

stance without stint or limitation, and thus deprive, during the continuance of the patent, the public from using what they were theretofore entitled to do, but it is also a claim for that which is of no utility, for, as before stated, unless cyanide of potassium be used in the limited manner the plaintiffs by their specification and second claim state it is to be used it brings into solution the baser metals conjointly with the gold and no beneficial result is attained. If in the specification there had but been the second claim alone—*i.e.*, for the dilute solution containing the small solution of cyanide of potassium as therein substantially described—there would not, in our judgment, have been any real difficulty in this case, and we should have been of opinion that this was a good patent; and the passage in the judgment of the Court of Exchequer delivered by Baron Bramwell in *Hills v. the London Gas-light Company*, in 5 “*Hurlston and Norman*,” at page 369, is very pertinent to this point. The learned Baron, who was dealing with a patent for the purification of gas by the operation of hydrated oxide, says this: “Then it is said that the mere application of the hydrated oxides to absorb the sulphuretted hydrogen from coal-gas is not the subject of a patent, that property of it being previously well known. With that we do not agree. The answer is that the question is not properly stated. The application of the hydrated oxide is a principle. If a man were to say, ‘I claim the use of hydrated oxide of iron for the purification of coal-gas,’ without saying how it is to be applied, it is possible the objection might be well founded, but here the plaintiff says, ‘I claim it in the manufacture of gas in the way I have described,’ and he shows how it is to be used. Therefore this objection fails.”

In our judgment the plaintiff's invention as claimed by his second claim has novelty, invention, and utility; it has not been anticipated, and it has been infringed.

The point as to disconformity when the law applicable thereto is borne in mind in our opinion comes to nothing. In the case of *Gadd v. the Mayor, &c., of Manchester*, nine patent cases, at page 529, Lord Justice A. L. Smith stated the law on this subject, and we do not restate here what he said therein.

The plaintiffs, in their provisional specifications, state the nature of their invention as being that they treat the powdered (*i.e.*, crushed) ore with a solution of cyanide of potassium till nearly all the gold is dissolved. In a provisional specification no claim is ever made by the patentee; he has not to state therein what he claims, or how he carries out his invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter with that of the complete specification which is to come thereafter may be ascertained. In the complete specification the patentee has to do much more; not only has he to state therein what his invention is, but he must particularly describe how his invention is to be carried out and performed, and what he claims, and then comes the time, applying this rule of law to the present case, for the plaintiffs to state the proportions in which they find that the cyanide of potassium is to be used in the solution to carry out their invention; and that is what they have done. We cannot hold that there is any disconformity, as argued by the defendants, assuming the specification to be read as the plaintiffs desire that it should be.

But still there remains the question as to what is the true reading of the specification with claim No. 1 in it. Sir Richard Webster argued that claim No. 1, with the words at the end, “substantially as hereinbefore described,” limited that claim to the quantity of cyanide of potassium to be used in the solution to be applied to the ore in the same way as claim 2 did, and he argued that claim 2 was inserted as being only applicable to the richer ores mentioned in the specification, and that in neither claim was the use of any solution of cyanide of potassium at large claimed. We cannot read the specification in this way. We would if we could, but we cannot do so. It appears to us that claims 1 and 2 are independent claims having application to the whole specification, the first making claim for the use of any cyanide of potassium in solution irrespective of amount substantially as therein described, and the second making claim for the use of a dilute solution containing a specified quantity of cyanide of potassium substantially as therein described. It appears to us impossible to discard either the one or the other, or to hold that both mean the same thing, or that claim 1 applies to one part of the specification and claim 2 to another; for this, in our judgment, is not the true construction of the specification as framed. If the first claim had been disclaimed or omitted, we should not have been faced with the difficulty we are, but as it is in the specification we are unable to read it as the plaintiffs desire to do; and for this reason, and for this alone, we must, with reluctance, give judgment for the defendants, and dismiss this appeal with costs.

Mr. Moulton: Your Lordships have found for the plaintiffs on the great bulk of the issues. The costs of the issues that you have found in favour of the plaintiffs will, I presume, be the plaintiffs’.

Lord Justice A. L. Smith: You ought to have all the costs about infringement.

Mr. Moulton: But about the validity on the ground of anticipation. My learned friends have got a certificate that they have proved certain anticipations and certain objections. Perhaps your Lordships would allow us to come before the Court with regard to that.

Lord Justice Lindley: What did Mr. Justice Romer do about these details?

Mr. Moulton: Your Lordships see that he gave us the costs of infringement, but he gave the defendants a certificate that they had proved their objections. Now, my Lords, the only objection that your Lordships have found proved is one based on the construction of the specification with regard to the first claim. The learned Judge in the Court below held *Simpson and Rae* to be anticipations; so I should submit that perhaps we had better come before one of your Lordships.

Mr. Neville: I will only mention this (my friend will correct me if I am wrong), that I do not know any exception to the rule laid down by the Court some time ago that, where the Court dismisses the appeal, it does not deal with the costs in the Court below.

Lord Justice Lindley: I was thinking of that.

Mr. Moulton: Your Lordships did it in the *Deeley* case.