

## ORIGINAL CIVIL

Before Gregory J.

INDIAN VACUUM BRAKE Co., Ltd., *In re.*

*v.*

E. G. LUARD.\*

1925

July 14.

*Patent, revocation of—“Utility”, “Novelty”, “Invention”, meaning of—  
Patent and Designs Act (II of 1911), s. 26.*

An application for revocation of patent granted to the respondent was made on the ground (i) that it was of no utility, (ii) that it was not a new invention, and (iii) that it was anticipated by another patent. It was proved at the trial that in no respect was the patent an improvement on or more useful and better than the petitioner's design and that there was nothing new, in the sense of novelty, in the patent and it disclosed no invention. Furthermore, that in material features, the patent was anticipated by another patent :—

*Held*, that in these circumstances, the patent granted to the respondent should be revoked.

*Young v. Rosenthal* (1), *Harwood v. G. N. Ry.* (2), *Rickmann v. Thierry* (3), *Blakey v. Latham* (4) referred to.

THIS was a petition under section 26 of the Patent and Designs Act (II of 1911) for the revocation of a Patent granted to the respondent on the 21st March 1922 by the Controller of Patents and Designs, Calcutta. The case was tried with the aid of an assessor.

The petitioners were the Vacuum Brake Co., Ltd., who carried on business in the manufacture and sale of vacuum brake fittings for railway locomotives and rolling stock. The respondent was an

\* Ordinary Original Civil Jurisdiction

(1) (1884) 1 R. P. C. 29.

(3) (1896) 14 R. P. C. 105, 121.

(2) (1865) 11 H. L. C. 654, 682.

(4) (1889) 6 R. P. C. 184, 187.

Engineer and was a Director of the Consolidated Brake and Engineering Co., Ltd., manufacturers of vacuum brakes.

The petitioners alleged that in accordance with two designs developed and adopted by them and known in their business as No. 14153 and No. 14678, they imported and sold in British India since 1910 many vacuum brake cylinders with the valve chamber mounted on the inner side of the piston and the said design and methods of construction had been published and become publicly known in British India. The petitioners further alleged that Letters Patent granted to one Joseph Robert Hardy (being British No. 5864 of 1905) also described a similar method of construction and was publicly known and published in British India, and vacuum brakes, according to that patent had been publicly used in British India. The respondent made an application for a patent in England on the 21st February 1922 (being No. 5099 of 1922) and the sealing of such patent was opposed by the petitioners. An exactly similar application was made in British India on the 21st March 1922 and accepted on the 11th June 1922 and a Patent in terms thereof was subsequently granted to the respondent (being No. 8018 of March 21, 1922.)

The petitioners stated that the invention in respect of which the patent was granted in British India was in no wise novel at the date of the same and was of no force and validity. The petitioners had publicly manufactured in England and sold in British India to various railway companies vacuum brakes constructed substantially according to the alleged invention subsequently patented by the respondent as aforesaid. The petitioners claimed that the alleged invention had already been anticipated

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by the aforesaid designs used by the petitioners as also by specification No. 5864 of which they were the assignees, and submitted that the patent should be revoked on the following grounds: (i) that no part of the alleged invention was new; (ii) that the respondent knowingly included in his specification something which was not new; (iii) that the alleged invention was of no utility; and (iv) that the grant of patent to the respondent would materially affect the petitioner's extensive business.

In answer to the petition, an affidavit was filed on behalf of the respondent in which it was *inter alia* alleged that the essential features of the patent No. 8018 were entirely different from the patents referred to in the petition, that the application for revocation of the patent was *mala fide* and malicious, and that the petitioners well knew that the said patent No. 8018 was a new patent containing novel designs and that the same was a new invention and it was submitted that the prayer for revocation of patent No. 8018 should be rejected.

*Mr. S. N. Banerji* (with him *Mr. A. K. Roy*), for the respondent. There were two points for determination: (i) was it useful (ii) was it new? It was admitted by the petitioner's own witness that the respondents' combination of valve-ball was just as useful as the petitioner's design. It was well settled that a slight amount of utility would be sufficient to support a patent. Referred to Frost on Patent Law (4th Edition), p. 161. The evidence showed that it was an *improvement* as it had got a less number of parts than the petitioner's design and amounted to an *invention*. Consequently it was patentable. It was submitted that as the respondent's combination gave the public a useful choice between two things which

did the same work, it was patentable. Referred to Fletcher Moulton on Patents (1913), page 79.

*Mr. P. N. Chatterji* (with him *Mr. C. Bagram*), for the petitioners. There were two fallacies underlying the arguments on behalf of the petitioners. First, it was thought that the word "use" meant utility and that because witnesses had admitted that the respondent's design was just as useful as the article manufactured by the petitioners, therefore the respondent's design must be patentable. In Patent law the term 'useful' meant "of more use than what had gone before" and unless an alleged invention proved itself to be more useful than what had gone before, no patent would be granted. *Young v. Rosenthal* (1) *Welsbach v. New Incandescent Co.* (2). Secondly, it was thought because the respondent's article was a kind of new combination, therefore it was patentable. It was not every novelty which was useful that could be the subject matter of a patent. To be patentable, the novelty must show invention. *Harwood v. G. N. Ry. Co.* (3); *Rickmann v. Thierry* (4), *Blakey v. Latham* (5), *Longbottom v. Shaw* (6). There was no invention in the respondent's article. In considering whether a new article was an invention, it was important to consider whether the new article produced a result never obtained before or produced an old result in a better or cheaper way or merely furnished a useful variant for obtaining the old result. In any of these cases, the article might be patentable but the Courts are more apt to find invention in an article which produced a result never obtained before or which produced a better or cheaper result than in

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(1) (1884) 1 R. P. C. 29.

(2) [1900] 1 Ch. 843.

(3) (1865) 11 H. L. C. 654 ; 682.

(4) (1896) 14 R. P. C. 105.

(5) (1889) 6 R. P. C. 184 ; 187.

(6) (1891) 8 R. P. C. 333.

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one which merely furnished a more useful variant. Referred to Fletcher Moulton on Patents (1913), p. 37.

*Cur. adv. vult.*

GREGORY J. This is a petition under section 26 of the Patent and Designs Act (II of 1911) for the revocation of a patent granted to the respondent on the 21st March 1922 by the Controller of Patents and Designs, Calcutta. At the request of the parties this case has been tried with the aid of an Assessor, Mr. A. H. Thackwell, Works Manager, East Indian Railways Carriage and Wagon Workshops, Lillooah, and I desire to acknowledge his assistance to me. The petitioner is the Vacuum Brake Company, Limited, who carry on business in the manufacture and sale of vacuum brake fittings for railway locomotives and rolling stock. The respondent is an Engineer and is a Director of the Consolidated Brake and Engineering Company, Limited, manufacturers of vacuum brakes. The petitioner for many years, in the business of the Company, imported from the factory in England and sold in British India, vacuum brake cylinders described as having the valve chamber mounted in the inner side of the piston according to two designs, No. 14153, dated 2nd November 1909 and No. 14678, dated 23rd April 1910. These designs were published, and have been publicly known in British India since 1910. The petitioner also claims to be the assignee of a patent known as "Hardy's Patent" being British Letters Patent No. 5864 of 1905, This also was publicly known, and published in India, and vacuum brake cylinders according to that patent have been publicly used in India.

On the 21st February 1922, the respondent applied for and obtained in England a patent relating to

the pistons of vacuum brake cylinders identical with the one in the present suit. That patent was No. 5099 of 1922. On appeal however by the present petitioner, the patent 5099 was cancelled on the 31st July 1924, by the Solicitor-General, who held the view that it disclosed no invention. In the meanwhile, on the 21st March 1922, the respondent had applied in Calcutta to the Controller of Patents for a patent of the same device. The application was opposed by the petitioner, but it was accepted on the 11th June 1922, and Patent No. 8018, dated the 21st March 1922, the subject matter of the present suit was granted. On the 10th December 1923, the respondent applied to the Patent Office in Calcutta for an amendment of his specification No. 8018, of 21st March 1922. The amendments asked for were allowed subject to the insertion of a disclaimer in the specification relating to British specification No. 5864 of 1905, and in consequence of this, the present proceedings were instituted for a revocation of the Patent.

The specification relating to Hardy's patent is marked as exhibit A in this case, and the drawings show some examples of forms of construction of the invention. Specimens of the petitioner's design 14153 of 1909 and 14678 of 1910 are marked C and D respectively. The only difference between these two lies in the method of attachment to the vertical wall of the piston. The respondent's specification 8018 accompanied with the drawings is marked F.

I think there can be no doubt that both in the working principle and general character of construction, the petitioner's designs and the respondent's patent are founded on Hardy's patent. It is material in the present case to observe that the ball valve in this patent of 1905 is attached to the

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inner wall of the piston, and Fig. 2 shows a removeable seating at the bottom of the valve. If the nuts are removed from the bolt, the ball seat below and the ball come away. The ball can be let in either from above or below, and in the type shown in Fig. 4, from the side.

In the respondent's patent the ball valve, as it is in Hardy's patent, is attached to the piston wall inside the cylinder. The valve consists of the body with the screw plug underneath and the ball inside the body rests on the plug which is put in position from below, and which is removeable by unscrewing it. So both in Hardy's patent and in the petitioner's design the ball rests on a removeable seating. Exhibit E is a model which has been used in this case to show the general character of the construction and principle of the respondent's ball valve. It is not an exact model, but it shows the principle. Later, during the case, a specimen of the respondent's ball valve in section, was secured by Mr. Thackwell, the Assessor, and at the request of the respondent's counsel it was marked as exhibit I.

The petitioner's design C and D as already stated are identical. Type C is attached to the inner wall of the piston by two studs and nuts and type D is attached to the inner wall of the piston by the valve being screwed in. The ball valve consists of the valve body, the ball seating which is screwed in; the ball which is contained in a small cage, and a screw plug which closes the top of the body. It has been proved, and it is not disputed that the petitioner's ball valve type, exhibit D, has been in use on Indian Railways many years and long prior to the grant of Patent 8018 to the respondent, and the present application for a revocation of that patent is made on the ground that it is of no utility and

that it is not a new invention, within the meaning of the patent law. The patent is also attacked on the ground that it was anticipated by Hardy's patent. It is important, therefore, to see the interpretation placed by the Courts on the terms "utility", "novelty" and "invention".

The cases show that in patent law the term "utility" is used, not in the abstract, but in a very special sense. Mere usefulness is not sufficient to support a patent. In the case of *Young and Neilson v. Rosenthal & Company* (1), Grove J. in charging the jury described "utility" as meaning an invention better than the preceding knowledge of the trade as to a particular article. As to the meaning of "novelty" and "invention", Lord Westbury in the case of *Harwood v. Great Northern Railway* (2), said "you have a patent "for a well mechanical contrivance merely when "it is applied in a manner or to a purpose, which "is not quite the same, but is analogous to the "manner or to a purpose in or to which it has been "hitherto notoriously used". In citing this rule in *Rickmann v. Thierry* (3) Lord Davey said: "It is "not enough that the purpose is new or that there is "novelty in the application, so that the article produced is in that sense new, but there must be some "novelty in the mode of application. By that I "understand that in adopting the old contrivance to "the new purpose, there must be difficulties to be "overcome, requiring what is called invention, or "there must be some ingenuity in the mode of making "the adaptation" and Cotton L. J. in *Blakey v. Latham* (4) laid down that to be new in the patent sense, the novelty must show invention: see also Fletcher Moulton on Patents, p. 21.

(1) (1884) 1 R. P. C. 29.

(3) (1896) 14 R. P. C. 105, 121.

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Three witnesses have been called on behalf of the parties, Mr. Cook, a District Carriage and Wagon Superintendent on the Bengal-Nagpur Railway, and Mr. Remfry, an Engineer and Patent Agent, on behalf of the petitioner, and Mr. Bwye, an Engineer in the employment of the Consolidated Brake and Engineering Company, Limited, on behalf of the respondent. Mr. Luard is a Director of this company and was the Managing Director when Mr. Bwye came out to India in 1923. The evidence of Mr. Cook and Mr. Remfry, generally speaking, is to the effect that they cannot find anything new in the respondent's ball valve or any improvement on that of the petitioners. It is common ground that the principle is the same, and the valves function exactly alike. Mr. Bwye says that the essential difference between the two is the simplicity of the respondent's ball valve which has fewer parts; the ball seat being combined with the plug. I do not think that this in itself is enough to support a patent. Many cases are collected in Fletcher Moulton on Patents, p. 39, where it is stated that patents for making in one piece, articles, previously made in two or more pieces, have generally been held invalid. I have been unable to see what advantage results from this and I cannot regard it as an invention. Mr. Luard, in an affidavit that has been referred to, says in paragraph 4, that his patent differs from the petitioner's designs in two features which are claimed by him to be of great value. One of these features is that the valve seat can be removed without first removing the ball and that upon removing the valve seat for the purpose of inspection, cleansing or removal, the ball is simultaneously removed. The first part of this statement suggests that the ball can be left in the valve chamber after the valve seat has been removed. As a matter of fact it cannot. As soon as the ball seat

is removed, the ball falls out, and the latter portion of Mr. Luard's statement shows that this is so. In my opinion there is no substance in the point made. For the purpose of inspecting or cleaning the valve seat, in Mr. Luard's design, the screw plug underneath is removed and the ball falls out; and in the petitioner's construction the screw plug at the top is removed and the small cage containing the ball is taken out. Even for the purpose of grinding the valve seat, which is done according to Mr. Cook about once in five years, and according to Mr. Bwyne once every year, it is not necessary for the valve seat in the petitioner's construction to be taken out. The overhauling of the ball valve is so occasional, that if Mr. Luard's design showed any greater convenience, which I have been unable to find, it would not be one of any value. The other feature claimed to be valuable is that the ball is properly located within the valve chamber without the provision of a cage which Mr. Luard says may possibly be omitted when replacing the parts. As there is no greater likelihood of the cage not being replaced than there is of the ball not being replaced in the chamber in Mr. Luard's construction there is no substance in the advantage he claims inferentially for his own design. Mr. Luard is mistaken if he suggests that the cage is necessary to keep the ball in position. The evidence of Mr. Cook and Mr. Remfry shows that the absence of the cage would make no difference to the working of the valve, for the ball must come into position as soon as the screw-plug at the top is screwed down properly. The cage is merely a convenient receptacle for the ball which is taken out simply by lifting out the cage. In this connection Mr. Luard has made a statement in his amended specification to which exception has, and I think justly, been taken. Referring to the

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petitioner's construction Mr. Luard says "in removing the screw plug the ball must be removed with some difficulty". If Mr. Luard had seen a specimen of the petitioner's ball valve, it should have been patent to him that the ball comes away in the cage, and that his statement was misleading. With reference then to the special features in patent 8018 mentioned by Mr. Luard, I am unable, for the reasons I have given, to take his view of their value. From the point of view of convenience, it has been said on behalf of the petitioner that it is much easier to get at the screw plug when placed at the top of the ball valve, as in the petitioner's designs, than when it is placed underneath and is practically unseen, as in patent 8018. Both Mr. Cook and Mr. Remfry say this, but Mr. Bwye thinks it is equally easy in either case. Such judgment I am able to form on this particular point does not lead me to agree with Mr. Bwye. There is one more point in Mr. Bwye's evidence I shall refer to before stating my conclusions in this case. He says that welding the ball valve after it has been fixed, to the piston wall, eliminates a possible source of leakage of air at the place of attachment. I do not think it can be contended that there is any invention in this. Mr. Bwye concedes there is no novelty in welding, and there can be no question that welding could be applied equally well in the case of the petitioner's ball valves if it were considered an advantage. The possible consequences, however, of fixing the ball valve in the manner described by Mr. Bwye preparatory to the welding, have been criticised as serious. Mr. Bwye says that the ball valve is attached to the vertical wall of the piston by drilling a hole in the piston wall to receive the turned portion of the valve, and, as the hole is drilled smaller than the turned

portion of the valve, it is necessary to drive the valve into position by the use of a hammer, after which the welding is done. When at the Assessor's instance he was asked what would happen if a considerable degree of force were used, he said this would not be permitted; but that if a considerable degree of force was used, there would be every likelihood of injuring the piston wall. Mr. Bwye's evidence further shows that if for any cause it became necessary to remove the valve body, the welding would have to be chipped away by hammer and chisel and the ball valve driven out and the effect of his evidence is that there would be some slight damage to the inside of the piston wall, but he says that it would not be material if reasonable care were used. Mr. Remfry says that injury to the piston wall would mean injury to the piston itself. Mr. Cook was not cross-examined on this question. The evidence altogether leaves the impression on my mind that the welding process, taken as a whole, is not unattended with danger to the piston. I do not find in Mr. Luard's specification or affidavit a claim to any speciality in the process and it does not impress me as a valuable feature of the patent.

As stated before, the evidence shows, and it is not disputed, that type D, of 1910 of the petitioner's designs has been in use on Indian Railways for many years prior to the grant of patent 8018. Mr. Cook had many years' practical experience of vacuum brakes and is well-acquainted with the construction and working of the petitioner's ball valve type D, and he is a witness unconnected in any way with the parties. He was unable to find anything new, or, from the point of view of practical utility, anything more useful in Mr. Luard's patent. After giving my best consideration to the several matters on which evidence has been given and the

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questions raised in this case with reference to both Mr. Luard's patent and the petitioner's design, I have come to the conclusion that in no respect is the patent 8018 an improvement on, or more useful or better than the petitioner's design. In my judgment, it is not, as claimed, an improved vacuum brake piston and so far as I can see there is nothing new, in the sense of novelty, in the patent, and it discloses no invention. Furthermore, in my view, in material features the patent was anticipated by Hardy's patent. Applying the principles laid down in the cases cited, I am of opinion that the patent No. 8018 of the 21st March 1922 granted to Mr Luard, the respondent, with the amended specification relating thereto, ought to be revoked, and I give judgment accordingly in favour of the petitioner. The respondent must pay the petitioner's costs in these proceedings. The Taxing Officer will on taxation fix what allowance can reasonably be made to the expert witnesses in the suit, viz:—Messrs. Cook, Remfry and Bwye for qualifying themselves for the purposes of giving evidence and also for their attendance in Court; the amount to be fixed by the Taxing Officer in his discretion. Under section 35 of the Patents and Designs Act I fix the remuneration of the Assessor at Rs. 100 per diem. This item will not be chargeable to the parties.

Attorney for the petitioners: *R. Remfry.*

Attorney for the respondent: *P. L. Mullick.*

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