van der Lely* and in *Rodi* was purpose driven.

[9] After a brief discussion of the cases of *Van der Lely*, *Rodi* and *Beecham* as decided by the House of Lords, Cornish and Llewellyn express the view³³ that, if the attitude taken by the House of Lords in *Beecham* (after the attitude it had taken in *Van der Lely* and *Rodi*) suggested that some liberalisation over the attitude of the 1960s was beginning, this was confirmed by subsequent events. In support of this statement these authors then say that in the *Catnic* case the House of Lords, speaking through Lord Diplock, shifted emphasis in the construction of patent claims. The authors continue and say that, while it was true that Lord Diplock's speech first insisted that interpretation was the sole issue, and that there was no separate question of non-textual infringement, he equally underscored the importance of "purposive" rather than a "purely" literal construction. These authors also draw attention to the fact that in his speech Lord Diplock also disapproved of the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge and preferred the understanding of persons with practical knowledge and experience of the kind of work in which the invention was intended to be used. Very interestingly, and, in line with what has been said in this dissertation, these authors draw attention to the fact that in their speeches in *Rodi*, both Lord Reid and Lord Pearce disapproved of undue meticulousness.³⁴

[10] The statement by Cornish and Llewellyn that, if the House of Lords' decision in *Beecham* suggested a liberalisation over the attitude of the 1960s, which is in effect the House of Lords' attitude as reflected in the *Van der Lely* and *Rodi* cases, this was confirmed by the *Catnic* decision lends further credence to the proposition made elsewhere in this dissertation that, after the House of Lords' decision in *Rodi*, the

³¹ Pendleton at par 39.

³² Pendleton at par 534.

³³ Cornish and Llewellyn at 238.

³⁴ Cornish and Llewellyn at 238.

House of Lords must have realised that the Upjohn LJ approach had been a mistake and *Beecham* became the first case in which the House of Lords turned its back on the Upjohn LJ approach and effectively adopted the Lord Reid approach. The fact that these authors draw attention to the fact that Lord Diplock was not alone in disapproving of undue meticulousness in the construction of patent claims in *Catnic* and that both Lord Reid and Lord Pearce had also disapproved of undue meticulousness in their respective judgments in the *Rodi* may be an indication that they, too, see a connection between, on the one hand, Lord Diplock's rejection of a meticulous and "pure literal" approach to the construction of patent claims and, on the other, Lord Reid's reasoning in the *Van der Lely* and *Rodi* cases just as it has been contended elsewhere in this dissertation that Lord Diplock's approach in *Beecham* was a rejection of the Upjohn LJ approach and the adoption of the Lord Reid approach. Lord Diplock was effectively borrowing the approach of the dissenters but, unfortunately, he did not give them the credit that they deserved, particularly Lord Reid whose reasoning he largely adopted in *Beecham* and in *Catnic*.

10.3 Common Features Between the Lord Reid Approach and Lord Diplock's Speeches in *Beecham* and *Catnic*

- [11] In *Catnic* Lord Diplock specifically addressed the question of the materiality or non-materiality of an integer of an invention in the determination of whether or not non-textual infringement had been shown.³⁵ That he did so and did so specifically is remarkable because in the majority judgments in *Van der Lely* in the Court of Appeal and in the House of Lords as well as in the *Rodi* matter in the Court of Appeal and in the House of Lords the materiality of the integer omitted or varied or added was not taken into account and, it is suggested, with the resultant injustices that those judgments produced. It was Lord Evershed MR in *Van der Lely* as well as Lord Reid in the House of Lords in *Van der Lely* and Lord Reid and Lord Pearce in *Rodi* who took the issue of the materiality of the omitted integer or the variant into account in the determination of non-textual infringement. The Upjohn LJ approach simply focused on the language of the claim. It is suggested that the general approach that Lord Reid seems to have followed was that if the variant or omitted integer or added

³⁵ Lord Diplock in *Catnic* at 243 lines 12-24.

feature had no material effect on the functioning of the invention, one then invoked the rule of patent law on immaterial variations and, once that rule was invoked, a finding of infringement was almost inevitable. It is accepted that Lord Reid did not anywhere in his speech in *Van der Lely* and in *Rodi* refer in express terms to the rule on immaterial variations but it is suggested that in effect he applied the rule in his approach to the doctrine of pith and marrow without mentioning it.

CHAPTER 11

11 FIVE JUDGES WHO PLAYED SPECIAL ROLES IN THE EVOLUTION OF THE ENGLISH PATENT LAW JURISPRUDENCE FROM *VAN DER LELY* TO *CATNIC*

- [1] The Upjohn LJ approach began with Lloyd-Jacob J's judgment in the Chancery Division in *Van der Lely* and was taken further by Upjohn LJ and Pearson LJ in the Court of Appeal in the same matter. In due course it was approved by the House of Lords in the same matter. The Lord Reid approach began with Lord Evershed MR's judgment in the Court of Appeal in *Van der Lely* and was taken further by Lord Reid in the House of Lords in the same case. When the *Rodi* case came before Lloyd-Jacob J in the Chancery Division after both the Court of Appeal and the House of Lords had approved the Upjohn LJ approach, Lloyd-Jacob J turned his back on the Upjohn LJ approach and applied the Lord Reid approach in deciding the issue of infringement. It is significant to observe in this regard that Lloyd-Jacob J would have read the decisions of the Court of Appeal and the House of Lords in *Van der Lely* as well as the dissenting judgments of Lord Evershed MR and Lord Reid in *Van der Lely*. When then the *Rodi* matter came before him and he applied the Lord Reid approach in determining infringement, Lloyd-Jacob J in effect went against both the Court of Appeal and the House of Lords which had decided that the correct approach to apply was the Upjohn LJ approach.
- [2] When the *Rodi* matter reached the Court of Appeal, that court still applied the Upjohn LJ approach in determining the issue of infringement. When the matter reached the House of Lords, although the majority applied the Upjohn LJ approach, not only did Lord Reid stick to the Lord Reid approach but also the number of the proponents of the Lord Reid approach increased because Lord Pearce joined Lord Reid in applying the Lord Reid approach. So, whereas during the journey of the *Van der Lely* matter from the Chancery Division to the House of Lords only two out of nine judges who dealt with the matter applied the Lord Reid approach with all the other seven applying the Upjohn LJ approach, by the end of the journey of the *Rodi* matter from the Chancery Division to the House of Lords, the number of judges who had applied the Lord Reid approach increased from two to four. This was after Lloyd-Jacob J had left the Upjohn LJ camp and joined the Lord Reid camp. The four were Lloyd-Jacob J,

Lord Evershed MR, Lord Reid and Lord Pearce. In *Rodi* the House of Lords was split 3:2. The majority continued to apply the Upjohn LJ approach while Lord Reid and Lord Pearce dissented and applied the Lord Reid approach. The dissents which were produced by the dissenters were very powerful dissents. When, subsequently, the House of Lords dealt with the *Beecham* matter, it unanimously turned its back on the Upjohn LJ approach and adopted the dissenters' approach, the Lord Reid approach.

- [3] The roles played by five judges in this entire episode must be highlighted. The five judges were Lloyd-Jacob J, Lord Evershed MR, Lord Reid and Lord Pearce, Lord Upjohn and Lord Diplock. Lloyd-Jacob J's role in this episode was a very strange and yet interesting one. He was the one who began the Upjohn LJ approach when he gave the judgment that he gave in the Chancery Division in *Van der Lely*. The approach he adopted in determining non-textual infringement was later approved and adopted by the Court of Appeal on appeal in the form of a joint judgment of Upjohn and Pearson LLJ and later by the House of Lords in a further appeal. However, he was the first one to abandon the Upjohn LJ approach after he had read Lord Evershed MR's dissent and Lord Reid's dissent in *Van der Lely*.
- [4] Lord Evershed MR was the first judge among the judges who got involved in the four important cases discussed herein starting with *Van der Lely* and ending with *Catnic* who dissented from the Upjohn LJ approach and adopted the approach to the determination of non-textual infringement and the doctrine of pith and marrow referred to herein as the Lord Reid approach. Lord Reid was the first Law Lord in the House of Lords to dissent from the judgments propounding the Upjohn LJ approach. He took the same approach as had been taken by Lord Evershed MR in the Court of Appeal in the *Van der Lely* matter. When he got a second chance in *Rodi* to change his mind about opposing the Upjohn LJ approach, he not only did not change his mind but, instead, he persisted in the approach he believed was right and gained another Law Lord in the House of Lords to his side in this debate, namely, Lord Pearce. Lord Pearce was the second Law Lord in the House of Lords to go against the Upjohn LJ approach and to support in effect the Lord Reid approach.
- [5] Upjohn and Pearson LLJ were the judges who strengthened the Upjohn LJ approach in general. Upjohn LJ initially did so in the Court of Appeal but, later, he also did so

in the House of Lords when he was promoted to the House of Lords. Lastly, Lord Diplock played a very interesting role in this entire saga. First, he sat in the *Rodi* appeal in the Court of Appeal and specifically expressed agreement with the Upjohn LJ approach that had been taken by Upjohn and Pearson LLJ in their judgment in the Court of Appeal in *Van der Lely* but Lord Diplock later completely changed his mind and turned his back on the Upjohn LJ approach and, for all intents and purposes adopted the Lord Reid approach in *Beecham*.

- [6] In *Catnic*, Lord Diplock used in his judgment a very significant part of the reasoning previously employed by both Lord Reid and Lord Pearce. It is a pity that Lord Diplock does not seem to have seen the need to give Lords Reid and Pearce some credit in his judgments because an analysis of all the relevant judgments reveals that Lord Reid's dissents influenced, in a very significant way, Lord Diplock's decision to abandon the Upjohn LJ approach and adopt the approach he adopted in *Beecham* and *Catnic*. That Lord Reid's reasoning in *Van der Lely* and *Rodi* and Lord Pearce's reasoning in *Rodi*, influenced Lord Diplock's approach very significantly in *Beecham* and *Catnic* is shown by a comparison of his judgments in *Beecham* and *Catnic* to the judgments of Lord Reid in *Van der Lely* and *Rodi* and Lord Pearce's judgment in *Rodi* which is to be found elsewhere in this dissertation.

CHAPTER 12

12 SPECIAL QUESTIONS ON CATNIC

12.1 Is the *Catnic* Test for Determining the Essential Features of a Patent?

[1] Burrell¹ has pointed out that it has been said that the decision of the Appellate Division in *Multotec Manufacturing (Pty) Ltd v Screenex Wire Weaving Manufacturer (Pty) Ltd*² was not an indication that in SA the doctrine of pith and marrow had been replaced by the doctrine of purposive construction, but it revealed that the approach of the Appellate Division was in fact to “embellish” the doctrine of pith and marrow by using the doctrine of purposive construction as a means of determining which features are essential and which ones are not. In this regard Burrell is referring to JR Steyn’s view.³ It is suggested that within the context of the South African patent law, Steyn’s view may well be supported by the fact that in South Africa the position is that the Supreme Court of Appeal continues – well after the *Multotec* case, to use the principles of patent construction which had been used prior to the *Multotec* decision. These principles are those set out in the *Gentiruco*⁴ judgment of the Appellate Division. This practice in South Africa must be contrasted with what happened in English law after the *Catnic* decision. In English law, soon after the *Catnic* decision, the Court of Appeal said in the *Improver* case that it would no longer be necessary to refer to pre-*Catnic* case law.

[2] Burrell has expressed the view that, while the determination of essential and non-essential features of an invention has always been part of the doctrine of pith and marrow, the rule of purposive construction dispenses with the need to distinguish between essential and non-essential integers of a claim as a step preparatory to the application or non-application of the doctrine of pith and marrow.⁵ In South Africa there was a whole debate between the Appellate Division and Burrell about this proposition. The Appellate Division took the view that purposive construction helped to determine the essentiality of features of an invention whereas Burrell took the view that purposive

¹ Burrell TD *South African Patent Law Practice* (1986) (2nd ed) at 251.

² 1982 B P 421 (A).

³ See Steyn JR “*Multotec Manufacturing (Pty) Ltd v Screenex Wire Weaving Manufacturers (Pty) (Ltd) – Pith and Marrow’s Embellished By Catnic*” (1983) 1 *European Intellectual Property Review* 14.

⁴ *Gentiruco AG v Firestone SA (Pty) Ltd* 1971 BP 58 (A).

⁵ Burrell *South African Patent Law and Practice* (1986) (2nd ed) at 251.

construction dispensed with the need to distinguish between essential and non-essential features.⁶ It is suggested that the Appellate Division's view is the correct one of the two views in the debate. Support for this is to be found in Lord Diplock's speech in *Catnic* itself. In the oft-quoted passage in *Catnic* starting with "My Lords..." Lord Diplock articulated the question to be asked in each case. That question expressly inquires into whether a person with practical knowledge and experience in the relevant field "would understand that strict compliance with the particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention with the result that any variant would fall outside the monopoly claimed ...".⁷ It is suggested that Burrell was in error in this regard.

12.2 Did *Catnic* Bring About Any Change in the Law?

[3] Since the delivery of the decision of the House of Lords in *Catnic* in November 1980, there have been many debates in many parts of the world about whether or not *Catnic* brought about any changes in the law and, if it did, what changes it brought about and in particular whether it rejected the doctrine of pith and marrow. In this regard it is to be noted that the Supreme Court of South Africa has expressed the view that *Catnic* did not bring about any changes in the law.⁸ The Supreme Court of Canada also takes the same view. Mr Justice Binnie, writing for an unanimous Supreme Court of Canada, went to the extent of saying that *Catnic* was simply old wine in a new bottle.⁹ Unfortunately, neither the Supreme Court of Appeal of South Africa nor the Supreme Court of Canada gave any reasons for their view in this regard. Despite the high status of these two Courts, the view they have expressed in this regard does not appear to be the result of any serious analysis of the *Catnic* decision of the House of Lords and the English patent law jurisprudence relating to the law of infringement of patents immediately before the *Catnic* decision was delivered.

[4] It is suggested that the *Catnic* decision did bring about changes in the law relating to the construction and infringement of patent claims. To conclude whether *Catnic* brought

⁶ See Visser C "The Interpretation of Patent Claims: A Chronology of the Vicissitudes of the 'Pith and Marrow' doctrine and the doctrine of Purposive Construction in the Appellate Division in Khan E (ed) *The Quest for Justice* (1995) at 328, particularly from 334 *et seq.*

⁷ Lord Diplock in *Catnic* at 242 line 44 to 243 line 11.

⁸ See *Vari-Deals 101 (Pty) Ltd t/a Vari-Deals v Sunsmart Products (Pty) Ltd* 2008 (3) SA 447 (SCA) par 11.

⁹ *Whirlpool v Camco* [2002] 2 SCR 1067.

about changes or not, it might not be enough to analyse the *Catnic* decision only. It is suggested that the *Clark v Adie* decision, the *Marconi* decision, the *Birmingham* decision, the judgments of all the Courts at different levels in *Van der Lely*, *Rodi* and *Beecham* which preceded *Catnic* and, of course, the *Catnic* decision itself should all be considered and analysed carefully first. This is what has been done in this dissertation and the conclusion is that the *Catnic* decision of the House of Lords did bring about changes in the law. Support for this is to be found below:

- 4.1 First, it would appear that, prior to *Catnic* the question of whether infringement was a question of construction or of fact was the subject of conflicting opinions according to Lord Reid in *Van der Lely*. *Adie* had said that whether a device had taken the substance of a patented invention was a question of fact. *Catnic* decisively said that infringement was a question of construction.
- 4.2 Secondly, under the doctrine of pith and marrow which definitely applied prior to *Catnic*, the question to be asked was different from the question which *Catnic* decreed should be asked. Under the doctrine of pith and marrow the question was whether or not the allegedly infringing device or apparatus had taken the substance of the patented invention.¹⁰ Under *Catnic* the question is whether or not persons with practical knowledge and experience in the art in which the product or process is to be used would understand that the patentee had intended that strict compliance with the descriptive word or phrase in a claim be an essential requirement so that any variant fell outside his monopoly even if such variant would have no material effect on the working of the invention.
- 4.3 Thirdly, although both under the doctrine of pith and marrow and the *Catnic* test, there would be no infringement if the variant had a material effect on the functioning of the invention, under the doctrine of pith and marrow, once the variant was found not to have a material effect on the functioning of the

¹⁰ Blanco-White expresses the view that prior to *Catnic* the question to be asked in order to determine infringement was: "Are the essential integers of the claim present?" (Blanco-White (1974) (4th ed) at 87). It is suggested that Blanco-White's formulation is so wide as to be unhelpful.

invention, the general rule was that there was infringement whereas under *Catnic* this does not appear to be the case. Under the doctrine of pith and marrow this was the case because of the patent law rule on immaterial variations. Under *Catnic* where the variant has no material effect upon the functioning of the invention, the rule of patent law on immaterial variations is not invoked. In fact it was not referred to in *Catnic* nor was it referred to in the important cases that came out soon after *Catnic* such as *Codex*,¹¹ *Improver* and *Kirin-Amgen*. The rule seems to have effectively been abolished by *Catnic*. Under *Catnic*, once it is found that the variant has no material effect upon the functioning of the invention, the question is asked whether or not the patentee has not by the way he has framed his claims made the missing integer an essential integer of his invention (notwithstanding the fact that objectively it is an immaterial integer). If it is found that the patentee has done so by the language he has used in his claims, that is the end of the inquiry because, in such a case, the accused device or apparatus lacks an essential feature of the patentee's invention and, therefore, there is no infringement. This is said here despite the fact that in *Catnic* Lord Diplock did seem to lean towards finding no infringement where he could not see why the patentee would have limited his monopoly in an unnecessary manner.

- 4.4 Under the doctrine of pith and marrow it was the Court or tribunal dealing with a complaint of patent infringement which made up its mind whether or not the alleged infringer had taken the substance of the patented invention. In *Clark v Adie* it was said that this was for the jury dealing with the facts of the case to decide. Under *Catnic* whether a particular integer is or is not an essential integer of the patentee's invention is not decided according to the value judgment of the Court but the Court defers to the judgment of the notional addressee who must give his understanding of whether the patentee intended that strict compliance with a descriptive word or phrase in a claim be an essential requirement. If the notional addressee says that his understanding is that that is what the patentee intended, then the integer is treated as an essential integer and there is no infringement. If, however, the notional

¹¹ *Codex Corp v Recal-Milo Ltd* 1983 RPC 369 (CA).

addressee says that that is not what the patentee intended, then such integer is not treated as an essential integer and there is infringement.

4.5 It is difficult to understand the proposition that *Catnic* did not change the law when even the House of Lords said in *Kirin-Amgen* subsequently that what the House of Lords did in *Catnic* was “abandon literalism”.¹² There Lord Hoffmann said in part: “If literalism stands in the way of construing patent claims so as to give fair protection to the patentee, there are two things you can do. One is to adhere to literalism in construing the claims and evolve a doctrine which supplements the claims by extending protection to equivalents. That is what the Americans have done. The other is to abandon literalism. That is what the House of Lords did in the *Catnic* case” *Hitchman and MacOdrum*¹³ seem to agree that *Catnic* did bring about some change in the law. They say that the *Catnic* decision appears to have been a watershed decision which moved the law from the two fold test of literal infringement and infringement in substance to an analysis of the claims given the purpose of the invention. Fox says that the English Courts have accepted that the strict literalism of the past and the limited application of the doctrine of pith and marrow have been superseded by a “purposive” approach to claim construction where the scope of protection extends beyond its literal meaning to encompass variants of a claimed invention.¹⁴

[5] It is suggested that the changes which *Catnic* brought about as pointed out above support the proposition that *Catnic* did sound the death knell to the doctrine of pith and marrow in English patent law. May LJ’s remarks in the Court of Appeal in *Codex* to the effect that from thenceforth it would be unnecessary to refer to the pre-*Catnic* authorities seems to also support this. The fact that in the important cases on the infringement of patents that came after *Catnic* in English patent law no reference was made to the doctrine of pith and marrow also supports this proposition. The absence of any reference in subsequent English case law to the patent law rule on immaterial

¹² See Lord Hoffmann in *Kirin-Amgen* at par 41.

¹³ *Hitchman and MacOdrum* at 178.

¹⁴ Fox Nicholas “Divided by a Common Language: A Comparison of Patent Claim Interpretation in the English and American Courts” (2004) *EIPR* 528 at 530.

variations which was an important part of the doctrine of pith and marrow, also supports this proposition.

[6] The doctrine of pith and marrow had been used for over 100 years. Accordingly, if there was to be a departure from a principle that had been followed by the English courts for such a long time, this should have been said in clear and unambiguous terms and the reasons for the departure should have been given. This was not done in any express terms in *Catnic*. Some may take this as providing support for the proposition that *Catnic* did not reject or abandon or replace the doctrine of pith and marrow. It is suggested that, when all relevant factors are taken into account, there can be no doubt that it did. What has been said above shows that *Catnic* replaced the doctrine of pith and marrow. Leger views the *Catnic* test or the doctrine of purposive construction introduced into Canadian patent law by the O’Hara decision as a new doctrine which is different from the doctrine of infringement by the taking of the substance of an invention and, he says that the doctrine of purposive construction relates to the meaning of claims and whether or not the infringing article is within the claims.¹⁵ This suggests that Leger also takes the view that, after *Catnic*, the law was no longer the same as before on the construction of patents and the determination of patent infringement. Leger¹⁶ says purposive construction may be said to be the prevailing mode of considering the issue of patent infringement in substance in Canada today. In response to this, attention should be drawn to the judgments of the Supreme Court of Canada in *Whirlwind* and *Free World* which are to the effect that Lord Diplock’s judgment in *Catnic*, which introduced purposive construction, was nothing new.

[7] Brian C Reid has pointed out that in *Catnic* Lord Diplock did not “dissent” from the enunciation as to law contained in *Van der Lely*, *Rodi* and *Beecham*. Reid then says:

“The question may reasonably be asked – if Lord Upjohn’s enunciation was already correct and comprehensive, then why was it necessary for Lord Diplock to restate it at all? Certainly, much time, effort and words on the part of patent practitioners generally could have been saved in the years since if Lord Diplock had refrained from making his restatement.”¹⁷

¹⁵ Leger at 234.

¹⁶ Leger at 235.

¹⁷ Reid Brian C *A Practical Guide to Patent Law* (1999) (3rd ed) at 112.

The question raised by Brian C Reid in the above passage is very important within the context of a discussion of the effect of the decisions of the Court of Appeal and the House of Lords in *Van der Lely*, *Rodi*, *Beecham* and *Catnic*. It must be remembered that in both *Van der Lely* and *Rodi* both the Court of Appeal and the House of Lords approved and applied the Upjohn LJ approach. In this dissertation it has been suggested that the dissents of Lord Evershed MR and Lord Reid in *Van der Lely* were very powerful and persuasive. Indeed, it has been suggested that they were so powerful and persuasive that Lloyd-Jacob J was persuaded by them to abandon the Upjohn LJ approach and apply the Lord Reid approach in *Rodi* in the Chancery Division despite the decisions of the Court of Appeal and the House of Lords in *Van der Lely*. It has also been suggested in this dissertation that in *Beecham* both the Court of Appeal and the House of Lords followed suit and that, ultimately, Lord Diplock significantly borrowed from the Lord Reid approach in his *Catnic* decision. If all this is correct, it must follow that the answer to Brian C Reid's question is: but Lord Diplock had abandoned the Upjohn LJ approach already in *Beecham* – long before *Catnic*! Accordingly, by the time of the *Catnic* decision, Lord Diplock could not have still thought that Lord Upjohn's enunciation was correct. By that time he had long concluded that it was the Lord Reid approach that was correct. Pendleton has expressed the view that it is the purposive characterisation of essentiality that constitutes the major departure from existing law at the time of the *Catnic* decision.¹⁸

12.3 Was the Introduction of the *Catnic* Test Necessary?

[8] It is suggested that the *Catnic* test was unnecessary and unjustified. The reasons for this proposition are the following:

8.1 in the *Catnic* judgment, Lord Diplock did not himself advance any reasons to justify the discontinuation of the doctrine of pith and marrow which had been followed by the Courts for over a century. All that Lord Diplock said was that people were dealing with the issue of liability for the infringement of patent claims as if textual and non-textual infringements were two separate causes of action. He did not in any way substantiate this statement.

¹⁸ Pendleton Michael "The Purposive Approach to Patent Construction: A Divergence in Anglo-Australian Judicial Interpretation" (June 1983) 14 *Melbourne University Law Review* 75 at 78.

8.2. to some extent the *Catnic* test seeks to do in a very complicated, confusing and roundabout way what the doctrine of pith and marrow had been doing simply, easily and in a clear manner for over a hundred years.

8.3. The *Catnic* test is confusing and has caused much uncertainty.¹⁹ In support of this proposition, the following can be said:

(a) soon after the *Catnic* decision, Hoffman J found it necessary in the *Improver* case to clarify it by giving guidance for its application. That is why Hoffmann J proposed what later became known as the Protocol questions. The need for this clarification arose because there was uncertainty about the *Catnic* decision.

(b) in Canadian patent law there are cases which used both the doctrine of pith and marrow as well as the *Catnic* test to determine liability for non-textual infringement; from this it can be inferred that the *Catnic* test caused confusion with the result that judges did not know whether the *Catnic* test replaced the doctrine of pith and marrow or whether the *Catnic* test and the doctrine of pith and marrow were mutually exclusive; or whether they could be used at the same time. Indeed, there is even a case in Canada where the Court said that there is no real difference between the *Catnic* test and the doctrine of pith and marrow.

(c)(i) In South Africa the *Catnic* test gave rise to a huge debate and confusion about, among other things, its relationship with the doctrine of pith and marrow.²⁰

(ii) In South Africa the case that seems to be the best example of the confusion about the role and place of the *Catnic* test, particularly in

¹⁹ Annand thinks that the *Catnic* test achieves a reasonable degree of certainty for third parties but not always fair protection for the patentee now required in the UK by the Protocol (Annand at 52).

²⁰ See Visser Coenraad “The Interpretation of Patent Claims: A chronology of the Vicissitudes of the Pith and Marrow Doctrine and the Doctrine of Purposive Construction in the Appellate Division” in *The Quest For Justice: Essays In Honour Of Michael McGregor Corbett* (1995) 328 at 334-341; see also Burrell TD *Burrell’s South African Patent and Design Law* (1986) at 256 pars 5.15-5.27 at 271.

relation to the principles of construction is *Nampak Products*.²¹ The Supreme Court of Appeal is the highest court in the land in patent cases. In that case it held that the principles of patent construction set out in *Gentiruco*²² which were the principles that applied prior to the adoption of the *Catnic* test in South Africa – still applied after the adoption of the *Catnic* test. Furthermore, in the *Nampak* case the Court said that purposive construction applied as an interpretive aid when in fact purposive construction is applied to determine the essential integers of a patent claim.

(iii) in *Triomed*²³ the Supreme Court of Appeal, through Nugent JA, expressed the view that, to the extent that in *Nampak Products* it had been suggested that purposive construction might be invoked only to construe an ambiguous claim, this was wrong. In the *Triomed* case the Supreme Court of Appeal said that “(w)hile the claim must be construed to ascertain the intention of the inventor as conveyed by the language he has used (*Gentiruco AG v Firestone (Pty) Ltd* 1972 (1) SA 589 (A) at 614 B-C) what is sought by a purposive construction is to establish what were intended to be the essential elements or the essence of the invention, which is not to be found by viewing each word in isolation but rather by viewing them in the context of the invention as a whole”.

(iv) in *Vari-Deals*,²⁴ the Supreme Court of Appeal said, through Hurt AJA, that “*Catnic* did not change the law relating to construction ...”.²⁵ In support of this proposition the Supreme Court of Appeal referred to the *Kirin-Amgen* decision of Lord Hoffmann²⁶ and quoted a passage from that paragraph. That passage does not support the proposition for which reference to it was made.²⁷

²¹ *Nampak Products Ltd and another v Man-Dirk (Pty) Ltd* 199 SA.

²² *Gentiruco AG v Firestone SA (Pty) Ltd* 1972 (1) 589 (A) at 613D-618G.

²³ *Agtiebolaget Hassle and another v Triomend (Pty) Ltd* 203 (1) SA 155 (SCA).

²⁴ *Vari-Deals 101 (Pty) Ltd t/a Vari-Deals v Sunsmart Products (Pty) Ltd* 2008 (3) SA 447 SCA.

²⁵ *Vari-Deals* at par 11.

²⁶ It referred to a passage at 77 of Lord Hoffman’s speech in *Karin-Amgen*.

²⁷ *Triomed* at par 9.

- (v) although in *Sunsmart Products*,²⁸ the Supreme Court of Appeal, through Streicher JA, pointed out in paragraph 13 that it was well settled that the claims in a specification should be given a purposive construction so as to extract from them the essence or the essential elements of the invention, the Court decided the infringement of claims with absolutely no reference to the patentee's intention as understood by a person skilled in the art and with no reference whatsoever to how a person skilled in the art would have understood the claims. What Streicher JA did was to decide the case on the basis of his own understanding of what the patentee used the wording of the claims to mean instead of deciding it on the basis of what a person skilled in the art would have understood the patentee to have intended. In other words Streicher JA paid lip service to purposive construction and the *Catnic* test which that Court had adopted. Indeed, an examination of the Supreme Court of Appeal's judgment in *Sunsmart Products* reveals that in reality purposive construction as advocated in *Catnic* was not applied at all by the Court in that case.
- (d) In so far as the basis for the rejection and abandonment of the "pith and marrow" doctrine was that it undermined the statutory requirement that a patentee should clearly and distinctly set out his invention in the claims in that the doctrine extended the patentee's monopoly beyond the terms of his claims, it seems that those who take that view expect the impossible from patentees; they expect patentees to write for every conceivable eventuality when they formulate their claims – something that is an impossibility; it is recognised that Parliament cannot cover every eventuality when it drafts legislation. That is why courts interpret legislation to deal with different eventualities. The position is no different in respect of the doctrine of pith and marrow. At any rate the doctrine of purposive construction is also subject to the same criticism because in certain circumstances it also entails the adoption of an interpretation that

²⁸ *Sunsmart Products (Pty) Ltd v Flag and Flagpole Industries (Pty) Ltd t/a National Flag* 2007 BIP 44 (SCA).

extends the scope of legislation or document beyond the literal terms thereof. A good example hereof is to be found in Lord Diplock's judgment in *Kammins Ballrooms*.²⁹ The doctrine of pith and marrow was adequate to deal with the determination of non-textual infringement of patents. That is why even in *Beecham* in the House of Lords and *Catnic* in the Court of first instance, Lord Diplock and Whitford J, respectively, used the doctrine of pith and marrow to determine non-textual infringements. Accordingly, the introduction of the *Catnic* test was not necessary.

12.4 Conclusion

[9] Having highlighted the commonality of various features and statements between, on the one hand, Lord Reid's and Lord Pearce's speeches and, on the other, Lord Diplock's judgments in *Beecham* and *Catnic* – after the decisions of the Court of Appeal and the House of Lords in both *Van der Lely* and *Rodi* which followed the Upjohn LJ approach – the conclusion is inescapable that, after the *Rodi* decision of the House of Lords, Lord Diplock turned his back on the Upjohn LJ approach. Having done so, the question arose as to what approach should be adopted. It is suggested that it would have been very difficult for him to boldly announce that the Court of Appeal and the House of Lords had both been wrong in the approach they had adopted in *Van der Lely* and *Rodi*. He had been part of that approach. He could also not boldly announce that the Lord Reid approach as reflected in Lord Evershed MR's dissent, Lord Reid's dissents and Lord Pearce's dissent in both cases had been right. It seems that initially Lord Diplock decided to apply the Lord Reid approach in *Beecham* without saying much about this turn. However, when it came to *Catnic*, he must have thought that he should find a way for the House of Lords to get itself out of the legal quagmire in which it had placed itself. It had to rectify the position and abandon the Upjohn LJ approach without losing face. It so happened that these developments occurred at a time in English law when there was a move away from literalism in the interpretation of statutes and other legal documents.³⁰ In 1971³¹ Lord Diplock had called for the adoption of purposive

²⁹ *Kammins Ballrooms Co LTD v Zenith Investments (Torquay) LTD* (1971) All ER 850 (HL).

³⁰ See a discussion on this in *Equity Aviation Services (Pty) Ltd v SATAWU and others* (2009) 30 ILJ 1997 (LAC) at 2015 I-2021 F; or pars 47-63.

construction of statutes and other legal documents. It seems that he considered that the adoption of purposive construction in the construction of patents would enable the House of Lord to take much of Lord Reid's approach and turn its back on the Upjohn LJ approach without having to credit him for it as it would be seen as features of the purposive construction and, therefore, the *Catnic* test that the House of Lords would advocate in its decision.

[10] This is how English patent law came to have the *Catnic* test replacing the doctrine of pith and marrow in the determination of non-textual infringement of patents. It is suggested that Lord Evershed's, Lord Reid's and Lord Pearce's dissents provided an important contribution even though they were not credited for it. Lord Diplock should have acknowledged the help he derived from those dissents, particularly Lord Reid's dissents. It is a pity that he did not do so.

³¹ See *Kammins Ballrooms Co Ltd v Zanith Investments (Torquay)* [1971] 2 All ER 850 (HL).

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